

O-088-05

TRADE MARKS ACT 1994

**IN THE MATTER OF AN INTERLOCUTORY HEARING
IN RESPECT OF THE ACCEPTANCE OF A NOTICE OF OPPOSITION
UNDER NO. 92756
AGAINST APPLICATION NO 2340250
IN THE NAME OF RAYMOND MORRIS GROUP LTD**

TRADE MARKS ACT 1994

IN THE MATTER OF an interlocutory hearing in respect of the acceptance of a Notice of Opposition under No. 92756 against Application No. 2340250 in the name of Raymond Morris Group Ltd

Issue

1. On 24 January 2005, I held an interlocutory hearing in respect of the above proceedings. The hearing was to determine whether a valid notice of opposition had been filed against the application.
2. Having taken all the relevant material and submissions into account, I gave my decision. This was that the opposition was valid. Following the hearing, the applicant filed a Form TM5 seeking a written statement of the grounds of my decision. These I now give.

Background

3. Application No. 2340250 stands in the name of Raymond Morris Group Ltd and was published for opposition purposes on 11 June 2004.
4. On 25 August 2004, a Form TM7, notice of opposition and statement of grounds, was filed at the registry along with the appropriate fee. The form was signed by a Mr Desmond Palmer, who gave his title as "Director".
5. Once received, the form was reviewed by a registry clerk who noted that the first page of the form showed the applicant and the opponent to be one and the same company -Raymond Morris Group Ltd, represented by RM Trade Marks Ltd. The clerk made contact with Mr Palmer, on the telephone number given as a contact point on the form, to query the name of the opponent and its representative. She also queried the information given at Box 6 of the form in relation to the section(s) of the Act under which the application was being opposed. Rather than specifying which section(s) applied, the filer had simply written "Class 35, 36, 42".
6. As a result of that telephone conversation, an amended first page of Form TM7 was filed on 1 September 2004. This amended first page was again signed by Mr Palmer. It stated that the opponent was "The Company Shop" at an address in Belfast. The same details were given as the opponent's address for service. At Box 6, the grounds of opposition were given as "Sec 54A".
7. The Form TM7 as amended was then examined in accordance with registry practice. As a result, the examiner wrote to The Company Shop. The letter, dated 2 September 2004 included the following:

“Form TM7

Under Box 6 of the form you have stated that the application is being opposed under Section 54A of the Trade Marks Act 1994. This appears to be an error and should read Section 5(4)(a) of the Trade Marks Act 1994 and requires amending on the form.

Section 5(4)(a) Grounds of Opposition

In order to bring grounds of opposition under Section 5(4)(a) the Registrar requires the opponent to provide a representation of the earlier mark, sign or right. The Registrar also requires the opponent to state where the earlier right has been used and the specific goods or services in relation to which the mark has been used.

In light of the preliminary view expressed above, you are invited to file an amended statement of case, on or before 23 September 2004.”

8. On 7 September 2004 the opponent filed a further amended front page of Form TM7 showing the grounds of opposition as being under Section 5(4)(a) of the Act.

9. By way of a letter dated 13 September 2004, the Notice of Opposition (as amended a second time) was served on the applicant. A period of three months was allowed for the applicant to file its defence by way of a Form TM8 and counter-statement.

10. The applicant’s Form TM8 and counter-statement was received on 1 November 2004. In that counterstatement the applicant denied that a valid opposition had been filed. In the alternative, if it was deemed that a valid opposition had been filed in the name of Raymond Morris Group Ltd, then it withdrew that opposition on its client’s behalf. The applicant contended that a separate fee was required for each form filed. The applicant submitted that “The Company Shop” was an organisation incapable of owning property but that in the event that it was deemed that a valid opposition had been filed then the applicant requested to be heard.

