

1 THE PATENT OFFICE

Harmsworth House,
13-15 Bouverie Street,
London EC4 8DP.

Monday, 23rd June 2008

5 Before:

6 MR. G. HOBBS QC
(The Appointed Person)

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8 In the matter of THE TRADE MARKS ACT, 1994.

9 and

10 In the matter of UK Trade Mark Application No. 2371858
11 IN THE PINK in Class 16 by Gerard Dugdill
12 (formerly in the name of Blue Moon
Publishing)

13 and

14 In the matter of Opposition No. 93785 by Xcess Media

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16 Appeal of the Applicant from the
17 Decision of Mr. Raoul Colombo

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19 (Transcript of the Stenograph Notes of Marten Walsh Cherer
Ltd., 6th Floor, 12-14 New Fetter Lane, London EC4A 1AG.
20 Telephone No: 020-7936 6000)

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22 The Applicant appeared in person.

23 MR. STEPHEN CHUBB and MS. KATHERINE CHUBB appeared in person for
the Opponent.

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25 D E C I S I O N (As approved)

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1 THE APPOINTED PERSON: Mr. Gerard Dugdill is the recorded assignee
2 of Trade Mark Application No. 2371858, filed on 31st August
3 2004. The application for registration is opposed by Xcess
4 Media Limited. The Notice and Statement of Grounds of
5 Opposition were filed on 4th October 2005.

6 By steps and stages the opposition proceeded to the
7 point at which the Opponent's evidence in reply was due to be
8 filed under Rule 13C(5) of the Trade Mark Rules 2000 on or
9 before 28th May 2007. The evidence it needed to address in
10 reply was substantial. It consisted of a first witness
11 statement of Mr. Dugdill dated 31st January 2007 (this was 4
12 pages long with 10 exhibits) and a second witness statement of
13 Mr. Dugdill dated 28th February 2007 (this was 132 pages long
14 with a further 51 exhibits).

15 On 29th May 2007 the Opponent filed a form TM9
16 requesting an extension of time for filing its reply evidence
17 over until 28th August 2007. The reasons for the request were
18 summarised by Ms. Katherine Chubb on behalf of the Opponent in
19 the following terms: "I have disinstructed D Young & Co and I
20 am now dealing with the opposition in person on behalf of
21 Xcess Media Limited.

22 "We have not yet received our files from D Young and I
23 will need more time to read, understand and respond to Mr.
24 Dugdill's evidence, which is extremely lengthy, complex and
25 very confusing.

1 "My job as a magazine publisher is full time. I need to
2 adhere to demanding deadlines and work long hours so I can
3 only attend to this in my spare time.

4 "Now acting in person, it is impossible for me to
5 respond within the current deadline and I request more time as
6 the current deadline of 28th May is impossible for me to
7 meet."

8 On 8th June 2007 the Registry issued a preliminary view,
9 indicating that the Registrar was minded to refuse the
10 requested extension. This indication was subject to the
11 operation of Rule 54 of the Trade Marks Rules and, therefore,
12 subject to the Opponent's right to request a hearing at which
13 to argue that an extension of time should be granted.
14 However, on 22nd June 2007 the Registry issued another
15 preliminary view, this time indicating that the Registrar was
16 minded to grant the requested extension. This was also
17 subject to the operation of Rule 54 and, therefore, subject to
18 Mr. Dugdill's right to request a hearing at which to argue
19 that no extension of time should be granted.

20 Mr. Dugdill requested a hearing and this took place
21 before Mr. Raoul Colombo, acting on behalf of the Registrar,
22 on 12th September 2007. In the meantime, the Opponent sent
23 its evidence in reply to the Registry by fax on 28th August
24 2007, with the hard copies of the documents arriving by post
25 on 30th August 2007.

1 The question for determination at the hearing on 12th
2 September 2007 was not, as Mr. Dugdill maintained, whether the
3 Registrar's preliminary view issued on 8th June 2007 should be
4 upheld; nor was it, as the Hearing Officer maintained, whether
5 the Registrar's preliminary view issued on 22nd June 2007
6 should be upheld. Those indications were both
7 non-determinative and entirely non-binding for the purposes of
8 the hearing which had been appointed in accordance with the
9 requirements of Rule 54.

10 The question for determination was whether the
11 Opponent's request for an extension of time, made in the form
12 TM9 it had filed on 29th May 2007, should be granted or
13 refused under Rule 68.

14 Since Mr. Dugdill objected to the request, the correct
15 procedure was for the Opponent to begin by addressing the
16 Hearing Officer in support of its request, for Mr. Dugdill to
17 respond in support of his objections to the request and for
18 the Opponent to reply to what Mr. Dugdill had said. That is,
19 indeed, what happened at the hearing.

