

O/177/06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS. 82390, 82391, 82392 & 82393
FOR REVOCATION OF TRADE MARK NOS. 1319477, 1319478,
1419333 & 1419651 IN THE NAME OF
GALILEO INTERNATIONAL TECHNOLOGY, LLC**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application Nos. 82390, 82391, 82392 & 82393
For revocation of trade mark nos. 1319477, 1319478, 1419333 & 1419651
in the name of Galileo International Technology, LLC**

BACKGROUND

1. Trade mark Nos. 1319477, 1319478, 1419333 and 1419651 are for the trade mark GALILEO, and are registered in respect of the following range of goods and services:

1319477	Class 09:	Electrical and electronic apparatus and instruments; computers; data processing apparatus; parts and fittings for all the aforesaid goods; all included in Class 9.
1319478	Class 39:	Transport of passengers and of goods by air; reservation services relating thereto; all included in Class 39.
1419333	Class 09:	Electrical and electronic apparatus and instruments; computers; word processors; data processing apparatus; electrical and optical data processing apparatus; apparatus and instruments; all for the retrieval, storage, input, processing and display of data; semi-conductor memory apparatus; micro processors; computing apparatus; keyboard apparatus for use with computers; printers for use with computers; computer programmes and computer software; punched (encoded) cards and punched (encoded) tapes; magnetic tapes and discs; disc drives; modems; electrical and electronic communication apparatus; computer communication apparatus; parts and fittings for all the aforesaid goods; all included in Class 9.
1419651	Class 42:	Computer services; computer programming; design of computer software; all included in Class 42.

2. The registrations currently stand in the name of Galileo International Technology, LLC.

3. By applications dated 23 January 2006, The European Community applied for the registrations to be revoked under the provisions of Section 46(1)(a), on the basis that the trade marks have not been put into genuine use in relation to the goods or services for which they are registered, either by the registered proprietors or with their consent, and there are no proper reasons for non-use.

4. On examination of the form of application, Form TM26(N), it was found that the applicants for revocation had provided the offices of Ernest T Freylinger S.A, 234, route d' Arlon, B.P. 48, L-8001 Strassen, Luxembourg as their address for service, whereas Rule 10(1)(c) of the Trade Marks Rules 2000 requires an address for service in United Kingdom be provided.

5. By an official letter dated 26 January 2006, the applicants' representatives, Ernst T Freylinger S.A were notified of the requirement to file an address for service in the United Kingdom. The letter also mentioned other matters that have no relevance for the issue in dispute, and of which nothing further need be said.

6. The applicants' reply can be found in a letter dated 31 January 2006, from Pierre Kihn of Ernest T Freylinger S.A. This challenged the requirement for an address for service in the UK, arguing that under European case law, trade mark agents who exercise their activities as self employed persons, or who are organised within a company, benefit from the principles of freedom of establishment and freedom to provide services enshrined in Articles 43 et seq, and Articles 49 et seq, of the EC Treaty. The letter enclosed various documentation establishing that Ernst T Freylinger S.A and named registered representatives are authorised to practice as Counsel in intellectual property matters, a copy of a publication entitled "Representation before patent offices by patent agents within the internal market" published by the European Commission in June 2000, and two letters dating from June 2005, relating to an application to register the trade mark YOUR EUROPE. I will deal with each of these in more detail below.

7. By an official letter dated 10 February 2006, the registrar maintained the requirement that the applicants for revocation provide an address for service in the United Kingdom, setting a due date of 26 March 2006. The applicants' representatives responded in a letter of 14 February 2006, citing as an address for service, the "transmitting agency" established by Article 2.1 of Council Regulation (EC) No. 1348/2000 of 29 May 2000, on the service in the Member States of judicial and extrajudicial documents in civil or commercial matters. In a letter dated 22 February 2006, the registrar rejected this argument, on the grounds that acting as an address for service in the United Kingdom did not fall within the functions of that authority; accordingly the registrar maintained the requirement that an address for service in the UK be provided by 26 March 2006, and pointed out that the consequence of failing to do so would result in the applications being deemed as having been abandoned.