11. The registry responded to the applicant in a letter dated 11 November 2004. This read:

“The Registrar has noted your comments in relation to the filing of the opposition. Following the publication of Tribunal Practice Notice (TPN) 4/2000 it is the Registrar’s practice to allow parties to amend their pleadings. In the abovementioned proceedings the form TM7 was completed incorrectly by the opponent who is a private litigant. The Registrar considers this to be a minor typographical error and as such it is a correctible formality. This error does not allow the Registrar to refuse to accept the notice of opposition as having been filed incorrectly.

I can confirm that the Registrar considers the opponent to have paid the fee for the notice of opposition in accordance with The Trade Marks Fee Rules. Again, under the provisions of TPN 4/2000 parties are provided with an opportunity to correct errors.

The Registrar has requested that the opponent should state whether or not the earlier right has been used in the United Kingdom. A period of **14 days** from the date of this letter, that is on or before **25 November 2004**, has been allowed for the opponent to provide this information.

The Registrar has noted your request for a hearing if the opposition is deemed to have been validly filed.....”

12. Also on 11 November 2004, the registry wrote to The Company Shop. This letter read:

“With reference to RM Trade Marks Limited’s letter dated 29 October 2004 and the accompanying form TM8 and counterstatement (copies of which are enclosed).

Please find enclosed a copy of the official letter dated 11 November 2004 which has been sent to the applicant in response to the abovementioned letter.

The Registrar has allowed a period of **14 days** from the date of this letter, that is on or before **25 November 2004**, in order for the opponent to clarify where the earlier right, depended upon in the claim brought under Section 5(4)(a), has been used.

The form TM8 and counterstatement has not been served and therefore the opponent’s period for filing evidence under Rule 13C(1) of the Trade Marks (Amendment) Rules 2004 has not been set.”

13. On 16 November 2004 a letter was received from the opponent confirming the opponent’s use of the mark in the UK since 1994.

14. Given the applicant’s objection to the registrar’s acceptance of the Notice of Opposition, a hearing was appointed and took place before me on 24 January 2005. At the hearing Mr Redpath represented the opponent. Mr Varney of RM Trade Marks represented the applicant. The issue before me was whether a valid opposition had been filed. Both parties filed written material prior to the hearing, the applicant in the form of skeleton argument, the opponent in letter form with attachments.

15. Having taken all relevant material and submissions into account, I gave my decision which I confirmed later that day, in writing, as follows:

“I had the benefit of written arguments and, after considering these and the submissions made by both parties I gave my decision. This was that the opposition was valid. I indicated that the incorrect name appearing on the original Form TM7 was an obvious error that was capable of correction. There were subsequent errors before the office which should be corrected under the provisions of Rule 66 of the Trade Marks Rules 2000 (as amended).

Having reached this decision, I allowed the opponent a period of 7 days to file a further replacement Form TM7. This document should set out the correct information as has already been provided in a number of separate documents as to the legal name of the proprietor and the full grounds of the attack. I

would recommend that the document be sent by fax to the number given above. Once received and processed by the Registry, I will then allow a further period of seven days for the applicant to advise whether it wishes to amend its counterstatement.

Having reached this decision, I then heard submissions in relation to the costs of today's hearing. Having done so, I determined that the opponent should pay costs to the applicant in the sum of £300."

Submissions

16. Both parties filed extensive written materials prior to, and made oral submissions at, the hearing. However, before I proceed to deal with the issue of whether a valid opposition had been filed, I take the opportunity at this point, to mention another issue that arose at the hearing.

17. During his submissions, Mr Redpath said that if he needed to take legal advice, it would be necessary to adjourn the hearing. Mr Varney did not agree that Mr Redpath should be allowed further time to seek legal advice. He pointed out that the hearing had originally been set for a date in early December. The parties had spoken to each other in late November and, at that time, the opponent had indicated that it wanted to take legal advice. For that reason, it had been agreed between them that the hearing should be delayed and a new date set.

18. Mr Redpath replied that it had not been convenient to travel to London at short notice for the hearing arranged in December and that this was why the December hearing had been postponed.

