

# O-173-17

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NUMBERS 1,236,293

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF GEORGE SALTHOUSE (O/398/16) DATED 16<sup>th</sup> AUGUST 2016 AS AMENDED BY (O/483/16) DATED 17<sup>th</sup> OCTOBER 2016.

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## DECISION

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### Introduction

1. This is an appeal from the decision of Mr George Salthouse, for the Registrar, dated 16<sup>th</sup> August 2016 (which he corrected on 17<sup>th</sup> October 2016), in which he dismissed the opposition of Kevin Hickey in relation to the application of DO-IT s.r.o's for protection of its international trade mark number 1,236,293. The opposition was based on s 5(4)(b) of the Trade Marks Act 1994. Mr Hickey appeals.
2. The trade mark which is the subject of the application for protection is:



3. Protection for this mark was sought in Classes 7, 9 and 42. Mr Hickey's opposition was confined to only some of those goods and services in Classes 9 and 42, in particular:

Class 9: Apparatus and instruments included in this class, computer programs and apparatus for transferring digital data including pictures into the three-dimensional form, software for control of apparatus for making of three- dimensional models, photographic, cinematographic, optical apparatus and instruments, apparatus for measuring, apparatus for recording, transmission and reproduction of pictures, data processing apparatus, computers, software.

Class 42: Programming of multimedia applications and equipment, digitization of documents, creation of customized web pages, design of information databases, hosting of computer sites, media conversion into electronic form, construction drafting of three dimensional models by software, styling of industrial design by computer program, computer software consultancy, computer programming, computer hardware consultancy, maintenance of computer software, conversion of data from physical to electronic media, rental of equipment for making three-dimensional models and accessories, design and development of software for three-dimensional printing and accompanying three dimensional technology, creating and maintaining web sites, mechanical research, research and development of new products, especially of three-dimensional models.

## Approach to appeal

4. The principles applicable on appeal from the registrar were considered in *TT Education Ltd v Pie Corbett Consultancy* (O/17/17) by Daniel Alexander QC sitting as the Appointed Person. After reviewing the authorities (in particular: *REEF* [2002] EWCA Civ 763; *EI Du Pont De Nemours & Company v S.T. Dupont* [2003] EWCA Civ 1368; *BUD Trade Mark* [2002] EWCA Civ 1534; *Fine & Country Ltd v Okotoks Ltd* [2013] EWCA Civ 672; *Re: B (a child)* [2013] UKSC 33; and *Henderson v. Foxworth Investments* [2014] UKSC 41), he summarised the position at paragraph 52 (I made a few minor updates on this summary in *Grill'O Express* (O/140/17), paragraph 6, which I have incorporated in square brackets):

52. Drawing these threads together, so far as relevant for the present case, the principles can therefore be summarized as follows.

- (i) Appeals to the Appointed Person are limited to a review of the decision of Registrar (CPR [52.21]). The Appointed Person will overturn a decision of the Registrar if, but only if, it is wrong ([...][CPR 52.21]).
- (ii) The approach required depends on the nature of decision in question (*REEF*). There is spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision. At one end of the spectrum are decisions of primary fact reached after an evaluation of oral evidence where credibility is in issue and purely discretionary decisions. Further along the spectrum are multi-factorial decisions often dependent on inferences and an analysis of documentary material (*REEF, DuPont*).
- (iii) In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it (*Re: B and others*).
- (iv) In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF, BUD, Fine & Country and others*).
- (v) Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be "clearly" or "plainly" wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar's decision was wrong, should the appeal be allowed (*Re: B*).
- (vi) The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account. (*REEF, Henderson and others*).

