O-326-04

TRADE MARKS ACT 1994

IN THE MATTER OF AN INTERLOCUTORY HEARING HELD IN RELATION TO OPPOSITION Nos: 90931, 90932 & 90933 BY CHICAGO MERCANTILE EXCHANGE TO APPLICATION Nos. 2175249A, 2175246A & 2175243A IN THE NAME OF GLOBIX CORPORATION

TRADE MARKS ACT 1994

IN THE MATTER OF an Interlocutory Hearing held in relation to Opposition Nos: 90931, 90932 & 90933 by Chicago Mercantile Exchange to Application Nos. 2175249A, 2175246A & 2175243A in the name of Globix Corporation

BACKGROUND

1. On 19 August 1998, Bell Technology Group Ltd of New York, United States of America applied to register three trade marks in Classes 9, 36, 37, 41 and 42; the applications now stand in the name of Globix Corporation. Following examination the applications were divided and were subsequently published in Journals 6429 and 6431 on 8 and 22 May 2002 respectively. The marks for which registration was sought are as follows:

2175243A – GLOBIX COMMUNICATIONS

2175246A – GLOBIX

2175249A – GLOBIX CORPORATION

2. On 8 August 2002, Boult Wade Tennant acting as agents for Chicago Mercantile Exchange filed notices of opposition to these applications.

3. In official letters dated 30 September 2002, the Trade Marks Registry served the Forms TM7 and Statements of Case on the Applicant's agents Reddie & Grose, who were then allowed until 30 December 2002 to either file Forms TM8 and counterstatements, or to make requests to enter cooling-off periods.

4. On 30 December 2002, Reddie & Grose filed three counterstatements but no Forms TM8.

5. On 13 January 2003, the Trade Marks Registry wrote to the parties in the following terms:

> "I acknowledge receipt of the counterstatements filed on 30 December 2002 in respect of the above applications.
>
> I have to advise you that under Rule 13(5) of the Trade Marks Rules 2000 the counterstatement must be accompanied by the official Form TM8.
>
> The official letter dated 30 September 2002 stated that you had a period of **3 months** for the filing of a Form TM8 and counter-statement, that period being non-extendable under Rule 68(3) of the Trade Marks Rules 2000. The last day for filing the Form TM8 and counter-statement was 30 December 2002.
>
> As the Forms TM8 have not been received the above applications will be deemed withdrawn in accordance with Rule 13(6) of the above rules."

6. On 27 January 2003, Reddie & Grose responded to the official letter mentioned above. They did so in the following terms:

> "We have noted your comments that as our TM8 did not accompany the counterstatement, the applications will be deemed withdrawn in accordance with Rule 36 of the Trade Laws 2000.
>
> We attach copies of the TM8's which we have on file, which you will note, are dated 30 December 2002. It also states that two pages, namely the counterstatement, would be accompanying the TM8.
>
> We cannot explain why these forms have not been received by you. They were signed in our office and given to our filing clerk for hand delivery to you. It is not clear from our filing book whether the forms were included in papers filed on that day on each of these three cases. Thus, we cannot say whether the forms were not filed by us, or whether they were filed and have become lost in the Registry since filing.
>
> The procedure for filing documents in our office requires an official letter action sheet to be completed. The sheets for these three cases are attached. At the top of the sheet is an identification of the action required (TM8 & C/STAT) indicating that a form TM8 and a counterstatement are required.
>
> These sheets are given to the filing clerk with the sheets. The filing clerk checks the matter required and details such as application number. If the document agrees with what is required, the box in the final line is initialled. It can be seen that the boxes have been initialled in all three cases. Finally, the sheet is returned to a diary clerk who initials it and takes the deadline off the diary reminder system. The initials LJH on the bottom right hand corner show that this had been done.
>
> The filing clerk in this instance has performed his job for over 10 years. He is highly reliable. We therefore believe that he received the forms for filing. If they had been detached in our office, we would have expected them to be found or even filed on the next day. This has not happened, suggesting that the forms were filed.
>
> It is clear that, whatever the circumstances, it was our intention to file the forms. File copies are present in our files, and the forms were executed in our office. Moreover, the fact that you have received the counterstatements strongly indicates the intention to file the forms.
>
> The purpose of the TM8 is to facilitate processing of the counterstatement. However, the procedural step to be taken at this stage is the filing of the counterstatement. This was completed within the deadline.
>
> As it was the Applicant's clear intention to file forms TM8 with the counterstatements, and as is not clear whether the forms were lost in the Registry or accidentally not filed by us, we ask that you exercise your discretion and treat the forms and counterstatements as having been filed on time."

