

O-258-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION 2000252 IN CLASS 8 BY  
PHILIPS ELECTRONICS NV AND IN THE MATTER OF  
OPPOSITION THERETO UNDER NO 45011 BY REMINGTON  
CONSUMER PRODUCTS LTD**

## TRADE MARKS ACT 1994

**In the matter of Application No. 2000252 in Class 8  
By Philips Electronics NV and in the matter of  
Opposition thereto under No 45011 by Remington  
Consumer Products Ltd.**

### BACKGROUND

On 31 October 1994 Philips Electronics NV (Philips), under application No 2000252, applied to register the three dimensional shape of the head of an electric razor in Class 8. The trade mark was examined and accepted on the basis of distinctiveness acquired through use and prior rights in registration No 1254208 for the following specification:

*Shaving apparatus; shaving unit, namely housing with shaving heads; and parts and fittings included in Class 8 for all the aforesaid goods.*

The prior registration was for a two dimensional representation of the head of an electric razor and had also been accepted on the basis of distinctiveness acquired through use.

The application was published on 1 May 1996 and was opposed by Remington Consumer Products Ltd (Remington). The grounds of opposition were :

- i. Under Section 3(1)(a) because the trade mark applied for was not a sign within the meaning of Section 1(1) of the Act;
- ii. Under Section 3(1)(b) because the trade mark was devoid of any distinctive character;
- iii. Under Section 3(2)(a) because the trade mark consisted of the shape which resulted from the nature of the goods;
- iv. Under Section 3(2)(c) because the trade mark consisted of a shape which gave substantial value to the goods;
- v. Under Section 3(3)(a) because the registration of the mark was applied for in bad faith.

The grounds were denied by the applicant and both sides filed evidence in support of their pleadings. Philips had also commenced infringement proceedings in the High Court against Remington on the basis of their prior registration of a two dimensional representation of a three headed rotary shaver head. Remington defended by disputing the validity of the registration and counterclaimed that it was invalid. In a judgement delivered in December 1997, Philips Electronics NV v. Remington Consumer Products Ltd (1998) RPC 283 Mr. Justice Jacob upheld Remington's contentions and

found that the registration was invalid. In view of Mr. Justice Jacob's decision, Remington contended that the opposition proceedings before the Registrar were *res judicata*. They believed that the issues raised in the opposition proceedings were so closely similar to those already decided by the High Court that to continue with the proceedings would amount to an abuse of process. Philips denied both claims and sought to stay the proceedings pending the outcome of an appeal to the Court of Appeal to Mr Justice Jacob's decision.

On 6 January 2006 an interlocutory hearing was appointed and the Hearing Officer, in a written decision O/002/99, found that Mr Justice Jacob's decision did not give rise in the opposition proceedings before the Registrar to *res judicata* because he was not satisfied that the same cause of action was involved. He also found that there was no abuse of process on the part of Philips in seeking to continue the opposition proceedings before the Registrar. The Hearing Officer then went on to consider the request by Philips to stay the proceedings until the decision of the Court of Appeal in Philips v. Remington was known. In view of the circumstances the Hearing Officer agreed that a stay of the opposition proceedings was appropriate until the decision of the Court of Appeal was known. The opponents, Remington, were ordered to forward a copy of the judgement and decision, once received, to the Registrar for inclusion into the proceedings.

On 29 January 1999 Remington filed a Notice of Appeal to the High Court against the Hearing Officer's decision. In a judgement dated 29 March 1999, HC 1999 Case No 00510, Mr Justice Rimer rejected Remington's appeal and upheld the Hearing Officer's decision to refuse Remington's application for the refusal of No 2000252 on the basis of *res judicata* and in the alternative that it be struck out as an abuse of process. Mr Justice Rimer also directed that the opposition proceedings should be stayed pending the outcome of the decision of the Court of Appeal in the action in the High Court between Remington v. Philips concerning the infringement and validity of trade mark No 1254208.

On 31 March 1999 Remington filed a Notice of Appeal to the Court of Appeal against the decision of Mr Justice Rimer.

