

1 THE PATENT OFFICE

Court 1,  
Harmsworth House,  
13- 15 Bouverie Street,  
London EC4

4 Monday, 24th November 2008

5 Before:

6 MR. GEOFFREY HOBBS QC  
7 (Sitting as the Appointed Person)

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9  
10 In the Matter of an Appeal to the Appointed Person  
11 In the Matter of Application No: 2404164 by Gary Milton Munroe  
12 to Register a Series of Marks in classes 9 and 42, opposition  
13 thereto under no. 94454 by Intel Corp., and appeal against the  
14 decision by the Registrar dated 29 May 2008

13 - - - - -

15 (Transcript of the Stenograph notes of Marten Walsh Cherer  
16 Ltd., 6th Floor, 12-14 New Fetter Lane, London EC4A 1AG  
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18 - - - - -

20 MR. MARK ENGELMAN appeared as counsel on behalf of the  
21 Applicant.  
22 MR. JAMES MELLOR QC (instructed by Messrs. CMS Cameron McKenna  
23 LLP) appeared as counsel on behalf of the Opponent.

22 - - - - -

24 APPROVED DECISION RE APPLICATION TO AMEND GROUNDS OF APPEAL

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1 THE APPOINTED PERSON: Mr. Gary Munroe appeals from a decision  
2 issued by Mr. David Landau acting on behalf of the Registrar  
3 of Trade Marks. The decision was issued under reference  
4 number BL O-150-08 on 29th May 2008 in the context of Intel  
5 Corporation's opposition number 94454 to Mr. Munroe's trade  
6 mark application number 2404164 filed on 12th October 2005.

7 The hearing officer's decision was issued following  
8 a hearing in the Registry on 14th May 2008 at which Mr. Munroe  
9 represented himself and Intel Corporation was represented by  
10 Ms. Anna Carboni of counsel, instructed by Messrs Saunders &  
11 Dolleymore.

12 Ms. Carboni was and is one of a small number of persons  
13 appointed under section 77 of the Trade Marks Act 1994 to hear  
14 and determine appeals from the Registrar of Trade Marks under  
15 section 76 of the Act.

16 The hearing officer will have been aware of her status  
17 as an Appointed Person. He did not mention it and I have no  
18 doubt that he did not do so because it never occurred to him  
19 that it could have the slightest significance in relation to  
20 any aspect of the conduct of the proceedings before him.

21 Mr. Munroe was not aware of Ms. Carboni's status as an  
22 Appointed Person until it was brought to his attention in the  
23 course of the events which I now go on to describe.

24 The notice and grounds of appeal were filed on 25th June  
25 2008. The papers in the case were subsequently forwarded to

1 me via the Treasury Solicitor's Department in mid-July.

2 On 1st August 2008 Messrs. Saunders & Dolleymore sent  
3 a letter to the UK Intellectual Property Office confirming  
4 that Intel Corporation was agreeable to the appeal being heard  
5 by an Appointed Person and did not intend to ask for the  
6 matter to be referred to the court under section 76(3)(c) of  
7 the Act. The letter confirmed that their client intended to  
8 be represented by Ms. Carboni at the hearing of the appeal.

9 The letter of 1st August was forwarded to me via the  
10 Treasury Solicitor's Department. I saw it on my return to  
11 chambers on 13th August. Having noted that Intel Corporation  
12 intended to be represented by one Appointed Person on appeal  
13 to another, I wrote to the Treasury Solicitor's Department on  
14 15th August 2008 in the following terms:

15 "The letter dated 1 August 2008 from Messrs.  
16 Saunders & Dolleymore was drawn to my  
17 attention on my return to Chambers on 13  
18 August 2008.

19 I note that the respondent to the above appeal  
20 intends to be represented by Ms. Anna Carboni  
21 of Counsel.

22 Ms. Carboni is one of the 5 persons currently  
23 authorised to sit as the Appointed Person on  
24 appeals from the Registrar of Trade Marks  
25 under Section 76 of the Trade Marks Act 1994.

The respondent thus intends to be represented  
by one Appointed Person on appeal to another.

That is a situation which has not arisen  
before. I believe that it raises the question  
whether the right to be represented by an  
advocate of one's choosing is to any extent  
restricted in the circumstances of the present

1 appeal by the requirement for the tribunal  
2 hearing the appeal to be (and be seen to be)  
3 independent and impartial under Article 6  
4 ECHR.

5 I note that in *Lawal v Northern Spirit Ltd*  
6 [2003] UKHL 35; [2004] 1 All E R 187 (HL);  
7 the House of Lords held that part time judges  
8 of the Employment Appeal Tribunal should not  
9 appear as advocates before a panel of that  
10 Tribunal consisting of one or two lay members  
11 with whom they have previously sat.

12 That decision was preceded by the decision of  
13 the Court of Appeal in *Geveran Trading Co. Ltd*  
14 *v Skjevesland* [2003] EWCA Civ. 1567; [2003] 1  
15 WLR 912 to the effect that an advocate may  
16 only be prevented from acting for a party in  
17 exceptional circumstances.

18 I am unsure as to whether or when exceptional  
19 circumstances may be found to exist in a case  
20 where an advocate intends to appear before an  
21 appellate tribunal of which (s)he is a part  
22 time member and the appellate tribunal is a  
23 specialist body whose membership is confined  
24 to persons qualified to act alone in a  
25 judicial capacity.

I do not want these matters to go unnoticed by  
the parties or the Registrar. Would you  
please therefore forward this letter to them  
with a request for any observations that they  
may wish to make in response to what I have  
said to be sent to me in writing (and at the  
same time copied to the others of them) by no  
later than 17:00 hours on Friday 5th September  
2008.

I shall consider whether any further action is  
required in the light of any responses I  
receive. The fixing of the date for the  
hearing of the appeal will in the meantime be  
deferred."

