

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK
APPLICATION No. 2240731
IN THE NAME OF ANDREW CHARLES FREEMAN**

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER No. 51838
BY EUROPEAN BATTERY COMPANY LIMITED**

**AND IN THE MATTER OF AN APPEAL BY THE APPLICANT
TO THE APPOINTED PERSON
AGAINST THE DECISION OF DR. W. J. TROTT
DATED 11 OCTOBER 2002**

DECISION

Request for referral to the court

1. On 9 April 2003, I heard a request by Andrew Charles Freeman (“the Applicant”) under section 76(3) of the Trade Marks Act 1994 (“TMA”) and rule 64 of the Trade Marks Rules 2000 (“TMR”) to transfer this appeal to the High Court. At the conclusion of that hearing, I refused the Applicant’s request for reasons that I would detail in my written decision.
2. The appeal is brought by the Applicant against the decision of Dr. W. J. Trott, the Hearing Officer acting for the Registrar, dated 11 October 2002. In that decision, Dr. Trott upheld the opposition by European Battery Company Limited (“the Opponent”) under section 5(4)(a) of the TMA to Application No. 2240731 for registration of the trade mark EBC in Classes 7, 9 and 12 in respect of batteries. The Applicant contends in the notice of appeal lodged on 8 November 2002 that the Hearing Officer erred in his application of the law of passing off for the purposes of section 5(4)(a) and as a consequence incorrectly approached the evidence before him.
3. The reasons for the Applicant’s request that the appeal be referred to the High Court are set out in a letter from Messrs. A.A. Thornton & Co., the Applicant’s trade mark attorneys, to the Registrar dated 27 January 2003 (Attachments not included):

“The written decision in the above proceedings was dated 11 October 2002, i.e. a Friday, and so the Trade Marks Registry letter notifying us of the Appeal period did not reach us until 14 October 2002, i.e. a Monday. The official letter of 11 October 2002 set a deadline for

Appeal to either the Appointed Person or the Court of 8 November 2002. A copy of the official letter of 11 October 2002 is attached as Attachment 1.

On 1 November 2002, an extension of time request was submitted on behalf of the Applicant. A copy of this request is attached as Attachment 2. The contents of this request are self-explanatory, but the crux of the matter was that delays had been encountered in securing Counsel's opinion since the Registrar's decision was not received until after a weekend placed at the beginning of the Appeal period. Instructions were sent promptly to Counsel following report of the Registrar's decision to the Applicant, but Counsel was involved in a number of other matters and was so unable to provide an opinion until the date of the request for an extension of time. Added to this, the representative of the Applicant at this firm was due to be absent from the office in the last week of the Appeal period, as was the Applicant himself who would need to give instructions concerning any Appeal. Notwithstanding these genuine reasons for requiring an extension of time, the Registrar refused to grant an extension and a copy of this refusal is attached as Attachment 3.

As a result of the Registrar's refusal to grant an extension of time, an Appeal to the Appointed Person was lodged by the due date of 8 November 2002 in order to protect the Applicant's position, even though the Applicant's definitive instructions could not be taken due to absence of the Applicant in advance of the Appeal deadline.

Upon the return of the Applicant from his absence from the office, the Applicant instructed that he would prefer the appeal to be heard by the Court rather than by the Appointed Person. Various telephone discussions followed between the Trade Marks Registry Law Section and our Mr. Goodenough, resulting in advice from the Law Section that we should seek a further extension of time for withdrawal of the Appeal to the Appointed Person and re-filing of the Appeal before the Courts. Our letters of 12 November and 15 November 2002 refer to the second request for an extension of time and copies are attached as Attachment 4.

The second request for an extension of time was also refused as can be seen from the attached copy letter from the Trade Marks Registry of 22 November marked Attachment 5.

Although the opportunity to discuss the Registrar's refusal to grant an extension of time at an Interlocutory Hearing was offered, it was decided, especially in view of the two separate refusals to date of an extension of time request, that it would be more appropriate to request that the Appointed Person refer the Appeal to the Court, in the light of the above circumstances, in accordance with the discretion granted to him under Rule 64 of the Trade Marks Rules 2000.

The Appointed Person is hereby respectfully requested to consider referral of this Appeal to the Court. The Appeal papers were filed within the set Appeal period but were only addressed to the Appointed Person rather than the Court due to our inability to take our client's definitive instructions and as a result of the refusals by the Trade Marks Registry to grant any extension to the Appeal period."

