

TRADE MARKS ACT 1994

IN THE MATTER OF OPPOSITION No. 47103

IN THE NAME OF LES BRASSEURS DE GAYANT

TO APPLICATION No. 2115233

TO REGISTER A TRADE MARK IN CLASS 32

IN THE NAME OF JACK MOORE

D E C I S I O N

The Application

On 9th November 1996 Jack Moore (“the Applicant”) applied to register the words DEMON ALE for use as a trade mark in relation to “beer, mineral waters” in Class 32. During the course of examination the specification of goods was restricted by amendment to “beer”. The application was advertised for opposition purposes on 26th March 1997.

The Notice of Opposition

On 25th June 1997 Les Brasseurs de Gayant (“the Opponent”) filed notice of opposition to the application. The Opponent was required by Rule 13(1) of the Trade Mark Rules 1994 to “*include a statement of the grounds of opposition*” with its notice of opposition. The Opponent’s grounds of opposition were stated in the following terms (with references to sections of the Trade Marks Act 1994 emphasised by me):

1. Les Brasseurs de Gayant (the “Opponent”) is inter alia, a manufacturer and merchant of alcoholic beverages including but not limited to beer.
2. The Opponent is the proprietor of the Trade Mark BIÈRE DU DEMON in the United Kingdom and elsewhere which it has used in the United Kingdom since prior to 1988 in connection with beer. It has registered that trade mark in numerous countries.
3. Application No. 2115233 (the “Application”) should be refused registration under *Section 3(3)(b)* of the Trade Marks Act 1994 because the trade mark is of such a nature as to deceive the public into believing that the Applicant’s trade mark is in some way associated or connected with the Opponent and its trade mark.
4. The Application should be refused registration under *Section 3(4)* in that use of the trade mark identified in the Application would amount to passing off.
5. The Application should be refused registration under *Section 3(6)*. The Applicant is not the proprietor of the trade mark. Further, the Application has been made in bad faith, the Applicant having been aware of the Opponent’s trade mark and of the Opponent’s use of the trade mark in connection with beer prior to filing the application.
6. The Application should be refused registration under *Section 5(1)*. The trade mark DEMON ALE is the English translation of the Opponent’s trade [mark] BIÈRE DU DEMON. The Opponent’s trade mark is, and was, at the date of application entitled to protection under the Paris Convention as a well-known trade mark in respect of beer.

7. The Application should be refused registration under *Section 5(2)*. The Applicant's trade mark is identical or similar to the Opponent's earlier trade mark and is to be registered for goods identical with those for which the earlier trade mark is protected and there exists a likelihood of confusion on the part of the public, which includes a likelihood of association with the Opponent's earlier trade mark.

8. The Application should be refused registration under *Section 5(3)*. The Applicant's trade mark is identical with or similar to the Opponent's earlier used trade mark. The Opponent's earlier used trade mark has a reputation in the United Kingdom and use of the Applicant's trade mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent's earlier trade mark.

9. The Application should be refused registration under *Section 5(4)*. The Opponent has made substantial use of the trade mark and in so doing has accrued significant goodwill and reputation. The Application thereby offends against the provisions of *Section 5(4)*.

10. The Application should be refused registration by virtue of *Section 56*. The Opponent's trade mark is entitled to protection under the Paris Convention as a well-known trade mark.

11. The nature of the Application is such that the Registrar should in his discretion refuse registration.

12. The Opponent requests an award of costs in its favour and such other orders as the Registrar may grant in favour of the Opponent.