Over the following four weeks I received written  
observations from Mr. Allan James on behalf of the UK

1 Intellectual Property Office, from Ms. Carboni, from Messrs.  
2 Saunders & Dolleymore and from Mr. Munroe. Mr. Munroe's  
3 observations were prepared with the assistance of Mr. Mark  
4 Engelman of counsel acting under the rules relating to direct  
5 public access to Members of the Bar in England and Wales.

6 Mr. Munroe maintained that, if one Appointed Person  
7 represented a party on appeal to another, there would be  
8 a breach of the requirements of Article 6 of the European  
9 Convention on Human Rights. Article 6 provides:

10 "In the determination of his civil rights and  
11 obligations .... everyone is entitled to  
12 a fair and public hearing .... by an  
independent and impartial tribunal established  
by law."

13 The need for compliance with the requirements of  
14 Article 6 was said to lead to the conclusion that Ms. Carboni  
15 should not be permitted to represent Intel Corporation on the  
16 proposed appeal to one of her fellow Appointed Persons.

17 Although it was open to Mr. Munroe to waive any  
18 objection he might otherwise have been entitled to raise to  
19 her appearing for Intel Corporation on the appeal, he did not  
20 do so.

21 On 15th September 2008 I issued a direction for the  
22 determination of a preliminary issue. This explained my  
23 concerns in the light of the written observations I had  
24 received. I directed that a hearing be appointed for the  
25 purpose of determining Mr. Munroe's objection to Intel

1 Corporation being represented by Ms. Carboni, with the hearing  
2 of the appeal against the decision below being deferred  
3 pending the determination of that issue.

4 A copy of the direction I issued on 15th September 2008  
5 is attached as Appendix A to this decision.

6 In making the observations I did, I was particularly  
7 conscious of two matters. The first was the need to recognise  
8 that the concepts of independence and impartiality are linked  
9 in a way that requires each of them to be seen as necessary  
10 for the attainment of the other. I think it is clear that  
11 affiliation bias can be a source of legitimate concern under  
12 Article 6. When I speak of "affiliation bias", I have in mind  
13 the capacity of at least some collegiate connections to  
14 influence the stance that members of a particular group may  
15 adopt towards each other or towards outsiders. The focus of  
16 attention would from that perspective be the conformation of  
17 the Appointed Persons as a group.

18 The second matter of particular concern to me was the  
19 need, as noted in paragraph 28 of my direction, to ensure that  
20 the Registrar as a decision-making body is always subject to  
21 the control of an appellate body which itself constitutes an  
22 independent and impartial tribunal.

23 I will take this opportunity to repeat the observations  
24 I made in *ADRENALIN Trade Mark*, BL O-397-02, 23rd September  
25 2002, at paragraphs 51 to 54.

1 "51. Mr. Gracey further submitted that his  
2 appeal should proceed by way of a rehearing of  
3 his requests to the Registrar, rather than a  
4 review of the Principal Hearing Officer's  
5 decision, in order to meet the point that his  
6 requests had not yet been determined by an  
7 independent and impartial tribunal established  
8 by law in accordance with the requirements of  
9 Article 6(1) ECHR.

10 52. The following paragraph in the judgment of  
11 the ECtHR in *Findlay v UK* (1997) 24 EHRR at  
12 244, 245 addresses the issues of independence  
13 and impartiality under Article 6(1);

14 '73. The Court recalls that in order to  
15 establish whether a tribunal can be  
16 considered as "independent", regard must  
17 be had *inter alia* to the manner of  
18 appointment of its members and their term  
19 of office, the existence of guarantees  
20 against outside pressures and the question  
21 whether the body presents an appearance of  
22 independence. As to the question of  
23 "impartiality", there are two aspects to  
24 this requirement. First, the tribunal  
25 must be subjectively free of personal  
prejudice or bias. Secondly, it must also  
be impartial from an objective viewpoint,  
that is, it must offer sufficient  
guarantees to exclude any legitimate doubt  
in this respect. The concepts of  
independence and objective impartiality  
are closely linked and the Court will  
consider them together as they relate to  
the present case ...'

53. It seems likely that an exhaustive  
assessment of the Registrar's role, the duties  
and powers of her hearing officers and the  
circumstances of their involvement in the  
decision taking process would be required in  
order to arrive at a fully considered view of  
the status of their decisions under Article  
6(1): *R v Spear* [2002] UKHL 31 (18th July  
2002) and *Millar v Dickson* [2001] UKPC D4  
(24th July 2001).

54. I do not consider it necessary to embark  
upon such an assessment in view of the

1 established principle that the protected  
2 afforded by Article 6(1) requires either that  
3 the decision-making body (in this case the  
4 Registrar) should constitute an independent  
5 and impartial tribunal or, if not, be subject  
6 to the control of an appellate body which  
7 itself constitutes an independent and  
8 impartial tribunal established by law with  
9 '**full jurisdiction**' (within the meaning of  
10 that expression as used in the case law of the  
11 ECtHR relating to Article 6(1) ECHR) to deal  
12 with the decisions of the Registrar as the  
13 nature of the case requires: *R (on the  
14 application of Alconbury Developments Ltd) v  
15 Secretary of State for the Environment,  
16 Transport and the Regions* [2001] UKHL 23 (9th  
17 May 2001) see paragraphs 86 to 88 and 107 to  
18 115 of the Opinion of Lord Hoffmann; *Ghosh v  
19 The General Medical Council* [2001] UKPC 29  
20 (18th June 2001) see paragraphs 31 to 34 of  
21 the Judgment delivered by Lord Millett;  
22 *Porter v Magill* [2001] UKHL 67 (13th December  
23 2001) see paragraphs 87, 88 and 93 of the  
24 Opinion of Lord Hope."

