

O-070-22

FINAL DECISION

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS. 2447064 & 2454306

BY PHILIP MAITLAND-KRAFT

TO REGISTER:



&



AS TRADE MARKS IN CLASS 33

AND

THE CONSOLIDATED OPPOSITIONS THERETO UNDER NOS. 96027 & 96054

BY

O2 WORLDWIDE LIMITED

Background

1. On 6 October 2010, the registrar's Hearing Officer, David Landau, issued a provisional decision in these proceedings (BL-O-346-10 refers). As Mr Landau has since retired, these proceedings have been passed to me to issue a Final Decision.
2. In summary, on 17 February and 1 May 2007 respectively, Philip Maitland-Kraft applied to register the trade marks shown on the cover page of this decision for "alcoholic beverages" and "vodka" respectively in class 33. The applications were opposed by O2 Holdings Limited under sections 5(1), 5(2)(a), 5(2)(b), 5(3) and 5(4)(a) of the Act.
3. In his decision (with footnotes omitted) the Hearing Officer stated:

"4) In its grounds of opposition Holdings relied upon a number of earlier trade mark registrations and applications. At the hearing, whilst not abandoning the other registrations and applications, in relation to sections 5(1) and 5(2) of the Act Holdings put forward its case on the basis of Community trade mark application no 4423475 and Community trade mark registration no 7177363, the latter being a scion of the former as the result of a division of the application. Community trade mark application no 4423745 is now for goods in classes 30, 32 and 33. It is the subject of oppositions. Opposition no B1040486 was successful in its attack on the class 32 and 33 goods of the application. This decision is currently the subject of an appeal by Holdings, received on 29 December 2009. Registration no 7177363 is currently the subject of a cancellation application. At the hearing Holdings relied upon retail services, services for providing food and drink and entertainment; although not limiting its oppositions to these services. By a letter dated 21 September 2010, Holdings advised that all of these services, with the exception of providing drink, are the subject of the cancellation action. **Owing to the status of application no 4423745, it is not considered appropriate to make findings on the basis of this application in relation to Mr Maitland-Kraft's applications. As the issue of the validity of parts of**

registration no 7177363 is currently being contested, it is not considered appropriate to take those parts of the specification currently being contested into account. Consequently, this decision is a provisional decision pending the outcome of application no 4423475 and outcome of the partial cancellation action in respect of registration no 7177363. As application no 4423745 is the sole earlier right upon which Holdings relies which has identical goods to those of the applications, no findings will be given, at this stage, in relation to the ground of opposition under section 5(1) of the Act.”

And:

“6) In relation to the grounds of opposition under sections 5(2)(a) and (b) of the Act, Holdings specifically relies upon the following services of registration no 7177363: retail services, entertainment and services for providing food and drink, which are in classes 35, 41 and 43 respectively. Owing to the cancellation action against the registration, consideration will be given only to the services for providing drink...”.

And:

“55) Consequent upon the findings in paragraph 4 the consideration of likelihood of confusion will be made in relation to Community trade mark registration no 7177363 in respect of services for providing drink.”

4. I note that in relation to the oppositions based upon sections 5(2)(a) and (b) of the Act, the hearing officer concluded:

“64) There is a likelihood of confusion and Holdings is successful in its opposition under section 5(2)(b) of the Act and the applications of Mr Maitland-Kraft are to be refused in their entireties.”

5. In paragraphs 72 and 76 of his decision, the Hearing Officer dismissed the oppositions based upon sections 5(3) and 5(4)(a) of the Act. In paragraph 77 of his decision, he stated:

“...this is a provisional decision, owing to the opposition and invalidation actions against the trade marks of Holdings at the Community trade marks office. When there is a final outcome to these proceedings a final decision will be issued. The setting of the period for paying costs and the appeal period will flow from this final decision. However, as per the submission of Mr Stobbs, if Holdings should withdraw its reliance upon these trade marks (or parts of these trade marks) a final decision will be issued; which will simply confirm the findings of this decision.”

6. In relation to costs, the Hearing Officer stated:

“80) In *West t/a Eastenders v Fuller Smith Turner PLC* [2003] EWCA Civ 429 Pumfrey J, sitting in the Court of Appeal, decided that in awarding costs the success in relation to separate grounds and the evidence adduced in relation to those grounds should be taken into account. In this case Holdings failed in relation to the grounds under sections 5(3) and 5(4)(a). These were the only grounds that required evidence. The success of Holdings was simply based on the comparison of one of its Community trade mark registrations with the applications of Mr Maitland-Kraft. Taking into account the time that Mr Maitland-Kraft would have had to spend in considering this evidence, the statement of grounds in relation to the unsuccessful grounds, the parts of the hearing that were actually relevant to the outcome of the case, it is considered that each party should bear its own costs with the exception of the costs of the opposition fees. Consequently, when a final decision is issued Mr Maitland-Kraft must pay O2 Holdings Limited the sum of £400 within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.”