These grounds of opposition conformed to a familiar pattern. That pattern was described in the following terms by Mr. Knight, Principal Hearing Officer and Head of Law Section at the Trade Marks Registry, in a paper entitled **Trade Marks Act 1994 – Inter Partes Issues** [<http://www.itma.org.uk/pr19981021.htm>] which he delivered to the Institute of Trade Mark Attorneys on 20th October 1998:

“It is a common practice in inter-partes proceedings before the Trade Marks Registry for the “kitchen sink” to be pleaded. The pleadings seem to attempt to encompass any possible grounds of opposition, invalidation etc, in terms of absolute and relative grounds. However, as evidence is filed, in the vast majority of cases, it becomes clear that there is no justification for the breadth of the pleadings. This is confirmed subsequently at Main Hearings where the parties will only argue in relation to a very limited number of the pleadings. The explanation given by those involved is that their clients are often not very decisive or do not understand the need for focused pleadings. Therefore, Trade Mark Attorneys will often use “kitchen sink” pleadings in order to cover themselves for any eventuality – especially the advice of Counsel, who usually enter the affray at a late stage.”

The Counterstatement

The Applicant’s counterstatement under Rule 13(2) was filed on 29th September 1997. It was prepared by a friend of his, Mr. Malcolm Weaving, who I understand to be an hotelier with no knowledge or experience of trade mark law or practice. The counterstatement contained the following response to the grounds of opposition:

“WHEN THE PATENT WAS APPLIED FOR:-

1. No registration found.
2. The French name registered 9 months after registration by Jack Moore.
3. `Biere Du Demon' beer of the demon. Nothing has been passed off as Bier due Demon. There was never any intention.
4. *Jack Moore was thinking of a mineral water not a beer – as in `Ginger Ale' or `Ginger Beer'.*

STATEMENT OF GROUNDS

- Para. 3 *Is the public going to be confused between a beer and a lemonade?*
- Para. 5 How can the application be made in bad faith when Jack Moore had never heard of `Bier Du Demon', nor has anybody we know heard of it. Not even Scottish and Newcastle plc. **Secondly Jack Moore is an antique dealer - not a brewer.**
- Para. 6 Beer is an alcoholic drink made from malt and hops – *Demon Ale is an anagram of lemonade.*
- Para. 7 What was the earlier French trademark mentioned – if it was Demon Ale was it registered?

Para. 8 Do the French class `Demon Ale' as identical or similar. Can you please clarify which as there is an obvious difference.

Finally, what are these extensive costs that Jack Moore has been threatened with. [There then followed a comment on a telephone conversation].

The passages I have italicised relate to the particular objection upon which the opposition proceedings ultimately came to be determined. The state of the pleadings after the counterstatement had been filed accorded with the further observation in Mr. Knight's paper to the Institute of Trade Mark Attorneys that:

“Once a statement of grounds in proceedings is filed on an over broad basis it is almost inevitable that the pleadings in the counterstatement will respond in like manner and so the proceedings will immediately fall into the quagmire of the ill-defined and over-generalised.”

The Evidence

In December 1997 the Opponent filed evidence in support of its opposition. The evidence consisted of a Statutory Declaration of David John Rickard. Extensions of time for the filing of further evidence were sought and obtained on behalf of the Opponent. Eventually the Opponent's trade mark attorneys wrote to the Trade Marks Registry on 1st October 1998 confirming that the Opponent did not intend to file any further evidence at that time. The Applicant was then notified in a letter from the Trade Marks Registry dated 6th

October 1998 that the time for filing his evidence in answer under Rule 13 of the 1994 Rules would expire (in the absence of any extension) on 1st January 1999. Mr. Weaving responded in a letter on behalf of the Applicant dated 8th October 1999 stating that considered the correspondence and papers he had filed to be sufficient and did not wish to file “any more evidence”. The Applicant and Mr. Weaving appear to have been unaware that the correspondence and papers on file were not evidence of the kind envisaged by the official letter from the Registry dated 6th October 1998.

The formal evidence in the opposition proceedings therefore consisted of a single statutory declaration in which Mr. Rickard declared as follows:

1. I am a solicitor of the Supreme Court of England and Wales, a Registered Trade Mark Agent and a Representative before OHIM. I have the day to day conduct of UK opposition No. 47103 on behalf of Les Brasseurs de Gayant (the “Opponent”) to trade mark application No. 2115233 in the name of Jack Moore. I make this Declaration on behalf of the Opponent. The statements contained in this Declaration are within my own knowledge.

