

BEFORE:

MR GEOFFREY HOBBS QC

IN THE MATTER OF THE TRADE MARKS ACT 1994

AND

**IN THE MATTER OF APPLICATION NO 2015594
FOR THE REGISTRATION OF THE
MARK RASTAPLAST IN CLASS 5 IN THE NAME OF
GARETH JONES AND MARK WRIGHT**

**APPEAL OF APPELLANTS FROM THE DECISION OF
MR D C MORGAN DATED 14 NOVEMBER 1997**

THE APPELLANTS did not attend and were not represented

MR I BUCHAN appeared on behalf of the Respondent

**D E C I S I O N
(as approved)**

Mr Hobbs: On 28th March 1995 Gareth Jones and Mark Wright applied to register the word RASTAPLAST for use as a trade mark in relation to medical and surgical plasters, bandages, surgical dressings, all in Class 5.

5 In due course notice of opposition was filed on behalf of T J Smith & Nephew Limited. The notice of opposition raised various grounds of objection to registration under Section 3 of the Act and under Section 5 of the Act. A counterstatement was filed by Marks & Clerk as agents of record on behalf of the applicants for registration. In the counterstatement it was admitted that the opponent was the proprietor of the various trade mark registrations it had put forward
10 as earlier trade mark rights in support of its opposition under Section 5.

The opponent filed evidence in support of the opposition in the form of a statutory declaration of Mr Philip Gilholm dated 25th October 1996. I have taken the opportunity to look at that statutory declaration and the exhibits relating to it. No evidence was filed on behalf of the
15 applicants.

Matters proceeded to a hearing on 23rd October 1997. The hearing was taken by Mr Morgan, acting as Hearing Officer for the Registrar of Trade Marks. The opponent was represented by Mr Buchan of Eric Potter Clarkson. The applicants did not attend. I am told that there was a
20 short adjournment to allow for the possibility of late arrival, but in the event the hearing went ahead in their absence.

On 14th November 1997 the Hearing Officer issued a written decision upholding objections to registration under Section 3(6) and Section 5(2)(b) of the Act. The other grounds of
25 objection which had been raised in the notice of opposition and the statement in support of it had either been ruled out or withdrawn during the course of the proceedings. The applicants were ordered to pay £735 towards the opponent's costs of the opposition proceedings.

In a letter of the 10th December 1997 which was received in the Registry on
30 12th December 1997, the applicants indicated that they proposed to appeal against the Hearing Officer's decision. The letter of 10th December 1997 was in the following terms:

“We are writing to appeal against the Registrars decision on the 14th November 1997 with regard to our application to register Rastaplast as a trademark. It is both untrue and unfair to state that our application was made in bad faith. Smith and Nephew have provided no evidence whatsoever to prove this. The reason that we did not supply
5 evidence at your hearing was twofold. Firstly because we believed that Smith and Nephew’s opposition had no grounds and secondly that Marks and Clerk told us that even if we won Smith and Nephew could and would continue to appeal. We simply cannot afford this.

10 It is our opinion that Smith and Nephew have committed the act of bad faith. They are a large company with huge resources - indeed they have a department set up to oppose trademark applications. Their sole intention is to restrain other trade. We however are small businessmen with limited resources who cannot afford to fight such a company either financially or with our time as we have to earn a living.

15 We submit that it [is] irrelevant what type of work we currently do as we had an idea, which we acted upon in good faith. We engaged Marks & Clerk to check to see what trade marks were in existence and to ensure that Rastaplast would be acceptable.

20 Marks & Clerk produced evidence of trademarks already in existence and we enclose a copy of their report with this appeal.

25 By conducting a survey Smith & Nephew prove our point about resources but their findings are meaningless. To state that 25% of the public would expect Smith & Nephew to produce Rastaplast proves our point that their opposition to our application is an act of bad faith as they are only intent on ensuring that we cannot proceed. No doubt so that they can.

30 Indeed, Astroplast is already in existence as a trademark although significantly it is not owned by Smith & Nephew.

By awarding them costs you add insult to injury. Smith & Nephew make millions in profits. Surely if they wish to oppose people like ourselves to stop potentially goods ideas from entering the market place then they should at least pay for it themselves. You have effectively fined us for coming up with a good idea. In summary we state
5 once again that we made our application in good faith and we appeal to your sense of fairness that a large company should not be allowed to restrain trade and if they wish to oppose small businessmen then they should be made to pay their own costs.”

10 It seems that in large measure the appeal was prompted by the award of costs which the Hearing Officer had made in favour of the appellants. It certainly appears from a number of passages in this letter that the question of costs weighted heavily upon the minds of the applicants.