7. In an official letter dated 31 January 2003, the Trade Marks Registry responded to the letter mentioned above, commenting that the period allowed for filing Form TM8 and

counterstatement (under the provisions of rule 13(3)) was non-extendable (under the provisions of rule 68(3)). Thus, the Trade Marks Registry's preliminary view was that they were unable to admit copies of the Forms TM8 filed on 27 January 2003 and that as a result, the applications would be withdrawn in accordance with rule 13(6). The parties were allowed until 14 February 2003 to provide written arguments and to request a hearing.

8. On 14 February 2003, Reddie & Grose filed written arguments and requested a hearing.

THE INTERLOCUTORY HEARING

9. On 20 March 2003, an interlocutory hearing took place before me to consider the Applicant's request. At the Hearing, Mr Patrick Lloyd of Reddie & Grose represented the Applicant for registration; the Opponent was represented by Mr John Wallace of Boult Wade Tennant.

THE SKELETON ARGUMENTS

10. Given that the respective parties skeleton arguments were brief, I have reproduced them below in full.

The Applicant's skeleton argument

> "The Applicant will rely on the following:
>
> 1. The purpose of a form TM8 is to assist the Registry in completing the administrative part of opposition revocation and invalidity proceedings.
>
> 2. The Applicant has given the Registry the necessary information in its counter-statements and thus has effectively filed its forms TM8.
>
> 3. The instructions on the form TM8 sent to the Applicant by the UK Trade Mark Registry are misleading and confusing as to whether a TM8 and counter-statement are the same or separate documents.
>
> 4. The purpose of Lord Woolfe's reform was to simplify and improve the speed of proceedings. The Registry's decision to refuse to accept the Applicant's forms TM8 as filed, is not in the spirit of the Woolfe reforms.
>
> 5. The Opponent has not been prejudiced by the alleged failure to file the forms TM8. However, if the Applicant's TM8's are deemed not to have been filed, with no remedy available, the Applicant will have been prejudiced. In the interest of fairness and equity, the Applicant should be allowed to correct any deficiency in the papers filed.
>
> 6. The opponent was given the opportunity to amend its Notice of Opposition on two separate occasions on a non-extendable deadline. In the interests of fairness and equity the Applicant should be given the same opportunity."

The Opponent's skeleton argument

"Background

On 30 September 2002 the Registrar sent the amended Form TM7 (Notice of Opposition) from the Opponent. The Applicant was advised that under Rule 13(3) of the Trade Mark Rules 2000 they had three months from the date of the letter in which to file a Form TM8 and Counterstatement.

By copy of letter of 13 January 2003 the Opponents were advised that Counterstatements had been filed on the 30 December 2002 but that Forms TM8 had not been filed.

On the 24 January 2003 the Registrar issued a preliminary ruling and as no TM8 had been filed and that by virtue of Rule 13(5) of the Trade Mark Rules 2000 and Rule 68(3) this period was not extendable, the late filed Forms TM8 could not be admitted. By virtue of Rule 13(6) of the Trade Mark Rules 2000 the applications will shortly be deemed withdrawn.

Section 66 of the Trade Marks Act 1994 provides the Registrar with the authority to require the use of Forms in proceedings before him/her.

Rule 3 of the Trade Mark Rules 2000 provides that a requirement under the Rule to use a form as published is satisfied by the use either of a replica of that form or of a form which is acceptable to the Registrar and contains the information required by the form as published and complies with any directions as to use in such a form.

Rule 13(3) provides a three month period following notification of the opposition to file a Form TM8 and Counterstatement.