Bearing in mind the repeated reminders that different points are likely to be particularly relevant in other cases, this is not intended to be a summary of universal application for other cases where particular aspects of the approach may require different emphasis

5. I will apply these principles.

### **Grounds of appeal**

6. The Respondent's international mark was published in the usual way in accordance with the Trade Marks (International Registration) Order 2008 (SI 2008/2206 as amended) ("the 2008 Order"). The Hearing Officer erroneously suggested in paragraph 2 of his Decision that it was published in accordance with the Trade Marks (International Registration) Order 1996; however, that Order was revoked and replaced by the 2008 Order. Nothing turns on this mistake.
7. The Appellant provided very detailed written submissions attached to his Notice to Appeal, which extended to 106 paragraphs. He presented further written submissions in response to the Respondent's Skeleton Argument, which extended to a further 116 paragraphs. These submissions were mostly a semantic unpicking of comments made by the Registry in correspondence and the Hearing Officer in his Decision, in particular in relation to the word "rights" (and the fact the word was used in the plural).
8. In the hearing before me, Mr Hickey essentially made three points: (a) that the Registry should have given him more assistance and allowed him to amend his case to add grounds of opposition under section 5(4)(a) and section 3(6) or that the Registrar should have done this of its own motion; (b) that section 5(4)(b) extends beyond the rights specifically mentioned in that provision and extends to a right to "use" the mark; and (c) that the Respondent's use of its international mark would infringe the copyright in his work. While Mr Hickey made many other minor points in his written submissions none of them appeared to take his case further and so as the crux of his case were these three points, I will consider them in turn.

### **Duty of the Registrar towards litigants in person**

9. There are, and have always been, many unrepresented persons who apply to register trade marks, oppose applications or otherwise act in relation to proceedings before the Registry. In recent years, the number of litigants in person appearing before the higher courts has increased substantially, which has led those courts to consider how to ensure fairness between the parties where one (or both) may have little or no idea of how the legal system works.
10. In *Tinkler v Elliot* [2012] EWCA Civ 1289, the Court of Appeal considered whether the judge below was right to have set aside a judgment following an application by a litigant in person. Maurice Kay LJ gave judgment on behalf of the Court where at paragraph 32 he stated:

I accept that there may be facts and circumstances in relation to a litigant in person which may go to an assessment of promptness but, in my judgment, they will only operate close to the margins. An opponent of a litigant in person is entitled to assume finality without expecting excessive indulgence to be extended to the litigant in person. It seems to me that, on any view, the fact that a litigant in person "did not really understand" or "did not appreciate" the procedural courses open to him for months does not entitle him to extra indulgence. Even if one factors in Mr Elliott's health problems, the evidence shows that between April and July 2010 he was active in this litigation. The fact that, if properly advised, he would or might have made a different

application then cannot avail him now. That would be to take sensitivity to the difficulties faced by a litigant in person too far. In my judgment, this is where Sharp J went wrong. She regarded this to be “a special case on its facts” but it could only be considered such if one goes too far in making allowances for a litigant in person. For these reasons, I do not consider that it was open to her to find the promptness requirement satisfied.

11. In *Denton v TH White* [2014] EWCA Civ 906, [2014] 1 WLR 3926, Lord Dyson MR and Vos LJ in a joint judgment make a related point at paragraph 40:

Litigation cannot be conducted efficiently and at proportionate cost without (a) fostering a culture of compliance with rules, practice directions and court orders, and (b) cooperation between the parties and their lawyers. This applies as much to litigation undertaken by litigants in person as it does to others....

12. Subsequently, in *Regina (Hysaj) v Secretary of State for the Home Department* [2014] EWCA Civ 1633, [2015] 1 WLR 2472, Moore-Bick LJ giving judgment for the court, in a section entitled “Litigants in person” at paragraphs 44 and 45 said:

