

O-319-08

TRADE MARKS ACT 1994

IN THE MATTER OF AN INTERLOCUTORY HEARING IN RELATION TO:

**APPLICATION NO 2429824
BY PAVEL MASLYUKOV
TO REGISTER THE TRADE MARK:**



IN CLASSES 33 AND 43

AND

**OPPOSITION THERETO (UNDER NO 96604) BY FREDERIC ROBINSON
LIMITED**

TRADE MARKS ACT 1994

IN THE MATTER OF An interlocutory hearing in relation to:

Application no 2429824

By Pavel Maslyukov to register in classes 33 & 43 the trade mark:



and

**Opposition thereto (under no 96004),
by Frederic Robinson Limited**

BACKGROUND

1. Pavel Maslyukov applied for the registration of the above trade mark on 13 September 2006 in classes 33 and 43. The application was published for opposition purposes in the Trade Marks Journal on 14 December 2007. On 12 March 2008, Frederic Robinson Limited filed a Form TM7 and notice of opposition against the registration of the above application.
2. On 12 May 2008, Mr Maslyukov filed a defence by way of a Form TM8 and counterstatement. On this date, he also requested a suspension of the proceedings in light of two sets of opposition proceedings ongoing at the Office for Harmonization in the Internal Market (Trade marks and Designs) ("OHIM"). Mr Maslyukov is the opponent in the proceedings at OHIM against two later filed Community Trade Marks ("CTMs"); his opposition at OHIM is based on the pending trade mark application which is the subject of the proceedings here. On 22 May 2008 a preliminary view was issued by the Tribunal Section of the Intellectual Property Office ("IPO") refusing the request for suspension; this was reiterated in further letters dated 3 July 2008 and 29 July 2008. Mr Maslyukov then requested a hearing.

The Hearing

3. The hearing took place before me on 7 October 2008. Mr Maslyukov, having also filed written submissions in advance of the hearing, represented himself. Neither the opponent, nor its representative, attended the hearing, nor did it file any written submissions. However, in its letter dated 15 September 2008,

the opponent indicated that it agreed with the preliminary view not to suspend the proceedings.

4. During the hearing, Mr Maslyukov focussed on two key factors:

- Firstly, that the proceedings at OHIM were launched prior to the proceedings here and that the OHIM proceedings should, therefore, be allowed to proceed to a conclusion first. Mr Maslyukov specifically referred to a practice of OHIM which allows for the suspension of proceedings at Community level if a dispute at national level has been launched first; Mr Maslyukov argued that there was no reason why such a practice could not operate in reverse. Further, it was proper, in his view, for OHIM to reach a decision on the similarity of the respective trade marks first and then for the IPO to decide on the similarity of the goods and services.
- Secondly, that he suspected that the opponent in the proceedings here and the CTM applicants in the OHIM proceedings had engineered the opposition against his trade mark. He referred to this as “sourcing”, his suspicion being that the opponent here had surrendered other registered trade marks in order to clear the way for the later CTM applications. As further support for this line of argument, Mr Maslyukov pointed out that the opponent in the proceedings here had failed to oppose the later CTM applications despite them being (in his view) “confusingly similar” to its earlier trade marks. Mr Maslyukov went on to argue that allowing the proceedings here to continue before the proceedings at OHIM were resolved could set a dangerous precedent because the circumstances described would have the effect of enabling later CTM applicants to dispose of an earlier national trade mark.

5. Following the hearing, my decision was to refuse Mr Maslyukov’s request for the proceedings to be suspended. On 10 October 2008, Mr Maslyukov filed a Form TM5 requesting a written statement of the grounds of my decision, this is given below.

DECISION

The Registrar's power to direct suspension

6. When Mr Maslyukov made his first request for suspension neither the Act nor the trade mark rules that were in force at that time (the Trade Marks Rules 2000 (as amended)) included any express reference to a power enabling the Registrar to suspend proceedings. However, I note the decision in *Pharmedica* [2000] R.P.C. 536, where Pumfrey J stated at page 541:

“Notwithstanding the fact that the Registrar is, like the County Court, a tribunal which is established by statute, I have no doubt that the Registrar has the power to regulate the procedure before her in such a way that she neither creates a substantial jurisdiction where none existed, nor exercises that power in a manner inconsistent with the express provisions conferring jurisdiction upon her.”

7. In any event, by the time Mr Maslyukov renewed his request for suspension at the hearing before me on 7 October, the Trade Marks Rules 2008 had come into force. These rules expressly confer a discretionary power on the Registrar to direct suspension in appropriate circumstances. Rule 62(1)(f) states:

“62.—(1) Except where the Act or these Rules otherwise provide, the registrar may give such directions as to the management of any proceedings as the registrar thinks fit, and in particular may—

(a).....