Arguments

The Applicants contend that the purpose of the Form TM8 is merely a formality and the information provided in their Counterstatement is such to meet the requirement laid down by the Rules for the filing of this form. Rule 3(2) allows for the use of a replica form, which has clearly not been filed in this case or "of a form which is acceptable to the Registrar" and contains the information required by the form as published and complies with the directions as to the use of such a form. The filing of a Counterstatement on its own is neither a replica of Form TM8 or "of a form which is acceptable to the Registrar" – quite simply no form has been filed.

The Applicant refers to Tribunal Practice Notice 1/2000 (copy attached) which is effective for proceedings from the 26 April 2000. This document is headed Practice and Proceedings before The Comptroller and sets out some overriding objectives of the Office and its role as a tribunal. No where in the tribunal practice notes does it refer to any of the forms required in any proceedings before the Office. It does however introduce Paragraph 27 a requirement that claims and defences in Trade Mark proceedings should contain a Declaration on behalf of the parties confirming the accuracy and truth of the matter contained in them. The signing of form TM8 acts as the Declaration the accuracy and truth of the matter contained in the accompanying

Counterstatement. Without Form TM8 there is no statement of truth as now required. For this reason, and the fact that the Counterstatement is not "a form which is acceptable to the Registrar", we submit the relevant requirements have not been made and that as the Registrar has no discretion to allow the late filing of this form, the applications must be dismissed, and costs awarded to the Applicants."

THE DECISION FOLLOWING THE INTERLOCUTORY HEARING

11. My decision at the hearing was communicated to the parties in a letter dated 21 March 2003, the relevant portion of which is reproduced below:

> "Having considered the parties skeleton arguments and authorities and having had the benefit of the oral submissions at the Hearing, my decision was that no Forms TM8 or, in the words of rule 3(2) of the Trade Marks Rules 2000,
>
> *"...a replica of that form or of a form which is acceptable to the registrar and contains the information required by the form as published..."*
>
> had been filed within the statutory period provided for in rule 13(3); both documents are clearly required to constitute a properly filed defence. That being the case, and notwithstanding your arguments regarding what you considered to be my discretion to allow additional time for the position to be regularised (ie. by allowing the Forms TM8 attached to your letter of 27 January 2003 into the proceedings), in my view the mandatory provisions of rule 68(3) ie. the non-extendable nature of rule 13(3) and the use of the word "shall" in rule 13(6) as opposed to the word "may" which appears in rules 32(3) and 33(3) come into play with the result that the Applicants are deemed to have withdrawn their applications for registration.
>
> Finally I heard submissions on Costs. Whilst I accept that Mr Wallace may have felt it prudent to be present at the Hearing to represent his clients interests, I agree with your submission that their presence was not determinative of the outcome of the proceedings. As a result, I propose to make no award of costs."

12. Following the issue of my letter above, Reddie & Grose on behalf of the Applicant for registration filed Forms TM5 requesting a written statement of the grounds of my decision. I will return to my decision later, but first, I must record the exchange of correspondence which took place following the request for written grounds.

13. On 13 May 2003 I wrote to the respective parties; I did so in the following terms:

> "The Joint Hearing which took place before me on 20 March 2003 in connection with the above sets of proceedings and your requests for written grounds filed on 4 April 2003 refers.
>
> In my decision in *LEATHER MASTER* (BL 0/090/03) dated 2 April 2003 (a copy of which is attached for ease of reference), you will note that I considered much the same issue as that which arose in these current sets of proceedings. On 28 April 2003 that earlier decision was appealed to an Appointed Person.

> It is my view that the Appointed Person's decision in the earlier proceedings will, effectively, decide the outcome of these sets of proceedings. If I am correct, then it would, in my view, be sensible to stay these proceedings to await the Appointed Person's decision.
>
> I would be grateful if you would review my earlier decision and advise if you agree with my suggested approach.
>
> A copy of this letter and attachment goes to Mr Wallace at Boult Wade Tennant with a request that he considers the position and responds accordingly."

14. On 23 May 2003, Boult Wade Tennant responded to my letter. In that letter they said, inter alia:

> "I can confirm that our clients are in agreement to stay these proceedings until the appointed person's decision is issued in connection with LEATHER MASTER (BL 0/090/03)."