44 At the time when the decisions which they now seek to challenge were made Mr Benisi and Mr Robinson were both acting in person. It is therefore convenient to consider whether the court should adopt a different approach in relation to litigants in person. The fact that a party is unrepresented is of no significance at the first stage of the inquiry when the court is assessing the seriousness and significance of the failure to comply with the rules. The more important question is whether it amounts to a good reason for the failure that has occurred. Whether there is a good reason for the failure will depend on the particular circumstances of the case, but I do not think that the court can or should accept that the mere fact of being unrepresented provides a good reason for not adhering to the rules. That was the view expressed by the majority in the *Denton case* [2014] 1 WLR 3926, para 40 and, with respect, I entirely agree with it. Litigation is inevitably a complex process and it is understandable that those who have no previous experience of it should have difficulty in finding and understanding the rules by which it is governed. The problems facing ordinary litigants are substantial and have been exacerbated by reductions in legal aid. None the less, if proceedings are not to become a free-for-all, the court must insist on litigants of all kinds following the rules. In my view, therefore, being a litigant in person with no previous experience of legal proceedings is not a good reason for failing to comply with the rules.

45 The CPR are available free online on the website of the Ministry of Justice and to that extent are widely available. What the ordinary person requires, however, is more help in discovering and understanding the rules and some basic guidance about the way in which proceedings should be conducted. If, as seems inevitable, the courts can expect to see an increasing number of litigants in person, assistance of that kind will become essential if the administration of justice is not to be undermined.

13. The Court of Appeal similarly made it clear in *Nata Lee Ltd v Abid* [2014] EWCA Civ 1652 (paragraph 53) and *Elliot v Stobart Group Limited* [2015] EWCA Civ 449 (paragraph 39) that the fact a party is a litigant in person is not of itself a reason for the disapplication of rules, orders and directions, or for the disapplication of that part of the overriding objective which now places great value on the requirement that they be obeyed by litigants. While it is true that the CPR has been amended since these decisions were handed down by the addition of CPR 3.1A, which deals with case management where one or more parties is unrepresented, this has not fundamentally changed the general tenor of the comments made by the Court of Appeal in those decisions.

14. The principles identified can be summarised into two stages. First, when giving directions or making an order, added time or guidance might be appropriate to address the additional difficulties that a litigant in person might face (this has been given statutory effect before the courts by CPR 3.1A); secondly, litigants in person have to play by the same rules as represented parties; accordingly, litigants in person do not get any special dispensations and, in particular, they are not excused from complying with rules, directions or orders. In other words, litigants in person should be given any assistance in advance of the matter and not dispensation afterwards.
15. The situation identified before the court applies equally (if not with more force) in *inter partes* disputes before the Registry (in *ex parte* proceedings different considerations may apply). The Registrar should not allow litigants in person to play by different rules from represented parties. Furthermore, in such proceedings, the Registrar must not descend into the arena so as to help any party make its case.
16. In this case, it was for Mr Hickey to identify the grounds of opposition he wanted to run. He was advised in a letter from the Registry dated 23 March 2016 that if he wanted to add sections 5(4)(a) and 3(6) to his opposition he should file a Form TM7G and pay the relevant fee £100. It was also made clear that merely mentioning it in his evidence was not sufficient. In a subsequent letter sent to Mr Hickey dated 12 April 2016 he was told that, as he had not filed Form TM7G, his request to amend could not be considered and so the case would proceed under section 5(4)(b) only. As I have indicated, litigants in person have to follow the rules. Mr Hickey was expressly told what he had to do, but he did not take the necessary steps. The Registry's conduct was exemplary in this regard.
17. Mr Hickey's suggestion that the Registrar should have considered section 5(4)(a) and section 3(6) of its own motion is also problematic. In relation to domestic marks, there is a system under section 38(3) whereby a person may make observations in writing as to whether the mark should be registered. A person making observations (in contrast to an opponent) does not become a party to proceedings. The Registrar may, by reason of those observations or on the basis of other matters coming to his notice, refuse the application in accordance with section 40(1), which reads:
  - (1) Where an application has been accepted and—
    - (a) no notice of opposition is given within the period referred to in section 38(2), or
    - (b) all opposition proceedings are withdrawn or decided in favour of the applicant,the registrar shall register the trade mark, unless it appears to him having regard to matters coming to his notice since the application was accepted that the registration requirements (other than those mentioned in section 5(1), (2) or (3)) were not met at that time.
18. The situation is more problematic in relation to international marks. The 2008 Order provides in article 3 that the Trade Marks Act 1994 applies to international trade marks with some modifications. One of those modifications is that section 40 does not apply to international marks (see article 3(3) and Schedule 1, Part 1). Accordingly, observations can still be made under section 38(3) (as applied by the 2008 Order), but it is not clear from the face of the Order what happens to those observations.