8. The applicants requested to be heard on the matter, and by a letter dated 23 March 2006, provided further details of the arguments he would be relying upon in support of their case. The hearing took place by telephone on 27 March 2006, the hearing being voice recorded and later transcribed. Mr Pierre Kihn of Ernest T Freylinger S.A represented the applicants. The registered proprietors were not represented, but had provided brief written submissions arguing that the address for service requirement should be maintained.

9. After hearing Mr Kihn's submissions I maintained the preliminary decision that an address for service in the United Kingdom was required, and that on the facts of the case and relevant jurisprudence, this requirement was not contrary to Article 43, Article 49 or Article 54 of the EC Treaty. After discussing the next steps with Mr Kihn, it was agreed that I should provide detailed reasons for my decision. After a careful study of the relevant papers and the submissions provided, I now go on to set out my decision.

DECISION

The Law - UK

10. As I have already stated, Rule 10(1) of the Trade Marks Rules 2000 requires parties to proceedings before the registrar to provide an address for service in the United Kingdom, the relevant provision in the case in hand being Rule 10(1)(c). Rule 10 reads as follows:

“Address for service (Form TM33)

10. - (1) For the purposes of any proceedings before the registrar under these Rules or any appeal from a decision of the registrar under the Act or these Rules, an address for service in the United Kingdom shall be filed by-

- (a) every applicant for the registration of a trade mark;
- (b) every person opposing an application for registration of a trade mark;
- (c) every applicant applying to the registrar under section 46 for the revocation of the registration of a trade mark, under section 47 for the invalidation of the registration of a trade mark, or under section 64 for the rectification of the register;
- (d) every person granted leave to intervene under rule 35 (the intervener); and
- (e) every proprietor of a registered trade mark which is the subject of an application to the registrar for the revocation, invalidation or rectification of the registration of the mark.

(2) The address for service of an applicant for registration of a trade mark shall upon registration of the mark be deemed to be the address for service of the registered proprietor, subject to any filing to the contrary under paragraph (1) above or rule 44(2) below.

(3) In any case in which an address for service is filed at the same time as the filing of a form required by the registrar under rule 3 which requires the furnishing of an address for service, the address shall be filed on that form and in any other case it shall be filed on Form TM33.

(4) Anything sent to any applicant, opponent, intervener or registered proprietor at his address for service shall be deemed to be properly sent; and the registrar may, where no address for service is filed, treat as the address for service of the person concerned his trade or business address in the United Kingdom, if any.

(5) An address for service in the United Kingdom may be filed at any time by the proprietor of a registered trade mark and by any person having an interest in or charge on a registered trade mark which has been registered under rule 40.

(6) Where an address for service is not filed as required by paragraph (1) above, the registrar shall send the person concerned notice to file an address for service within two months of the date of the notice and if that person fails to do so-

(a) in the case of an applicant as is referred to in sub-paragraph (a) or (c), the application shall be treated as abandoned;

(b) in the case of a person as is referred to in sub-paragraph (b) or (d), he shall be deemed to have withdrawn from the proceedings; and

(c) in the case of the proprietor referred to in sub-paragraph (e), he shall not be permitted to take part in any proceedings.”

11. At the hearing I explained to Mr Kihn that by a Statutory Instrument No. 760 made on 14 March 2006, which came into force on 6 April 2006, the provisions of Rule 10 of the Trade Marks Rules 2000 were revised to read as follows:

“Address for service

10. (1) For the purposes of any proceedings under the Act or these Rules, an address for service shall be filed by-

(a) an applicant for the registration of a trade mark;

(b) any person who opposes the registration of a trade mark in opposition proceedings;

(c) any person who applies for revocation, a declaration of invalidity or rectification under the Act;

(d) the proprietor of the registered trade mark who opposes such an application.

(2) The proprietor of a registered trade mark, or any person who has registered an interest in a registered trade mark, may file an address for service on Form TM33.

(3) Where a person has provided an address for service under paragraph (1) or (2), he may substitute a new address for service by notifying the registrar on Form TM33.

(4) An address for service filed under paragraph (1)(a) or (2) shall be an address in the United Kingdom, another EEA State or the Channel Islands.

(5) An address for service filed under paragraph (1)(b) to (d) shall be an address in the United Kingdom, unless in a particular case the registrar otherwise directs.¹

¹ Regulation 10(5) as amended originally read “...the *comptroller* otherwise directs”; this drafting error was corrected by a further amendment made by SI 2006 No 1029.