14 The principle I referred to in paragraph 54 has since  
15 been reaffirmed by the House of Lords in the case of *Runa  
16 Begum v Tower Hamlets London Borough Council* [2003] UKHL 5 and  
17 the Court of Appeal has gone on to confirm in the case of  
18 *Fazia Ali v Birmingham City Council* [2008] EWCA Civ 1228 (7th  
19 November 2008) that the principle remains valid and binding in  
20 the United Kingdom consistently with the reasoning of the  
21 judgment of the European Court of Human Rights in the case of  
22 *Tsfayo v United Kingdom* (60860/00) [2007] HLR 19.

23 My direction for the determination of a preliminary  
24 issue was subsequently overtaken by the decision on the part  
25 of Intel Corporation to be represented by alternate counsel,

1 Mr. James Mellor QC, at the hearing of the appeal.

2 The decision was notified in a letter of 1st October  
3 2008 in which Messrs. Saunders & Dolleymore made it clear that  
4 their client's decision to instruct other counsel was taken  
5 for reasons of expedience and not upon the basis of any  
6 perceived or conceded need to yield to Mr. Munroe's objection  
7 to its previous choice of counsel.

8 At that point there ceased to be any room for argument  
9 or doubt as to the Registrar's decision in the present case  
10 being subject to review by an independent and impartial  
11 tribunal established by law with full jurisdiction to deal  
12 with the decision of the Registrar as the nature of the case  
13 requires. See *DuPont Trade Mark* [2003] EWCA Civ 1368 at  
14 paragraphs 82 to 98 per May LJ and *Thorn Security Ltd v*  
15 *Siemens Schweiz AG* [2008] EWCA Civ 1161 at paragraphs 22 to 26  
16 per Mummery LJ.

17 Nevertheless, on 7th November 2008, Mr. Munroe gave  
18 notice of an application to amend his grounds of appeal so as  
19 to raise an allegation that he had been deprived of an  
20 independent and impartial hearing in the Registry because  
21 Intel Corporation had at that stage been represented by  
22 Ms. Carboni of counsel who, as an Appointed Person, should not  
23 have been permitted to appear before the hearing officer  
24 without his, Mr. Munroe's, knowledge and consent.

25 The proposed amendments to the grounds of appeal were as

1 follows:

2 "The HO was acting for and on behalf of the  
3 Registrar, which is a public authority within  
4 ss.6 and 6(3)(a) of the Human Rights Act 1998.  
The Appellant alleges that his Convention  
rights have been infringed.

5 PARTICULARS

6 The Appellant is and was entitled to enjoy the  
7 Convention right in the determination of his  
8 civil rights and obligations to a fair and  
9 public hearing within a reasonable time by an  
independent and impartial tribunal established  
by law within the meaning of Article 6(1) of  
Part I of the Convention Rights and Freedoms.

10 (i) The Respondent has failed to respect the  
11 Appellant's right in that the Appellant's  
12 counsel was aware when representing the  
13 Respondent before the Registrar and the  
14 Appointed Person that there were matters to  
15 which objection might be taken by the  
16 Appellant, namely that one Anna Carboni during  
17 that period of representation at all material  
18 times had been appointed and continued to act  
19 as an Appointed Person within the meaning of  
20 s.77(1) of the Trade Marks Act 1994 whilst at  
21 the same time acting as counsel to the  
22 Respondent and continued so to act, but failed  
23 to notify the Appellant at the earliest  
24 opportunity of the fact of that appointment, a  
25 matter which could and did prejudice the  
proper administration of justice.

(ii) In the circumstances, the Appellant was  
not fully cognisant of his right to object Ms  
Carboni's appearance as counsel for the  
Respondent which gave rise to both actual and  
apparent bias. Nor was he provided the  
opportunity of objecting, nor did he waive his  
rights to raise that objection.

(iii) In the circumstances, Ms Carboni's role  
both as an Appointed Person and appeared from  
time to time as counsel before both the  
Registrar and Appointed Person tended to  
undermine public confidence.

1 (iv) The HO despite the infringements of the  
2 Appellant's rights refused the Appellant's  
Trade Mark Application by his Decision.

3 The matters particularised above operated as  
4 infringements of the Appellant's rights as  
5 aforesaid and constituted material errors of  
law."

6 These averments are confused and confusing as to who did  
7 what in a manner which allegedly resulted in a breach of the  
8 requirements of Article 6. They are highly personal in  
9 relation to Ms. Carboni's involvement as counsel on behalf of  
10 Intel Corporation. They even go so far as to say that her  
11 appearance as counsel gave rise to both actual and apparent  
12 bias.

13 At the hearing before me Mr. Engelman recognised and  
14 accepted that these averments should at least be amended so as  
15 to make it clear that no case of actual bias was raised and  
16 also so as to make it clear that the objection related not to  
17 the conduct of Ms. Carboni but to the conduct of the  
18 Registrar's hearing officer.

19 I must make it clear that I consider these pleas to be  
20 not only misdirected but also pointless in the events which  
21 have happened. As can readily be appreciated from the  
22 language of Article 6 and the case law relating to the scope  
23 and effect of its provisions, the question for consideration  
24 in the event of an objection such as the present is whether  
25 the tribunal, which is to say the person or persons by whom

1 the relevant decision is to be taken, can rightly be regarded  
2 as independent and impartial. If the Registrar's hearing  
3 officer Mr. Landau was acting independently and impartially to  
4 the required standard, there could be no objection to  
5 Ms. Carboni performing her duties as counsel by fully and  
6 effectively representing her client's interests at the hearing  
7 before him.

8 That cannot be doubted in the light of the recent  
9 judgment of the Court of Appeal in *The Queen (in the*  
10 *application of John Haase) v Independent Adjudicator* [2008]  
11 EWCA Civ 1089 (14th October 2008).

