

**TRADE MARKS ACT 1994 AND  
THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF INTERNATIONAL APPLICATION NO. 649830  
BY PHARMEDICA GMBH**

**AND**

**OPPOSITION NO. 70025 THERETO  
BY DALGETY HOLLAND BV  
AND A REQUEST TO SUBSTITUTE  
FRISKIES NEDERLAND B.V.  
AS THE OPPONENT IN THE PROCEEDINGS**

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20 **BACKGROUND**

25 Dalgety Holland BV (DHBV) filed opposition against international application no. 649830, an application made under the Madrid Protocol, on 16 December 1997. The grounds of opposition included Section 5(2)(b) i.e. based on an earlier trade mark, in the instant case various registrations and one application in the United Kingdom.

30 On a form TM9, request for an extension of time, received by the Trade Marks Registry on 17 March 1999 the then agents of record, Stevens Hewlett & Perkins, indicated that Friskies Petcare (UK) Limited had become the owners of the trade marks upon which the opposition was based. Upon the form it was stated:

35 “The trade mark registrations on which this opposition is based have changed ownership. The recordal of assignment has not yet been filed at the Office. The original owners had entered into negotiations to settle the dispute. The new owners have indicated that they wish to maintain the opposition. The new proprietors are collating evidence in support of the opposition and it is expected that this will be submitted within the time now requested.”

40 (In evidence from the current agents of record, Nestlé UK Ltd, it is indicated that the beneficial owner of the trade marks in question, and the party requesting to be substituted as the opponent, is Friskies Nederland BV (FNBV). However, in relation to the substance of this decision nothing turns upon this point.)

45 In response to the form TM9, the Trade Marks Registry wrote to Stevens Hewlett and Perkins on 23 March 1999 to advise them that the extension of time request was refused and advising them that it was not possible to substitute an opponent. Stevens Hewlett and Perkins responded by filing a further TM9, in the name of DHBV. The form TM9 was accompanied by a letter, both documents were dated 29 March 1999, which advised that DHBV intended to continue as a party

to the proceedings, they also requested a Hearing in relation to the refusal to grant the earlier extension of time. Nestlé UK Ltd filed a form TM33 dated 7 April 1999 for them to be recorded as the agent of record of the opponent. A letter of the same date accompanied this form. In the letter Nestlé stated that for the time being they wished the opposition to continue in the name of DHBV. They commented that the refusal of the request for the extension of time appeared to be based on the proposed substitution of the opponent. (This in fact was not the reason for the refusal). They advised that they wished the Hearing to deal with the issue of the refusal to allow the substitution of the opponent as well as the refusal to allow an extension of time.

The agents for the applicant sent a letter dated 12 May 1999 in lieu of attending the Hearing. They stated that in line with the Registrar's revised practice they considered that the position that the Trade Mark Registry had adopted was correct in the refusal to allow the substitution. (A copy of this practice which was published in the Trade Marks Journal on 7 April 1999 is attached to this decision as Annex A). They also gave reasons why they considered that the extension of time request should be refused.

The matter came to be heard on 19 May 1999 when the opponent was represented by Miss Himsworth of Counsel.

At the Hearing I allowed an extension of time for one month to allow the opponent to file their evidence in chief, which they have subsequently done. However, I refused to allow the substitution of the opponent. (It was, however, agreed that if needs be the opposition could continue in the name of the original opponent.)

Consequent upon this decision the opponent filed form TM5 requesting a formal statement of grounds. As Miss Himsworth appeared content with the decision in relation to the extension of time, and as subsequently the evidence for which it was granted has been filed, I have assumed that the request for the statement of grounds relates solely to the issue of the refusal to allow the substitution of the opponent.