Failure to provide an address for service

10A. (1) Where-

- (a) a person has failed to file an address for service under rule 10(1); and
- (b) the registrar has sufficient information enabling her to contact that person, the registrar shall direct that person to file an address for service.

(2) Where a direction has been given under paragraph (1), the person directed shall, before the end of the period of 2 months beginning with the date of the direction, file an address for service.

(3) Paragraph (4) applies where-

- (a) a direction was given under paragraph (1) and the period prescribed by paragraph (2) has expired; or
- (b) the registrar had insufficient information to give a direction under paragraph (1), and the person has failed to provide an address for service.

(4) Where this paragraph applies-

- (a) in the case of an applicant for registration of a trade mark, the application shall be treated as withdrawn;
- (b) in the case of a person opposing the registration of a trade mark, his opposition shall be treated as withdrawn;
- (c) in the case of a person applying for revocation, a declaration of invalidity or rectification, his application shall be treated as withdrawn; and
- (d) in the case of the proprietor opposing such an application, he shall be deemed to have withdrawn from the proceedings.

(5) In this rule an "address for service" means an address which complies with the requirements of rule 10(4) or (5)."

12. The revision of Rule 10, inter alia, allows for the address for service provided under Rule 10(1)(a) and Rule 10(2) to be an address in the United Kingdom, another EEA State, or the Channel Islands. However, in respect of proceedings falling under Rule 10(1)(b), Rule 10(1)(c) and Rule 10(1)(d), which would include applications for revocation, the requirement for an address for service in the United Kingdom remains unchanged, save that Rule 10(5) permits the registrar to direct that an address for service outside of the United Kingdom shall satisfy the provisions of Rule 10(1)(b)(c) and (d). Consequently, even after the amendments made by S.I. 2006 No 760, applicants for revocation are required to provide an address for service in the UK unless the Registrar directs otherwise. In the present case, time for filing an address for service

expired before those amendments came into force; accordingly, the registrar has no discretion, and the applications must be treated as abandoned by virtue of the rule 10(6)(a), in the version of rule 10 which had effect prior to the amendments.

The law - EC

13. The applicants for revocation assert that Rule 10 of the Trade Marks Rules 2000 is incompatible with the terms of Article 43, Article 49 and Article 54 of the EC Treaty. These articles set out the rights of freedom of establishment and freedom to provide services under the EC Treaty. It is accepted that those provisions are directly effective in UK law, and hence would override any incompatible domestic provisions. Article 43 is not immediately relevant in this case, since the applicants' complaint relates to the freedom of its agents to provide cross-border services from an office established in Luxembourg, rather than their freedom to open a branch of that office in the UK. It provides however as follows:

“Article 43

Within the framework of the provisions set out below, restrictions on the freedom of establishment of nationals of a Member State in the territory of another Member State shall be prohibited. Such prohibition shall also apply to restrictions on the setting-up of agencies, branches or subsidiaries by nationals of any Member State established in the territory of any Member State.

Freedom of establishment shall include the right to take up and pursue activities as self-employed persons and to set up and manage undertakings, in particular companies or firms within the meaning of the second paragraph of Article 48, under the conditions laid down for its own nationals by the law of the country where such establishment is effected, subject to the provisions of the chapter relating to capital.”

14. More relevant are the provisions in Article 49 of the EC Treaty, which reads as follows:

“Article 49 EC

“Within the framework of the provisions set out below, restrictions on freedom to provide services within the Community shall be prohibited in respect of nationals of Member States who are established in a State of the Community other than that of the person for whom the services are intended.”

15. The applicants for revocation also cite Article 54 of the EC Treaty, which reads as follows:

“Article 54 EC

As long as restrictions on freedom to provide services have not been abolished, each Member State shall apply such restrictions without distinction on grounds of nationality or residence to all persons providing services within the meaning of the first paragraph of Article 49.”

16. The provisions of those Articles require Member States to give effect to the principles of freedom of establishment and freedom to provide services, and (in conjunction with Article

10) to revoke any incompatible national provisions. It is well-established, in the case-law of the European Court of Justice (ECJ), that those provisions prohibit not only national rules that are directly discriminatory, but also rules which are indistinctly applicable to domestic and foreign operators but which hinder or render less attractive the exercise of the freedoms in question; in particular if they result in delays or additional costs. These principles are, however, not absolute. By Article 46, Member States may provide for special treatment for foreign nationals where they are justified on grounds of public policy, public security or public health, provided that they are necessary and proportionate. That provision does not appear to be relevant in the present circumstances.