12 The fact that Ms. Carboni is an Appointed Person would  
13 not prevent the Registrar's hearing officer from being an  
14 independent and impartial tribunal if there was no legitimate  
15 concern on the basis of affiliation bias, as I have indicated  
16 above, and no legitimate concern on the basis of any factors  
17 relating to the particular circumstances of the case at hand.

18 Nothing in the particular circumstances of the case at  
19 hand is said to have given rise to any concern as to the  
20 independence or impartiality of the hearing officer. The  
21 complaint is put upon the basis that the situation in the  
22 Registry was analogous to that of an appellate judge appearing  
23 before a junior judge in the same line of specialist work --  
24 effectively a superior appearing before a subordinate. This  
25 is said to have given rise to a situation in which

1 Ms. Carboni's status as an Appointed Person was to a tangible  
2 degree liable to have exerted undue influence over the hearing  
3 officer's approach to her client's case. The suggestion was  
4 that, being well aware of her status as a person before whom  
5 his decisions were liable to come up for consideration on  
6 appeal, he would not want to upset her and would as a matter  
7 of self-interest be inclined to try and curry favour with her  
8 so as to put himself in her good books. The argument  
9 proceeded upon the premise that he and she should be regarded  
10 as members of the same circle by virtue of her status as an  
11 Appointed Person. It was contended that advocates who are  
12 liable to sit on appeal from decisions of the Registrar's  
13 hearing officers should not be permitted to appear in the  
14 Registry without the full knowledge and consent of the party  
15 or parties against whom they would wish to appear.

16 On that basis the Appointed Persons, and also, it would  
17 seem, members of the intellectual property bar authorised to  
18 sit as deputy High Court judges hearing appeals from Registry  
19 decisions, should not normally appear in proceedings before  
20 the Registrar.

21 I regard the reasoning of this argument as unreal.  
22 There is a long legal tradition in this country of  
23 practitioners acting as part-time judges. It is right and  
24 proper to distinguish between their activities as judges and  
25 their activities as practitioners. In making that distinction

1 in the circumstances of the present case, I think it is right  
2 to recognise that the Registrar's hearing officers and the  
3 Appointed Persons are not in any real sense colleagues or  
4 members of the same circle with regard to the administration  
5 of justice under the Trade Marks Act 1994.

6 The Registrar's hearing officers are well qualified and  
7 highly trained to do the specialised work they do. They are  
8 not laymen. In their area of work they are professional  
9 decision makers and they are equipped by their training and  
10 experience to administer justice fairly and impartially in the  
11 cases which come before them.

12 The relevant question as set out by Lord Hope in *Porter*  
13 *v Magill* [2001] UK HL 67 at paragraph 103 is whether the  
14 fair-minded and informed observer, having considered the  
15 facts, would conclude that there was a real possibility that  
16 the tribunal was biased.

17 I do not see that that test can be regarded as satisfied  
18 here. There is in my view no affiliation that might be  
19 thought to give rise to a real possibility of affiliation bias  
20 when the matter is judged from the perspective of the  
21 fair-minded and informed observer.

22 For these reasons I can see no proper basis for  
23 permitting Mr. Munroe to pursue an objection under Article 6  
24 in relation to the hearing in the Registry. Even if the  
25 Registry proceedings could be regarded as deficient under

1 Article 6 for reasons relating to the representation of one of  
2 the parties by an Appointed Person, I would regard it as  
3 pointless to pursue the matter in the context of the present  
4 appeal.

5 Intel Corporation is now represented by different  
6 counsel. There is no lack of independence or impartiality on  
7 the part of this tribunal. It should be clear from what  
8 I have already said that this tribunal positively asserts the  
9 right under section 76 of the 1994 Act to deal with the  
10 Registrar's decisions as the circumstances of the case may  
11 require.

12 For these reasons the application to amend the grounds  
13 of appeal is refused.

14 MR. MELLOR: Thank you, sir.

15 THE APPOINTED PERSON: Shall we deal with the costs?

16 MR. MELLOR: Yes. Sir, I do not think you will be surprised to  
17 hear that this bit of the case took a bit longer than the  
18 application to adduce evidence. I do not have any material,  
19 but as a rough estimate I would say I had probably spent a day  
20 on this aspect of the appeal in preparation.

21 THE APPOINTED PERSON: If I can ask the question, in the overall  
22 amount of preparation of the case on your side, what  
23 proportion went on that?

24 MR. MELLOR: It was probably half.

25 THE APPOINTED PERSON: Okay, so you are looking for a contribution

1 commensurate with that proportion.

2 MR. ENGELMAN: Sir, this issue was raised not exactly de novo. It  
3 was raised by yourself during the course of these proceedings.  
4 It involved an important principle of law which needed to be  
5 addressed and assessed and disposed of. We have done  
6 precisely that, and we have done it in conformity with the  
7 original direction. We might have assisted as things go  
8 forward with the administration of justice now that the matter  
9 has been properly disposed of.

10 We would ask you for some latitude with regard to an  
11 order on costs because there is an important point which we  
12 did not initiate but we ran with, sir, and we would submit  
13 that it is not exactly an issue that is outside the realms of  
14 a reasonable conclusion on what took place. So we would ask  
15 that there should be a reduction of costs. Costs are not  
16 awarded on an indemnity basis. They should be awarded on  
17 a standard basis. I do not think my learned friend is asking  
18 for that. So, therefore, we would ask very much for some sort  
19 of leniency in that regard. In addition, one must remember  
20 Mr. Munroe is a litigant in person in these proceedings and is  
21 acting under public access.

22 THE APPOINTED PERSON: Mr. Mellor, do you want to respond?

23 MR. MELLOR: No.

24 THE APPOINTED PERSON: The issue raised by me as the tribunal was  
25 narrow and specific. It was the question of whether there was

1 any problem or concern in relation to the appearance of one  
2 Appointed Person on appeal to another. It will be apparent  
3 from the decision I have just given that I have not pronounced  
4 upon that point because there was in fact no need to do so.