(b).....

(c).....

(d).....

(e).....

(f) stay the whole, or any part, of the proceedings either generally or until a specified date or event;
.....”

8. It is, therefore, clear from the above that I have the power to direct suspension and that such a power is to be exercised as a matter of discretion.

The principles to be applied

9. In terms of the principles that underpin the manner in which I should exercise my discretion in this matter, I bear in mind that the IPO, in its role as a tribunal, adheres to the same overriding objective as the Court in order to deal with cases justly, as per Part 1.1 of the Civil Procedure Rules. This includes,

so far as is practicable:

- (a) ensuring that the parties are on an equal footing;
- (b) saving expense;
- (c) dealing with the case in ways which are proportionate -
 - (i) to the amount of money involved;
 - (ii) to the importance of the case;
 - (iii) to the complexity of the issues; and
 - (iv) to the financial position of each party;
- (d) ensuring that it is dealt with expeditiously and fairly; and
- (e) allotting to it an appropriate share of the court's resources, while taking into account the need to allot resources to other cases.

10. I have also borne in mind the guidance provided in *Sears v Sears Roebuck* [1993] R.P.C. 385 where Lindsay J. stated:

“I do not need to say, nor do I say, that the High Court proceedings will of themselves determine the proceedings in the Registry. Nor do I need to say that there is no issue in the Registry which is not also an issue in the High Court. I do, however, say that the matters are substantially the same. The multiplicity ground, in my judgment, is made good.”

11. Taking the above in the round, the decision on whether to exercise my discretion to suspend these proceedings requires an assessment of the factors relied upon in order to determine the impact that they will have on the proceedings (and the parties). In terms of this impact, the consequences on cost, time and justice between the parties are important as is the requirement for cases to be dealt with expeditiously and fairly. In terms of the proceedings being the subject of litigation elsewhere, whilst complete identity between the proceedings is not essential, nor that one is determinative of the other, the proceedings should nevertheless be substantially the same – I also note that Lindsay J. called for the adoption of a commonsense approach.

Application of the principles

12. In this case, Mr Maslyukov is using his pending UK trade mark (the subject of the proceedings here) as the basis for oppositions at OHIM. The parties and the relevant trade mark details for all of the proceedings can be seen in the Annex to this decision. As can be seen, with the exception of Mr Maslyukov, the parties in the proceedings at OHIM differ from the proceedings here. Likewise, the CTMs under opposition at OHIM are not the same as those in

issue here. Mr Maslyukov (and his trade mark application) is the only common denominator.

- 13.** One of the key issues to be considered is the impact that the proceedings at OHIM will have on the proceedings here. During the hearing, I indicated that I considered this to be an important matter and Mr Maslyukov was given an opportunity to make submissions specifically on this point. However, he was unable to directly address this; rather, he restated his view that OHIM was the correct authority to decide on the similarity of the respective trade marks. There are two scenarios to be considered, depending on whether Mr Maslyukov succeeds or fails with his oppositions at OHIM. If he were to succeed, there is, in my view, no real impact on the proceedings here. The proceedings here would still need to proceed to a conclusion and, although OHIM may have found a similarity (and a likelihood of confusion) between Mr Maslyukov's trade mark and the later filed CTMs, this would have no bearing on the proceedings here given that an opposition decision of OHIM does not bind national offices in any way and, furthermore, the marks and the comparisons to be made in the proceedings here are, in any event, not the same. Mr Maslyukov's submissions on this point led me to believe that he considers a success at OHIM to be helpful to his position in the proceedings here; in my view, this is not the case. Even if Mr Maslyukov fails with his oppositions at OHIM then, similarly, there is no impact on the proceedings here as they would still need to be concluded and, for the reasons already given, the proceedings at OHIM and the outcome reached there is of no real assistance to this tribunal.
- 14.** In my view, this is quite different from the situation in the *Sears v Sears Roebuck* case as the aim of avoiding a multiplicity of litigation will not be avoided and, neither will the decision reached by OHIM, despite Mr Maslyukov's submissions, be of any assistance. In terms of potential impact, the only impact, bearing in mind the relationships between the various proceedings, that may arguably support a request for a stay, relates more to the fact that Mr Maslyukov relies on his pending UK application in his oppositions at OHIM. It therefore seems that any stay would be in reverse, namely, that the proceedings at OHIM may benefit from suspension given that they are based on an earlier mark which has not achieved registration and is, itself, under challenge. However, that is not a matter for me. The earlier marks the subject of the opposition before this tribunal are registered marks with no challenge having been made to them.
- 15.** Mr Maslyukov's second line of argument relates to what he described as opposition "sourcing" or, in other words, that the opponent here and the applicants at OHIM have in some way engineered the opposition against his trade mark. There is no real evidence to support this proposition. That the opponent chose not to oppose the later CTM marks that Mr Maslyukov has opposed was entirely a matter for it to decide based on its own commercial interests and decisions. It is, in any case, not relevant to the issue in question as I can see no benefit in suspending the proceedings.