17. More relevant are the principles established by the ECJ in relation to “indistinctly applicable” provisions, i.e. provisions of national law which are not on their face discriminatory, but which may none the less amount to a restriction on the freedom of establishment or the freedom to provide services (as already observed, it is the latter freedom which is at issue in the present case). In those circumstances, the ECJ has stated that the restrictions “must be justified by imperative requirements in the general interest, be suitable for achieving the objective which they pursue and not go beyond what is necessary in order to attain it. They must in any event be applied without discrimination” *Piergiorgio Gambelli and others*, Case C-243/01, 6 November 2003.

18. In his written submissions, Mr Kihn referred to the fourth paragraph on page 8 of the European Commission publication entitled “Representation before patent offices by patent agents within the internal market” published in June 2000, the paragraph reading as follows:

“As regards the obligation to have a business address in the Member State in which representations are to be made, while this condition is the least restrictive version of the domicile concept, it nevertheless always involves a particular effort on the part of the patent agent in order to set up the address. Moreover, setting up the address incurs costs, whether the approach is to hire a P.O. box, or to use the address of a fellow patent agent who has an actual domicile in the Member State concerned. The latter arrangement, in particular, places the patent agent in a delicate situation where he or she is obliged to forge professional links with a fellow agent with whom there may be conflicts of interest, even if no recourse is had to the agent’s services. Furthermore, this situation is liable to encourage foreign clients to engage the services of local patent agents. The Commission therefore considers that such an obligation thus imposes a restriction on freedom to provide services.”

19. The provisions of Rule 10 do not require a party either to be domiciled in the UK, or to engage a professional representative who is domiciled in the UK. Rather they impose the less onerous requirement of an address for service in the UK. It can be accepted that such a requirement may amount to a restriction on the freedom to provide services. But as the Commission itself acknowledges in the cited passage, it is the “least restrictive version” of the requirements it discusses. This must be borne in mind when assessing the proportionality of the restriction. As the Commission also recognises in that document, the crucial question is whether the requirement is “proportionate to the public interest that is to be safeguarded...”, a reference to the judgement of the European Court in Case C-76/90 *Manfred Säger v Dennemeyer & Co Limited*. In that case the ECJ stated the position as follows:

“[15] Having regard to the particular characteristics of certain provisions of services, specific requirements imposed on the provider, which result from the application of rules governing those types of activities, cannot be regarded as incompatible with the Treaty. However, as a fundamental principle of the Treaty, the freedom to provide services may be limited only by rules which are justified by imperative reasons relating to the public interest and which apply to all persons or undertakings pursuing an activity in the State of destination, in so far as that interest is not protected by the rules to which the person providing the services is subject in the member-State in which he is established. In particular, those requirements must be objectively necessary in order to ensure compliance with professional rules and to guarantee the protection of the recipient of services and they must not exceed what is necessary to attain those objectives (see, most recently, Cases C-154/89, E.C. Commission v. France, C-180/89, E.C. Commission v. Italy and C-198/89, E.C. Commission v. Greece.)”

20. The Commission’s document goes on to say that in Case C-19/92, *Kraus v. Land Baden-Wurtemberg*, the ECJ extended the application of this line of argument, and put in place four conditions that need to be satisfied for a restriction to be accepted as compatible with Community law. The document says that the conditions laid down in *Kraus* require that any national restriction must:

be applied in a non-discriminatory manner,
be justified by imperative reasons relating to the public interest,
be suitable for the attainment of the objective which they pursue,
not go beyond what is necessary in order to attain it.

21. Mr Kihn also referred me to Case 252/83 *Commission of the European Communities v Kingdom of Denmark*, and Case C-478/01 *Commission of the European Communities v Grand Duchy of Luxembourg*. Having reviewed these cases I do not consider that they either challenge or add anything to the guidance found in the *Säger* or *Kraus* cases.