4. Ms. Rachel Havard of Messrs A.A. Thornton & Co. represented the Applicant at the interim hearing on 9 April 2003. Ms. Havard is the same representative as mentioned in the letter of 27 January 2003. Pursuant to rule 57 of the TMR, I requested Ms. Havard to supply written confirmation of Messrs. A.A. Thornton's authority to file notice of appeal on behalf of the Applicant. An appropriate time limit would be communicated to her through The Treasury Solicitor following the hearing. Such written confirmation was duly provided. In the meantime I proceeded on Ms. Havard's oral assurance that I was seised of the appeal and could entertain the Applicant's request.

5. During her submissions, Ms. Havard gave further reasons why the Applicant requested transfer of the appeal to the High Court – the availability of further appeals and (in Ms. Havard's words):

“Another factor is that judges will apply passing off tests first-hand because they see passing off cases. Also the client [the Applicant] was very concerned at the opponent's use of EBC because our client had an existing interest in the automotive parts market and wanted to hit the problem as hard as possible, which is why he preferred the High Court route.”

6. Mr. T. M. Gregory of Messrs. T. M. Gregory & Co. appeared on behalf of the Opponent. He confirmed that the Opponent wished the appeal to be heard by the Appointed Person. The Opponent's reasons for contesting the Applicant's request for transfer of the appeal to the High Court were largely set out the Opponent's written representations filed on 25 February 2003. In brief they included:

- (a) The Applicant's request for transfer is in effect a request for an extension of time within which to file notice of appeal. The Registrar refused the same request on two previous occasions.
- (b) The Applicant's reasons for requesting an extension of time amount to little more than a plea that the 28-day period for filing an appeal [at that time either to the court or to the Appointed Person] was inconvenient. The Opponent queries: (i) what difference a weekend would have made to the obtaining of Counsel's opinion; (ii) the claimed pivotal role of Ms. Havard since notice of appeal was timeously filed by Mr. N. Goodenough of A.A. Thornton & Co. who, Ms. Havard confirmed, has overall control of the case; (iii) why the applicant's instructions were not obtained earlier or by telephone, fax or e-mail since there is no suggestion that his absence from the office was anything other than a routine business trip planned in advance.

- (c) A reference to the High Court would involve significantly more expense and also delay. Both are likely to be prejudicial to the Opponent's business.
- (d) The appeal raises no novel and important point of law. The Opponent additionally filed observations on the Applicant's grounds of appeal and statement of case to support the Opponent's contention that no point of general legal importance was involved.

Section 76(3) TMA

7. Section 76(3) of the TMA states;

“Where an appeal is made to an appointed person, he may refer the appeal to the court if –

- (a) it appears to him that a point of general legal importance is involved,
- (b) the registrar requests that it be so referred, or
- (c) such a request is made by any party to the proceedings before the registrar in which the decision appealed against was made.

Before doing so the appointed person shall give the appellant and any other party to the appeal an opportunity to make representations as to whether the appeal should be referred to court.”

8. I believe the correct approach to the question whether to refer was set out in the decision of Mr. Simon Thorley QC sitting as the Appointed Person in *ACADEMY Trade Mark* [2000] RPC 35 at 37 – 38 (see also *Eicher Ltd's Application*, SRIS O/273/01). Mr. Thorley in turn referred to the earlier decision of Mr. Matthew Clarke QC sitting as the Appointed Person in *A. J. and M. A. Levy's Trade Mark* [1999] RPC 358. It is convenient to set out paragraphs 9 to 15 of Mr. Thorley's decision in *ACADEMY*:

“9. The provisions of the Act providing for a right of appeal to the Appointed Person are significant in that they provide for a quick and cheap method of testing any decision of the Registrar. The fact that no appeal lies from the decision of the Appointed Person enables finality at an early date. The Act however expressly provides for appeals to the Appointed Person to be referred to the court and I have gained assistance in considering the circumstances in which the Appointed Person should refer by some observations of Matthew Clarke QC acting as one of the Appointed Persons in *A. J. and M. A. Levy's Trade Mark No. 1343470*, a decision given subsequent to a hearing on July 2, 1998.

10. In that decision, Mr. Clarke referred to the court the question of whether there was a residual discretion under section 46(1) of the 1994

Act to allow a trade mark to remain on the register in a case where there had been no genuine use of the registered trade mark and no proper reasons had been established for its non use. Mr. Clarke stated:

“At the hearing before me, Mr. J. Pennant, agent for the applicant submitted that the appeal should not be referred to the High Court. He emphasized that his client was a private individual who had deliberately elected to use the appeal procedure for the Appointed Person under section 76 of the 1994 Act so that a quick, final and relatively inexpensive decision on the matter of revocation could be obtained. If the matter were now to be referred to the High Court, that objective could be defeated since there would then be the prospect of further appeals and possible reference to the European Court of Justice, with all the attendant additional costs and delay that would involve. (It would of course be competent for the Appointed Person if so advised to refer the issue to the European Court of Justice.) Mr. Pennant stressed that there would be many new questions of law arising from the provisions of the 1994 Act and it would be appropriate that the Appointed Person should seek to deal with these as and when they arise.”

