

TRADE MARKS ACT 1938 (AS AMENDED) AND TRADE MARKS ACT 1994

IN THE MATTER OF OPPOSITION No. 32964

IN THE NAME OF TABO SA

TO APPLICATION No. 1316378

TO REGISTER A TRADE MARK IN CLASS 11

IN THE NAME OF UGNSGRUPPEN SCANFURNACE AB

DECISION

On 21 July 1987 Ugnsgruppen Scanfurnace AB (“the Applicant”) applied under Section 17(1) of the Trade Marks Act 1938 to register the word TABO for use as a trade mark in relation to “Furnaces; all for use in crematoria; parts and fittings for all the aforesaid goods; all included in Class 11”. The application was advertised for opposition purposes on 17 June 1992. On 16 September 1992 Tabo SA (“the Opponent”) filed a notice of opposition to the application. The Opponent contended in its Grounds of Opposition that the application should be refused under Sections 11 and 17 of the 1938 Act and in the exercise of the Registrar’s discretion under Section 17(2) of that Act. The Applicant filed a Counterstatement maintaining that its application should be permitted to proceed to registration.

The 1938 Act was repealed with effect from 31 October 1994 upon commencement of the Trade Marks Act 1994: Section 106(2) and Schedule 5 of the 1994 Act. The Rules made under the 1938 Act were repealed with effect from 31st October 1994 upon commencement

of the Trade Marks Rules 1994: Rule 69 and Schedule 1 of the 1994 Rules. The application could not be converted into an application for registration under the 1994 Act because it had been advertised prior to the commencement of that Act: Rule 11 of the 1994 Rules. It therefore fell to be determined in accordance with the provisions of Schedule 3 of the 1994 Act as required by Section 105 of that Act.

The 1994 Act implements the provisions of Council Directive No. 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks. The fifth recital in the preamble to the Directive confirms that Member States remain free to fix the provisions of procedure concerning the registration of trade marks. Article 4(6) of the Directive further confirms that Member States remain free to provide that the grounds for refusal of registration in force prior to implementation should apply to applications for registration made prior to the date of implementation. Section 105 and paragraph 10 of Schedule 3 of the 1994 Act were, as the Directive allowed, enacted for the purpose of ensuring that the 1938 Act continued to govern applications for registration made prior to 31 October 1994 if they were not converted into 1994 applications under Rule 11 of the 1994 Rules.

Paragraph 1 of Schedule 3 confirms that references in that Schedule to “*the old law*” are references to the Trade Marks Act 1938 and any other enactment or rule of law applying to trade marks registered under that Act immediately before commencement of the 1994 Act. Paragraph 10(1) of Schedule 3 goes on to provide that “*an application for registration of a mark under the 1938 Act which is pending on the commencement of this Act shall be dealt*

with under the old law” subject to the operation of paragraphs 10(2) and 10(3) of that Schedule. The reference to “*the commencement of this Act*” is a reference to “*the commencement of the main substantive provisions of Parts I and II of [the 1994] Act and the consequential repeal of the Trade Marks Act 1938*”: Section 109(2) of the 1994 Act. These provisions unequivocally require applications for registration to be “**dealt with**” under the 1938 Act if they were advertised prior to 31 October 1994 and remained pending on that date.

Paragraph 10(2) of Schedule 3 confirms that practice and procedure with regard to such applications may be regulated after 30 October 1994 (i.e. following the repeal of the Rules made under the 1938 Act) by rules made in the exercise of the powers conferred upon the Secretary of State by Section 78 of the 1994 Act. The Trade Marks Rules 1994 are stated to have been made under a variety of statutory provisions, including Section 78 of the 1994 Act. In R v Registrar of Trade Marks ex p. Interturbine Germany GmbH (22 February 1999) Laddie J held that the rules of practice and procedure contained in the 1994 Rules apply (by virtue of paragraph 10(2) of Schedule 3) to applications for registration which are continuing under “*the old law*” except to the extent that the Secretary of State may provide for them to be subject to different rules of practice and procedure. This accorded with the approach adopted by Neuberger J in relation to paragraph 10(2) of Schedule 3 and Rule 19 of the 1994 Rules in Interlego AG’s Trade Mark Applications [1998] RPC 69 at 102 to 104.

The provisions of paragraph 10(3) of Schedule 3 are not relevant and can be put on one side for present purposes.

As required by Section 105 and paragraph 10(1) of Schedule 3 of the 1994 Act, the Opposition to registration of the word TABO as a trade mark in the name of the Applicant proceeded to a hearing at which registrability was considered and contested entirely by reference to the provisions of "*the old law*". The hearing took place before Mr M Foley acting as Hearing Officer for the Registrar of Trade Marks on 12 October 1998. The Opponent was represented by Counsel. The Applicant was not represented. In a decision issued on 5 March 1999 the Hearing Officer reviewed the evidence filed on behalf of the parties and considered the objections to registration which had been raised on behalf of the Opponent. Having done so, he rejected the Opposition and ordered the Opponent to pay £635 as a contribution towards the Applicant's costs of the proceedings.

In April 1999 the Opponent gave notice of appeal to an Appointed Person under Section 76 of the Trade Marks Act 1994. The papers in the case were subsequently forwarded to me as the person by whom the appeal would in due course be heard. I queried whether I had jurisdiction to hear and determine the appeal. My concerns were communicated to the parties via the Treasury Solicitor's department. A hearing was subsequently appointed to consider the question of jurisdiction as a preliminary issue. I should say at this juncture that the present appeal is one of a number of appeals from decisions of the Registrar determining opposition proceedings under "*the old law*" in which the same question has arisen: whether appeals from such decisions are governed by Section 18 of the 1938 Act to the exclusion of Section 76 of the 1994 Act.

