

UK INTELLECTUAL PROPERTY OFFICE

The Rolls Building,
7 Rolls Buildings,
Fetter Lane,
London, EC4A 1NL

Monday, 26th February, 2018

Before:

MR. GEOFFREY HOBBS Q.C.
(sitting as the Appointed Person)

- - - - -

In the Matter of the Trade Marks Act 1994

-and-

In the Matter of United Kingdom Trade Mark Application
No. 2198456 A.A. COOPER
IP Title: TIN PAN ALLEY Words in Class 15 and Cancellation
Action 501346 by CONSOLIDATED DEVELOPMENTS LIMITED

UK Trade Mark Registration No. 2574641 A.A. COOPER
IP Title: TIN PAN ALLEY Words in Classes 16, 35, 41, 42, 43
and Cancellation Action 501349 by CONSOLIDATED DEVELOPMENTS
LIMITED

UK Trade Mark Registration No. 2311354 A.A. COOPER
IP Title: TIN PAN ALLEY Words in Class 35 and Cancellation
Action 501347 by CONSOLIDATED DEVELOPMENTS LIMITED

UK Trade Mark Registration No. 2574627 A.A. COOPER
IP Title: TPA Word in Classes 16, 35, 41, 42, 43 and
Cancellation Action 501348 by CONSOLIDATED DEVELOPMENTS
LIMITED

- - - - -

(Transcript of the Shorthand Notes of Marten Walsh Cherer
Ltd., 1st Floor, Quality House, 6-9 Quality Court,
Chancery Lane, London, WC2A 1HP.
Tel No: 020-7067 2900. Fax No: 020-7831 6864.
email: info@martenwalshcherer.com.
www.martenwalshcherer.com)

- - - - -

MS. DENISE MCFARLAND (instructed by Murgitroyd Attorneys)
appeared on behalf of Consolidated Developments
Limited.

MR. JAMIE MUIR WOOD (instructed by Kilburn & Strode)
appeared on behalf of Mr. A.A. Cooper.

- - - - -

APPROVED DECISION

- - - - -

THE APPOINTED PERSON: Consolidated Developments Limited, the Applicant, sought by means of four applications filed under reference Nos. 501346-501349, on 26th September 2016, to revoke four trade mark registrations standing in the name of Mr. Andrew Cooper, the Proprietor. The trade mark registrations in issue were: No. 2198456 TIN PAN ALLEY, registered on 8th December 2000, for use in relation to goods in Class 15; No. 2311354 TIN PAN ALLEY, registered on 21st February 2003, for use in relation to services in Class 35; No. 2574641 TIN PAN ALLEY, registered on 12th August 2011, for use in relation to goods and services in Classes 16, 35, 41, 42 and 43; and No. 2574627 TPA, likewise registered on 12th August 2011, for use in relation to goods and services in Classes 16, 35, 41, 42 and 43. In each case, revocation was requested under section 46(1)(a) and/or section 46(1)(b) of the Trade Marks Act 1994 for non-use during the five-year periods prescribed for the purposes of revocation by those provisions.

The proceedings were consolidated. The Proprietor defended the applications for revocation on the basis of a witness statement with 12 exhibits dated 20th March 2017. The Applicant decided to file no evidence. The Registry informed the parties on 2nd June 2017 that the written stage of the

procedure was closed. On 5th June 2017, they were asked to indicate whether they wished to be heard or to file written submissions in lieu of a hearing with the due date for filing written submissions being 3rd July 2017.

Neither side asked to be heard. The Applicant replied on 3rd July 2017, providing written submissions and opting for a decision to be taken on the papers. On the same date, the Proprietor filed a Form TM9R seeking an extension of time from 31st March 2017 over until 31st July 2017 within which to file additional evidence in defence of his registrations.

A case management conference was appointed to determine the request for more time and to consider possible directions for the further conduct of the proceedings. This took place on 20th July 2017. It resulted in a decision and directions with regard to the filing of additional evidence on the terms recorded in an official letter of the same date. The text of the letter is set out in paragraph 25 of the decision below. In the event, the Proprietor filed no additional evidence pursuant to the decision and directions given at the hearing on 20th July 2017. He also filed no written submissions in defence of his registrations.