## **DECISION**

Miss Himsworth opened her submissions by commenting upon the Journal Notice in relation to the inability to substitute opponents. She noted that the notice referred to there being a requirement for a locus standi in opposition proceedings under the 1994 Act, so differing from the position under the 1938 Act. She submitted that in fact there had been no requirement for a locus standi under the 1938 Act. This is clearly a correct interpretation of the position. Under the terms of Section 18(2) of the 1938 Act any person may oppose an application. In "Kerly's Law of Trade Marks and Trade Names Twelfth Edition" at pages 44-45 the following is stated in relation to this issue:

"There is nothing in section 18(2) (which provides for opposition to registration) corresponding to the requirement in section 32 that an applicant for rectification of the Register be a person "aggrieved" by the entry concerned; nor do the rules (or the form on which the opponent enters a statement of his case) require an opponent to assert an interest. It must, however, be considered open to question whether opposition is open to a mere busybody, or to one solely concerned to annoy the applicant. An opponent is not

confined to objections based on interference with his rights, but can set up any proper ground of opposition....”

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Miss Himsworth then referred me to the position in the High Court. In particular she referred me to the following part of Order 15, rule 7/16:

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“However in *Industrie Chimiche Halia Centrale v. Alexander G. Tsarlinis & Sons Maritime Co.* (1995) *The Times*, August 8, Mance J. declined to follow that ruling and held that the substitution of a party to an action by someone to whom the party's interest or liability had been transferred after expiry of the limitation period was irrelevant provided the action was originally commenced in time.”

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Miss Himsworth also referred me to Rule 19.1(4) of the Civil Procedure Rules. Rule 19.1 of the Civil Procedure Rules reads:

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“(1) This rule applies where a party is to be added or substituted except where the case falls within rule 19.4(special provisions about changing parties after the end of a relevant limitation period).

(2) The court may order a person to be added as a new party if -

(a) it is desirable to add the new party so that the court can resolve all the matters in dispute in the proceedings; or

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(b) there is an issue involving the new party and an existing party which is connected to the matters in dispute in the proceedings, and it is desirable to add the new party so that the court can resolve that issue.

(3) The court may order any person to cease to be a party if it is not desirable for that person to be a party to the proceedings.

(4) The court may order a new party to be substituted for an existing one if -

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(a) the existing party's interest or liability has passed to the new party; and

(b) it is desirable to substitute the new party so that the court can resolve the matters in dispute in the proceedings.”

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It was her submission that the Courts would allow the proposed substitution in similar circumstances. Miss Himsworth argued strongly that the position should be the same for the prospective opponent in the instant case. She also considered that, because of the practice in the Courts, the parameters set out in the Journal Notice of where amendment would be allowed, i.e. where there is a change of the name of the company but no change of legal entity, were too narrow.

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Miss Himsworth also argued that substitution of the opponent should be allowed as there should be a presumption of legal certainty. In the instant case the publication of the Journal Notice in relation to the substitution of opponents was after the request for substitution had been made. She submitted that the “practice” should only have force from the date that it was published; requests to substitute opponents prior to then should be processed according to the previous practice.

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Article 10 of The Trade Marks (International Registration) Order 1996 states, inter alia:

5           **10.**-(1) Where following examination pursuant to article 9 it appears to the registrar that the requirements of article 3 are met in relation to all or some of the goods or services comprised in the international registration, the registrar shall publish a notice specifying particulars of the international registration and specifying the goods or services for which protection will be conferred.

10           (2) Any person may, within three months of the date of publication pursuant to paragraph (1) above, give notice to the registrar of opposition to the conferring of protection. The notice shall be given in writing in the manner prescribed by rule 13, shall include a statement of the grounds of opposition and shall where the opposition is based on an earlier trade mark indicate the goods or services on which the opposition is based.

15           (5) Subject to the provisions of this article, rules 13 and 14 shall apply in relation to opposition proceedings, with the substitution of the holder for the applicant.

Article 32(1) of the Order states:

20           “Except as otherwise provided, or where their application would be inconsistent with the provisions of this Order, the Rules shall apply, with the necessary modifications, in relation to an international registration designating the United Kingdom, (including a protected international trade mark (UK) as in relation to a registered trade mark or application.”

Rule 13 at the time of the filing of the opposition stated:

30           **“13.**-(1) Notice of opposition to the registration of a trade mark shall be sent to the registrar on Form TM7 within three months of the date on which the application was published under rule 12, and shall include a statement of the grounds of opposition; the registrar shall send a copy of the notice and the statement to the applicant.