5 It is a different and separate question whether the  
6 appearance of an Appointed Person before one of the hearing  
7 officers in the Registry does or does not give rise to an  
8 Article 6 concern; and, also, if there is an Article 6  
9 concern, whether it matters to pursue it in the context of  
10 this appeal, given that the appeal is to a fully independent  
11 and impartial tribunal.

12 In the circumstances I think it is appropriate that  
13 there should be an award of costs requiring payment of  
14 a contribution towards the Intel Corporation's costs in that  
15 connection. I will direct that Mr. Munroe shall pay as  
16 a contribution to the Intel Corporation the sum of £1200  
17 within 14 days of today.

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APPENDIX A

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**OPPOSITION No. 94454**

**IN THE NAME OF INTEL CORPORATION**

**TO TRADE MARK APPLICATION No. 2404154**

**IN THE NAME OF GARY MILTON MUNROE**

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**DIRECTION FOR THE DETERMINATION  
OF A PRELIMINARY ISSUE**

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1. In my capacity as an Appointed Person hearing appeals from the Registrar of Trade Marks under Section 76 of the Trade Marks Act 1994 I am duty bound by Section 6 of the Human Rights Act 1998 to ensure that the appeals which come before me are so far as possible determined in conformity with Article 6 of the European Convention for the Protection of Human Rights and Fundamental Freedoms 1950 (“**ECHR**”).
2. Article 6 ECHR provides that *‘In the determination of his civil rights and obligations ... everyone is entitled to a fair and public hearing ... by an independent and impartial tribunal established by law ...’*.
3. In its case law relating to the requirement for determination *‘by an independent and impartial tribunal’* the European Court of Human Rights (**ECtHR**) has

consistently pointed to the need for structural independence and objective impartiality.

4. In delivering the judgment of the court in R. v. Khan and other appeals [2008]

EWCA Crim 531 (14 March 2008) Lord Phillips of Worth Matravers CJ stated:

3. Independence and impartiality are not the same, albeit that lack of independence will often carry with it lack of impartiality. Lack of independence involves a connection between the tribunal and one of the parties, or between the tribunal and the executive.
4. Lack of impartiality is usually described as bias. It is important to define bias in this context. Lord Goff did so in *R v Gough* [1993] AC 646. He described bias as unfairly regarding “with favour or disfavour the case of a party to the issue under consideration”.
5. Not merely must a judicial tribunal be impartial it must be seen to be impartial. This is a requirement of both European and our domestic law.

“40...according to the constant case law of Convention organs, the existence of impartiality must be determined according to a subjective test, namely, on the basis of a personal conviction of a particular judge in a given case – personal impartiality being assumed until there is proof to the contrary.

41. In addition, an objective test must be applied. It must be ascertained whether sufficient guarantees exist to exclude any legitimate doubt in this respect. Even appearances may be important: what is at stake is the confidence which the court must inspire in the accused in criminal proceedings and what is decisive is whether the applicant’s fear as to lack of impartiality can be regarded as objectively justifiable.” *Gregory v United Kingdom* (1997) 25 EHRR 577 at p. 587.”

6. In English law the requirement that the tribunal should be seen to be impartial results from the principle that

“...it is not merely of some importance but it is of fundamental importance that justice should not only be done, but should manifestly and undoubtedly be seen to be done” *R v Sussex Justices, ex p. McCarthy* [1942] 1 KB 256 at p. 359 per Lord Hewart CJ.

5. In their letter to the UK Intellectual Property Office dated 1 August 2008 Messrs Saunders & Dolleymore confirmed on behalf of the respondent to the above appeal that they agreed to the matter being heard by an Appointed Person. They stated that the respondent would be represented by Ms. Anna Carboni of Counsel. That is to say, the respondent intended to be represented by one Appointed Person on appeal to another.
6. On seeing that letter, it appeared to me that this raised the question whether the right to be represented by an advocate of one’s own choosing was to any extent restricted in the circumstances of the present appeal by the requirement for the tribunal hearing the appeal to be (and be seen to be) independent and impartial under Article 6 ECHR.
7. In my letter of 15 August 2008 I informed the parties and the Registrar that I was unsure as to whether or when exceptional circumstances preventing an advocate from acting for a party might be found to exist in a case where the advocate intended to appear before an appellate tribunal of which (s)he is a part-time member and the appellate tribunal is a specialist body whose membership is

confined to persons qualified to act alone in a judicial capacity. I invited them to submit any observations they might wish to make in response to what I had said by no later than 17:00 hours on Friday, 5 September 2008. On Tuesday, 8 September 2008 I received a letter from Mr. Munroe asking for more time in which to respond. I extended his time for responding over until 16:00 hours on Friday, 12 September 2008.

8. Mr. Allan James confirmed in a letter sent on behalf of the Registrar on 21 August 2008 that the Registrar had, after careful consideration, come to the view that (subject to the usual rules) there should be no objection to Ms. Carboni acting as an advocate for the respondent to the present appeal. This was because the Appointed Persons operate independently of one another and there is on that basis no reason why such a person's appearance as an advocate before a different Appointed Person should call into question the independence of the decision maker or of the tribunal. The situation was comparable to other situations which had given rise to no difficulty or concern: senior counsel sitting as deputy High Court judges whilst continuing to appear as advocates before the High Court and the appearance of persons who are Appointed Persons as advocates before the Registrar.
9. On 2 September 2008 I received a letter from Ms. Carboni confirming that she had carefully considered the position when accepting instructions to represent the respondent in the present appeal and had concluded that it was not appropriate for her either to reject the instructions or to draw any matter to the attention of the

parties or the Appointed Person. She had concluded that her position was analogous to that of a barrister who sits part-time as a deputy High Court judge and continues to represent parties in the High Court, and that the Appointed Person before whom she appeared was no more nor less likely to be (or perceived to be) biased than a High Court judge hearing a part-time deputy judge as advocate.