15. In a letter dated 30 May 2003, Reddie & Grose commented as follows:

> "In principle I agree that the circumstances between the above matters and the LEATHER MASTER case (BL 0/90/03) are extremely close. It would therefore make sense to wait until a decision is made by the Appointed Person on the LEATHER MASTER case. However, we reserve the right to file an appeal on this matter."

Mr Lloyd went on to say:

> "We would also like to request further time to file some additional evidence before the decision is issued. Further evidence has recently come to light in our case which suggests that the forms may have been received, and then lost, by the Registry. You will recall from our written arguments we submitted that the Applicant intended filing the Forms TM8. We also submitted that on 30 December 2002, counterstatements and Forms TM8's were prepared for each application and handed to our filing clerk for hand delivery to the Patent Office. Our "receipt for documents filed" on 30 December 2002 confirm that counterstatements were filed but did not say whether TM8's accompanied the counterstatements. However, copies of the Forms TM8 which we have on file dated 30 December 2002 were sent to you under cover of our letter of dated 24 January 2003. We therefore could not categorically confirm that TM8's were filed. However we have never been able to say, either, that they were not filed.
>
> Two weeks ago my assistant received a call from OHIM regarding a Community trade mark application which we filed on 30 December 2002 (our reference number PADL/14717.EM01), the same day as we filed the counterstatements. The community application was filed through the UK Registry. OHIM received our priority documents for the application. These were filed separately after the application was "filed" but they had not received our application from the UK Registry.
>
> A review of our file showed that the Community trade mark application in question was hand delivered on 30 December 2002 to the UK Trade Mark Registry. Our filing clerk's records confirm that the documents were delivered by hand. His record book

shows that a new Community application was filed on that day our reference PADL/14717. We enclose a copy of the "receipt for documents filed in London" and the Patent Office's official receipt.

My assistant contacted the International Section of the Patent Office who suggested that we contact the fees section. They checked their records up to 9 January 2003 and could find no record of our application having been filed. The Office has asked us to send them a copy of the Community trade mark application and our fee sheet so that they can investigate this matter further. We are still waiting a response.

I believe that this new evidence is crucial to the above case. Although the Community trade mark application in question was filed in a different envelope to the counterstatements and Forms TM8, it was hand delivered at the Registry with the envelope we believed to have contained the TM8's and counterstatements on these cases. I believe that this does cast doubt over the way in which our Forms TM8's may have been handled by the Registry.

In our experience, it is rare for the Registry to lose documents, at the point of filing. The apparent loss of a trade mark application filed at the same time as TM8's which have gone missing appears to be more than a coincidence. The fact the Office appears to have made an error processing other documents filed by our office on the same day suggests that it is likely that a similar error was made when processing our Forms TM8.

At the very least, there must be very serious doubt as to whether or not these documents were received by the Registry. It is, we submit, no longer equitable to assume that they were not filed. In view of this, I believe that the Registry has an obligation to deem that the documents were filed, and lost. This is not an exercise of discretion by the Registrar but a finding that, on the balance of probabilities, the documents were filed.

This evidence has only recently come to light and was not available before the main hearing. I request that it be taken into consideration in your decision. I also request further time to submit further evidence to support this point as it comes to light."

16. In a letter dated 1 July 2003, I responded in the following terms:

"I note that both yourself and Mr Wallace of Boult Wade Tennant agree in principle that these proceedings should be stayed to await the outcome of the appeal to the Appointed Person in the *LEATHER MASTER* proceedings; I also note that you have requested further time in which to file additional evidence.

Ordinarily of course, my decision which was communicated to the parties in my letter of 21 March 2003 would have (subject to confirmation of the same in the form of written grounds) been the end of the matter at least in so far as the Registrar was concerned. However, in my view by agreeing that a stay was appropriate, the parties accepted that my decision in these proceedings became provisional until the findings of the Appointed Person in the earlier case was known.

> That being so, I am minded to allow you to file any additional evidence you consider appropriate. Of course, Mr Wallace must be given an opportunity to comment on the approach suggested, and, assuming he agrees with it, in due course to comment on any additional evidence you choose to file.
>
> I would hope that another hearing would not be necessary and that the further conduct of these proceedings could be dealt with "from the papers". In view of my comments above, I would ask Mr Wallace to confirm within 1 month of the date of this letter his agreement (or otherwise) to the approach I have suggested. Assuming Mr Wallace agrees with my approach, I will then set a period for you to file any additional evidence on which you wish to rely. Mr Wallace would then be allowed a similar period in which to reply."

