O-194-15

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION NO. 102670

IN THE NAME OF THE SAUL ZAENTZ COMPANY

TO TRADE MARK APPLICATION NO. 2588875

IN THE NAME OF SUCCESS STORY MANAGEMENT LTD

INTERIM DECISION AND DIRECTIONS UNDER
RULES 62(1) AND 73(4) OF THE TRADE MARKS RULES 2008

Background

1. Opposition No. 102670 in the name of The Saul Zaentz Company ("the Opponent") to Trade Mark Application No. 2588875 for registration of the mark HENRY SPURWAY'S BILBO BAGGINS in Classes 9 and 41 in the name of Success Story Management Ltd ("the Applicant") succeeded for the reasons given in a decision issued by Mrs Ann Corbett on 11 June 2013 on behalf of the Registrar of Trade Marks (ref. BL O-225-13).

2. The Applicant subsequently applied to have the appeal heard by the Court of Session in Scotland. The Appointed Person, Geoffrey Hobbs Q.C., refused that application, giving his reasons in a decision dated 27 February 2014 (ref. BL O-096-14).

3. The appeal therefore went forward for hearing by the Appointed Person, and a hearing date of 4 November 2014 was fixed and notified to both parties by letters dated 16 October 2014 from the Treasury Solicitor's Department ("TSol", which administers appeals to the Appointed Person).

4. On 23 October 2014, Mr Spurway, the sole director and shareholder of the Applicant, wrote to TSol, stating that he was unable to attend the hearing on 4 November 2014. He did not explain why. The Opponent's representatives then contacted my office on 27 October 2014 to ask for the hearing to be re-scheduled due to their unavailability. Accordingly, the

hearing was rearranged for 20 November 2014, which date was notified to the parties by letter dated 28 October 2014 from TSol.

5. Mr Spurway responded by letter dated 31 October 2014, stating that until the Applicant had legal representation, it would be impossible for it to be represented at the hearing, and that it had no assets. He indicated, however, that he was pursuing a complaint with the Scottish Legal Complaints Commission against his former representatives in the appeal, seeking compensation from them, and stated that he would advise TSol as soon as there was a settlement.

6. I considered that the reasons given did not preclude the hearing going ahead, and informed Mr Spurway via a letter dated 3 November 2014 from TSol that I intended to proceed with the hearing, as well as informing him that he was entitled to attend the hearing in person and that the Applicant was allowed to appear without legal representation. The letter also informed him that, if he wished to make any submissions as to either the substance of the case or my decision to go ahead with the hearing, he could do so either orally at the hearing and/or in writing in advance.

7. Mr Spurway sent an undated letter received by TSol on 11 November 2014, informing TSol that he was unable to attend the hearing due to his right knee being in constant pain and indicating that he was on a waiting list for an operation. He enclosed a medical appointments card to show that he had been receiving physiotherapy as a hospital outpatient during September and October 2014 and was due to have a further appointment on 11 November 2014. Mr Spurway also stated that the Applicant had not traded and would not trade until a hearing date had been arranged that was suitable for both parties. He stated that it would not be open and fair if both parties could not be present at the hearing.

8. In an effort to hold onto the hearing date, and having regard to the time already elapsed since the first instance decision, I invited Mr Spurway (via letter from TSol dated 12 November 2014) to attend the hearing by way of video or telephone conference instead of in person. Mr Spurway responded by fax dated 13 November 2014, sent from the West End Hotel in Edinburgh. Mr Spurway explained that he was due to attend a hearing the next day, as Pursuer, at Livingston Sherriff Court (20 miles away from Edinburgh) but that, because of the state of his right knee, apparently caused by a bad fall, he had obtained a doctor's note explaining his difficulty in attending that hearing. He ended the letter by stating that he would contact TSol for a new hearing date in March 2015. The fax contained a copy of a letter dated 11 November 2014 from a doctor, stating that Mr Spurway had

significant osteoarthritis of the knee, that he may soon require surgery, that he has a significant flair up of pain and disability affecting his ability to stand and walk, and that this may compromise his ability to attend court the following day.