10. On 4 September 2008 I received a letter from the respondent's agents of record Messrs Saunders & Dolleymore. They referred to the test set out by Lord Hope in Porter v. Magill [2001] UKHL 67 at paragraph 103:

The question is whether the fair-minded and informed observer, having considered the facts, would conclude that there was a real possibility that the tribunal was biased.

They itemised the facts surrounding the appointment and role of the Appointed Person under Sections 76 and 77 of the 1994 Act and enclosed a copy of the terms and conditions applicable to Ms. Carboni's appointment as an Appointed Person. They noted that the terms and conditions did not expressly prohibit an Appointed Person from appearing before another Appointed Person.

11. With regard to the terms and conditions relating to Conflict of Interest (paragraphs 15 to 19) they commented that '*None of these situations apply in this case*'. Paragraphs 15 to 19 state as follows:

## CONFLICT OF INTEREST

15. The governing principle is that no person should sit in a judicial capacity in any circumstances, which would lead an objective onlooker with knowledge of all the material facts reasonably to suspect that the person might be biased.
16. As a general principle therefore, a barrister or solicitor advocate ought not to sit as a judicial office holder, or to appear before a tribunal at a particular hearing centre, if he or she is liable to be embarrassed in either capacity by doing so.
17. As a general rule, it is undesirable for a judicial office holder who is a solicitor to sit at a tribunal or hearing centre where they regularly practise. This is to help avoid them being assigned to adjudicate in cases from which they would have to stand down. If a judicial office holder who is a solicitor does sit at such a hearing centre or a tribunal, then the Lord Chancellor and the Lord Chief Justice regard it as the judicial office holder's personal responsibility (and not that of the staff of the Tribunal or the hearing centre) to avoid, as far as possible, any potential conflict of interest which might require him or her to stand down from a particular case.
18. Fee-paid judicial officer holders:
  - (a) should not sit in a case involving their own firm or client, or otherwise where to do so could give rise to the perception of prejudice in the administration of justice;
  - (b) should comply with the existing case law governing pecuniary or other interests in deciding whether to declare an interest in, or to stand down from, a particular case e.g. *Locabail (UK) Ltd v. Bayfield Properties Ltd and Another* [2000] Q.B. 451; *In re Medicaments and Related Classes of Goods (No 2)* [2001] 1 W.L.R. 700; and *Lawal v. Northern Spirit Limited* [2003] UKHL 35.
  - (c) should not sit on a case if they have a personal, professional or pecuniary interest in that case; or if

any business or practice of which they are members in any capacity has such an interest.

19. Judicial office holders are expected to refrain from any activity, political or otherwise, which would conflict with their judicial office or be seen to compromise their impartiality, having regard for example to the comments of the Court of Appeal in the case of *Locabail*. They should also be aware of the risk of a perceived lack of impartiality arising from published articles or public pronouncements, etc. (*Timmins v. Gormley* [(2000) 2 WLR 870]). Fee-paid judicial office holders should exercise caution in any reference to their appointment on, for example, letterheads or in chambers' advertising literature. They hold office only when exercising the functions of the office and should not use their office as a means of pursuing personal, professional or commercial advantage.
  
12. On the basis that the relevant observer would be aware of legal traditions and culture in the United Kingdom (Taylor v. Lawrence [2002] EWCA Civ 90 at paragraphs 61 to 64) they maintained that while he or she would know that there are certain situations in which part-time judges are forbidden from appearing as counsel, they would also be aware of the long-established practice of deputy High Court judges appearing as advocates before other High Court (or deputy High Court) judges.
  
13. They further maintained that there is no reason for an informed observer to suspect that the Appointed Person (as a senior barrister, solicitor or former judicial office holder) will prefer the submissions of another Appointed Person simply because of their appointment, any more than they would be expected to prefer the

submissions of, for example, the most senior specialist Queen's Counsel or a member of their own Chambers.

14. They went on to observe as follows:

We therefore agree with the position taken by the Registrar, as set out in the letter from Allan James dated 21 August 2008. The situation is analogous to that of an advocate who continues to appear in the High Court following their appointment as a deputy judge. Apart from the adverse impact on the practice of an advocate who sits as Appointed Person at the same time as wishing to retain a specialist trade mark practice, a rule precluding an Appointed Person from hearing a case in which a party is represented by another Appointed Person would remove an element of choice that is currently available to parties who appeal from the Registrar. A party wishing to be represented by such an advocate would have to appeal to the High Court, thus losing the advantages of speed, finality and reduced cost which are usually associated with cases that go to the Appointed Person. Alternatively, to retain their preferred forum, they would have to forgo the usual right to choose their preferred counsel.

It seems particularly unnecessary to impose such a rule in circumstances where the same issues arise in the alternative forum of the High Court, and where those issues are accepted as being part of the legal landscape in our jurisdiction. We note in particular that you sit as a deputy High Court judge, and yet no problem arose out of your representation of the respondent before another High Court judge in *ESure Insurance Ltd v. Direct Line Insurance plc* [2007] EWHC 1557 (Ch) on appeal from the Registrar. Similarly, Richard Arnold Q.C. is a deputy High Court judge (as well as being another Appointed Person) and yet he represented the respondent in the High Court in *Rousselon Freres v. Horwood Homewares Ltd* [2008] EWHC 881 (Ch). In our view, the perception of potential bias on the part of the High Court judges concerned was no more nor any less possible than if those appeals had been taken to another Appointed Person.

Accordingly, we do not believe that there is any risk of Article 6 ECHR being breached by virtue of the fact that our client is to be represented by one Appointed Person before another. We have spoken to Mrs. Carboni and neither she nor we are aware of any other reason why she would be professionally embarrassed to appear in this case. In our opinion, the circumstances are not such as to justify precluding her from doing so.