20 The Hearing Officer granted the request for an extension
21 of time for the reasons he subsequently gave in a written
22 decision issued under reference BL O-320-08 on 1st November
23 2007. His determination was as follows: "37. In reaching my
24 decision to confirm the Registry's Preliminary View to allow
25 the extension of time request, I took account of the guidance

1 provided by the Appointed Persons. I was satisfied that XML
2 had provided strong and compelling reasons to support their
3 request for more time to be allowed. XML had shown the
4 reasons why more time was required to prepare and submit their
5 evidence in reply. XML had, for financial reasons, taken the
6 decision to dispense with their legal representation and as
7 a consequence of this decision they had had to obtain all the
8 papers entered into the proceedings from their previous legal
9 representatives. There had been a delay in obtaining the
10 papers and once obtained, XML were required to scrutinize what
11 they regarded as being lengthy, complex and confusing
12 material. All of this contributed towards a need for
13 additional time within which to prepare a response to the
14 evidence submitted by GD in support of the trade mark
15 application.

16 "38. The decision to dispense with their legal
17 representation was XML's and I accept that there is an
18 argument for saying that they should have been better prepared
19 to face the possible consequences of their decision. That
20 said, I am mindful of the fact that by having dispensed with
21 their legal representation, at such an advanced stage in the
22 proceedings, XML found themselves to be in a disadvantageous
23 position. This is because, even though GD is also a litigant
24 in person operating no doubt under similar pressures and
25 constraints as XML, XML had clearly relied on their legal

1 representatives to advise them and deal with all the issues
2 pertaining to the case. XML were therefore not as familiar
3 with the details of the proceedings compared to GD,
4 who had litigated the case from the outset.

5 "39. I was of the view, that having obtained the
6 relevant papers from D Young & Co, XML should be allowed a
7 period of time within which they could identify, prepare,
8 collate and submit their evidence in reply. This would, I
9 believe, place the parties to these proceedings on a more
10 equitable footing.

11 "40. I bore in mind that, by the date of the hearing,
12 the work of compiling all the evidence had been completed and
13 that the evidence had already been filed at the Registry.
14 When the Registrar is faced with having to decide on a
15 dispute, in particular one as acrimonious as this one appears
16 to be, it must be clearly to the benefit of all the parties to
17 have all of the evidential material placed into the
18 proceedings. This will ensure that the Hearing Officer, at
19 final determination, will have the benefit of having
20 before him all of the evidence and submissions. This must be
21 preferable to the possible alternative of the proceedings
22 being terminated and then having another set of proceedings
23 started between the same parties, covering the same issues and
24 with the same evidence being filed into the new proceedings.

25 "41. However, this is not to be taken as meaning that

1 the Registrar will always, when the evidence has been filed,
2 favour the party seeking the indulgence. Nevertheless, it must
3 surely be in the interest of all the parties to the
4 proceedings that the dispute is resolved expeditiously, fairly
5 and by saving expense wherever and whenever possible. This,
6 in general terms, accords with the observations of Laddie J in
7 the appeal case Hunt-Wesson Inc's Trade Mark Application
8 (1996) RPC 233 at 241:

9 'An opposition may determine whether or not a new
10 statutory monopoly, affecting all traders in the country, is
11 to be created. Refusing permission to an opponent who files
12 evidence late affects not only him but also may penalise
13 the rest of the trade although the matter is not clear,
14 it is probable that if the evidence is excluded and the
15 opponent, as a result, loses then he will be able to
16 return again in separate proceedings to seek rectification of
17 the register. An advantage of allowing in the evidence
18 is that it may well avoid a multiplicity of proceedings.'

19 "42. Before reaching my decision to grant the extension
20 of time I considered the possible consequences that my
21 decision would have for GD. In reviewing all of the papers on
22 the case I came to the conclusion that there did not appear to
23 me that there would be any obvious or immediate consequences
24 for GD if the extension of time for three months was granted.
25 What was clear to me was that the parties were involved in a

1 protracted and increasingly fractious dispute with some very
2 serious accusations having been made. In view of this, I
3 believed that the view expressed in the TMR's letter of 28
4 June 2007 to ensure that it would be in the interest of both
5 parties to have all the available evidential material admitted
6 into the proceedings and placed before the Hearing Officer at
7 final determination, was correct. In LIQUID FORCE (1999) RPC
8 429 the Appointed Person said:

9 '... In the interest of legal certainty it is plainly
10 desirable that valid applications for registration should
11 succeed and valid objections to registration should be
12 upheld without undue delay.'