22. The purpose of the Trade Marks Rules 2000 is to regulate the practice and procedure relating to trade marks granted under the Trade Marks Act 1994, and in particular to ensure that proceedings before the Trade Marks Registry are conducted in a manner which is effective, which saves the parties unnecessary expense, and are expeditious and fair. Requirements imposed for such a purpose can quite evidently be justified in the public interest.

23. The requirement to have an address for service in the UK applies equally to UK and non-UK nationals, whether resident in the UK or elsewhere, and therefore the UK legislation draws no distinction based on nationality. Similarly, the requirement does not directly discriminate on the basis of residence: a person or firm which is not resident in the UK is not prevented from furnishing an address in the UK which can be used for service. Such a requirement does not prevent a trade mark attorney who is not resident in the UK from representing applicants for UK trade marks. The attorney may again make arrangements for an address to be provided in the UK. It is of course undeniable that such arrangements will involve a certain amount of additional trouble and expense, and to that extent arguably

amount to a restriction on the attorney's freedom to provide services. But the requirement does not directly discriminate on the ground either of residence or nationality, and to the extent that it imposes an additional burden on non-UK applicants or their attorneys it is (as the Commission has acknowledged) one which is relatively less onerous. For the reasons I shall set out below, I consider that the requirement for an address for service in the UK (to the extent that it hinders or renders less attractive the exercise of a fundamental freedom) is proportionate and justified by imperative reasons relating to the public interest.

24. In his submissions, Mr Kihn referred to proceedings involving an application for the registration of the trade mark YOUR EUROPE where the requirement for an address for service had been considered satisfied by the provision of an electronic address for service. He argued that the conclusion to be drawn from this is that the UK Patent Office was of the opinion that the requirement for an address for service in the United Kingdom is not compatible with the EC Treaty. Mr Kihn noted that the decision to accept an electronic address for service had not drawn any distinction between ex-parte and inter-parte proceedings.

25. Mr Kihn is drawing his inferences from a letter of 10 June 2005, from Mr Allan James, the Head of Examination Practice, Trade Marks and Designs, to Olivier Laidbeur of Office Ernest T Freylinger S.A. In this, Mr James expressed concern should the UK Patent Office find that its domestic legislation is incompatible with the terms of the EC Treaty. He confirmed that the UK Patent Office had already considered whether any changes are required to the UK offices address for service requirements, and that in light of the submissions, would do so again. It is now a matter of history that the requirement for an address for service in the UK in ex-parte proceedings has been removed. Whilst I accept that the letter does not specifically mention or draw any distinction between ex-parte and inter-parte proceedings, it does say, "As far as this application is concerned...", clearly indicating that what is to follow related to the case in question, the ex-parte application to register a trade mark.

26. Thus in the case of administrative actions and ex-parte proceedings, the UK has decided to change its legislation and remove the requirement for an address for service in the UK. That is consistent with the UK's general approach to such matters, which leans in favour of the removal of barriers to trade and of restrictions on the free movement of goods and services. However, in the case of contested proceedings before the Trade Marks Registry, the UK is not yet persuaded that it is appropriate to relax its address for service requirements. It has therefore decided to maintain those requirements, as necessary and proportionate in the general interest.

27. In prosecuting applications to register trade marks, and most administrative actions to maintain a trade mark registration, all that will usually be required is the provision of a form, in some cases the payment of a fee, and a means by which to send and receive correspondence. It is now reasonably commonplace for these actions to be done electronically, whether by facsimile transmission, e-mail or the Internet. I of course accept that that all of these actions may well occur during inter-partes proceedings, and where practicable, the UK allows electronic filing in inter-partes proceedings. There is, however, one major and important distinction that significantly affects inter-partes proceedings. In an ex-parte application to register a trade mark, evidence may be filed, most usually to establish that a trade mark that is otherwise devoid of distinctive character has become distinctive of a trader through use. The filing of evidence in ex-parte matters is very much the exception rather than the rule, whereas in inter-partes proceedings it is

the rule. Whilst evidence in draft form may be filed electronically, there is, as yet, no provision for filing evidence with an electronic signature; the original signed documents will always be required.