2. On 1 July 1997, I spoke with Mr. Jack Moore after he telephoned me. He stated that:
 - (a) he had filed application 2115233 in order to stop manufacturers of alcopops using the trade mark DEMON ALE;
 - (b) the trade mark DEMON ALE is an anagram of “lemonade” and he was concerned to stop manufacturers

of alcopops using it. He stated that he was “dead against” manufacturers of alcopops;

(c) he is an antique dealer and has nothing to do with brewing;

(d) he did not at any stage intend to use the trade mark DEMON ALE in connection with beer; and

(e) he was thinking of withdrawing the application.

In response I informed Mr. Moore that if he did so, I would be entitled to ask for my costs of about £300 but that if he told me that he would withdraw it if my client would pay its own costs then I would seek instructions as to whether my client would accept such an arrangement.

3. After considering the matter further and discussing the situation with the Opponents’ French Trade Mark Attorney and having regard to the Opponents long use of the trade mark BIERE DU DEMON in Europe including the UK I telephoned Mr. Moore on 2 July 1997. I asked him whether he would be willing to assign the trade mark DEMON ALE together with application 2115233. Mr. Moore responded that he would assign the trade mark and application 2115233 for the sum of £250.00 on the basis that the Opponent bore its own costs of the opposition and the costs of the assignment. I informed Mr. Moore that I would take instructions.

4. I subsequently received instructions and wrote to Mr. Moore on 16 July 1997. I informed Mr. Moore that the

Opponent had accepted his offer and accepted sale of the application for the sum of £250 with the Opponents agreement on costs. I included a short form written Agreement with that letter. Now shown to me marked Exhibit DJR1 is a true and correct copy of that letter.

5. After a couple of weeks, I became concerned that the signed Agreement had not been returned by Mr. Moore. I telephoned him and left messages on numerous occasions including but not limited to 1st, 20th, 26th and 31st August 1997. On 2nd September 1997, I spoke to Mr. Moore. I stated that an agreement had been reached and that I hoped that he would honour that agreement. He agreed that we had reached an agreement and he said that he would honour it. I informed Mr. Moore that should he refuse to honour the agreement I would have to take an alternative course of action and also claim costs. I made it clear that my client had no wish to do this and that I looked forward to receiving the signed Agreement

6. On 9 September 1997, I received a telephone call from a Mr. Weaving who said that he was a friend of Mr. Moore and had been asked by Mr. Moore to call me. He said that Mr. Moore is an antique dealer and that neither he nor Mr. Moore have anything to do with brewing. He said that Mr. Moore did not have any intention of brewing a beer or using the trade mark DEMON ALE in connection with a beer. Her then said that Mr. Moore would not honour his agreement with my client. He went on to say that Mr. Moore would accept the sum of £1,000 to transfer the application. I informed Mr. Weaving that Mr.

Moore was in breach of his agreement and that I would be taking instructions.

The letter exhibited as Exhibit DJR1 accorded with the evidence given in paragraphs 3 and 4 of the Statutory Declaration. In the events which had happened the Registrar was entitled to assume that the Applicant had chosen to allow the evidence in Mr. Rickard's Statutory Declaration to stand unchallenged.

The Application to Amend

Mr. Rickard's Statutory Declaration was filed under cover of a letter in which the Opponent sought leave to amend paragraph 9 of its grounds of opposition by inserting the following averments prior to the last sentence:

“The Applicant agreed to assign the application to the Opponent, which agreement is binding. The Applicant now refuses to honour his agreement and thereby is in breach of contract, which breach is remedial by an Order for “Specific Performance”. In the result use of the trade mark by the Applicant is prohibited by virtue of rule of law.”

The letter requesting amendment referred to Mr. Rickard's Statutory Declaration and asked the Registrar to order costs on an indemnity basis, in view of the Applicant's refusal to honour the agreement for assignment of the pending application, when exercising his discretion to award costs in favour of the Opponent.