16. In summary, and considering the two factors relied on by Mr Maslyukov, I am not satisfied that there is any real benefit in suspending these proceedings. Awaiting the outcome of the proceedings at OHIM would serve no real purpose, it will not have the effect of, for example avoiding unnecessary expense from having to pursue multiple proceedings because each of them requires independent determination, neither will awaiting the outcome of the OHIM proceedings assist this tribunal in its determination. Indeed, the only impact I can see is a negative one in terms of the additional time that will be taken to resolve the dispute here; this is certainly not in line with the overriding objective to deal with cases in an expeditious manner. The “sourcing” argument is not relevant either for the reasons given. As such, the request to suspend these proceedings was refused.

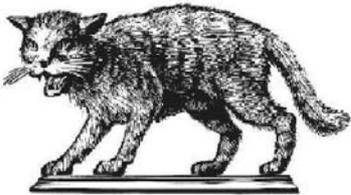
17. No submissions on costs were made by either party.

Dated this 4th day of December 2008

**Louise White
For the Registrar
The Comptroller General**

Annex

OHIM proceedings (x2)

Applied for trade marks	Opponent's earlier trade mark
<p>CTM 6207963 for the mark:</p>  <p>In the name of Diageo Scotland Limited</p> <p>In respect of:</p> <p>Class 33: Alcoholic beverages (except beers); whisky and whisky based beverages.</p> <p>Application date: 17 August 2007</p>	<p>UK application 2429824 for the mark:</p>  <p>In the name of Pavel Maslyukov</p> <p>In respect of:</p> <p>Class 33: Gin; prepared alcoholic cocktails containing gin; gin-based liqueurs.</p> <p>Class 43: Services for providing temporary accommodation; services for providing drinks from a vending machine.</p> <p>Application date: 13 September 2006</p>
<p>CTM 6278618 for the mark:</p> <p>HAYMAN'S OLD TOM GIN</p> <p>In the name of Hayman Limited</p> <p>In respect of:</p> <p>Class 33: Alcoholic beverages (except beers);</p> <p>Application date: 14 September 2007</p>	<p>UK application 2429824 for the mark:</p>  <p>In the name of Pavel Maslyukov</p> <p>In respect of:</p> <p>Class 33: Gin; prepared alcoholic cocktails containing gin; gin-based liqueurs.</p> <p>Class 43: Services for providing temporary accommodation; services for providing drinks from a vending machine.</p> <p>Application date: 13 September 2006</p>

UK Proceedings

Applied For trade mark	Opponent's Trade marks
<p data-bbox="188 383 638 416">UK application 2429824 for the mark:</p>  <p data-bbox="188 725 574 759">In the name of Pavel Maslyukov</p> <p data-bbox="188 786 349 819">In respect of:</p> <p data-bbox="188 846 705 913">Class 33: Gin; prepared alcoholic cocktails containing gin; gin-based liqueurs.</p> <p data-bbox="188 925 730 1021">Class 43: Services for providing temporary accommodation; services for providing drinks from a vending machine.</p> <p data-bbox="188 1032 635 1066">Application date: 13 September 2006</p>	<p data-bbox="810 383 1260 416">UK registration 2125204 for the mark:</p> <p data-bbox="810 443 959 477">OLD TOM</p> <p data-bbox="810 510 968 544">In respect of:</p> <p data-bbox="810 571 1358 667">Class 32: Beer, stout, lager, porter, ale; drinks containing not more than 1.2% (by volume) of alcohol.</p> <p data-bbox="810 678 1230 712">Application date: 28 February 1997</p> <p data-bbox="1075 770 1134 804" style="text-align: center;">AND</p> <p data-bbox="810 831 1246 864">UK registration 854052 for the mark:</p> <p data-bbox="810 898 1238 931">ROBINSON'S OLD TOM ALE</p> <p data-bbox="810 965 968 999">In respect of:</p> <p data-bbox="810 1025 968 1059">Class 32: Ale</p> <p data-bbox="810 1093 1254 1126">Application date: 13 September 1963</p> <p data-bbox="810 1153 1406 1220">Both marks stand in the name of: Frederic Robinson Limited</p>