28. In ex-parte proceedings, the applicant for registration will only be required to provide evidence to the registrar, whereas in inter-parte actions, copies of evidence must be provided to the registrar and the opposing party, and unlike ex-parte cases where the filing of evidence is a single action, in contested actions a party may have to file evidence at several points during the conduct of the case. Evidence in trade mark proceedings is often bulky and unsuitable for electronic submission. The cost of transporting evidence between Member states is likely to be a significant. In ex-parte proceedings, the periods for completing actions are reasonably generous in terms of the time allowed, are generally set by the registrar, and with a few exceptions, can be extended with no detriment to another party or the public interest. In inter-partes proceedings, the time periods for the completion of actions are prescribed by statute are much more restrictive in the periods set, and may not be able to be extended in any circumstances. In most cases, the time period is triggered by the sending of a form or evidence. Mr Geoffrey Hobbs, QC, sitting as the Appointed Person in *Ms. Alison June Coggins v Skjelland Group AS* (BL O-340-04), stated (at page 3 line 22 to page 5 line 8):

“In accordance with the provisions of Rule 31(1), the Registrar sent copies of the application for revocation and the revised statement to the registered proprietor of the trade mark in suit. The copies were sent to her by post at her address for service. Initially, they were sent to her by recorded delivery post on 16th January 2004. However, the letter was returned by the Post Office as "undeliverable". A further letter containing copies of the relevant documents was sent to the same address by ordinary post on 23rd January 2004.

Rule 10(4) of the Trade Marks Rules 2000 provides as follows:

"Anything sent to any applicant, opponent, intervener or registered proprietor at his address for service shall be deemed to be properly sent; and the registrar may, where no address for service is filed, treat as the address for service of the person concerned his trade or business address in the United Kingdom, if any."

Section 7 of the Interpretation Act 1978 further provides that:

"Where an Act authorises or requires any document to be served by post (whether the expression 'serve' or the expression 'give' or 'send' or any other expression is used) then, unless the contrary intention appears, the service is deemed to be effected by properly addressing, pre-paying and posting a letter containing the document and, unless the contrary is proved, to have been effected at the time at which the letter would be delivered in the ordinary course of the post."

By virtue of the combined effect of these provisions, service of the documents which the Registrar was required to send to the registered proprietor under Rule 31(1) is

deemed to have been effected when they were sent, i.e. despatched, to her address for service by pre-paid post under cover of the unreturned letter of 23rd January 2004.

and at page 9 lines 2 to 24 inclusive:

The appeal on behalf of the registered proprietor was put upon the footing that she had not been duly served with copies of the relevant Form TM26(N) and statement of case under Rule 31(1). It was submitted that the Registrar was under a duty in the circumstances of the present case to verify the currency of the address for service at 43 Moreton Street. In my view these submissions are misconceived. The policy considerations underlying provisions such as those found in Rule 10(4) and Section 7 of the Interpretation Act 1978 negate the existence of any such duty and entitle the Registrar to accept the address for service at face value, see the judgments of the Court of Appeal in the case of *C A Webber (Transport) Ltd v. Railtrack Plc* [2003] EWCA Civ 1167 15th July 2003.”

29. So provided the documents are properly sent to a notified address, they are deemed to have been received. The consequence of a form or batch of evidence not reaching its intended destination could be severe, and result in the loss of an application to register a trade mark, or the cancellation of a registration. Even where a time period for completing an action may be able to be extended, it must be borne in mind that unlike ex-parte actions, in inter-partes proceedings there is a third party involved who may consider an extension to a time period prejudicial to their case, and who have the right to object to the extra time being granted.

30. It is in the public interest that a dispute over the ownership of a trade mark is determined as quickly as practicable, and with the minimum expense to the parties involved. This is particularly the case in respect of the increasing number of private litigants and small companies for whom the dispute may have significant financial and business implications. To achieve this aim there has to be a high degree of certainty that items sent by postal services, reach their intended destination, and do so expeditiously. The UK postal service is able to offer a service that guarantees next day delivery, and in the event of an item of mail going astray, or being not able to be delivered, it is possible to track the item, or in the latter case, it will be returned directly to the sender. I have no information as to the state of the postal services in Luxembourg or the other Member States, whether they are able to provide a reasonable guarantee of documents reaching their intended destination, and if documents do go astray, whether it is possible for missing items to be tracked and located. This is particularly important in the case of evidence, where exhibits may be of value, or irreplaceable.