11. Mr. Clarke then went on to cite section 76(3) and continued:

“On my reading of those provisions, even if the Appointed Person himself did not consider that a point of general legal importance is involved, he may refer the appeal to the court where a request is made by either the registrar or one of the parties, after he has heard representations relating thereto. Having said that, I am firmly of the view that the power to refer under section 76 should be used sparingly, otherwise the clear object of the legislation to provide a relatively inexpensive, quick and final resolution of appeals by a specialist tribunal would be defeated. Moreover, I am of the opinion that it will normally be a matter of particular significance if the registrar requests the Appeal to be referred because he considers that it raises a point of general legal importance.”

12. In that case Mr. Clarke directed that the appeal be referred to the court because the question of residual discretion was not the subject of any authoritative guidance and because it raised an issue of wide general importance. It should be noted that he rejected an attempt by counsel to raise an additional ground for reference as follows:

“Counsel also attempted to persuade me that there was another reason why the appeal should be referred to the High Court and that was that the Hearing Officer had concluded that there had been no genuine use by the registered proprietors of the mark in respect of cigarettes. His clients wished to challenge that

decision having regard to the evidence that they had placed before the Hearing Officer. I should make it clear that I would not have decided to refer this appeal to the High Court simply to enable that point to be raised.”

13. I accept and intend to apply the principles set out by Mr. Clarke. Whilst it is not essential for a reference that a point of legal importance is identified, the power to refer should be used sparingly and I anticipate that it will be rare in the extreme that a reference is made in circumstances where a point of general legal importance cannot be identified. The attitude of the registrar is important but not decisive. The registrar’s officers have considerable day to day experience in matters relating to trade mark registrations and applications for revocation. Their views as to whether a particular point is a point of general legal importance should be given great weight.

14. So also should consideration be given to the views of the party not seeking to refer. The relative importance of cost and expense to that party should be taken into account. Where that party is a large corporate entity, the necessary cost and expense of legal advisers is, perhaps, of less significance than in the case where the party in question is an individual or a small company or partnership which has not gone and does not wish to go to the expense of employing legal advisers.

15. Finally I believe it is proper to have regard to the public interest. There are plainly two conflicting public interests. One is the public interest in having the uncertainty of a pending application for a trade mark or a pending application for revocation disposed of finally at the earliest possible date, so that not only the parties but rival traders may know the state of the Register, but, equally, there is a public interest that important points of law are decided by the higher courts.”

9. I accepted Ms. Havard’s submission that I have the power to refer even though no point of general legal importance is involved. Nevertheless, she sought to persuade me that a point of general legal importance lay here in obtaining High Court guidance on the way the Trade Marks Registry applies the principles of passing off in section 5(4)(a) cases. The courts have had several opportunities to consider the Registry’s approach under section 5(4)(a) of the TMA (see, for example, *REEF Trade Mark* [2002] RPC 387, [2003] RPC 101, CA). The Registry follows the guidance provided by Mr. Geoffrey Hobbs QC sitting as the Appointed Person in *WILD CHILD Trade Mark* [1998] RPC 455, which in turn draws on the summary of the elements of an action for passing off set out in *Halsbury’s Laws of England*, Vol. 48. I indicated that I should not be willing to refer on that ground.
10. As to the reasons for the Applicant’s request set out in Messrs. A.A. Thornton & Co.’s letter 27 January 2003, I do not believe that they amount to such a rare circumstance in which the discretion to refer under section 76(3) should be exercised. The timely obtaining of instructions as to the venue for appeal is

a matter between client and representative. I note that this did not prevent the due filing of notice to appeal. I have some sympathy with the Opponent's view that the present request is an attempt to overrule the Registrar's refusals of extensions of time within which to appeal. However, I record here for completeness that the Registrar proffered no comments on the Applicant's request to have the matter transferred to the High Court.

Conclusion

11. The Applicant's request pursuant to section 76(3) of the TMA and rule 64 of the TMR to have this appeal referred to the court is denied. A suitable date will be appointed for the appeal to be heard by the Appointed Person forthwith. The parties have agreed that the costs of this application should be dealt with along with the costs of the appeal.

Professor Ruth Annand, 30 April 2003

Ms. R. Havard (A.A. Thornton & Co.) appeared on behalf of the Applicant.

Mr. T. Gregory (T. M. Gregory & Co.) appeared on behalf of the Opponent.