19. The closest parallel to section 40 in the 2008 Order is the modification which inserts sections 38A and 38B (see Schedule 2, paragraph 6). Subsections (1) and (2) of section 38B states:
- (1) Where no notice of provisional refusal is given to the International Bureau following publication under section 38(1), the international registration which is the subject of the request for extension shall be protected as a protected international trade mark (UK) with effect from the first day immediately following the end of the period prescribed for the purposes of section 38(2).
  - (2) Where notice of provisional refusal is given following publication under section 38(1), the international registration which is the subject of the request for extension shall be protected as a protected international trade mark (UK) with effect from the date on which the registrar notifies the International Bureau that the final decision is that the provisional refusal should not be upheld in accordance with section 38A(4).
20. It appears that section 38B(1) stands in place of section 40(1)(a) and section 38B(2) in place of section 40(1)(b). However, section 38B does not expressly include the words in section 40(1): “unless it appears to him having regard to matters coming to his notice since the application was accepted that the registration requirements (other than those mentioned in section 5(1), (2) or (3)) were not met at that time”. For the reasons given below, I do not have to decide the matter and so I will not venture an opinion as to whether the Registrar can refuse to protect a mark based on observations submitted in relation to an international mark.
21. Returning to domestic marks for a moment, observations by Mr Hickey in relation to section 3(6) (but not section 5(4)(a)) could have been considered by the Registrar under section 38(3) and the mark refused registration under section 40(1). It was not argued before me whether a person can make observations and also oppose the application at the same time. Once more I do not intend to give an opinion on this matter.
22. What is clear is that a person who makes observations is not a party to the opposition. The Decision of the Hearing Officer relates to Mr Hickey’s Opposition and this appeal is from that decision. Accordingly, even if Mr Hickey’s comments on section 3(6) were treated as observations under section 38(3) (as applied by the 2008 Order), it would not have fallen to the Hearing Officer to consider those observations as they were not part of the opposition.
23. In summary, I find that the Hearing Officer was right to conclude that the opposition was confined to section 5(4)(b). It is also clear that neither the Registry nor Hearing Officer were obliged to do more than they did to assist Mr Hickey in selecting the right grounds upon which to base his opposition.
24. As I have said, the issue as to whether the Registrar can refuse protection on the basis of the additional observations by Mr Hickey under section 3(6) is currently not ripe. What is clear, however, is that if his observations are rejected by the Registrar, Mr Hickey would not be able to appeal the decision under section 76 as the observations were not part of any proceedings to which he was party.

**‘Use’ as a right under section 5(4)(b)**

25. As Mr Hickey made a point about the drafting of section 5(4) it is worth setting it out:

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

26. Mr Hickey accepted that, as his opposition did not cover section 5(4)(a), he could not argue that the Respondent's use of its mark would amount to passing off (although, as explained below, he had a different understanding of what passing off required). He submitted that section 5(4)(b) was not confined to objections based on the "the law of copyright, design right or registered designs" but extended to other rights by reason of the words "in particular". I accept his submission in this regard. However, as I emphasised in the hearing itself, the "earlier right" referred to must be a legally recognisable right.

27. Mr Hickey argued that "use" of a mark was such an earlier right. He provided no authority for this proposition and the basis of his submission was his comparison with what he said was required to establish passing off under section 5(4)(a). In a nutshell, Mr Hickey argued that passing off required deception and knowledge; and therefore where this was not present there must "logically" be protection for the use itself.