31. There can be no argument that a party to proceedings must provide a means of serving documents. In some circumstances an electronic address may suffice, but for the reasons I have stated, this will not always be the case. If there is no UK address for service, a party wishing to bring or defend proceedings would have to serve documents out of jurisdiction, and comply with the rules for doing so of the Member State in which the opposing party says his address for service is located. This is likely to require documents to be translated, resulting in significant costs, and given the extent and complexity of evidence required in contested cases, has the potential to cause considerable delay.

32. The requirement for an address for service in the UK is not an onerous requirement, it may simply be a forwarding or Box Office address. I recognise that the paragraph from the Commission document referred to above mentions setting up the address incurs costs, whether the approach is to hire a P.O. box, or use the address of an agent domiciled in the Member State concerned, but not having an address has the potential to impose even greater costs upon the opposing party. In considering whether a restriction is proportionate, regard must be had to all the interests involved: the removal of a burden on one party may involve the imposition of a greater burden on another.

34. Given the distinctions in the evidential requirements that I have outlined, the registrar does not consider it to be inconsistent to require an address for service in the UK for inter-partes proceedings, but not to do so for the prosecution of trade mark applications, or the actions involved in maintaining a trade mark registration. In the circumstances, and for the reasons I have set out above, I determine that the preliminary decision requiring the applicants for revocation to provide an address for service in the UK is not discriminatory, is justified by imperative reasons relating to the public interest, is suitable and attains the objective of the requirement, and is proportionate for what is necessary to attain the purpose of the restriction.

TRANSMITTING AGENCY

35. In their letter of 14 February 2006, the applicants representatives argued that the “competent national transmitting agency” established under Article 2.1 Council Regulation (EC) No. 1348/2000 of 29 May 2000 should be regarded as an address for service in the UK. They suggested that the transmitting agency would be able to receive documents, and according to Article 2.1 Regulation, transmit them to the competent “national receiving agency” for onward transmission to the their final destination, in this case, the offices of the applicants’ representatives in Luxembourg. As can be seen from Article 1.1 of the Regulation, however, the function of the agency referred to is to transmit documents to another Member State in order that they can be served there; by contrast, the requirement for an address for service in the United Kingdom is to enable documents to be served in the UK. The applicants’ arguments based on Regulation No. 1348/2000 can therefore be rejected.

36. Even if acting as an address for service in the UK fell within the functions of the UK’s designated transmitting agency – something which is self-evidently not the case – there are practical considerations that render the use of a transmitting agency as an address for service as impracticable for the purposes of inter-partes proceedings. For example, an addressee may refuse to accept documents in a language other than an official language of the Member State in which they are to be served, or an official language of the country of origin that the recipient understands (Article 5(1)). If refused, the documents will be returned to the sender for the provision of a translation. Accordingly, the only way to be certain that documents will not be refused is to have them prepared in an official language of the country to which they will be sent. Article 5(2) places the cost of translation on the party providing the documents. Setting aside the fact that there is no provision in trade mark law that requires a party to provide translations of documents, should a party elect to use a transmitting agency as their address for service, this would place an additional and unfair financial burden upon their adversaries, which, in the case of evidence may be significant or prohibitive.

37. The provision contained in paragraph (9) of the preamble to Regulation 1348/2000, quite rightly states that “Speed of transmission warrants documents being served within days of reception of the document” but goes on to say “However, if service has not been effected after one month has elapsed, the receiving agency should inform the transmitting agency. The expiry of this period should not imply that the request be returned to the transmitting agency where it is clear that service is feasible within a reasonable period.” Actions in inter-partes proceedings are time governed, in some cases by time periods that cannot be extended. If the service of documents were to be governed by the provisions under which transmitting and receiving agencies operate, the consequential effect would undermine the certainty required in the prosecution of inter-partes proceedings. It also opens the possibility for a party wishing to delay proceedings to use the refusal procedure to delay proceedings or cause additional expense to the other side, which would not serve the public interest of any Member State. For these reasons I consider the refusal to accept the transmitting agency as an address for service in the UK is reasonable, necessary and proportionate. It is in any event justified on the basis that the transmitting agency has neither the function nor the power of hosting as such an address.

38. In summary, I maintain the preliminary decision requiring the applicants for revocation to provide an address for service in the UK, and reject the notification of the transmitting agency as satisfying this requirement.

Dated this 23rd day of June 2006

**Mike Foley
For the Registrar
The Comptroller-General**