

1 THE PATENT OFFICE

Room 1,
Harmsworth House,
13-15 Bouverie Street,
London, EC4Y 8DP.

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Thursday, 9th November 2006

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Before:

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THE APPOINTED PERSON
(MR. GEOFFREY HOBBS QC)

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In the Matter of THE TRADE MARKS ACT 1994

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-and-

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In the Matter of UK Trade Mark Application No. 2332714
by RATIOPHARM GmbH to register a series of marks comprising
the word FELENDIL in class 5

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-and-

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In the Matter of Opposition No. 92126 thereto by
ASTRAZENECA AB

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Appeal of the Applicant from the decision of
Mr. M. Reynolds dated 8th June 2006 on behalf of the Registrar

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(Computer-Aided Transcript of the Stenograph Notes of
Marten Walsh Cherer Ltd., Midway House,
27-29 Cursitor Street, London EC4A 1LT.
Telephone No: 020-74055010. Fax No: 020-74055026)

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MR. JAMES ABRAHAMS (instructed by Messrs. Stevens Hewlett &
Perkins) appeared on behalf of the Applicant/Appellant.

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MR. MARK ENGELMAN (instructed by Messrs. Wildbore & Gibbons)
appeared on behalf of the Opponent/Respondent.

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R U L I N G
(As Approved)

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1 THE APPOINTED PERSON: In a letter issued on 26th April 2006, the
2 Registrar expressed a view on the opponent's request for
3 disclosure under rule 57. That was nothing more than a
4 preliminary indication. It was a precursor to the use of the
5 rule 54 procedure. The letter itself stated that it was open
6 to either party if they were dissatisfied with the indication
7 that had been given to file written reasons for saying so and
8 to request a hearing. Neither of those two things happened.
9 The result of that was that the letter never acquired the
10 status of a decision. It remained nothing more than
11 a preliminary indication and did not constitute a decision
12 susceptible of appeal, in my opinion.

13 Following a hearing on 23rd February 2006,
14 Mrs. Ann Corbett issued a letter on 24th February dealing with
15 two matters which had been canvassed at the hearing before
16 her. The first was an application by the opponent to amend
17 its pleadings to include a section 3(6) objection, the second
18 was a request on behalf of the opponent for an order for
19 cross-examination of the applicant's witness. Both of those
20 requests were refused.

21 In accordance with the procedure envisaged by rule 62 of
22 the Trade Marks Rules, the letter written by Mrs. Ann Corbett
23 said explicitly: "This letter does not contain a full
24 statement of reasons for this decision. If either party
25 wishes to appeal the decision they should file a Form TM5

1 requesting a statement of reasons within one month", that is
2 by 24th March 2006.

3 No attempt was made to file a Form TM5 requesting
4 reasons for the decision. According to the evidence which has
5 most recently been filed, the fourth witness statement of
6 Ms. Barr, there was a conscious decision on the part of the
7 opponent not to pursue an appeal. In those circumstances, I
8 think it is a very important matter when it comes to the
9 exercise of any discretion at this stage that there was a
10 conscious decision on the part of the opponent not to
11 challenge the decision recorded in Mrs. Corbett's letter.

12 So far as appeals to the Appointed Person are concerned,
13 these are governed by section 76 read in conjunction with
14 sections 68 and 69, and rules 63 to 65. The procedure laid
15 down is quite an elaborate procedure. It requires the
16 Form TM55 initiating an appeal to be filed with the Registry
17 and it requires a screening process to be gone through by
18 Registry officials, by the parties to the proposed appeal and
19 by the Appointed Person himself or herself. There are times
20 specified in those rules for each party to make its
21 contribution to that screening process.

22 In addition, when it is necessary for the party wishing
23 to appeal to seek an extension of time for doing so, that
24 application must be determined in accordance with the
25 provisions of rule 68, in particular, the provisions of

1 rule 68(1), rule 68(4) and rule 68(5). It is crystal clear
2 under the rules that the Registrar is the person to whom the
3 relevant application for an extension of time must be made.
4 The power to extend time is in the first instance vested in
5 the Registrar.

6 The consideration of requests for extension of time is
7 guided by Tribunal Practice Note TPN 3 of 2000. In addition
8 it is the practice of the Registrar's officials to be guided
9 by my decision in the Opposition by Virgin Records Limited to
10 various trade mark applications in the name of Ministry of
11 Sound Recordings Limited, a decision which carries the
12 reference BL 0-136-03 (17th April 2003).

13 Mr. Engelman has submitted in writing and in his oral
14 submissions that I have an inherent power to accede to his
15 client's request to extend time for appealing in respect of
16 the interlocutory matters mentioned above on the basis that
17 I am somehow exercising powers which are coterminous or
18 coextensive with those of a High Court judge acting in an
19 appellate capacity under CPR 52. This is quite wrong. The
20 inherent and implied powers of a statutory tribunal including
21 this statutory tribunal are, as the expression goes,
22 interstitial. They can be exercised only in accordance with
23 and within the latitude allowed by the express statutory
24 provisions contained, in this case, in the Trade Marks Act
25 1994 and the Trade Marks Rules.