15. The position adopted in the final paragraph of their letter was as follows:

If you continue to have any concerns once you have reviewed this letter and that of the Registrar, as well as any comments from the appellant, we should be grateful for the opportunity to make more detailed submissions. However, we hope that this will not be necessary and that the appeal can proceed to hearing, with our client's chosen counsel, without any further delay.

16. On 12 September 2008 I received a letter from Mr. Munroe which I understand to have been written with assistance from Mr. Mark Engelman of Counsel acting under the rules relating to public access to members of the Bar in England and Wales. Mr. Munroe emphasised that he was not suggesting that any question of actual bias arises in the present proceedings. He none the less maintains that there are exceptional circumstances which should be taken to prevent Ms. Carboni from continuing to act for the respondent. In his view the circumstances are such as to *'constitute "apparent bias" and tend to undermine public confidence in the appeal system operated under the provisions of s.76 of the Trade Marks Act 1994. They also constitute a breach of my rights under Art 6 of the European Convention on Human Rights.'*

17. Mr. Munroe states that he was unaware until he received my letter of 15 August 2008 that Ms. Carboni sits as an Appointed Person on appeals from the Registrar under Section 76. He maintains that this ought to have been disclosed to him even though she herself considered it to be immaterial. He refers in that connection to Geveran Trading Co. Ltd. v. Skjevesland [2003] EWCA Civ. 1567 at paragraph 49 and Taylor v. Lawrence [2003] QB 528 at page 549. In addition he maintains that since he was not fully cognisant of Ms. Carboni's appointment as a member of this appeal tribunal, he cannot be taken to have waived any right he might have to object to her representing the respondent in the present proceedings.
18. He notes that although the decision of the Court of Appeal in Geveran Trading Co. Ltd v. Skjevesland (above) establishes that an advocate may only be prevented from acting for a party in exceptional circumstances, such circumstances can be found to exist in situations where a party is represented by someone connected with the tribunal or a member of it (as in Lawal v. Northern Spirit Ltd [2003] UK HL 35; see also R v. Abdroikov and other appeals [2007] UK HL 37). He considers that the relevant principle is encapsulated in paragraph 603 of the Bar Council Code of Conduct which provides as follows:

603. A barrister must not accept any instructions if to do so would cause him to be professionally embarrassed and for this purpose a barrister will be professionally embarrassed:

...

- (d) if the matter is one...in which whether by reason of any connection...with the Court or a member of it or otherwise it will be difficult for him to maintain

professional independence or the administration of justice might be or appear to be prejudiced;

In his view there is a connection of that kind in the present case. Deputy High Court judges *'are not of parallel status to full-time High Court judges'*. The position of an Appointed Person is not analogous to that of a deputy High Court judge.

19. I am grateful to all concerned for the assistance I have received from their written observations. These point to the role and remit of the Appointed Persons as members of the tribunal entrusted with the task of administering justice in appeals from the Registrar under Section 76 of the 1994 Act being key to the acceptability of one Appointed Person representing a party on appeal to another. Mr. Munroe objects to that happening in the context of his appeal to the Appointed Person in the present case. There is no suggestion that he is precluded by any clear and unequivocal waiver made with full knowledge of the facts relevant to the decision whether to waive or not in relation to any Article 6 objection that there might be: as to which see paragraphs 22 to 38 of the judgment of the court delivered by Lord Phillips of Worth Matravers CJ in Smith v. Kvaerner Cementation Foundations Ltd (Bar Council intervening) [2006] EWCA Civ. 242 (21 March 2006). His objection to the respondent being represented by Ms. Carboni should, in my view, be considered and determined as a preliminary issue. I therefore direct that a hearing be appointed for that purpose, with the hearing of the appeal against the decision below being deferred pending the determination of the preliminary issue.

The Registrar will be permitted to make representations in writing and orally as he considers appropriate for him to make in relation to the preliminary issue.

20. The parties are entirely free to develop their arguments on the preliminary issue as they wish. In doing so they may wish to comment in relation to the following matters.

21. Section 9 of the Supreme Court Act 1981 provides as follows:

(4) ... if it appears to the Lord Chief Justice, after consulting the Lord Chancellor, that it is expedient as a temporary measure to make an appointment under this subsection in order to facilitate the disposal of business in the High Court or the Crown Court, he may appoint a person qualified for appointment as a puisne judge of the High Court to be a deputy of the High Court during such period or in such occasions as the Lord Chief Justice, after consulting the Lord Chancellor, thinks fit; and during the period or on the occasions for which a person is appointed as a deputy judge under this subsection, he may act as a puisne judge of the High Court.

(4A) ...

(5) Every person while acting under this section shall, subject to subsections (6) and (6A), be treated for all purposes as, and accordingly may perform any of the functions of, a judge of the court in which he is acting.

(6) A person shall not be virtue of subsection (5) –

(a) be treated as a judge of the court in which he is acting for the purposes of section 98(2) or of any statutory provisions relating to –

(i) the appointment, retirement, removal or disqualified of judges of that court;

(ii) the tenure of office and oaths to be taken by such judges; or

(iii) the remuneration, allowances or pensions of such judges, or

(b) subject to section 27 of the Judicial Pensions and Retirement Act 1993, be treated as having been a judge of a court in which he has acted only under this section.

(6A) ...

...

22. In Scotland, the similar provisions of Schedule 4 to the Law Reform (Miscellaneous Provisions) (Scotland) Act 1990 confirm that the appointment of a person to act as a temporary judge of the Court of Session under Section 35(3) of that Act is without prejudice to his continuing with any business or professional occupation not inconsistent with his acting as a judge.