15 Subsequently, under cover of a letter received in the Registry on 14th January 1998, the applicants purported to supplement the grounds of appeal which had been intimated in their letter of 10th December 1997. The letter of 8th January 1998 enclosed a formal document headed “Grounds of appeal and case in support of the appeal”. The text of the enclosure is as follows:

20 “The applicant appeals against the decision referred to above on the following grounds:-

1. The trade mark RASTAPLAST falls within the definition contained in
25 Section 1(1) of the Trade Marks Act 1994 and is not devoid of any distinctive character in terms of Section 3(1)(b) of the Act in relation to the goods and services for which application has been made. Refusal of the application under Section 3(1)(b) is accordingly inappropriate.
2. The trade mark RASTAPLAST does not consist exclusively of a sign
30 that may serve in trade to designate the kind or quality of the goods and/or services applied for. Accordingly its registration is not

precluded by Section 3(1)(c) of the Act and refusal on those grounds is inappropriate.

- 5 3. That insufficient weight has been given to the entry of voluntary separate disclaimers in terms of Section 13(1)(a) of the Trade Marks Act 1994 in reaching a decision of registrability as aforesaid.
- 10 4. That the proviso to Section 3 of the Trade Marks Act 1994 applies in that the trade mark RASTAPLAST was used by the applicant prior to the date of application and insufficient regard has been given to the fact that it had acquired a distinctive character as a result of such use as shown in the informal evidence presented at the hearing.
- 15 5. The combination of the word RASTA with the word PLAST creates an unusual and novel combination RASTAPLAST. It is submitted that this is not a term which other trades, without improper motive, should need to use or indeed have used previously.

20 The applicants submit that the ordinary man in the street will recognise the connotation of the mark as separate from any existing trademarks.

- 25 6. It is respectfully submitted that the Hearing Officer's references to RASTAPLAST and ELASTOPLAST involves an artificial construction of those phrases so as to create an objection which simple cannot be justified.

30 The applicant has, by the entry of voluntary separate disclaimers, made it clear that it does not speak to monopolise the word RASTA per se or, indeed, the word PLAST but merely the fanciful and distinctive combination.

5 7. The Hearing Officer refers to the comments of Mr Justice Jacob in the ‘TREAT’ case (1996 RPC 261) and suggests that the mark is the sort of sign ‘which cannot do the job of distinguishing without first educating the public that it is a trade mark’. It is submitted that, on the contrary, the mark is manifestly distinctive and that because of its fanciful connotation it is prima facie in the category of a sign which will serve at first sight to announce to the public that it is a brand name or badge or origin.

10 8. Alternatively, it is submitted that the Hearing Officer is entitled to look at the use by the applicant of the mark RASTAPLAST in the copy of the extract from the brochure lodged with him at the Hearing and to hold that it had acquired distinctiveness by virtue of such use as at the date of the application. Gareth Jones & Mark Wright. Agent for
15 Applicant.”

The above “Grounds of Appeal and Case in support of the Appeal” bore no real relationship to the decision under appeal and bore no real relationship to the matters raised in the letter of 10th December 1997 which had been submitted to the Registrar by way of appeal. So far as I
20 can tell, basing myself on the documentary materials which are before me, the applicants’ “Grounds of Appeal and Case in support of the Appeal” had been modelled blindly upon a sample of such a document which the Registry had forwarded to the applicants under cover of a letter of 19th December 1997. In that letter of 19th December 1997 the Registry had invited the applicants to “formalise their submissions” and a sample statement of appeal had been
25 enclosed with the letter for their assistance in that connection.

In February 1998 the papers were forwarded to me by the Treasury Solicitor’s Department in connection with the proposed hearing of the appeal. Subsequently, in April 1998, I was informed by letter from the Treasury Solicitor that notice had been given to the parties
30 informing them that the hearing was fixed for today’s date to take place at 10.30 this morning.

Subsequently, in a letter of 16th June 1998 from the Treasury Solicitor's Department, I was advised that no response had been received from the applicants and that the Treasury Solicitor's Department had therefore sent them a reminder of the hearing.

5 On 19th June 1998 the applicants sent a letter by fax to the Treasury Solicitor's Department. That letter was in the following terms:

“I have just received your letter dated 16th June 1998 regarding a meeting in London at 10.30am on Monday, 22nd June 1998.

10 Unfortunately I did not receive your previous letter dated 15th May 1998.

As I explained previously my work takes me abroad a lot and I have just returned from Cyprus and shall be going to Tenerife very early on the morning of Tuesday 23rd June 15 1998 which makes it impossible for me to make this meeting.

Would you please ensure that Mr G Hobbs QC who is sitting as the Appointed Person looks at this in my absence, to ensure that a level of fairness is attained as it cannot be right that we can be made to pay the costs of a large company like Smith & Nephew 20 with its huge resources.”

The letter was signed by Mr R G Jones.