13 "43. Taking into account all the circumstances of the
14 case, including the fact that the evidence was now available
15 and ready to be admitted into the proceedings, I decided to
16 exercise the Registrar's discretion and allow the opponent'
17 request for an extension of time within which to file its
18 evidence in reply."

19 Mr. Dugdill gave Notice of Appeal to an Appointed Person
20 under Section 76 of the Trade Marks Act 1994 asking for the
21 preliminary view issued on 8th June 2007 to be reinstated and
22 confirmed and, as a consequence of that, for the requested
23 extension of time to be refused. The Statement of Grounds in
24 support of the appeal was 27 pages long. It was accompanied
25 by 75 pages of attachments. The penultimate paragraph of the

1 Statement of Grounds stated: "I submit now that these
2 matters, together with my third witness statement, filed now
3 under Rule 13C(6), are reviewed again, and that the request is
4 rejected."

5 Mr. Dugdill's third witness statement was dated 29th
6 November 2007. It was 6 pages long and accompanied by 8
7 exhibits. This evidence has not yet been formally admitted
8 into the Registry proceedings under Rule 13C(6). For the
9 reasons given in my ruling earlier this afternoon, I declined
10 to allow it to be tendered in evidence on this appeal.

11 It is necessary at this juncture to emphasise that the
12 starting point for the purposes of the present appeal is the
13 Hearing Officer's decision issued on 1st November 2007. I
14 would only be entitled to set his decision aside under s.76 of
15 the Act on the basis of manifest error or serious procedural
16 irregularity.

17 As I have already indicated, the Hearing Officer
18 maintained that the matter before him was the correctness or
19 otherwise of the preliminary view issued on 22nd June 2007.
20 He rejected Mr. Dugdill's contention that the question for
21 determination was whether the preliminary view issued on 8th
22 June 2007 should be reinstated and confirmed. All of this was
23 beside the point. Fortunately, it appears to have been
24 inconsequential in relation to the basic question which had to
25 be decided, i.e. whether the request for an extension of time

1 should be granted or refused.

2 I do not accept that the Hearing Officer's decision is
3 liable to be set aside on the basis of manifest error or serious
4 procedural irregularity simply because he allowed himself to
5 be drawn into a pointless debate about which of two
6 non-determinative and entirely non-binding preliminary views
7 should be regarded as subordinate to the other. I am
8 satisfied that this did not deflect or distract him from
9 determining the substantive merits of the question he needed
10 to determine under Rule 68 in the context of the case as a
11 whole.

12 So far as the substance of the determination is
13 concerned, it is incumbent on Mr. Dugdill to show that the
14 position adopted by the Hearing Officer in paragraphs 37-43 of
15 his decision was not tenable on any proper view of the matter.

16 Having considered the Statement of Grounds in support of
17 the appeal and having listened with care to the submissions
18 made by Mr. Dugdill at this hearing, I am of the view that not
19 only was the Hearing Officer correct to reach the conclusion
20 that he did, but that it would not have been just and fair to
21 the Opponent if he had ruled otherwise.

22 Mr. Dugdill's submissions, as summarised in his skeleton
23 argument for the hearing, amounted in varying degrees to an
24 invitation to me to exercise the relevant discretion under
25 Rule 68 as if it had not already been exercised in the first

1 instance by the Registrar's Hearing Officer.

2 A point was taken about the fact that extensions of time
3 had previously been granted in the proceedings. That point
4 was neither here nor there in relation to the matter as raised
5 and presented for consideration by the Hearing Officer.

6 It was emphasised by Mr. Dugdill on this appeal that
7 there would self-evidently be prejudice to him if he was
8 required to move forward in the opposition proceedings with a
9 greater burden of evidence to address than would have been the
10 case if the evidence in reply had not been allowed into the
11 proceedings. I can see from the materials before me that the
12 Hearing Officer was mindful of this consideration and he took
13 it into account when assessing the justice and fairness of the
14 case. He did not give it any wrong or improper weight in the
15 overall context of his deliberations.

16 Mr. Dugdill further contended that there was nothing of
17 assistance to the Opponent in the fact that it had
18 disinstructed its trade mark attorneys. The contention was
19 put to me, essentially, on the basis that this was not a
20 factor to be taken into account. If it was anything, it was a
21 self-inflicted inconvenience. I do not agree. The Hearing
22 Officer was entitled to weigh this factor in his
23 deliberations. He did so and I am not prepared to say that he
24 gave any wrong or improper weight to it.