19. Whatever the reasons might have been for the hearing not taking place in December, Mr Redpath did not make a formal request to adjourn the hearing that was now underway. Indeed, he proceeded to make his submissions and, in due course, replied to those made by the applicant. As no formal request for an adjournment was made, it was not an issue for me to consider further.

20. As to submissions on the validity of the opposition, Mr Redpath explained that his company was C S Business Ltd trading as The Company Shop. His company was primarily a company registration business but trade mark work was a small supplementary part of the business.

21. Mr Redpath submitted that his company had "accidentally discovered" the application and had quickly filed an opposition to its registration. This was the first time his company had sought to file an opposition and, because the form was completed in haste, it contained typographical errors. He submitted that these errors were capable of correction.

22. Mr Redpath said his company was going through a learning process and was therefore entitled to help from the registry on the processes involved. He went on to say his company had relied on the registry's letter of 11 November 2004 which had indicated the opposition was acceptable.

23. For the applicant, Mr Varney said that material filed prior to the hearing by Mr Redpath accepted that The Company Shop was not a proper legal entity. It was, he said, clear from his skeleton argument that The Company Shop was acting as agent in a substantial number of trade mark cases and should be treated as professionals rather than a private litigant.

24. Mr Varney said that he had on file a letter from the opponent dated 3 October 2003 indicating that it would oppose this application and he queried why the opponent was saying in its written submissions that it had filed the opposition in a rush. He went on to say that the transfer of an opposition may not be allowed. As for substitution of opponent, there had been no request to amend the form and, in any event, it should not be allowed.

25. Mr Varney submitted that the requirements of section 38(2) of the Act had not been complied with. None of the forms filed had identified the opponent properly. The Form TM7 attracts a fee and separate forms require separate fees. Only one fee had been filed and it was not clear, he said, to which form the fee related. He went on to say that rights cannot exist in a vacuum and therefore the opposition should have been filed in the correct name in the first place. There was no legal entity in existence at the time of filing in these cases, he said, and this amounted to a case of the opposition having been filed in bad faith.

26. By way of reply, Mr Redpath said that his company did not act as representative in a substantial number of trade mark cases. He reiterated that the company did deal with trade mark registrations but was inexperienced. The initial filing in the name of the applicant was a mistake, but was an error which could be corrected. He submitted that his company had originally been advised by the registry to file a Form TM16 to change the name but was later told that this was mistaken advice. It was then, he said, told to file a Form TM26R but later told that it did not need to do anything. A month later it had received a letter setting out the problem. There was, he said, no malice involved nor any intent to put the opposition in the wrong name. Mr Redpath indicated that his company had relied on what the registry had told it.

The decision

27. Opposition against registration of an application is provided for under Section 38 of the Trade Marks Act 1994. It states:

“38.- (1)

(2) Any person may, within the prescribed time from the date of the publication of the application, give notice to the registrar of opposition to the registration.

The notice shall be given in writing in the prescribed manner, and shall included a statement of the grounds of opposition.

(3).....”

28. Section 38 is underpinned by Rule 13 of the Trade Marks Rules 2000 (as amended) which states:

“13 Opposition proceedings: filing of notice of opposition; s38(2) (Form TM7)