On 5 May 1999 a judgement was handed down by the Court of Appeal in the Remington v. Philips infringement/revocation action, Case No 98/0103. The judgement upheld the decision of Mr Justice Jacob to hold the trade mark as invalid. However, the Court of Appeal ruled that as most of the issues between the parties had raised difficult questions of construction of the Council Directive, 89/104/EEC of 21 December 1988, a referral to the European Court of Justice in accordance with Article 177 of the Treaty would be necessary before a final decision could be reached. By an Order of the Court of Appeal dated 5 May 1999 the proceedings were stayed pending a ruling from the European Court of Justice on the questions referred to it by the Court of Appeal.

The Advocate General on 23 January 2001 delivered his Opinion to the European Court of Justice and this was followed on 18 June 2002 by the Judgement of the European Court of Justice Case C-299/99.

On 8 October 2003, with the agreement of the Registrar, Remington and Philips withdrew the appeal before the Court of Appeal against the Hearing Officer's Interlocutory Hearing decision. The opposition proceedings before the Registrar were stayed pending the final outcome, including any appeals, of the High Court Action (HC 2000 No. 00678).

Under the terms of the stay Philips agreed that if their registration of a two dimensional picture of the shape of a three headed rotary electric shaver, No 1533452, was held to be invalid and/or revoked and once all the appeal procedures had been exhausted, Philips would consent to an order in the opposition proceedings that the opposition be allowed. Application No 2000252 would be refused registration and an award of costs would be made by the Registrar in favour of Remington.

Remington agreed that if trade mark No 1533452 was held to be valid and once all the appeal procedures had been exhausted, Remington would consent to an order in the opposition proceedings that the opposition be dismissed and that an award of costs would be made by the Registrar in favour of Philips.

On 21 October 2004 Mr Justice Rimer handed down a judgement in the High Court HC 2000 No.00678, in favour of Remington, that trade mark No 1533452 was invalid. The judgement was appealed by Philips to the Court of Appeal on 18 November 2004.

The Court of Appeal on 26 January 2006 dismissed the appeal in respect of trade mark No 1533452 and refused any application to present a petition of appeal to the House of Lords. The cancellation of trade mark No 1533452 was to be stayed for 28 days and if within that period Koninklijke Philips Electronics NV lodged a petition of appeal with the House of Lords then the cancellation order would be further stayed until the determination of any appeal.

On 14 June 2006 the House of Lords Appeal Committee Report informed the parties that Koninklijke Philips Electronics NV's application for permission to appeal Mr Justice Rimer's decision was refused on the grounds that the petition did not raise an arguable point of law of general public importance. An appeal in relation to the point of European Community law raised in the application was also refused as the provision in question had already been interpreted by the European Court of Justice.

The effect of the refusal by the House of Lords to give permission for Koninklijke Philips Electronics NV to appeal Mr Justice Rimer's decision is that the proceedings have been concluded and the Order of the Court of Appeal is final. Trade mark No 1533452 is invalid. On 14 August 2006 the status of trade mark No 1533452 was recorded on the United Kingdom Trade Mark Register as Invalid.

## **DECISION**

The opposition proceedings before the Registrar in respect of No 2000252 were stayed pending the final outcome of the proceedings in respect of trade mark No 1533452 in accordance with the Order of Deputy Master Joseph in the Court of Appeal dated 15 October 2003. Permission to appeal has been refused by the House of

Lords and the effect of this is that the opposition by Remington Consumer Products Ltd is allowed and trade mark application No 2000252 is refused registration.

## **COSTS**

The opponents have been successful and are entitled to a contribution towards their costs. In accordance with paragraph 2(a) of the Terms of Stay agreed between the parties I order Philips Electronics NV to pay Remington Consumer Products Limited the sum of £ 935.00. This award is made from the scale of costs applicable in proceedings commenced before 22 May 2000.

Dated this 13th day of September 2006

Raoul Colombo  
For the Registrar,  
The Comptroller General