17. In a letter dated 1 August 2003, Boult Wade Tennant responded to my letter mentioned above. In short, they commented that they disagreed with the approach suggested in my letter and asked for the proceedings to continue on the basis indicated in my letter of 13 May 2003.

18. In a letter to the parties dated 19 August 2003, I responded to Boult Wade Tennant's comments in the following terms:

> "In the circumstances, it appears to me that the most sensible way forward for both parties is for these proceedings to remain stayed to await the decision of the Appointed Person in the LEATHER MASTER proceedings. In this regard, I am informed that the Appointed Person Mr Simon Thorley QC will hear those proceedings on 25 September 2003.
>
> When Mr Thorley's decision is known, it will then be open to Mr Lloyd to either accept the decision as determinative of these proceedings, or, alternatively, to request that I prepare written grounds in the instant proceedings and then seek to persuade either the Appointed Person or the Court that the additional evidence on which he now wishes to rely should be admitted on appeal."

19. In a letter dated 29 August 2003, Boult Wade Tennant responded confirming their agreement to the above approach; no response was received from Reddie & Grose.

20. On 20 January 2004, Mr Geoffrey Hobbs QC acting in his capacity as an Appointed Person issued a decision in the LEATHER MASTER proceedings mentioned above. In a letter dated 27 January 2004, I wrote to the parties indicating that in my view Mr Hobb's decision "effectively determines these proceedings"; the parties were allowed one month in which to respond.

21. In a letter dated 27 February 2004, Reddie & Grose responded to my letter. They did so in the following terms:

> "We have read the decision of Mr Geoffrey Hobbs QC in the LEATHER MASTER case but, for the record, do not accept this decision "effectively determines the proceedings". There are material differences between the LEATHER MASTER case and the present proceedings, notably, that in LEATHER MASTER, the applicant conceded, from the start, that it had not filed forms TM8. In the present case, no such

concession has been made and we have proceeded on the understanding that the forms were filed in good time.

Further, as indicated in my colleague, Patrick Lloyd's letter of 30 May 2003, we have, since the hearing in these proceedings was held, learned of other material facts which have come to light, To date, we have not been allowed an opportunity to put those facts, which concern papers filed on the same day as the "missing" forms TM8 which the Registry has admitted it lost. It would, as my colleague, Patrick Lloyd stated, be a breach of national (sic) justice if we are not allowed to put this information into these proceedings; I reiterate that it was not known to us at the date of the hearing which took place in the early part of last year.

In the circumstances, I am enclosing extension requests in respect of all three cases, seeking a three month extension of time to allow us to put together detailed arguments and supporting materials in connection with the material facts discovered after the hearing last year took place and to take into account the decision of Mr Geoffrey Hobbs in the LEATHER MASTER case. Forms TM9 in this connection are enclosed.

In the event that the hearing officer is not prepared to agree to the extension requests enclosed, then we would ask for the issue of written decisions on these proceedings on the basis of the forms TM5 filed on 4 April 2003 as it is our intention to take this matter to appeal."

22. In a letter dated 17 March 2003, Boult Wade Tennant commented that in their view my letter of 19 August 2003 represented the only options available to the Applicant and that in those circumstances: "…we do not see that there is any basis on which extensions of time could be granted and, even if they were, there is no basis for a rehearing by the Hearing Officer on this case which is essentially what the applicant is seeking."

23. In a letter to the parties dated 30 March 2004, the Trade Marks Registry commented, inter alia, as follows:

> "Your requests for an extension of time has been refused as the decision of the Registrar dated 21 March 2003 has been issued and hence the Registrar is now *functus officio*."

With the background to these proceedings now explained, I turn to the grounds of my decision.