28. The difficulty with this submission, as I pointed out to Mr Hickey at the hearing, is that passing off does not require knowledge or deception. As the law in this area is so well established, I can do no better than refer to Professor Wadlow's summary of position in his text: *The Law of Passing-Off: Unfair Competition by Misrepresentation* (5<sup>th</sup> Ed, 2016) at paragraph 5-51 (footnote omitted):

*...The defendant's state of mind is wholly irrelevant to the existence of the cause of action for passing off. Neither fraud, recklessness, negligence nor knowledge of the existence of the claimant's business are necessary...*

29. Mr Hickey is precluded from arguing passing off as he accepts and he presented no legal basis for arguing that he has a *legal* right based on use alone. Accordingly, I reject his submissions in this regard.

#### **'Copyright work'**

30. Mr Hickey's second argument under section 5(4)(b) was that the use of the mark seeking protection would be an infringement of his copyright. Mr Hickey's opposition was based on two claimed works. One was a work which involved the word "bE" (lower case b and upper case E) rotating so when it rotated 180° it looked like 3d (so as to be bE3d). It is not clear if he is claiming in its rotating form or as a series of frames. He also showed an image of a Lancaster Bomber where "be3d" was used on the screenshot. These images were Annex 1 to the Decision and so I will not reproduce them again. The second work, he claimed, were the characters "be3d" simpliciter.

31. To establish copyright infringement, it is necessary to establish that there is an original work, the author or work is qualified for protection, the claimant has title, and that the work (or a substantial part of it) has been copied by the defendant (and that the defendant has no copyright exception upon which they can rely). Importantly, where the defendant has independently created the work there can be no infringement.
32. The European Court of Justice has said that a single word cannot be a literary work (see *C-5/08 Infopaq* [2009] ECR I-6569 at paragraph 45). In *Exxon Corporation v Exxon Insurance Consultants* [1982] Ch 119, it was accepted that the invented word “Exxon” could not be a copyright work even if it had the requisite originality; and later, in *R Griggs Group v Evans* [2003] EWHC 2914 (Ch), [2004] FSR 31; [2005] EWCA Civ 11, [2005] FSR 31, a similar finding was made in relation to the words “Dr Martens” (also see *Navitaire v EasyJet* [2004] EWHC 1725, at paragraph 80).
33. It is true that since these cases were decided it has been held that newspaper headlines can be literary works (see *Newspaper Licensing Agency v Meltwater Holding* [2010] EWHC 3099 (Ch), upheld on appeal [2011] EWCA Civ 890) and that some of the most memorable and striking headlines have been only one or two words (the notorious “Gotcha!” headline in the *The Sun* following the sinking of the Belgrano in the Falklands War being a well-known example). Nevertheless, even if a single word can be protected in theory, I doubt it can in practice. In this regard, I can do no better than adopt what Graham J said in *Exxon Corporation v Exxon Insurance* [1981] 1 WLR 624 at 634-5:
- Nothing I have said above is intended to suggest that I consider that a word which is used as a title can, as a matter of law, never in any circumstances be the subject of copyright, and I would disagree with dicta in previous cases to the contrary effect. Such a word would, however, I think, have to have qualities or characteristics in itself, if such a thing is possible, which would justify its recognition as an original literary work rather than merely as an invented word. It may well turn out not to be possible in practice, but, as at present advised, I consider that the mere fact that a single word is invented and that research or labour was involved in its invention does not in itself, in my judgment, necessarily enable it to qualify as an original literary work within section 2 of the Act
34. Accordingly, I find that the characters be3d (whatever variations there may be in the case of letters) is not a copyright work. If, contrary to this finding, it is a work, Mr Hickey would be its author and so the copyright owner.
35. The Hearing Officer appears to have treated Mr Hickey as claiming b3 -3d in a series of frames. The Hearing Officer accepted in principle that the word “bE” in various stylised 3D forms could be original artistic works (Decision, 20 and 21). As a moving image, it would also be protected by copyright in other ways, in particular it would be protected as a “film” within the meaning of section 5B of the Copyright, Designs and Patents Act 1988 (the 1988 Act) (and so originality is not required: see the 1988 Act, s 1(1)(b)). Mr Hickey claims he created the film and, as this was not disputed, I will assume that Mr Hickey is the director, producer and owner of the copyright in the film of the rotating form (and also the author of any stills).



