

O/1072/23

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3799875
BY JOHN MYLAND LIMITED
TO REGISTER THE TRADE MARK:**

NATURE PAINT

IN CLASS 2

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 437978
BY STUART ROSS RHIND HARLING**

Background and pleadings

1. On 16 June 2022, John Myland Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in respect of goods in class 2. The applicant is professionally represented by Briffa.
2. On 12 December 2022, Stuart Ross Rhind Harling (“the opponent”) initially filed a Form TM7. However, this was deemed inadmissible by the Tribunal and after several amendment attempts an interlocutory hearing was convened on 20 September 2023. The opposition was brought against all the goods of the application on the basis of sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opponent represents himself, and is, therefore, a litigant in person.
3. At the interlocutory hearing it became apparent that Mr Harling at the time of the opposition did not own the earlier trade mark relied upon, nor did he have any goodwill in that trade mark. Consequently, I issued a letter dated 29 September 2023 and directed the following:

“(1) The opposition is struck out in its entirety

As identified and discussed at the hearing Mr Harling is not the trade mark owner, i.e. the proprietor of the earlier trade mark. The owner of the trade mark is Nature Paint Ltd. Mr Harling confirmed at the hearing that he stepped down in 2012 as director on health grounds, and because he did not agree with the strategy of the company. He clarified that subsequently a principal investor had taken over the company. Mr Harling, very honestly, explained that the goods under the mark were since sold by the primary investors of Nature Paint Ltd and not himself. Therefore, Mr Harling has no authority to bring an opposition claim under section 5 grounds on the basis of the earlier trade mark. Further, as Mr Harling himself has not been using the mark, he does not have any goodwill in the earlier right to bring a claim under section 5(4). Therefore, Mr Harling has no authority to bring an opposition claim under section 5 grounds on the basis of the earlier trade mark. As such, the opposition is struck out in its entirety.

For clarity this is in accordance with The Trademark (Relative Grounds) Order 2008, which states:

“Refusing to register a mark on a ground mentioned in section 5 of the Trade Marks Act 1994

2. The registrar shall not refuse to register a trade mark on a ground mentioned in section 5 of the Trade Marks Act 1994 (relative grounds for refusal) unless objection on that ground is raised in opposition proceedings by the proprietor of the earlier trade mark or other earlier right.”
(My emphasis added)

4. I observe that the letter dated 29 September 2023 did not contain an explicit notice to the parties informing them of their right to appeal.
5. Subsequently, the opponent wrote to the Tribunal to highlight section 3 grounds that he thought were relevant to his position. He communicated his surprise that these grounds had not been considered at the interlocutory hearing and asked for them to be considered.
6. Addressing the issue of why section 3 grounds were not raised at the interlocutory hearing, this is because they were never pleaded within the Form TM7. The onus is on the opponent to set out all the grounds on which it wishes to rely within the Form TM7. Therefore, as they were not pleaded, they were not considered.
7. My direction as communicated in the official letter dated 29 September 2023 still stands.
8. Should the parties wish to appeal, they have 21 days from the date of this decision.

Dated this 13th day of November 2023

S Wallace

For the registrar