The Trade Marks Registry invited the Applicant to comment in relation to the request for amendment. Having considered the Applicant's comments it notified the Opponent in a letter dated 3rd March 1998 that the request for amendment was refused. The Opponent then requested an oral hearing to consider the matter. The request was made under Rule 48 of the 1994 Rules. The oral hearing took place on 27th May 1998. The Applicant chose not to be present or represented at the hearing. Amendment was refused by the Registrar's hearing officer, Mr. S.J. Probert, on the basis that it would involve an unacceptable broadening of the pleadings.

Pleadings superseded

The evidence in Mr. Rickard's Statutory Declaration provided no basis upon which any of the multiple objections to registration pleaded in the Opponent's grounds of opposition could be upheld. The grounds of opposition therefore became liable to be struck out as an abuse of process when the Opponent informed the Trade Marks Registry in October 1998 that it intended to rely solely upon Mr. Rickard's evidence: c.f. Rhone-Poulenc SA's (Ketoprofen) Patent [1989] RPC 570.

It appears that the Opponent's evidence was left on file with a view to supporting one particular objection under Section 3(6) of the Act. According to that objection the Applicant had made a materially false statement in his application for registration. Section 32(3) of the Act requires an applicant for registration to:

“state that the trade mark is being used, by the applicant or with his consent, in relation to [the goods or services in relation to which it is sought to register the trade mark] or that he has a *bona fide* intention that it should be so used.”

The prescribed form of application for registration calls upon applicants to make a statement to the effect specified in Section 32(3). The statement must obviously be truthful in order to satisfy the statutory requirement and the Opponent was asserting, on the basis of Mr. Rickard’s evidence, that the Applicant could not have been telling the truth when he made the required statement in the application for registration in the present case. On that basis the Opponent was maintaining that registration should be refused under Section 3(6) of the Act which provides that:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

I do not think that this way of putting the objection under Section 3(6) can fairly be said to have been notified to the Applicant in paragraph 5 of the grounds of opposition filed on 25 June 1997. It seems to me that the Opponent should have applied to amend its grounds of opposition in order to make the true nature of its objection clear to the Applicant. In the meantime it was open to the Applicant to contend that the unpleaded allegation of bad faith ought not to be entertained. This was especially true in view of the omission of that allegation from the amendments which the Opponent had requested on the basis of Mr. Rickard’s Statutory Declaration in December 1997.

However, Mr. Weaving and the Applicant allowed the proceedings to continue without challenging the regularity of the Opponent's shift of position. They appear to have done so in ignorance of the objection which had emerged under Section 3(6) and in the belief that the fate of the application for registration continued to depend on the objections raised in the statement of grounds to which they had already responded.

The Registrar's Decision

Both sides indicated that they were content to seek the Registrar's decision solely on the basis of the papers filed and without recourse to a hearing. The relevant decision was issued by Mr. D.C. Morgan on behalf of the Registrar on 5th March 1999. He dismissed the Opponent's objections under Sections 3(3)(b), 3(4), 5(3), 5(4) and 5(6) of the Act on the basis that they could not succeed in the absence of any supporting evidence.

That left the Opponent with no viable basis upon which to claim protection under Section 5 for an "*earlier trade mark*" of the kind specified in Section 6(1)(c) of the Act. Rejection of the Opponent's objections under Sections 5(1) and 5(2) of the Act was then inevitable on the basis that:

“The opponents' mark *BIERE DU DEMON* for beers is as yet unregistered and the opponents' trade mark application is dated 14 July 1997, a later date than the application in suit (9 November 1996). Consequently, the opponents' mark is not an earlier right under the provisions of Section 6 and therefore the opposition under Section 5 fails.”