Section 76 of the 1994 Act provides as follows:

- “(1) An appeal lies from any decision of the registrar under this Act, except as otherwise expressly provided by rules. For this purpose, “decision” includes any act of the registrar in exercise of a discretion vested in him by or under this Act.
- (2) Any such appeal may be brought either to an Appointed Person or to the Court”.

I think it is clear that the exception created by the words “*except as otherwise expressly provided by rules*” in Section 76(1) of the Act applies only to decisions made by the Registrar in respect of the matters specified in Rules 40(4), 41(3) and 44(5) of the 1994 Rules.

The 1994 Rules were made under the 1994 Act. It cannot be doubted that a decision of the Registrar under the 1994 Rules is a decision under the 1994 Act for the purposes of Section 76. It seems to follow from paragraph 10(2) of Schedule 3 of the 1994 Act that a decision made under the 1994 Rules in proceedings relating to an application continuing under “*the old law*” may be appealed to an Appointed Person or to the Court under Section 76. That is consistent with the decision of Laddie J. in Ex p. Interturbine Germany GmbH (above) and the decision of Neuberger J. in Interlego AG’s Trade Mark Applications (above).

However, the appeal in the present case is not brought against a decision of the Registrar under the 1994 Rules. Nor is it brought against a decision of the Registrar under any of “*the main substantive provisions*” which precipitated “*the consequential repeal of the Trade Marks Act 1938*” referred to in Section 109(2) of the 1994 Act. It is brought against a

decision of the Registrar in relation to “*an application for registration of a mark under the 1938 Act*” which must (in accordance with paragraph 10(1) of Schedule 3 of the 1994 Act) be “*dealt with*” in accordance with the provisions of the Trade Marks Act 1938. The absence of any derogations from this requirement and the imperative terms in which it is expressed indicate to my mind that the application must be “*dealt with*” in accordance with all applicable provisions of the 1938 Act and not otherwise.

According to Section 18(6) of the 1938 Act a decision of the Registrar in opposition proceedings under that Act is “*subject to appeal to the Court*”. The legislative antecedents of Section 18(6) of the 1938 Act clearly show that Parliament intended, when enacting those provisions, to provide that all appeals from decisions of the Registrar in opposition proceedings under the 1938 Act should be brought before the Court. Section 14(5) of the Trade Marks Act 1905 permitted appeals from decisions on registrability given in opposition proceedings to be brought before the Court or, with the consent of the parties, to the Board of Trade. Section 8 of the Trade Marks Act 1919 removed the option of appealing to the Board of Trade and so required all such appeals to be brought before the Court. That continued to be the position under Section 18(6) of the 1938 Act. By contrast the option of appealing to the Court or the Board of Trade from decisions on registrability given in ex parte proceedings was preserved in Section 12(4) of the Trade Mark Act 1905. That continued to be the position under Section 17(4) of the 1938 Act. It is plainly no accident that an appeal to the Court was one of two options available under Section 17(4) but the only option available under Section 18(6) of the 1938 Act.

The operation of Section 18(6) of the 1938 Act in relation to applications continuing under “*the old law*” does not appear to have been altered by the 1994 Act or the 1994 Rules; indeed it appears to have been intentionally perpetuated by the 1994 Act. It therefore seems to me that Section 105 and paragraph 10(1) of Schedule 3 of the 1994 Act require the Registrar to determine applications “*under the old law*” by means of decisions which (because the relevant applications must “*be dealt with under the old law*”) are subject to the regime for appeals laid down in Sections 17 and 18 of the 1938 Act, whereas Section 105 and paragraph 10(2) of Schedule 3 of the 1994 Act enable the Registrar to make decisions in relation to such applications which (because they are decisions under provisions of the 1994 Rules) are subject to the regime for appeals laid down in Section 76 of the 1994 Act. This is reflected in the distinction drawn between proceedings under the 1938 Act and proceedings under the 1994 Act in the Practice Direction applicable to trade mark matters under Part 49 CPR. It is also reflected in the distinction between my appointment to hear appeals under Section 17(4) of the 1938 Act (made by the Secretary of State in 1996) and my appointment to hear appeals under Section 76 of the 1994 Act (made by the Lord Chancellor in 1995). These distinctions would have been meaningless if, which I do not accept, all decisions of the Registrar under the continuing provisions of the 1938 Act constituted decisions “*under this Act*” for the purposes of Section 76(1) of the 1994 Act.

For these reasons my conclusions on the preliminary issues are, shortly stated, as follows. The Opponent is seeking by means of the present appeal to reverse a decision as to registrability made in opposition proceedings continuing under the 1938 Act. That makes it an appeal which must (as required by the provisions of Section 105 and paragraph 10(1) of

Schedule 3 of the 1994 Act) “*be dealt with*” under Section 18 of the 1938 Act and not otherwise. Taken as it stands Section 18 of the 1938 Act is a section under which I am not authorised or empowered to hear appeals. Nothing in the 1994 Act or the 1994 Rules authorises or empowers me to hear appeals under that or any other section of the 1938 Act. I therefore have no alternative but to decline to proceed further with the appeal.

If (as I assume to be the case) I have jurisdiction to decide the issue I have just decided, it ought to follow that I have jurisdiction to make an award of costs in relation to the determination of that issue. On that basis I direct the Opponent to pay the Applicant £650 as a contribution towards its costs of the preliminary issue. I make no order for costs for or against the Registrar.

Geoffrey Hobbs Q.C.

27th October 1999

Douglas Campbell instructed by Messrs. Brookes & Martin appeared as Counsel on behalf of the Opponent.

Thomas Moody-Stuart instructed by Messrs. W.P. Thompson & Co. appeared as Counsel on behalf of the Applicant.

Mike Knight, Principal Hearing Officer, appeared on behalf of the Registrar.