It can be seen from the last paragraph of that letter that the writer was effectively requesting 25 that matters should proceed in the absence of the applicants at today's hearing. In fact as a precaution the Treasury Solicitor contacted Messrs Eric Potter Clarkson, the agents for the opponent, and enquired whether they would be willing to agree to an adjournment of today's hearing. Messrs Eric Potter Clarkson indicated that they were not agreeable to the suggestion of an adjournment. Therefore on 19th June 1998, in a letter sent by fax by way of reply to the 30 letter which had been received from Mr Jones, the Treasury Solicitor wrote to the applicants in the following terms:-

“Thank you for your letter of the 19th June 1998 copies of which have been passed to the Appointed Person, Messrs Eric Potter Clarkson and the Registrar of Trade Marks.

5 Messrs Eric Potter Clarkson inform me that they are not prepared to agree to the hearing on the 22nd June 1998 being adjourned. The hearing will therefore proceed before the Appointed Person on that date.

10 I note that you are not due to leave the country until the following day and in these circumstances you may well feel that it would be in your interests to attend the hearing.”

So far as I am aware no response has been received to this last letter and the hearing before me has commenced this morning in the absence of the applicants for registration.

15 I do not pause to consider whether it is strictly necessary for me to consider the merits of the appeal because I am able to say that I have reviewed the decision of the Hearing Officer, I have considered the evidence filed by the opponent in support of its opposition and upon which the decision as based and I am completely satisfied, on the basis of the materials I have seen, that the decision of the Registrar’s Hearing Officer was correct, both in relation to the
20 objection under Section 3(6) and the objection under Section 5(2)(b).

In the circumstances the appeal will stand dismissed and it will stand dismissed with costs.

25 I will not hear submissions from the agents for the opponent as to the quantum of costs that this should entail.

Mr Buchan: I would just like to point out that the original costs ordered to my clients were in line with the Registrar’s practice. That practice is published and was sent to the applicants on at least two occasions as a tariff, if you will.

30 Mr clients obviously take this matter very seriously. As far as this appeal is concerned we did

not know until 4.30 on Friday night that the appellants were not going to be represented. We, as you will have seen from the filed, had to go back to the Registry to get the materials that were never sent to us when they were copied to the Treasury Solicitor. We have had to research the procedure on appeals and deficient appeals. I have not had the opportunity to address you, but believe you me I have research it. We have prepared and filed further evidence in case it was of any assistance to you. We have prepared for and attended the hearing. I have come up prepared to take a full hearing. Up until Friday night I had no option and I had to view it as essentially a rehearing of the previous hearing. I think the appellants have been well warned of the consequences of their carrying on. They are incurring costs for my clients and I do not see why my clients should have to bear those costs.

Mr Hobbs: I understand. The position on appeals involving opposition has been that the Appointed Person has been invited to make an award of costs by reference to the scale which applied in Registry proceedings. Is that something that you would support.

Mr Buchan: Yes.

Mr Hobbs: In looking at it in the round, for the hearing below you will have had to prepare evidence or the clients on you side will have had to prepare evidence.

Mr Buchan: The clients, yes. That is correct.

Mr Hobbs: You will have had a hearing which I think will have lasted somewhat longer than the hearing which has lasted this morning.

Mr Buchan: Indeed, yes.

Mr Hobbs: An you will have had preparations for that. I think I picked up from the file that you did a substantial amount of research for that hearing as well.

Mr Buchan: I did indeed, yes.

Mr Hobbs: The Hearing Officer awarded you £735.

Mr Buchan: Yes.

5 Mr Hobbs: My perception at the moment is that the costs of coming here are perhaps somewhat less but not significantly less than the kind of costs that will have been incurred in relation to the hearing below. Would you like to comment on that?

10 Mr Buchan: Certainly we did prepare the main evidence so we did prepare additional evidence. I obviously six months ago for the hearing and out of courtesy for my clients and professional requirements I have gone through all the original arguments I had prepared and, as I say, I had to spend quite a lot of time looking at these deficient appeals because, I have to be honest, I could not find any authorities to guide me as to how the courts or yourself would treat them. I was told to prepare to argue my way through the whole thing.

15

Mr Hobbs: Yes. I can see.

Mr Buchan: I think in reality I spent as much time on this this time around as I did previously.

20 Mr Hobbs: Is there anything more you would like to say on the question of costs?

Mr Buchan: No. Thank you.

25 Mr Hobbs: I take the view that the preparation for the hearing which has taken place before me this morning will have been somewhat less extensive than the preparation required for the hearing below, but I do not think it will have been substantially less extensive. My impression is that a fair and proportionate order for costs in relation to the hearing before me would be to direct that the applicants pay the sum of £650 to the opponent as a contribution towards its costs of the appeal. Of course it goes without saying that that sum is additional to the sum
30 which has already been awarded in respect of the hearing before the Registrar's Hearing Officer.

Mr Buchan: Thank your, Sir.

Mr Hobbs: Thank you.