23. In relation to professional connections generally the Court of Appeal affirmed in Smith v. Kvaerner Cementation Foundations Ltd (Bar Council intervening) (above) at paragraph 17 that:

Judges in this jurisdiction, whether full-time or part-time, frequently have present or past close professional connections with those who appear before them and it has long been recognised that this, of itself, creates no risk of bias nor, to those with experience of our system, any appearance of bias [CITATIONS OMITTED].

24. It was observed in the judgment of the court delivered by Lord Bingham of Cornhill CJ, Lord Woolf MR and Sir Richard Scott V-C in Locabail (UK) Ltd v. Bayfield Properties Ltd and other appeals [2000] QB 451 (CA) at paragraph 25:

It would be dangerous and futile to attempt to define or list the factors which may or may not give rise to a real danger of bias. Everything will depend on the facts, which may include the nature of the issue to be decided. We cannot, however, conceive of circumstances in which an objection could be soundly based on the religion, ethnic or national origin, gender, age, class, means or sexual orientation of the judge. Nor, at any rate ordinarily, could an objection be soundly based on the judge's social or educational or service or employment background or history, nor that of any member of the judge's family; or previous political associations; or membership of social or sporting or charitable bodies; or Masonic associations; or previous judicial decisions; or extracurricular utterances (whether in textbooks, lectures, speeches, articles, interviews, reports or responses to consultation papers); or previous receipt of instructions to act for or against any party, solicitor or advocate in a case before him; or membership of the same Inn, circuit, local Law Society or chambers.

25. The Article 6 requirement for independence and impartiality has been considered in relation to the position of part-time judges in Clancy v. Caird (2000) SC 441; Lawal v. Northern Spirit Ltd [2003] UK HL 35; Kearney v. Her Majesty's Advocate [2006] UK PC D1, [2006] HRLR 15; and Smith v. Kvaerner Cementation Foundations Ltd (Bar Council intervening) (above).
26. Paragraph 603(d) of the Bar Council Code and paragraphs 16 and 18 of the terms and conditions reproduced in paragraph 11 above refer to the administration of justice being or appearing to be prejudiced by reason of a connection between the tribunal (or a member of it) and the representative of a party appearing before it giving rise to professional embarrassment.
27. The Appointed Person is a judicial tribunal established by statute. Its members must possess the minimum qualifications for appointment prescribed by Section

77(2) of the 1994 Act. Their decisions are final: Section 76(4). That does not exclude the possibility of judicial review.

28. It has been confirmed that the Appointed Persons operate so as to ensure that the Registrar (as a decision-making body) is subject to the control of an appellate body which itself constitutes an independent and impartial tribunal established by law with full jurisdiction (within the meaning of that expression as used in the case law of the ECtHR relating to Article 6 ECHR) to deal with the decisions of the Registrar as the nature of the case requires: ADRENALIN Trade Mark BL O-397-02 (23 September 2002) at paragraphs 51 to 54; DAAWAT Trade Mark [2003] RPC 11, p.187 at paragraph 52.
29. The ECJ accepts that the ‘tribunal’ is a judicial tribunal of the kind that is entitled to make orders for reference under Article 234 of the EC Treaty: Case C-259/04 Elizabeth Florence Emanuel v. Continental Shelf 128 Ltd [2006] ETMR 56, p.750 see paragraphs 18 to 25 of the Judgment of the Court and paragraphs 24 to 33 of the Opinion of Advocate General Ruiz Jarabo Colomer.
30. The tribunal exercises a jurisdiction which is not territorially limited to England and Wales. The appointment of its members is understood to be subject to consultation with the appropriate authorities in Scotland and Northern Ireland.
31. The first Appointed Persons were appointed in 1996. There were 3 of them. Prior to the recently announced appointment of Mr. Richard Arnold QC to the High Court bench there were 5. The tribunal has no full time members. Its members

are appointed to act as members of the tribunal for an initial period of 5 years, automatically renewable for successive periods of 5 years up to the age of 70 if the individual concerned remains eligible and willing to continue with the appointment.

32. There are a number of grounds for removal, one of which is persistent failure to comply with sitting requirements without good reason. The sitting requirements are addressed in paragraph 14 of the terms and conditions provided under cover of Messrs Saunders & Dolleymore's letter of 4 September 2008:

14. A fee-paid office holder is called upon to sit and to undertake other prescribed duties as the need arises. The frequency of sittings etc. depends upon the workload of the Patent Office and on the commitments of the office holder. Due to the nature of the workload, no guarantee can be given on the number of sitting days that will be offered to post holders. However, subject to overriding operational requirements, all post holders will be allocated work on the same basis. An office holder's workload is arranged in consultation with the office holder.

The members of the tribunal work upon the basis that they will either hear the appeals that are allocated to them or in any case where they perceive themselves to be in a position of conflict or possible conflict arrange for the appeal to be re-allocated to another member of the tribunal.

33. Parties may but need not be represented before the tribunal. They may be professionally represented by patent or trade mark attorneys, solicitors or counsel (including Queens Counsel). They may be non-professionally represented by

directors, officers managers, partners, colleagues or friends. It is quite common for parties to represent themselves as litigants in person.

34. If every member of the tribunal (including the Senior Appointed Person by whom appeals are allocated for hearing) is in principle entitled to represent any party to an appeal brought before the tribunal under Section 76, it would follow that all parties to any such appeal can, in principle, be represented by members of the tribunal entrusted with the task of administering justice in relation to those appeals. The members of the tribunal may find themselves acting by turn as the tribunal, as representatives of appellants and as representatives of respondents. Adversarial comment by members upon their own and each other's previous decisions would become a matter for members acting as the tribunal to take into consideration as part of the appeal process.
35. Parliament would on that basis have legislated for the establishment of a judicial tribunal whose members can all, as a general rule, accept instructions to represent parties in proceedings on appeal to each other.

**Geoffrey Hobbs QC**

15 September 2008