9. It appears that Mr Spurway did in fact attend (or try to attend) the hearing in Livingston, since noted in Mr Spurway's handwriting at the bottom of the doctor's letter was the following statement:

> *"N.B. I received your letter this morning 13/11/2014. The Appointed Person is now trying to harrass me, I had a fall yesterday out at Livingston and I will not be doing the telephone call you request, on the appointed person's behalf, on 20/11/2014. As I am in my seventieth year, the police came to my accident and I have other witnesses. As previously stated, I do not have video facilities, nor I am* (sic.) *going to do such an important hearing on my mobile [number given]. Should the hearing still go ahead I will then. I will then take necessary action, I am not well, under doctors and awaiting an operation. But I am not refusing to do it. As my company S.S.M.L. has spent a lot of money and time I would say by March 2015 I should be ready."*

10. In the light of this correspondence, I decided that I should not proceed with the full hearing of the appeal on 20 November 2014 (today), but should instead hold a case management conference call in order that (a) the Applicant could make representations as to why the hearing should be put off until March 2015, (b) the Opponent could express its views and make any representations, and (c) a new hearing date could be set while everyone was on the call, with access to their calendars. Accordingly TSol wrote to the parties on 14 November to notify them of this.

11. Mr Spurway responded to TSol by letter dated 17 November 2014, conveying his apologies to me for not agreeing to participate in a telephone conference call, as he was in too much pain. He repeated that the Applicant would not be trading as HENRY SPURWAY'S BILBO BAGGINS (the subject mark of this case), and stated that he would call to make a new date for the hearing. TSol informed Mr Spurway by letter of 18 November 2014 that the telephone conference would go ahead on 20 November 2014 in any event. An attempt was made by my office to reach Mr Spurway by phone half an hour before the scheduled conference call, to see whether he could be persuaded to participate in the call, but he did not answer his mobile phone and there was no message facility.

12. Therefore I proceeded with the case management teleconference call at 10.30am today, 20 November 2014, attended by Mr John Olsen and Ms Frédérique Bodson of Edwards Wildman UK LLP, representatives of the Opponent. It transpired that they had not seen the correspondence between Mr Spurway and TSol, and so I explained the gist of it to them and invited their comments on the proposed further delay to March 2015. Mr Olsen informed me that the Opponent was prepared to be flexible and did not wish to argue with the Applicant over the date, though he expressed the view that this would simply postpone the inevitable outcome that the first instance decision would be upheld.

13. We discussed Mr Olsen's availability to argue the case in March, and he indicated that he had good availability, and suggested that the hearing should be set after mid-March, in order to maximise the chance that Mr Spurway would be able to attend. However, he submitted that, once a date was set, any further delay by Mr Spurway should not be treated favourably.

Decision

14. Having considered the Applicant's request for a postponement until March 2015, I have concluded that the hearing of this appeal can wait until then. In doing so, I take account of Mr Spurway's painful problem with his knee and the fact that the Opponent does not oppose the request. I do not regard Mr Spurway's claim against his former representatives as being relevant to his ability to attend.

15. While it might be hoped that Mr Spurway will have had whatever treatment is needed by March 2015, I appreciate that this cannot be guaranteed. Nevertheless, a date should be fixed. If Mr Spurway maintains closer to the time that his position is no better, and that he cannot attend the rearranged hearing, I (or any other Appointed Person who takes over this case) cannot be expected to be as sympathetic. If Mr Spurway is serious about pursuing this appeal, then he must make arrangements to argue it, and must be prepared for the hearing to go ahead in his absence if he fails to attend. If he is not serious, then he should withdraw it. The Opponent cannot be expected to wait indefinitely for the appeal against the first instance decision to be upheld or otherwise dealt with.

16. In case further representations are made as to timing later in the proceedings, I consider that it is important that the Opponent has sight of the contents of the correspondence from Mr Spurway to TSol.

Directions

17. I therefore give the following directions under Rules 62(1) and 73(4) of the Trade Marks Rules 2008:

(1) TSol shall provide copies of the correspondence between Mr Spurway and TSol, referred to in this decision, within three working days;

(2) The parties are each directed to notify TSol in writing by no later than Friday, 28 November 2014 of any weekday dates in March 2015 when they would be unable to attend a hearing in London, whether in person, via a representative, or by some form of remote communication (video or phone link);

(3) A hearing will then be set for a date in March, even if no communication has been received from either party, with preference given to the second half of March, subject to the parties' available dates;

(4) If one of the parties does not attend the hearing, and no further order has been made in the meantime, the substantive hearing will go ahead and a decision will be rendered;

(5) Any claim for additional costs incurred by the parties by virtue of the case management teleconference today and the rearrangement of the hearing date shall be dealt with at the conclusion of the proceedings by the Appointed Person who hears the appeal.

ANNA CARBONI
20 November 2014