1 All references by analogy to the provisions of the CPR
2 need to be handled with care. There are at least two
3 decisions of the High Court in which it has been held that the
4 Rules of the Supreme Court (now found in the CPR) are not
5 applicable to proceedings before the Patent Office. On the
6 first occasion that I am aware of, Ferris J pointed out in
7 St. Trudo Trade Mark [1995] RPC 370 at 379: "Before the
8 Registrar the Rules of the Supreme Court have no part to
9 play." More recently in the case of Rhone-Poulenc Rorer &
10 Others v Yeda Research and Development Company Ltd [2006] EWHC
11 160 (CH), 16th February 2006, at paragraphs 43 to 44,
12 Lewison J said this under the heading "Do the CPR apply to
13 proceedings in the Patent Office?":

14 "43. Rorer's case was argued before the Hearing Officer
15 on the footing that the criteria in CPR 17.4 should be applied
16 to the hearing before him. In my judgment it is clear that
17 the CPR do not apply to proceedings in the Patent Office.
18 There is no power under the Civil Procedure Act 1997 to make
19 rules for the Patent Office. Moreover, proceedings in the
20 Patent Office are governed by their own rules, made under a
21 different rule making power, and by a different rule making
22 authority. Sometimes a separate procedural code will
23 incorporate the CPR (see, for example, Insolvency Rules 1986
24 rule 17.51). But that is not the position under the Patents
25 Rules.

1 "44. There can, however, be no objection to the
2 Comptroller indicating that the powers conferred upon him (or
3 his hearing officers) will, in general, be exercised in the
4 same way as a judge would exercise similar powers under the
5 CPR. That said, the powers of the Comptroller are those
6 conferred by the Patents Rules; and it would not be correct
7 for the Comptroller to fetter a discretion conferred by the
8 rules. Any expression of general policy must be capable of
9 being departed from in an individual case, provided that the
10 departure achieves justice and is within the powers conferred
11 by the Patents Rules. This is precisely what the Comptroller
12 says in the Patent Hearings Manual, and he is undoubtedly
13 right to say that."

14 That case was carried on appeal to the Court of Appeal.
15 There is nothing in the judgment of the Court of Appeal which
16 affects those observations made by Lewison J.

17 The powers which Mr. Engelman is seeking to invoke are
18 not in any relevant respect exercisable in the present case by
19 me de novo. I am not the Registrar. My role under section 76
20 is to consider the correctness or otherwise of decisions made
21 by the Registrar. I perform that role in the context of duly
22 filed appeals. I cannot authorise anyone to proceed in a way
23 which does not comply with the specific requirements of the
24 Act and the Rules. And even if I did have a discretionary
25 power to accede to the requests which are made to me by

1 Mr. Engelman, I would certainly not exercise the power in
2 favour of doing so. It seems to me that the time is long
3 since past for bringing into question on appeal either the
4 decision recorded in Mrs. Corbett's letter of 24th February
5 2006 or (if, contrary to my view, it was a decision), the
6 decision recorded in the Registry letter of 26th April 2006.

7 For those reasons I reject the applications made to me
8 by Mr. Engelman.

9 I now wish to deal with the question of costs.

10 MR. ABRAHAMS: Sir, I cannot say I spent a lot of time dealing
11 with this. It certainly distracted me from my preparation and
12 would have taken me some time to deal with. Also, I am aware
13 that my instructing trade mark agent spent some time dealing
14 with the papers, reading through the vast wodge of papers, and
15 certainly I had to read through the papers that were presented
16 to me.

17 THE APPOINTED PERSON: If you had to put a time on it,
18 Mr. Abrahams.

19 MR. ABRAHAMS: My time, I would say, including the fact I had to
20 deal with the skeleton and I made some notes, approximately
21 two hours. Can I just asking my instructing trade mark agent.
22 (Pause) His best guess is one or two hours. I would suggest
23 he is probably being quite conservative. It is probably more
24 likely two hours given the thickness of the papers.

25 THE APPOINTED PERSON: It took me about two hours which I did not

1 really have spare in preparing for this appeal to deal with
2 those matters. Are you asking for an allowance for costs in
3 respect of that time and work?

4 MR. ABRAHAMS: Indeed, that is right.

5 THE APPOINTED PERSON: Mr. Engelman, what do you say about that?

6 MR. ENGELMAN: Indeed, sir, I do not oppose it.

7 THE APPOINTED PERSON: I do not think you can resist it.

8 MR. ENGELMAN: Indeed, sir.

9 THE APPOINTED PERSON: I will direct the opponent to pay the sum
10 of £500 as a contribution towards the costs of the applicant
11 in respect of the matters I have just dealt with and for that
12 sum of money to be paid within 14 days of today's date.

13 (For proceedings: see separate transcript)

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