Finally the hearing officer turned to consider the acceptability of the application for registration under Section 3(6) of the Act. In that connection he referred to the evidence in Mr. Rickard's Statutory Declaration and the passages in the Applicant's counterstatement which I have italicised above and said:

"In my view some of the applicant's admissions give considerable credence to the opponents' claims. It does not appear that the applicant was trading in beer at the date of application or that he had a bona fide intention to trade in beer under the mark applied for. The statement to the contrary on the application form does not, therefore, appear to have been made in good faith. In all the circumstances, I take the view that I should find in favour of the opponents. I therefore find the opponents successful in their opposition under Section 3(6) of the Act."

He did not specifically reject the objection pleaded in paragraph 5 of the grounds of opposition. However, it seems clear from his decision that he regarded the objection as unsustainable in the terms in which it had been pleaded. He ordered the Applicant to pay the Opponent £300 as a contribution towards its costs of the successful opposition.

The Applicant's Appeal

The Applicant appealed to an Appointed Person under Section 76 of the 1994 Act. His notice of appeal was prepared by Mr. Weaving on his behalf. It stated as follows:

“I here by appeal to the appointed person and request that the result be overturned.

On the grounds:

Paragraph 35

Firstly Jack Moore did not make the application in bad faith. There is not one person in a thousand in Britain that has ever heard of the beer “Biere Du Demon”

Secondly When Jack Moore turned down the £250.00 verbal offer, threats were made to Jack Moore that it would cost him a lot of money in the end, subsequently a final offer of £500.00 was made, which was rejected by Mr. Moore. A bit of the David and Goliath syndrome.

Thirdly Please may I clarify Jack Moore’s reason for patenting “Demon Ale”. Having realised it was an anagram of lemonade his first intention was to patent it, then once he had the name secured his intention was to market the name in a legitimate manner. I don’t see any bad faith or crime in that.

Page 5

Paragraph 1 The comment “The applicant filed no evidence in the rebuttal of the opponents claim”. I personally spoke to the patent office (Jayne Francis) with whom I had been corresponding to ask her what was required, and since I had already stated our

case as simply as I could, I did not see any benefit to anybody in repeating my previous pleadings, so that is why I referred to my previous correspondence.

Paragraph 2 This appears to be taken out of context, and
(line 10) misinterpreted to benefit the French opposition.

I request the opportunity to put our case forward verbally and get the present finding overturned. I am positively at a loss to see what action we have taken that could enable anyone to conclude we have done anything in “Bad Faith”.

These observations on the Registrar’s decision appear to me to confirm that the Applicant and Mr. Weaving were unaware of the provisions of Section 32(3) and did not understand why the application for registration had been rejected under Section 3(6).

The Objection to the Appeal

On 20th May 1999 the Opponent’s trade mark attorneys objected in writing to the Applicant’s appeal. They contended that “the appeal does not constitute an appeal in terms of Section 76 of the Trade Marks Act read with Rule 57 of the Trade Marks Rules 1994” and asked for the notice filed on behalf of the Applicant to be “rejected on the ground that it does not comply with Rule 57, which is mandatory”. The paperwork was said to be insufficient to constitute a “*Notice of appeal accompanied by a statement in writing of the*

appellant's grounds of appeal and his case in support of the appeal" for the purposes of Rule 57.

The Opponent's letter was brought to my attention as the person who would be hearing the appeal under Section 76. I directed that the objection should stand over to be dealt with at the hearing of the appeal.

The Hearing of the Appeal

The appeal came on for hearing before me on 16th September 1999. The Applicant was present at the hearing and represented by Mr. Weaving. Mr. Knight appeared on behalf of the Registrar. The Opponent was not represented. I was informed shortly before the hearing that its trade mark attorneys wished me to act on the basis of the papers before me.