GROUNDS OF DECISION

24. These three oppositions have not been formally consolidated. However, all three cases involve the same parties, are at the same stage in proceedings, relate to trade marks which were filed on the same date for identical specifications in the same classes, and which were published only fourteen days apart. Bearing in mind the oppositions turn on objections to the GLOBIX element of the various applications, I have little doubt that they would have been (or at least should have been) consolidated in due course. Given that in these proceedings the only issue I needed to consider was whether or not the Applicant had filed properly constituted defences to the three oppositions, I propose to issue a single decision. This

approach will not, in my view, cause any difficulties for any appellate body who is required to make a judgement on the correctness (or otherwise) of the approach I have adopted.

25. From the background provided above, one can see that there were a number of exchanges of correspondence between the parties and myself following the filing of the request for written grounds. However, in these proceedings I made my decision at the hearing (on 20 March 2003) and communicated this decision to the parties in my letter dated 21 March 2003. After that date, the Registrar became *functus officio*. As such, in this decision I can not take into account any submissions made by Reddie & Grose after the date of my decision; I have however included details of their subsequent arguments for the sake of completeness.

26. In my letter to the parties dated 13 May 2003, I commented that, in my view, the forthcoming decision of the Appointed Person in *Uniters SpA v KML Invest AB* (the LEATHER MASTER case) was likely to be determinative of these proceedings and with that in mind, I suggested suspending these proceedings to await that decision. Both parties responded positively to this decision. In particular, I note that Mr Lloyd said:

> "In principle I agree that the circumstances between the above matters and the LEATHER MASTER case (BL 0/90/03) are extremely close. It would therefore make sense to wait until a decision is made by the Appointed Person on the LEATHER MASTER case…"

27. My own decision in *Uniters SpA v KML Invest AB* was issued on 2 April 2003 with Mr Hobb's decision following on 20 January 2004. Having reviewed both my own decision and that of Mr Hobbs, and notwithstanding Reddie & Grose's comments in their letter of 27 February 2004, the circumstances of the two cases are, it appears to me, extremely close. As such, I do not propose to repeat here a summary of the relevant sections of the Trade Marks Act and Rules which govern the handling of oppositions and the filing of forms before the Trade Marks Registry but have included as an Annex to this decision the decision of Mr Hobb's in *Uniters SpA v KML Invest AB* in which the pertinent sections and rules appear.

28. In short, the Trade Marks Registry set the Applicant's agents a date of 30 December 2002 in which to either file Forms TM8 and counterstatements or to request cooling-off periods; this date was set in accordance with rule 13(3) of the Trade Marks Rules 2000. On 30 December 2002, the Applicant filed three counterstatements but no Forms TM8; as such, they had failed to comply with the requirements of rule 13(3). As rule 13(3) is specifically mentioned in rule 68(3) as being non-extendable, the consequences of rule 13(6) bite on the three applications with the result that the applicant *shall* be deemed to have withdrawn their application(s) for registration.

29. In these proceedings, there is no evidence that the Forms TM8 were ever filed with the Trade Marks Registry. Whilst I have borne in mind the comments of Reddie & Grose prior to the hearing, as I mentioned above, I am not at liberty to take into account evidence which was not before me at the hearing. Having reviewed the official files once again, it is I think interesting to note that the three counterstatements are all present on the official files and all have on their front page a post-it label which carries the following date stamps: The Patent Office 30 December 2002 (stamped by the Patent Office's London Office) and 31 December 2002 (stamped by the Trade Marks Registry's Law Section based in Newport). Had the counterstatements been accompanied by the Forms TM8 when they were filed, one would have reasonably expected to see the Forms TM8 date stamped and not the counterstatements.

Whilst I accept this is far from conclusive, it is, at the very least, suggestive of the fact that when the counterstatements were received by both the Patent Office's London and Newport Offices, they were not accompanied by the Forms TM8.

CONCLUSION

30. In view of my findings above, I have concluded that:

(i) no Forms TM8 or "...a replica of that form or of a form which is acceptable to the registrar and contains the information required by the form as published..." were received by the Trade Marks Registry (in accordance with rule 13(3) of the Trade Marks Rules 2000) by the conclusion of the non-extendable deadline of 30 December 2002;

(ii) the consequences of this failure, is that the three applications mentioned will be deemed to have been withdrawn in accordance with rule 13(6) of the Trade Marks Rules 2000.