35           (2) Within three months of the date on which a copy of the statement is sent by the registrar to the applicant the applicant may file, in conjunction with notice of the same on Form TM8, a counterstatement; the registrar shall send a copy of the Form TM8 and the counterstatement to the person opposing the application.

40           (3) Within three months of the date on which a copy of the counterstatement is sent by the registrar to the person opposing the registration, that person shall file such evidence by way of statutory declaration or affidavit as he may consider necessary to adduce in support of his opposition and shall send a copy thereof to the applicant.

45           (4) If the person opposing the registration files no evidence under paragraph (3) above, he shall, unless the registrar otherwise directs, be deemed to have abandoned his opposition.

5 (5) If the person opposing the registration files evidence under paragraph (3) above or the registrar otherwise directs under paragraph (4) above, the applicant shall, within three months of the date on which either a copy of the evidence or a copy of the direction is sent to the applicant, file such evidence by way of statutory declaration or affidavit as he may consider necessary to adduce in support of this application, and shall send a copy thereof to the person opposing the application.

10 (6) Within three months of the date on which a copy of the applicant's evidence is sent to him, the person opposing the application may file evidence in reply by statutory declaration or affidavit which shall be confined to matters strictly in reply to the applicant's evidence, and shall send a copy thereof to the applicant.

15 (7) No further evidence may be filed, except that, in relation to any proceedings before him, the registrar may at any time if he thinks fit give leave to either party to file evidence upon such terms as he may think fit.

(8) Upon completion of the evidence the registrar shall, if a hearing is requested by any party to the proceedings, send to the parties notice of a date for the hearing."

20 (The above Rule has been amended since the date of the filing of the opposition but the amendments are not pertinent to the instant case.)

The rule relating to the extension of time periods is Rule 62, which stated in the unamended rules inter alia:

25 **62.-** "(1) The time or periods-  
(a) prescribed by these Rules, other than the times or periods prescribed by the rules mentioned in paragraph (3) below, or  
(b) specified by the registrar for doing any act or taking any proceedings,  
30 may, at the request of the person or party concerned, be extended by the registrar as he thinks fit.....

35 (3) The rules excepted from paragraph (1) above are rule 10(6) (failure to file address for service), rule 11 (deficiencies in application), rule 13(1) (time for filing opposition), rule 13(2) (time for filing counter-statement), rule 29 (delayed renewal), rule 30 (restoration of registration)."

(Again the amendments to the rules are not material to the issues in the instant case.)

40 Arising out of Articles 10 and 32, Rule 62 is the rule that governs extensions of time. Consequent upon Rule 62 the period for filing opposition is a non-extendable period. This is a change from the situation in relation to The Trade Marks and Service Marks Rules 1986. However, it is a position that was familiar in relation to applications for patents before the United Kingdom office; until the enactment of the 1977 Patents Act. The non-extendable opposition  
45 period was a matter which was dealt with by *Bamfords Application* (1959) RPC 66. In *Bamfords* a similar position obtained as in the current proceedings, where the opponent was completely subsumed by another company. In that case The Assistant-Comptroller ruled that it was not

possible for an opponent to be substituted. I take particular note of the following comments of The Assistant-Comptroller (I have quoted from this decision at length as it is particularly pertinent in the instant case):

5           “Mr. *Lochner’s* argument involves, in effect, two main propositions. Firstly, he says that  
in civil proceedings a cause or matter does not become defective by the assignment or  
devolution of an estate or title *pendente lite* (Rules of the Supreme Court, O. 17, R.1) and  
that where there is a change or transmission of interest or any person interested comes  
10 into existence after the commencement of a cause or matter, the Court may order that the  
proceedings shall be carried on between the continuing parties and a new party (O. 17, R.  
4.) Mr. *Lochner* argued that, by parity of procedure, a party who has acquired from an  
original opponent the interest which justified the opposition, should be substituted for or  
added to the original opponent.....

