

TRADE MARKS ACT 1994

IN THE MATTER OF:

**APPLICATION BY MIP METRO GROUP INTELLECTUAL PROPERTY
GMBH & CO. KG FOR PROTECTION IN THE UK OF INTERNATIONAL
TRADE MARK REGISTRATION NO. 885033**

AND OPPOSITION THERETO NO. 71427 BY HACKETT LIMITED

**APPEAL TO THE APPOINTED PERSON BY MIP METRO FROM THE
DECISION OF MR OLIVER MORRIS DATED 4 NOVEMBER 2009**

CASE MANAGEMENT CONFERENCE ON 19 SEPTEMBER 2012

INTERIM DECISION AND DIRECTIONS

1. I held a case management conference (“**CMC**”) by telephone on 19 September 2012, attended by Ms Kirsten Gilbert of Marks & Clerk Solicitors LLP on behalf of the Applicant/ Appellant in this case and by Mr Oscar Webb of Nabarro LLP on behalf of the Opponent/Respondent.
2. The relevant history is that on 4 November 2009 Mr Oliver Morris, hearing officer for the Registrar, issued a decision in Opposition No. 71427 (BL O-348-09) in which he found that the Opponent’s opposition to the protection in the United Kingdom of International Registration 885033 (“**the Mark**”) succeeded in respect of some but not all of the goods in the specification for the Mark. The Applicant filed a Notice of Appeal on 2 December 2009 seeking to overturn the decision insofar as the Opposition had succeeded under section 5(2)(b) of the Trade Marks Act 1994.
3. The case came to me in March 2010 with some outstanding procedural issues to deal with. I gave my preliminary views on those issues and invited the parties to try to agree how to proceed. I also set a date of 26 April 2010 for a hearing that would either be of the Appeal itself, if the procedural issues had been resolved, or would be a case management hearing in the absence of resolution.
4. I received letters from each party, indicating that agreement had been reached on how to deal with the procedural matters (which I summarise below). Then on 31 March 2010 the parties’ representatives wrote to me jointly, informing me that

the parties were “engaged in advanced settlement discussions”, but that these were unlikely to have concluded before the proposed hearing date. Therefore they asked if I would postpone the hearing for at least two months. On 1 April 2010, I agreed to take the hearing out of the diary on condition that I was notified of progress by 26 May 2010. Thereafter, there were subsequent exchanges, in which I was repeatedly informed that settlement discussions were continuing and a draft agreement was being discussed, with both parties keen to stay the appeal pending the outcome of those discussions. The last update that I was given was on 22 December 2010, when both parties informed me that they hoped to conclude the discussions shortly and in the meantime requested that no hearing date be set. At this point the case dropped out of my view and, in the absence of any communication from either party or the Registrar, I assumed that the matter had been settled.

5. It was drawn to my attention in August 2012 that the appeal remained on the record. The position was that the Mark had not been granted protection in the UK or been withdrawn, the appeal was outstanding, and no settlement had been reached. On further enquiry, it transpired that, not only had the Respondent’s representatives heard nothing from the Appellant’s representatives since 30 March 2011, but also the Appellant’s representatives had been unable to obtain instructions from their client despite attempts to do so.
6. Pursuant to my powers under rule 73(4) and rule 62(4) of the Trade Marks Rules 2008, I directed the parties to attend a CMC by telephone on 19 September 2012 at 10:30am in order to determine whether the appeal was to be pursued or withdrawn, and – if to be pursued – on what basis.
7. I received written submissions in a letter from the Respondent’s representatives before the CMC, stating that they did not know whether the Appellant wished to proceed with the appeal but that, if it did, the following preliminary matters were to be dealt with:
 - (1) the parties had agreed back in March 2010 that I should have sight of the unredacted versions of the hearing officer’s decision and the evidence (which I had asked for);
 - (2) the Appellant had agreed to delete paragraph 4(VI) of the Grounds of Appeal set out in its Notice of Appeal, pursuant to an objection raised by the Respondent that this referred to an earlier decision in the Opposition which had been annulled, and I had asked the Appellant to file an amended TM55 without the offending paragraph;

- (3) the Respondent was content for the appeal to be heard by the Appointed Person rather than the High Court (which it had previously suggested might be the preferred forum); and
 - (4) provided that paragraph 4(VI) was removed from the Grounds of Appeal, the Respondent would not file a Respondent's Notice.
8. The Respondent's representatives added that, if the appeal was to proceed, it should be heard by a different Appointed Person who was unaware of the paragraph that was to be deleted from the Notice of Appeal and the discussions that had taken place about it.
9. I received nothing in writing from the Appellant, but Ms Gilbert attended the CMC and informed me at the outset that she had just managed to obtain instructions from the Appellant, whose position was that it did wish to pursue the appeal. On behalf of the Respondent, Mr Webb stated that, having received nothing for well over a year, the Opponent had assumed that the Appeal would not be going ahead. However if it was to do so (and he did not attempt to persuade me that it should not), he submitted that there should be no further delay.
10. The discussions confirmed that the position on the preliminary matters that had been set out in the Respondent's letter and summarised at paragraph 6 above was correct. Since the Appellant had apparently not yet submitted an amended Notice of Appeal, I directed that this should be done within seven days of the CMC. I would add here that, if this direction is not complied with, I am likely to be sympathetic to an application for dismissal of the appeal, given the circumstances recited above.
11. In relation to the Respondent's request that the case be heard by a different Appointed Person, this turned out to be based on the concern that I might be swayed by the content of the paragraph of the Notice of Appeal that is to be withdrawn, which refers to an earlier decision of a different hearing officer for the Registrar, that was annulled. I do not consider this to be a legitimate reason for me to recuse myself from this case. I am well able to restrict my consideration of the appeal to the grounds that will be before me and to the decision that is in issue. I regard the annulled decision as irrelevant and I will take no account of it.
12. Furthermore, transferring the case to another Appointed Person at this stage could well result in further delay to the hearing of this appeal which, in the circumstances, would be a waste of time for both the administrators and the Appointed Persons concerned, would be disproportionate, and would not be in the overall interests of justice.

13. In order to avoid further delays, I invited the parties to agree a hearing date on the spot. In order to give Mr Webb an opportunity to instruct an appropriate advocate and also to give sufficient time for a last chance to pick up the settlement discussions, we agreed on Monday, 26 November. I cannot foresee any possibility of this hearing being adjourned again for further settlement discussions to take place. This case must be brought to a close.

Directions

14. Accordingly, I make the following directions:

- (1) The Appellant must file an amended Form TM55, omitting paragraph 4(VI) from the Statement of Grounds, and serve a copy on the Respondent (with a copy to me) by Wednesday, 26 September 2012.
- (2) The Respondent may not file a Respondent's Notice.
- (3) This appeal will be heard by me at 10:30am on Monday, 26 November 2012, with skeleton arguments to be exchanged and filed (with a copy to me) by 2pm on Thursday, 22 November 2012.
- (4) The costs relating to the Case Management Conference are reserved to be dealt with at the final hearing.

ANNA CARBONI

21 September 2012

The Appellant was represented by Kirsten Gilbert of Marks & Clerk Solicitors LLP.

The Respondent was represented by Oscar Webb of Nabarro LLP