Dated this 28th Day of October 2004

C J BOWEN
For the Registrar
The Comptroller-General

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 90599

IN THE NAME OF UNITERS SpA

TO APPLICATION No. 2199661A

IN THE NAME OF KML INVEST AB

DECISION

---

1. On 20th May 2002 Uniters SpA ***("the Opponent")*** filed a Notice of Opposition on Form TM7 to Trade Mark Application 2199661A proceeding in the name of KML Invest AB ***("the Applicant")***. The Notice was accompanied by a Statement of Grounds of Opposition as required by Rule 13(1) of the Trade Marks Rules 2000. The Statement of Grounds was amended on 12th June 2002 in response to a request for clarification raised by the Registrar.

2. On 17th June 2002 the Registrar sent copies of the Notice and amended Statement of Grounds to the Applicant. The Applicant then had a legislatively prescribed period of 3 months expiring on 17th September 2002 within which to defend the opposition by filing a counter-statement ***"in conjunction with notice of the same on Form TM8":*** Rule 13(3). The prescribed period of 3 months could not be extended: see Rules 68(1) and 68(3).

ANNEX

3. On 17th September 2002 the Applicant inadvertently filed a Counter-Statement without the Form TM8 that was intended to accompany it. The Registry informed the Applicant that its failure to file a Form TM8 within the prescribed period left the Registrar with no alternative but to treat the opposed application for registration as withdrawn in accordance with the provisions of Rule 13(6): ***"where a notice and counter-statement are not filed by the applicant within the period prescribed by paragraph (3) ….. he shall be deemed to have withdrawn his application for registration".***

4. The Applicant requested a hearing at which to argue against the imposition of the sanction for default. The hearing took place before Mr. C J Bowen acting on behalf of the Registrar. For the reasons given in a written decision issued on 2nd April 2003 the hearing officer held that there had been a default under Rule 13(3) which could not be cured, thus allowing no escape from the conclusion that Application 2199661A must be deemed withdrawn under Rule 13(6).

5. The Applicant gave notice of appeal to an Appointed Person contending: (i) that it had, in substance, complied with the requirements of Rule 13(3); and (ii) that even if it had not, it could and should be granted relief or dispensation from the provisions of Rule 13(6) so as to enable it to rely on the Notice on Form TM8 which it had sent to the Registry out of time under cover of a letter dated 25th September 2002. The arguments on which it relied were essentially the same as those which the hearing officer had rejected in the decision under appeal.

compliance?

6. The Applicant's Counter-Statement filed on 17th September 2002 was said to have satisfied the requirement in Rule 13(3) for the filing of ***"a counter-statement in conjunction with notice of the same on Form TM8"*** on the basis that it could be combined with the letter under cover of which it had been sent to the Registry so as to provide an acceptable alternative to Form TM8 within the latitude allowed by Rule 3(2).

7. Section 66 of the Trade Marks Act 1994 provides:

> **Power to require use of forms**
>
> 66. (1) The registrar may require the use of such forms as he may direct for any purpose relating to the registration of a trade mark or any other proceeding before him under this Act.
>
> (2) The forms, and any directions of the registrar with respect to their use, shall be published in the prescribed manner.

Rule 3 of the Trade Marks Rules 2000 further provides:

> **Forms and directions of the registrar under s.66**
>
> 3. (1) Any forms required by the registrar to be used for the purpose of registration of a trade mark or any other proceedings before her under the Act pursuant to section 66 and any directions with respect to their use shall be published and any amendment or modification of a form or of the directions with respect to its use shall be published.
>
> (2) A requirement under this Rule to use a form as published is satisfied by the use either of a replica of that form or of a form which is acceptable to the registrar and contains the information required by the form as published and complies with any directions as to the use of such a form.

ANNEX

8. The purpose of Rule 3(2) is to allow inexact equivalents of the prescribed forms to be used with the approval of the Registrar. The essential features and functions of the prescribed forms must be preserved. The Registrar is able to decide whether departures from the prescribed forms are acceptable, but cannot exempt anyone from the obligation to use an acceptable form as and when required by the substantive provisions of the Act and the Rules.