15           “In general in civil proceedings only the two parties, plaintiff and defendant, are involved.  
The defendant has taken or proposes to take some positive action injurious to the plaintiff.  
There is not any further question of public interest or economic policy. The position as  
regards oppositions is different. The applicant for a Patent is asking for a privilege - a  
monopoly - to which he is entitled under certain statutory conditions. The grant of such  
20 privilege, if justified, is considered to be in the public interest as well as in that of the  
applicant. The request for a Patent is not some positive action taken or proposed to be  
taken against the opponents’ interest. At the most, the request can only establish a patent  
position in which the patentee might be able to injure the opponent. The interest to  
oppose is thus, I think, different in character from the right of a person to bring an  
25 ordinary civil action. In the latter case the public are not really concerned- certainly not  
in the matter of the time when the action is bought. In the case of patent applications, the  
applicant is entitled to have his statutory right to a monopoly settled as quickly as possible  
and without unreasonable interference, not to be kept in suspense longer than necessary.  
It must be for these reasons, I think, that Sec. 14 imposes a time limit of three months for  
30 giving notice of opposition, and that the authorities have said that a person who lodges  
notice of opposition must, at the time he does so, have a real and existing interest which  
may be injured if a patent is granted. Further, it must be noted that the Legislature has  
provided alternative remedies which are open to those who do not oppose during the  
three months period between the publication of a specification and the grant of a Patent.  
35 A person who subsequently acquires an interest which may be injured by the Patent can  
apply to the *Comptroller* for its revocation during the first year after its grant, or to the  
Court at any time. For these reasons, I do not consider that the procedure in opposition  
proceedings in the matter of the substitution of a party which acquires an interest to  
oppose must follow that in civil actions.”

40           The above states that before the Registrar the position that relates to civil proceedings, where the  
substitution of parties in proceedings following assignment of rights is allowed, does not hold  
sway. (Order 15, rule 7/16 of the Rules of the Supreme Court and Rule 19.1 of the Civil  
Procedure Rules currently relate to this issue.) I also take note that in *St Trudo* (1995) RPC 379  
45 at lines 19-20 Ferris J states:

“Before the Registrar the Rules of the Supreme Court have no part to play.....”

Proceedings before the Registrar are discrete from those before the courts in matters of procedure. I am, therefore, not swayed by Miss Himsworth's references to the practices in the Courts. I have little doubt that if this was a matter before the court the substitution would be allowed. However, it is not a matter before the Courts, it is a matter before the Registrar.

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*Bamfords* confirms the decision of the Hearing Officer in the case of SRIS 0/086/99 of the possibility of an opposition continuing in the name of an original opponent, although it might have been purchased:

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“I think I should express my considered view that if *The Badger Coy.* survives and its *locus standi* at the time of the opposition is established it is free to continue to prosecute the opposition.”

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In the instant case the opposition is still in the name of DHBV. If as a result of an appeal from this decision it is confirmed that substitution of opponents is debarred, the opposition will continue in the name of DHBV.

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I note that in relation to *Bamfords* there is one element that differs from the position in relation to a trade mark opposition, in that there was a requirement for a *locus standi*; there is no such requirement in relation to a trade mark opposition. (The lack of a requirement for a *locus standi* strengthens the position of refusing the substitution of an opponent, it allows within the three month period for any person to oppose, even if that opposition is based on a consideration of futurity. In the instant case I accept that the prospective opponent did not purchase the rights upon which the opposition is fundamentally based until well after the date of the filing of the opposition.) However, *Bamfords* deals with the same fundamental issue, whether in opposition proceedings, which are covered by a non-extendable time limit, it is possible to transfer the opponent's interest in the proceedings. Unlike an application which is a piece of property which is owned, and hence can be assigned, an opposition is a procedure; the opponent is a party to the proceedings, he does not have any proprietary rights. It is therefore not a matter in which he can “assign” his interest. Here there is a clear difference with post grant actions in which a new party can intervene upon the basis of Rule 31(5) (Article 13(4) states that Rule 31 will apply to International Registrations with necessary modifications). Rule 31(5) gives a specific mechanism to encompass a transfer of interest, to allow an intervention. Rule 13 does not allow for any such transfer of interest. If the legislature had intended that one party could be substituted for another in opposition proceedings a rule such as Rule 31(5) would have been included under the provisions of Rule 13. In the case of *Langley v North West Water Authority* (1991) 3 All ER 610 it was stated that the County Court had inherent jurisdiction to make directions regarding its own procedures provided that such directions were not inconsistent with the Rules of the Court or any other statutory provisions. To allow the substitution of parties would be at variance with The Trade Marks (International Registration) Order 1996 and The Trade Marks Rules 1994. In the case of an opposition falling because the opponent ceases to exist, or transfers its interest in trade marks which represent the basis of opposition under Section 5, the new party has recourse to the mechanism of invalidity proceedings; once the application is registered. The testing of the validity of the grounds of objection can be resuscitated, they are not subject to a final termination by virtue of the failure of the opposition proceedings (subject of course to estoppel, which would not be an issue in the instant case).