7. On 17 June 2021, the opponent's representatives, Stobbs, wrote to the Tribunal, stating:

"We refer to the Decision on Consolidated Opposition Nos. 96027 and 96054 of 6 October 2010, and write to confirm that in the case of invalidation against EU Trade Mark No. 7177363, the invalidation action has been withdrawn and the mark is no longer under a cancellation action..."

We confirm that the relevant coverage for the decision has been retained.

The marks relied upon have subsequently been assigned from O2 Holdings Limited to O2 Worldwide Limited, who we respectfully request be substituted as the Opponent in this case. O2 Worldwide Limited stands by the grounds and statements made in the Notice of Opposition and subsequently in the proceedings, and confirms that where the name of the original opponent appears this should be read as though it is made in their name. Stobbs is representative for both O2 Holdings Limited and O2 Worldwide Limited."

8. In response to official letters sent to Stobbs on 5 and 15 November 2021, on 22 November 2021, Stobbs wrote to the Tribunal stating:

"Unfortunately the correspondence was not copied to Mr Maitland-Kraft – this is because upon searching the web for an appropriate address for Mr Philip Maitland-Kraft, it appears that Mr Maitland-Kraft passed away on the 20th of July 2018 according to our internet searches. It is not clear where any correspondence regarding this case should now be sent..."

9. Based on that information, the Tribunal wrote to Mr Maitland-Kraft's address for service (as shown on the official record) as well as to two other addresses associated with him identified from the official file. Those letters, which were sent on 2 December 2021 using the Royal Mail's "Signed For" service, read as follows:

“Please see the opponent’s emails dated 17 June and 22 November 2021.

It is the registry’s preliminary view that the substitution of the opponent is acceptable.

A period of 14 days until 16 December 2021 is provided for any comments.”

10. Two of the letters sent were returned to the Tribunal marked “addressee gone away”. Although the third letter, sent to the applicant’s address for service, was delivered and signed for by “KRAF” on 8 December 2021, no reply was received to the official letter mentioned.

DECISION

11. In his decision, the Hearing Officer refers to a Community Trade Mark application and registration; these are now known as European Union Trade Marks (“EUTMs”). Although the UK has left the European Union and the transition period has now expired, EUTMs are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. Tribunal Practice Notice 2/2020 refers.

The request for substitution

12. The Tribunal’s approach is outlined in paragraph 4.17 of the Tribunal Work Manual, the relevant part of which reads:

“Whilst the rules make no express provision, it has been held that parties can be substituted in proceedings (*Pharmedica* (2000) RPC 536). For example, where an interest in a mark or marks forming the basis of an opposition is assigned to another party, that party, may apply to the Tribunal to be substituted for the original opponent or applicant. It should be noted that this only applies if the transfer takes place after the proceedings have

commenced, whether or not any inextensible periods for filing pleadings have expired...”

13. I note that at the date of the provisional decision, the opponent was identified as O2 Holdings Limited. I further note that the official record now shows the name of the owner of registration no. 7177363 as O2 Worldwide Limited. As the change of ownership clearly took place after these proceedings commenced, I am satisfied that the preliminary view expressed in the official letter of 2 December 2021 was correct and the name of the opponent may be substituted to O2 Worldwide Limited.

Registration no. 7177363

14. At the time of writing this Final Decision, a review of the UK IPO’s database includes the following entry against the above registration:

“The existing EU trademark to which this comparable right corresponds is subject to invalidation or revocation action, the outcome of which may be applied to this trademark.”

15. Although the reference to a “comparable right” is not relevant for present purposes, a review of the database of the European Union Intellectual Property Office (“EUIPO”) appears to support the opponent’s submissions to the effect that “the mark is no longer under a cancellation action” and “the relevant coverage for the decision has been retained.” I further note that, inter alia, “services for providing food and drink” in class 43 remain in the specification.

Outcome

16. The Hearing Officer’s provisional decision under section 5(2)(b) of the Act was based upon “services for providing drink” in the opponent’s specification. Proceeding on the basis of those services alone, the Hearing Officer concluded that the oppositions succeeded in full. As the above services have been retained by the opponent following the cancellation action (and as there is nothing to suggest that there are any outstanding appeals before, inter alia, the EUIPO), the

oppositions succeed and, subject to any successful appeal, the applications will be refused.

Costs

17. This issue was dealt with by the Hearing Officer in paragraph 80 of his decision. Although it appears Mr Maitland-Kraft has passed away, as he is still shown on the official record as the owner of the applications, I have no alternative but to award costs against him. In those circumstances, I order Philip Maitland-Kraft to pay to O2 Worldwide Limited the sum of **£400**. Notwithstanding the reference to 7 days in the provisional decision, this sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of January 2022

C J BOWEN

For the Registrar