The Hearing Officer proceeded to issue a decision on the basis of the papers on file. For the reasons he gave in a decision issued on behalf of the Registrar of Trade Marks, under

reference BL O/574/17, on 21st November 2017, he concluded that Trade Mark Registration No. 2574641 should remain in place for "providing advertising space on websites, for others" in Class 35, but that subject to that all four of the registrations in issue should be revoked with effect from the dates on which the relevant trade marks were respectively registered. He ordered the Proprietor to pay £1,700 to the Applicant in respect of its costs of the Registry proceedings.

On 19th December 2017, the Applicant appealed to the High Court under section 76 of the 1994 Act contending that the Hearing Officer had erred by not revoking the registration of Trade Mark No. 2574641 in its entirety. On the same day, the Proprietor filed a Form TM55P Notice of Appeal to the Appointed Person under section 76 of the 1994 Act seeking "permission to file additional evidence to overturn parts of the decision of Allan James, the Hearing Officer for the Registrar, in case BL O/574/17".

The Notice and Grounds of Appeal did not identify the "parts of the decision" which the Proprietor wished to overturn. No "additional evidence" was filed with the Notice and Grounds of Appeal, nor has any subsequently been filed for consideration by this Tribunal. I understand that the evidence which the Proprietor proposes to put forward for consideration is presently expected to be available within 28 days from today's

date.

The Proprietor's request, shortly stated, is for an order or direction requiring the proceedings below to be reopened on the grounds of hardship and disability for the purpose of enabling him to try and retain as much of his registered trade mark protection as he can by filing better and more comprehensive evidence of use than that which was provided by his witness statement with 12 exhibits dated 20th March 2017.

On 19th January 2018, the Proprietor filed a Respondent's Notice in the pending appeal to the High Court. The Proprietor's position as respondent to the Applicant's appeal was identified in the Respondent's Notice as being primarily that the Applicant's appeal to the High Court ought to be stayed pending the outcome of his appeal to the Appointed Person and, secondarily, if his appeal to the Appointed Person was referred to the High Court under section 76(3) of the 1994 Act, that he should be permitted to run the arguments raised in support of it with a view to obtaining an order or direction of the High Court to substantially the same effect as he was seeking from the Appointed Person with regard to reopening the proceedings below.

On 19th January 2018, this Tribunal wrote to the parties and the Registrar asking them to respond in writing by 26th January 2018 shortly stating their respective positions with regard to the way in which the situation involving parallel

proceedings pending before the High Court and the Appointed Person should be dealt with. In the light of the responses received from the parties, this Tribunal gave notice under rule 72(5) of the Trade Marks Rules 2008 that it was minded to direct that the Proprietor's appeal be referred to the High Court under section 76(3) of the 1994 Act. The notification sent by email on 31st January 2018 stated as follows: "The Appointed Person has asked me to respond as follows to the statements of position provided by the parties' professional representatives as requested in my email of 19 January 2018 (below).

"(1) Kilburn & Strode have confirmed in their letter dated 26 January 2018 that Mr. Cooper '**does not question the decisions reached by the Hearing Officer on the papers before him**'.

"(2) Section 76 of the Trade Marks Act 1994 provides a statutory right of appeal against '**any decision of the registrar under this Act**'. However the Grounds of Appeal in the Appeal to the Appointed Person do not actually challenge any decision of the registrar and the Appeal would, for that reason, appear to fall outside the scope of the statutory right of appeal under the 1994 Act.

"(3) The statements in Kilburn & Strode's letter to the effect that the Appeal to the Appointed Person is '**purely procedural**' may, perhaps, be directed to the proposition that Mr. Cooper should be granted a belated extension of time within

which to file evidence in the registry proceedings.

"(4) If so, that would appear to overlook: (i) the fact that there are no extant proceedings in the registry with respect to which the extension could be granted, the proceedings having terminated on delivery of the unappealed decision of the Hearing Officer; and (ii) the fact that the power to grant extensions of time for filing evidence in registry proceedings under rule 77 of the Trade Marks Rules 2008 is, in any event, exercisable by the registrar in the first instance and is not a power conferred upon the Appointed Person by rule 73(4) of the 2008 Rules so as to be exercisable by the Appointed Person for the first time on appeal.

"(5) If it were to be contended on behalf of Mr. Cooper that the decision of Mr. Daniel Alexander sitting as the Appointed Person in GUCCI Trade Mark BL O/424/14 (01 October 2014) nonetheless allows for an appeal to be brought under Section 76 for the purpose of seeking permission on appeal to file further evidence in the registry with a view to securing reversal by the registrar of an unappealed decision previously delivered in registry proceedings, that would seem to raise '**a point of general legal importance**' within the ambit of rule 72(5) of the 2008 Rules.