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It is also fundamental to an opposition that there is an opponent, to allow a substitution of an opponent is to allow a de facto extension of time to the opposition period, something which is not permissible under the rules, as I have stated above. A time period has been stipulated in the regulations in order that questions as to the validity or otherwise of an application can be dealt with expeditiously. To allow for the substitution of parties would be to allow potentially for the trading in oppositions. Although I must emphasize that this is clearly not the case in the instant case.

It has also been argued by Miss Himsworth that the “new practice” should not affect the instant case as the request for a change of opponent was made before it was announced in The Trade Marks Journal that such amendments would not be allowed. The Registrar had previously allowed for the substitution of opponents in certain circumstances. Chapter 15 of the Work Manual stated:

### **“3.9 Change of opponent**

#### **Transfer of interest in a mark:**

An opponent may cite the existence of an application or registration in their ownership in their grounds of opposition, or may claim to have rights in a mark for which no application has been made. If they later sell or assign these rights, the new owner may ask for their name to be substituted as opponents. If there is an application to record the transfer as a registrable transaction or they can provide suitable documentation to confirm the transfer the Registrar will usually allow the request subject to any comments made by the applicant. If the applicant objects it may prove necessary to arrange an interlocutory hearing. If the transfer is to be allowed, the new opponent should be asked to provide written confirmation that they:

- # have had sight of any forms or evidence filed, (if not, they will have to make arrangements to do so with the original opponent)
- # stand by the grounds or statements made in the Notice of Opposition/evidence and confirm that where the name of the original opponent appears this should be read as though it is made in their name
- # are aware of and accept their liability for costs for the whole of the proceedings in the event of the opposition being unsuccessful

They must also provide details of an address for service in the UK if none has previously been given.”

This is not an argument that attracts me. I have to apply the law at the date of my decision as I understand it. My interpretation of the law is that The Trade Marks (International Registration) Order 1996 and the Trade Marks Rules 1994 have never allowed for the substitution of opponents outside of the period allowed for the filing of opposition. Consequently there are no vires to allow the substitution, and never have been. I could not sanction an action that was ultra vires through an act of judicial amnesia.

For the reasons outlined in this decision I refuse to allow the substitution of FNBV for DHBV as opponent in these proceedings.

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**Dated this 7 day of July 1999**

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15 **DW LANDAU**  
**For the Registrar**  
**The Comptroller General**

## ANNEX A

### **Substitution Of Opponents In Inter-partes Proceedings**

This notice is to advise practitioners of a change in the Registrar's practice which affects oppositions where a request is made to replace one opponent in inter partes proceedings before the Registrar with another.

At a recent Interlocutory Hearing regarding an opposition filed under the 1938 Act, the Registrar's Hearing Officer held that as it is no longer necessary for an opponent to have locus standi in opposition proceedings and following the introduction of an unextendable opposition period in the Trade Marks Rules 1994; in the absence of specific provision in either the Trade Marks Act 1994, or Trade Marks Rules 1994 (as amended by the Trade Marks (Amendment) Rules 1998), that substitution of the opponent outside of this period would constitute a de facto extension of time to an unextendable period and therefore could not be allowed. The opposition was accordingly deemed withdrawn under the provisions of Rule 13(3). The decision itself is not open to public inspection in accordance with Rule 44(4)(c) of the Trade Marks Rules (as amended by the Trade Marks (Amendment) Rules 1998).

This change of practice is effective from 3 February 1999.

Finally, this change in practice will not affect oppositions which are subject to a change of name where there is no change to the actual legal entity.

Queries in relation to this notice should be addressed to either:

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