- (1) Any person may, within three months of the date on which the application was published, give notice to the registrar of opposition to the registration on Form TM7 which shall include a statement of the grounds of opposition.
- (2) Where the opposition is based on a trade mark which has been registered, there shall be included in the statement of the grounds of opposition a representation of that mark and-
 - (a) the details of the authority with which the mark is registered;
 - (b) the registration number of that mark;
 - (c) the classes in respect of which that mark is registered;
 - (d) the goods and services in respect of which-
 - (i) that mark is registered; and
 - (ii) the opposition is based; and
 - (e) where the registration procedure for the mark was completed before the start of the period of five years ending with the date of publication, a statement detailing whether during the period referred to in section 6A(3)(a)(a) the mark has been put to genuine use in relation to each of the goods and services in respect of which the opposition is based or whether there are proper reasons for non-use (for the purposes of rule 13C this is the “statement of use”).
- (3) Where the opposition is based on a trade mark in respect of which an application for registration has been made, there shall be included in the statement of the grounds of opposition a representation of that mark and those matters set out in paragraph (2)(a) to (d), with references to registration being construed as references to the application for registration.
- (4) Where the opposition is based on an unregistered trade mark or other sign which the person opposing the application claims to be protected by virtue of any rule of law (in particular, the law of passing off), there shall be included in the statement of the grounds of opposition a representation of that mark or sign and the goods and services in respect of which such protection is claimed.
- (5) The registrar shall send a copy of Form TM7 to the applicant and the date upon which this is done shall, for the purposes of rule 13A, be the “notification date”.

29. Also of relevance is rule 3 of the Trade Marks (Fees) Rules 2000 which states:

“3. The fees to be paid in respect of any matters arising under the Act, the Trade Marks Rules 2000 and the Trade Marks (International Registration) Order 1996 shall be those specified in the Schedule to these Rules; and in any case where a form specified in the Schedule as the corresponding form in relation to any matter is specified in the Trade Marks Rule 2000 or the Trade Marks (International Registration) Order 1996 that form shall be accompanied by the fee, if any, specified in respect of that matter (unless the Rules or the Order otherwise provide).”

30. In accordance with rule 13(1), in order to give notice to the registrar of an opposition to the registration of an application, a would-be opponent must file a Form TM7 which shall include a statement of grounds within three months of the date the application was published for opposition purposes. In accordance with the schedule to rule 3 of the Trade Mark (Fees) Rules 2000, the form shall be accompanied by a fee.

31. Form TM7 is one of a number of forms published by the registrar. It has, over the years, gone through a number of revisions. The latest revised version was introduced in July 2004. As well as bearing the identifier “Form TM7” it bears the title “Notice of opposition and statement of grounds”. It is a multi-paged document but the number of pages it consists of may vary depending on the grounds of attack and the number of earlier marks (if any) relied on by an opponent.

32. However many pages are filed, the published form consists of a front page which identifies e.g. the application being attacked and the parties involved along with further pages identifying the grounds of attack. Whilst each of the published pages bears the heading Form TM7 the front page makes it clear that an opponent may use extra blank sheets if there is not enough space for answers to any section. The Form TM7 is therefore a combination of any number of separate pages, the whole constituting the Notice of opposition and statement of grounds.

33. The Form TM7 filed on 25 August 2004 was filed within the three month period allowed under rule 13(1). It was accompanied by the appropriate fee. It consisted of seven pages completed by hand. The front page gave the number of the application being opposed (No. 2340250) and the applicant’s name (Raymond Morris Group Ltd). The name and address details of the opponent and the opponent’s agent were also completed however, as set out in paragraph 5 above, they indicated that Raymond Morris Group Ltd were also the opponent and were represented by RM Trade Marks.

34. Whilst Section 38 and rule 13 indicate that “any person” may file an opposition, I cannot imagine of a situation where a person would wish to go to the effort and expense of opposing his own application where alternative options to amend applications or avoid registration exist. To do so would be somewhat illogical if not perverse. It seems clear to me that in completing the details in the way described in the paragraphs 5 and 33 above, Mr Palmer made an obvious error. It is equally clear to me that entering classes 35, 36 and 42 instead of the sections of the Act under which the application was opposed, was also an obvious error.

35. Obvious errors are capable of correction and the registrar has an inherent power to do so. In the circumstances described above it appears to me that it is appropriate to allow these errors to be corrected.