"(6) Further, as recognised in Kilburn & Strode's letter, Mr. Cooper's Appeal has the capacity, if it were to succeed, to

render Consolidated Developments Ltd's Appeal to the High Court redundant. Thus producing a situation in which it would appear to be inappropriate and undesirable for the Appeal to the Appointed Person and the Appeal to the High Court to proceed to independent determinations c.f. paras 14 to 16 of the GAP 360 Trade Mark decision. That difficulty is recognised but does not appear to be effectively cured by the proposals that have been put forward for one or other of the two sets of proceedings to be stayed pending the determination of the other.

"For the reasons summarised above, the parties and the registrar are required to treat this email as notice under rule 72(5) of the 2008 Rules to the effect that the Appointed Person is minded to direct that Mr. Cooper's Appeal be referred to the High Court under section 76(3) of the 1994 Act."

The decision of Mr. Daniel Alexander Q.C., sitting as the Appointed Person in the GUCCI Trade Mark case, is reported as *Gerry Weber International AG v Guccio Gucci SPA* [2015] R.P.C. 9. At paragraph 9 of his decision, Mr. Alexander observed: "In my judgment, at the heart of this case lies the question of whether a further application to adduce further evidence, this time on appeal, should be allowed. The proprietor contends that this evidence makes good all or at least the majority of the defects in the earlier evidence and that it should be admitted, having regard to (or perhaps despite) the *Ladd v Marshall* [1954] 1 WLR

1489, [1954] All ER 745, principles."

At paragraph 26, he observed that "... the *Ladd v Marshall* factors are not to be regarded as a straight-jacket or individually determinative and it is necessary to look at the position more broadly."

Mr. Alexander's decision proceeds upon the premise that the power to permit an appellant to adduce further evidence on appeal from the Registrar may be exercised in a broad, remedial way so as to enable the appellant to re-open proceedings in the Registry that have culminated in a decision which cannot otherwise be set aside for error or procedural irregularity. That is potentially a far-reaching proposition. The Proprietor relies on it in support of his appeal to this Tribunal and in support of his position as Respondent to the Applicant's appeal to the High Court.

I recognise that the appeal in the present case is not on all fours with the appeal in the GUCCI Trade Mark case. I think it nonetheless raises questions as to the correctness or otherwise of the approach for which the GUCCI Trade Mark case is relied upon by the Proprietor. And I think that is a point of general legal importance within the meaning of that expression as used in rule 72(5) of the 2008 Rules with regard to the scheme established for appeals from decisions of the Registrar under the 1994 Act.

That would justify an order for referral of the Proprietor's appeal to the High Court under section 76(3) of the Act even if the Applicant had not already brought its own related appeal to the High Court. The existence of the Applicant's appeal to the High Court adds to the justification for an order for referral in order to enable the Proprietor's appeal from the hearing officer's decision to proceed along with the Applicant's appeal from that decision before one and the same judicial tribunal.

The Applicant maintains that this Tribunal should nevertheless give effect to the considerations and reasoning summarised in numbered paragraphs (1) to (4) of the email notification sent on 31st January 2018 by striking out or dismissing the Proprietor's appeal to the Appointed Person for being manifestly unfounded and unsustainable. I might have been inclined to take that course if the appeal to the Appointed Person in the GUCCI Trade Mark case had not been decided in the way it was. Given that it was decided in the way it was and given that the Proprietor is relying on it both for the purposes of his appeal to the Appointed Person and for the purposes of his position as Respondent to the Applicant's appeal to the High Court, I consider that the right way of dealing with the situation which has arisen is to enable the Proprietor to pursue his appeal, but before the High Court rather than before the

Appointed Person in view of the general importance of the question which lies at the heart of it.

I therefore order that his appeal be referred to the High Court under section 76(3) of the Act. It will be incumbent upon him to take the steps necessary for that purpose within the prescribed time limit. It was submitted on behalf of the Applicant that I might impose conditions or make observations with regard to the further conduct of the High Court proceedings. I do not think it would be appropriate for me to do so. It is for the High Court to determine how matters should proceed hereafter. That is my decision on today's hearing.

- - - - -