36. The Hearing Officer spent five pages of his Decision on the qualification rules for copyright protection. As Mr Hickey is the author of the work and he is British, this could have been dealt with very briefly as he clearly qualifies under section 154 of the 1988 Act. Unfortunately, the Hearing Officer made a number of mistakes in his reasoning. He set out sections 153 to 155 of the 1988 Act but the version he used was very out of date (it referred to cable programmes for example, which ceased to exist as a separate type of work following the coming into force of the Copyright and Related Rights Regulations 2003 (SI 2003/2498)).
37. The Hearing Officer then went on to make reference to the Copyright (Application to Other Countries) Order 1999 (SI 1999/1751) and set out article 2 of that Order. This Order was revoked in 2005 with the approach of the Order substantially changing (see Copyright and Performances (Application to Other Countries) Order 2005 (SI 2005/852)). Indeed, that 2005 Order and its successors have been revoked and new orders replaced them numerous times since. The relevant order when the Hearing Officer gave his decision was the Copyright and Performances (Application to Other Countries) Order 2013. Indeed, that 2013 Order is being revoked and replaced later this week when section 22 of the Intellectual Property Act 2014 comes into force (it is being replaced by the Copyright and Performances (Application to Other Countries) Order 2016 (SI 2016/1219)). However, none of these Orders matters as Mr Hickey is British and so qualifies under section 154 of the Act without reliance on any of the Orders mentioned above.
38. Another problem with Mr Hickey's case was that he had no evidence that the Respondent had access to his work before the date of filing of the original application in the Czech Republic (2<sup>nd</sup> July 2013) because any copying would have to have taken place before the original application was filed. Unfortunately, this point was not considered by the Hearing Officer who went straight from considering qualification to looking at whether a substantial part of the work was taken. This omission was clearly a material error on the part of the Hearing Officer.
39. During the Hearing before me, I suggested to Mr Hickey that he had to prove access to establish copying. He answered:
- I cannot prove that at all. I cannot prove that at all. It is certainly inferred by some of the submissions which have come in.
40. I later asked him to direct me to any evidence from which an inference could be drawn that the Respondent had had access to his work. Mr Hickey eventually submitted that he relied on the fact that the element of the Respondent's mark "Be3d" was so similar to his copyright work that it must have been copied.
41. Mr Hickey's film work (the rotating bE-3d) is radically different from the symbol and words which the Respondent is seeking to protect. Even if one considers the stills as individual artistic works, the difference between the stylised word bE in 3D and the Respondent's mark is so great that it is difficult to see any significant similarity at all. Indeed, all that they have in common are the underlying characters themselves.

42. I have already found that the four characters be3d are not a copyright work, but even if they were such a work I do not believe that Mr Hickey has proved they have been copied by the Respondent. The selection of the same four characters (“be3d”) is not enough to prove copying as these could easily have been independently thought up and created – particularly where the font and case of the letters adopted differs between the Respondent and Mr Hickey.
43. As there was no copying, there is no need to consider whether or not a substantial part of the work has been copied (as none of it was copied).
44. Mr Hickey’s ground of opposition under section 5(4)(b) therefore fails. Accordingly, I dismiss Mr Hickey’s appeal in its entirety.
45. The Respondent wished to reserve its position as to costs. Any application for off-scale costs should be made by the Respondent within fourteen days of the date of this decision. If such an application is not made, Mr Hickey will be ordered to make a contribution to the Respondent’s costs of £1,000.

PHILLIP JOHNSON

THE APPOINTED PERSON

4<sup>th</sup> April 2017