36. To overcome these errors, the opponent was contacted by the registry by telephone. I was not privy to that conversation but it seems clear to me that the opponent was advised of the errors and, as a result, on 1 September 2004 filed what was intended to be corrected documentation. As set out in paragraph 30 above, the filing of a Form TM7 requires the payment of a fee. However, what was filed on 1 September 2004 was not a Form TM7 which required a fee but was merely a replacement front page for the Form TM7. That being the case, I do not consider that a separate fee was required.

37. That, of course, is not the end of the unfortunate saga, as the replacement page filed on 1 September also contained errors. The name of the opponent was given as "The Company Shop" and the opposition was said to have been based on Section 54A of the Act.

38. Dealing with the latter point first, it seems to me that as the Act does not contain a Section 54A and, given that other pages of the Form TM7 clearly indicated that the opposition was based on Section 5(4)(a) this was also an obvious, if relatively minor, typographical error which the opponent should be allowed to correct. By way of the official letter dated 2 September, the opponent was invited to amend this particular error and later did so.

39. As to the name of the opponent, The Company Shop is a trading name of C S Business Ltd and not a legal entity in its own right. The opposition should have been filed in the name of the legal entity and not in its trading style. It is clear that the opponent asked the registry for advice on how to change the name. As I indicated earlier I was not party to the telephone conversations between the registry and the opponent but it is clear, both from Mr Redpath's submissions (which were not challenged by the applicant) and from the registry file, that there was some sort of misunderstanding and the opponent was given advice on procedure which was not accurate and that the opponent acted on that advice. In my opinion, this is an irregularity in procedure.

40. There was a further irregularity in that the Form TM7 and Notice of Opposition did not contain full details of the use of the rights relied on by the opponent. As a result of the examination of the pleadings, the registry requested these details and these were given by the opponent in a separate letter.

41. The rules allow for correction of irregularities. Rule 66 states:

"66. Subject to rule 68 below, any irregularity in procedure in or before the Office or the registrar, may be rectified on such terms as the registrar may direct."

42. In order to rectify these errors and in an effort to ensure that both parties and the registrar had one complete set of correct documentation, my decision was that the opponent should file a replacement Form TM7 within seven days of the hearing

containing all the correct information that had previously been supplied in any number of separate documents, all of which had been filed within the three month period allowed for filing opposition.

Costs

43. Mr Varney submitted that there had been a “tremendous” amount of extra work caused. Skeleton arguments had been provided and attendance at the hearing was made. The opponent was not a private litigant. Mr Varney submitted that costs on an indemnity basis were justified.

44. For his part, Mr Redpath conceded that the forms had been filled out incorrectly and that the paperwork had not been checked properly but he insisted that his company was a professional set-up though it was inexperienced in trade mark matters. His company had been happy to reduce costs and have a hearing by telephone but Mr Varney had insisted on a face to face hearing. His company had spoken to the registry about the opposition, had relied on the advice given and thought that it didn't need to examine things that closely and so wouldn't have needed to file replacements.

45. I accept that the opponent may not be experienced in dealing with opposition actions before the registrar. But the opponent's own headed paper indicates that it provides trade mark registration services. It seems to me that opposition is a fundamental feature of the trade mark registration process. The opponent chose to file opposition and, for whatever reason, decided to handle the process itself. Whilst any person, whether a professional representative or private litigant and whether experienced or otherwise, is entitled to expect advice from the registrar, that advice will be on procedural matters only and cannot enable anybody to abrogate its own responsibilities.

46. The initial filing of opposition in the incorrect name was not a minor error but was an obvious one and because of this I have found it to be capable of correction. But the fact remains that the error was the fault of the opponent. Further errors have compounded the situation and led to a situation where a hearing was requested by the applicant as it was entitled to do. The applicant has been put to expense and inconvenience and is entitled to an award of costs. I therefore ordered the opponent to pay the applicant the sum of £300 as a contribution to its costs.

Dated this 31st day of March 2005

ANN CORBETT

**For the Registrar
The Comptroller-General**