

O-158-03

THE PATENT OFFICE

Room 2
Harmsworth House,
13-15 Bouverie Street,
London EC4Y 8DP.

Friday 4th April 2003

Before:

THE REGISTRAR'S PRINCIPAL HEARING OFFICER
(Mr. M. Knight
(Sitting for the Comptroller-General of Patents etc.)

In the Matter of the Trade Marks Act 1994

and

In the Matter of an Application No. 2277637
in the name of EIDOS INTERACTIVE LTD

and

In the Matter of an Opposition thereto by
MAGNUS FAHLEN under Opposition
No. 80513

(Transcript of the shorthand notes of Marten Walsh Cherer
Ltd., Midway House, 27/29 Cursitor Street, London EC4A 1LT.
Telephone No: 020-7405-5010. Fax No: 020-7405-5026).

MR. J. REDDINGTON (Gouldens) appeared on behalf of the
Applicant.

MR. C. MORCOM QC (instructed by Venner Shipley & Co.)
appeared as counsel on behalf of the Opponent.

DECISION (AS APPROVED)

THE HEARING OFFICER: I have a second preliminary point before me in opposition number 80513, which is to admit into the proceedings a witness statement by the opponent's trade mark attorneys, to which is attached what they claim to be an assignment document. This assignment document indicates that the opponent's trade mark was assigned to them within the period allowed for by the Paris Convention and the Trade Marks Act, such that they can claim priority over the applicants' trade mark.

In these proceedings the applicants have already submitted a document which states that it is a true copy of the original document and it is certified by the Swedish Patent and Registration Office as being so. That document indicates that the trade mark in question was assigned from one party to the opponent on 13th November 2001 which is outside the relevant date. The document that the opponent's attorney's witness statement seeks to have admitted states that the assignment took place in August; it is dated 21st August 2001.

Whilst I have no doubt that both sides are satisfied that their respective documents are authentic, it seems to me that the opponent's document raises more questions than it answers. If the opponents have already submitted an

assignment document to the Swedish Office dated November, in order that the assignment of the application for registration could be put into their name, what was the purpose of the earlier assignment document? Mr. Morcom submits that the later document may well have been a confirmatory assignment. Mr. Reddington, on the other hand, suggests that the earlier document was simply an agreement to assign and that the later document was the assignment document. The opponent's witness statement, as I have already indicated, does not provide any answers to these questions.

It seems to me that this dispute between the parties is one of some significance, and I have already ruled this morning that an amendment to the pleadings should not be allowed. When it comes to the question of whether or not this additional document should be admitted into the proceedings, it seems to me that that request should also be refused. That does not, however, solve the problem of the dispute between the parties; not least because there is another opposition not far behind this one, and indeed the outcome of this case could determine the later opposition.

For those reasons it may seem sensible, in order to avoid multiplicity of proceedings, for me to allow this document in, hear submissions, and reach a decision accordingly. But it seems to me, in the light of the paucity of information about the status of this new document as opposed to the first document which both sides accept is a certified copy of material which is on the file at the Swedish Patent and Registration Office, that there is little point in me doing so because, given the questions that come to mind in relation to that document, I would be able to give it very little weight in the proceedings. That being so, I do not see it being in any way determinative to the outcome of these proceedings.

For those reasons I am going to refuse the request to have admitted this further statutory declaration by the opponent's trade mark attorneys. That may well determine the opposition proceedings here. However, it would perhaps provide the opportunity for this application for registration to proceed and for the opponent in this case to consider a more focused application for a declaration of invalidity which would allow proper pleadings and proper evidence and thus a sensible, fair and just decision to be reached. Given the way this set of proceedings has developed, I think such an outcome is almost impossible.

I will hear submissions on costs.

MR. MORCOM: Before we get to that stage, sir, the position is that we may wish to appeal. We have to consider that. I have to say that, as far as the Convention point is concerned, although we are pretty clear in our submission that the fact that the company was a Jersey company is irrelevant, and we are confident in our case that the rules permitted what was done, I think I am, in view of your ruling, without any armoury at all on the ownership point, which means there would be no useful purpose served in arguing the rest of the opposition this morning.

In those circumstances, would you defer any decision dismissing the opposition until the time for appealing has expired and, if within that time we give notice of appeal, would you then be prepared to defer your decision on the opposition until that appeal is heard? That would seem to be the most sensible way.

THE HEARING OFFICER: I think Ruth Annand, the appointed person, in a decision in relation to the mark **POINT FOUR**, has confirmed that any appeal to the appointed person or the court has a suspensory effect on cases, so I do not need to give that particular instruction.

MR. MORCOM: What I did not want was an immediate decision dismissing the opposition.

THE HEARING OFFICER: No. I was not intending immediately to dismiss the opposition, but clearly if there was no appeal, then the effect of that would be that the opposition could be determined on the basis of the material before us.

MR. MORCOM: I think the position in practice is that if there is no appeal we would have to withdraw, because I cannot argue that ownership point.

THE HEARING OFFICER: You would have no earlier right, and that would be the end of the matter.

MR. MORCOM: Subject to applying for a declaration of invalidity.

THE HEARING OFFICER: Yes. Can I have submissions on costs?

MR. MORCOM: Again I cannot resist an order for the costs relating to today. I think the costs relating to the opposition would have to await any appeal. Having said that, on the basis that you ultimately dismiss the opposition at some stage, the costs would be worked out in the way that you usually do it. I do not think I can say any more than that.

THE HEARING OFFICER: Thank you. Mr. Reddington?

MR. REDDINGTON: That sounds fair enough.

THE HEARING OFFICER: Costs on the scale in the usual way?

MR. REDDINGTON: Yes. Could I ask what happens with regard to arguing my two other points on priority? If you say it looks as if today I have won on the identity of the applicant point, then if the appeal in relation to this evidence succeeds and if that evidence is admitted, and if when it is eventually considered substantively it is considered to be good evidence, when do I get the opportunity to argue my other two points?

THE HEARING OFFICER: Let us assume it is the appointed person rather than the

court, but even if it is the court, then the Registrar will not have considered the other matters, nor the substantive issue of the opposition as a whole, the 5(1) and 5(2)(a) points. Therefore it would be remitted back, which is why I do not want to hear all your submissions today because if the appeal does not succeed then we have not wasted anybody's time. If it does succeed, then yes, we will be back again on whatever basis the appointed person or the court directs.

Therefore I am refusing both. I will get the transcript and have a look at that and let you both have it, and the time for appeal will commence then. You are aware that if it is an appeal to the court you have got fourteen days; if it is an appeal to the appointed person it is twenty-eight days. If you want an extension of time to appeal to the court, you have got to go to the court for the extension of time. If you want more time in relation to the appointed person, you come to us.

MR. MORCOM: The time will run from the date you send us the transcript?

THE HEARING OFFICER: Yes. In both cases the date will run from the date that I set by the sending of the decision. I have refused both requests. The application for registration will not proceed until the matter of the appeal has been determined. Thank you both very much.
