

TRADE MARKS ACT 1994

IN THE MATTER OF

OPPOSITION No. 95081

IN THE NAME OF MEREDITH CORPORATION

TO TRADE MARK APPLICATION No. 234555A

IN THE NAME OF CHANNEL FOUR TELEVISION CORPORATION

INTERIM DECISION

1. On 15 February 2005 Channel Four Television Corporation (*'the Applicant'*) applied to register the designation **MORE 4** as a trade mark for use in relation to various goods and services in Classes 9, 16, 35, 38, 40, 41 and 42. In the course of examination the application was divided so as to result in the request for protection in Classes 9, 16 and 41 proceeding under number 2384555A (*'the Application'*).

2. The Application was opposed by Meredith Corporation (*'the Opponent'*) on 15 March 2007. In its Form TM7 and Statement of Grounds filed under Rule 13 of the Trade Marks Rules 2000 the Opponent objected to the Application on relative grounds under Section 56 of the Trade Marks Act 1994. No grounds of objection were specified under Section 5 of the Act.

3. The Opposition was taken to have been duly filed even though Section 56 appears to provide no basis for opposition independently of the provisions of Sections 5(1) to 5(4)

of the Act: see Melly's Trade Mark Application (FIANNA FAIL and FINE GAEL Trade Marks) [2008] RPC 20, p.454 at paragraphs 26 to 29 and EXPOSURE Trade Mark (BL O-107-08, 9 April 2008) at paragraph 5; see also the decision of the Second Board of Appeal at OHIM in Case R 1399/2007-2 Nova Hotels Ltd v. VRL International Ltd (27 June 2008) at paragraphs 13 and 17.

4. The Applicant failed to file a Form TM8 and Counterstatement within the inextendible period of twelve months allowed for that purpose under Rule 13A(1) in combination with Rule 13A(3).

5. On 25 March 2008 (one day prior to expiry of the twelve month period) the Applicant sent a letter to the Registry by fax stating:

In the light of ongoing negotiations between the parties, we hereby request a joint suspension of the proceedings. We look forward to receiving confirmation of the suspension at your earliest convenience.

The letter was signed by both parties. The Registry replied on 31 March 2008 in a letter stating that the information provided in the letter of 25 March 2008 was insufficient to allow a stay of proceedings and more detailed reasons would be required. In particular, in line with Tribunal Practice Notice (TPN) 6/2004 on requests for stays and suspensions, the Registry required a statement as to the progress of the negotiations, the dates of actions taken by the parties and the nature of those actions.

6. The Opponent replied by fax on 17 April 2008 stating:

We are unable to provide any further details about the negotiations between the two parties at this stage, and therefore understand that a further stay will not be granted. We look forward to hearing from you.

Down to that point in time it appears to have been forgotten that the deadline which had expired on 26 March 2008 was an inextendible deadline. However, the Registry reverted to the legislatively prescribed position in a letter sent to the Applicant on 22 April 2008. In that letter it was confirmed that in line with the provisions of Rule 68(3) there could be no extension of the period allowed under Rule 13A(1) in combination with Rule 13A(3) and that the Application would be deemed withdrawn under Rule 13A(1) on the basis that no Form TM8 and Counterstatement had been filed by the due date of 26 March 2008.

7. The Applicant contended that the letter sent to the Registry by fax on 25 March 2008 was sufficient in terms of its content to satisfy the basic administrative requirements of Rule 13A(1) and could, if necessary, be amended or supplemented so as to make good any deficiencies in the degree of detail required.

8. It was also contended that the Applicant should be allowed more time within which to make good any deficiencies on the basis that the deadline of 26 March 2008 would have been strictly adhered to if the Registry had immediately responded to the faxed letter of 25 March 2008 in terms to the effect that the deadline was not extendible. The suggestion was that by not immediately responding in terms to that effect the Registry had been guilty of an *'error, default or omission'* which ought to be redressed by re-setting the deadline in the exercise of the remedial power conferred upon the Registrar by Rule 68(7). In that connection the Applicant appears to have been maintaining that

nothing of any continuing effect had occurred when the parties were formally notified by the Registry in an official letter of 27 June 2007 that an inextendible deadline of 26 March 2008 had been set for the filing of any Form TM8 and Counterstatement that the Applicant might subsequently intend to file.

9. These contentions were rejected for the reasons given in a written decision issued under reference BL O-250-08 on 2 September 2008 by Ms. Judi Pike acting on behalf of the Registrar. She regarded the first main contention as unsustainable on the basis of the decision and reasoning in KML Invest AB's Trade Mark Application [2004] RPC 47, p.972. She regarded the second main contention as unsustainable on the basis that the failure on the part of the Applicant to comply with the requirements of Rule 13A(1) before expiry of the deadline of 26 March 2008 was not attributable to any act or omission on the part of the Registrar.

10. The Applicant gave notice of appeal to an Appointed Person under Section 76 of the Act. It repeated the contentions which the Hearing Officer had considered and rejected in the decision under appeal. At the conclusion of the hearing I allowed the Applicant a period of 14 days within which to consider whether it wished to proceed with an application to the Registrar for correction of a procedural irregularity under Rule 74 of the Trade Marks Rules 2008 upon the basis that the Notice and Grounds of Opposition filed on 15 March 2007 should have specified a ground of objection under Section 5 of the 1994 Act in order to be eligible for further processing in accordance with the provisions of the Act and the Rules. I stated that my decision on the appeal would in the meantime be deferred and I indicated that any application for deferral of the decision

beyond the 14 day period should be brought forward for consideration inter partes after the expiry of that period.

11. On 26 January 2009 the Applicant applied to the Registrar for correction of a procedural irregularity under Rule 74 along the lines referred to in paragraph 10 above. On 2 February 2009 it asked me to defer my decision on the present appeal pending the outcome of its application to the Registrar under Rule 74. On 13 February 2009 the Opponent confirmed that it did not object to the Applicant's request.

12. In the circumstances I consider that it is appropriate by analogy with the approach adopted by Warren J. in Rousselon Frères et Cie v. Horwood Homewares Ltd (No.2) [2008] EWHC 1660 (Ch); [2008] RPC 31, p.849 to defer my decision on the present appeal pending the outcome of the Applicant's Rule 74 request, with each of the parties and the Registrar being in the meantime permitted to apply for the appeal to be reactivated for determination by way of a decision on the merits. Pending such determination the question of how and by whom the costs of the appeal are to be borne and paid is reserved.

Geoffrey Hobbs Q.C.

31 March 2009

Mr. J. Stobbs of Messrs Boulton Wade Tennant appeared on behalf of the Applicant.

Mr. T. Byrne of Messrs Rouse & Co International attended the hearing as an observer on behalf of the Opponent.

The Registrar was not represented.