9. In Re M's Application [1985] RPC 249 the importance of insisting upon the use of prescribed forms was explained by Falconer J. at p.260 in the following terms:

> "…… it means that the Office knows at once how to process a document coming in. If there were not prescribed forms for the very many steps which have to be taken, an application or a step in an application might be taken in any form at all and, as it was put, the Office could not as a practical matter operate and the only sensible system is to have prescribed forms for the various steps which have to be taken, as a matter of practicality and, indeed, workability. However that may be, under the statute it is mandatory that the prescribed form shall be used, and it is mandatory that you pay the prescribed fee; and I cannot regard mandatory requirements under the statute as being matters of form and not of substance."

In the same case on appeal, Oliver LJ observed at p.271:

> The whole rationale of prescribing forms for time-critical documents is that they have to be received and filed, as a matter of ordinary Office administration, by staff who have neither the time nor the qualification to read, digest and reply to letters. Thus substantially all the time limits which are laid down by the Rules are related to the filing of forms or documents, rather than correspondence. Mr. Laddie has submitted that this is really what underlies the whole system.

ANNEX

The failure to file a prescribed form at the Patent Office within the specified period was held to be an irregularity which could not be cured under the rules applicable to the proceedings in question.

10. Most (perhaps all) of the information which would have been set out in a duly filed Form TM8 could be gleaned from the Applicant's Counter-Statement and covering letter. However, it could not be said that such information was presented to the Registry in a form which was either a replica of the required Form TM8 or an inexact but acceptable equivalent of it. In reality, the Counter-Statement and the covering letter did not separately or together constitute ***"a counter-statement in conjunction with notice of the same on Form TM8"*** and the Applicant did not intend or expect them to perform the function of a Form TM8 when it sent them to the Registry on 17th September 2002. I agree with the hearing officer in thinking that the Registrar had no alternative on 18th September 2002 but to apply the sanction specified in Rule 13(6) to Application 2199661A because the Applicant had not done everything necessary to comply with the requirements of Rule 13(3) within the legislatively prescribed period of 3 months.

relief or dispensation?

11. Rules 68(1) and 68(3) leave no room for the suggestion on behalf of the Applicant that the time for filing the required Form TM8 could (even though the time for filing a counter-statement ***"in conjunction"*** with it could not) be extended by the Registrar.

12. There is also no room for the suggestion that Rule 57 or Rule 66 could and should have been used to save Application 2199661A from deemed withdrawal under Rule 13(6).

ANNEX

13. Rule 57 provides that:

> At any stage of any proceedings before the registrar, she may direct that such documents, information or evidence as she may reasonably require shall be filed within such period as she may specify.

The Registrar could not reasonably require an applicant for registration to file a Form TM8 in defence of opposition proceedings at a time when the application in suit was deemed withdrawn under Rule 13(6).

14. Rule 66 provides as follows:

> Subject to Rule 68 below, any irregularity in procedure in or before the Office or the registrar, may be rectified on such terms as the registrar may direct.

The power conferred by this Rule is expressly subject to Rule 68 (which prevents extension of the period for filing a Form TM8 in defence of opposition proceedings). It is also interstitial: it cannot be used to thwart the intended effect of other provisions of the Act and the Rules: E's Application [1983] RPC 231 (HL). It therefore cannot be used to provide the Applicant with relief or dispensation from the unequivocally expressed provisions of Rule 13(6).

15. I regret that I am unable to grant the Applicant relief or dispensation. I would have allowed it to rely on the Form TM8 which it sent to the Registry on 25th September 2002 if I could have found a way of enabling it to do so in accordance with the Act and the Rules. However, the provisions of Rules 13(3), 13(6), 68(1) and 68(3) are too stringent and explicit to be denied their full meaning and effect.

ANNEX

Conclusion

16. At the end of the hearing before me, I dismissed the Applicant's appeal for reasons to be given in writing in due course and directed the Applicant to pay the Opponent £875 by 27th January 2004 as a contribution towards its costs of the unsuccessful appeal. That order and direction are hereby confirmed.

Geoffrey Hobbs QC

20th January 2004

Mr. Doug McCall of Messrs W.P. Thompson & Co appeared on behalf of the Applicant.

Mr. Simon Malynicz instructed by Clifford Chance LLP appeared as Counsel for the Opponent.

The Registrar was not represented.