25 A point was also taken as to whether the Opponent had

1 exercised, or been shown to have exercised, due diligence
2 during the initial period of three months allowed by the rules
3 for the filing of its evidence in reply. Reference was made
4 to the case of SYNERGY Trade Mark (BL O/165/07) and also to
5 the familiar citation of SIDDIQI'S APPLICATION (BL O/481/00).

6 I agree that the Hearing Officer could have been more
7 expansive than he was on the question of diligence during this
8 initial three month period. It is evident from the fact that
9 he referred to the SIDDIQUI decision in his decision (which is
10 part of the working knowledge and experience of the
11 Registrar's hearing officers) that the significance of this
12 point was not lost on him. I am satisfied that he did not
13 overlook it. It appears to me that he considered that it was
14 outweighed by other factors.

15 Mr. Dugdill maintained that no reliance should have been
16 placed on a letter which the Opponent had sent to the
17 Registrar on 21st June 2007. I was taken through this letter
18 at length. It was said to be "a pack of lies". I cannot
19 possibly say that the contents of it are "a pack of lies", as
20 contended. It is not evident to me, on looking at the
21 statements made in that letter, that they are lies. There
22 are, at worst, inaccuracies of expression in limited respects
23 concerning the conduct of related High Court proceedings. I
24 am satisfied on looking at that letter and comparing the
25 contents of it with the decision given by the Hearing Officer

1 that he gave only such weight to the uncontroversial aspects
2 of it as they were entitled to bear in the context of his
3 deliberations as a whole.

4 It must be remembered that the Hearing Officer's
5 decision was a case management decision. He needed to
6 identify the relevant factors and grade them according to the
7 weight that he thought they ought properly to be given in the
8 context of the request for an extension that was before him.
9 He did so. I am satisfied that his decision is
10 unobjectionable and not liable to be set aside on appeal.

11 For these reasons, shortly stated, the appeal is
12 dismissed and it will be dismissed with costs.

13 MR. CHUBB: Thank you sir.

14 THE APPOINTED PERSON: You need to address me on the question of
15 costs. You asked in your written submission for an award of
16 costs. I assume you are maintaining your application for
17 costs?

18 MR. CHUBB: Yes, I am, sir.

19 THE APPOINTED PERSON: The only costs in front of me are the costs
20 of this appeal. I need to have some indication from you of
21 the amount of time that you have spent, not only at today's
22 hearing but in the course of reading the materials that were
23 put to you by the other side and dealing with them and getting
24 ready for the hearing and I also need to hear whether you have
25 had travelling expenses and that sort of thing to be here.

[Type text]

1 Would you like to give me some details?

2 MR. CHUBB: Obviously, in terms of the time, we have been here, I
3 guess, since 2 o'clock. We have travelled from Bromley by
4 train. It is about half an hour travelling time each way.
5 Costs are £5 return. There was a taxi fair of £12 to get
6 here. In terms of preparing for today ----

7 THE APPOINTED PERSON: Skeleton argument?

8 MR. CHUBB: ---- the skeleton argument, I would probably say it
9 took me about an hour to do, sir. I have to admit, I followed
10 Mr. Colombo's decision. In terms of looking on the internet
11 and trying to check the procedural matters, was probably about
12 another hour, sir.

13 THE APPOINTED PERSON: Reading the paperwork that was served on
14 you by Mr. Dugdill?

15 MR. CHUBB: I would say that would be about another hour.

16 THE APPOINTED PERSON: Did you do this work alone or did you
17 collaborate?

18 MR. CHUBB: No, it is my own work, sir.

19 THE APPOINTED PERSON: Approximately speaking, about three hours
20 of work, two and a half hours of attendance and some travel
21 time, half hour each way?

22 MR. CHUBB: Yes, sir.

23 THE APPOINTED PERSON: Mr. Dugdill, do you want to say whether you
24 object to any allowance for costs being made in relation to
25 those matters?

1 MR. DUGDILL: The one point I would make is that I think that
2 costs in front of the Registry are viewed as being some sort
3 of contribution, rather than compensation.

4 THE APPOINTED PERSON: Yes. On the basis of the information I
5 have received, I will make an award in favour of the
6 successful party on this appeal. I shall award the sum of
7 £225, to be paid within 14 days of today's date by the losing
8 party to the prevailing party. Those are the costs in
9 relation to this appeal.

10 You will hear through the usual channels in due course
11 about the appeal in relation to security for costs and I have
12 already indicated earlier this afternoon that you may hear
13 from me with written indications of points that I would like
14 to be addressed. I will think about that when I have
15 familiarised myself with the papers in that other matter and I
16 will communicate with you in that connection.

17 That, I think, wraps it up for today. Thank you.

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