Two things became clear as the hearing progressed. First, the Applicant and Mr. Weaving were unaware that applications for registration must contain a statement to the effect specified in section 32(3) of the Act or that an application could be said to have been made in bad faith if it contained a false statement to that effect or that this had become the basis on which the Opponent was objecting under Section 3(6) to the present application for registration or that the evidence in Mr. Rickard's Statutory Declaration was directed to that objection or that the Registrar's hearing officer had upheld that objection in his decision issued on 5th March 1999. They became aware of these matters for the first time during the course of the hearing. Second, the Applicant and Mr. Weaving confirmed that the application for registration had been made with a view to obtaining some kind of "patent" protection for

the words DEMON ALE (as a clever anagram of the word “lemonade”) and further confirmed that the words had not been put forward for registration with the intention specified in Section 32(3) of the Act.

Decision

Article 3(2)(d) of Council Directive No. 89/104/EEC of 21st December 1988 to approximate the laws of the Member States relating to trade marks gave Member States of the European Union the option to “*provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where and to the extent that ... the application for registration of the trade mark was made in bad faith by the applicant*” . Article 51 of the Community Trade Mark Regulation (Council Regulation (EC) No. 40/94) similarly provides that “*A Community trade mark shall be declared invalid ... where the applicant was acting in bad faith when he filed the application for the trade mark*” subject to the qualification that “*Where the ground for invalidity exists in respect of only some of the goods or services for which the Community trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only*”. The United Kingdom opted in Section 3(6) of the 1994 Act to provide that “*A trade mark shall not be registered if or to the extent that the application is made in bad faith*”. I do not see any difference of substance in the variations between the language of Section 3(6) and the language of the parallel Community legislation.

The focus of attention under Section 3(6) is the propriety of the applicant’s claim to the protection he seeks. The words “*if or to the extent that the application is made in bad*

faith” in Section 3(6) and the similar wording in the parallel Community legislation emphasise that the propriety of the application must be tested with particular reference to the specification of goods or services (and therefore the scope of protection) for which registration of the sign in issue has been requested. That accords with Article 13 of the Directive which provides (with emphasis added) that:

“Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect only of some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.”

Although the words I have emphasised do not appear to have found their way into the text of the 1994 Act, they are binding upon the Registrar of Trade Marks as the person whose task it is to implement Article 13 on behalf of the State in Registry proceedings in the United Kingdom. Article 13 serves to confirm that no grounds for refusal of registration should exist in respect of any of the goods or services for which a trade mark is to be registered. It envisages that the coverage of an application for registration will (where possible) be restricted to the extent necessary to confine it to goods or services for which the trade mark in question is fully registrable.

With these considerations in mind, it appears to me that Article 13 of the Directive and Section 3(6) of the Act (Article 3(2)(d) of the Directive) combine to require that a sign

should only be registered for use as a trade mark in relation to goods or services specified (i) without bad faith on the part of the applicant; and (ii) within limits which leave the application altogether free of objection under the provisions of the 1994 Act. I do not think that Section 3(6) requires applicants to submit to an open-ended assessment of their commercial morality. However, the observations of Lord Nicholls on the subject of dishonesty in Royal Brunei Airlines Sdn. Bhd. v. Philip Tan [1995] 2 AC 378 (PC) at p.389 do seem to me to provide strong support for the view that a finding of bad faith may be fully justified even in a case where the applicant sees nothing wrong in his own behaviour.

In Gromax Plasticulture Ltd v. Don & Low Nonwovens Ltd [1999] RPC 367 Lindsay

J. said (p.379):

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short as to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

These observations recognise that the expression “bad faith” has moral overtones which appear to make it possible for an application for registration to be rendered invalid under

Section 3(6) by behaviour which otherwise involves no breach of any duty, obligation, prohibition or requirement that is legally binding upon the applicant. Quite how far the concept of “bad faith” can or should be taken consistently with its Community origins in Article 3(2)(d) of the Directive is a matter upon which the guidance of the European Court of Justice seems likely to be required Road Tech Computer Systems Ltd v. Unison Software (UK) Ltd [1996] FSR 805 at 817, 818 per Robert Walker J.

In the present case the objection under Section 3(6) related to the Applicant’s breach of a statutory requirement. Section 32(3) of the Act required him to be a person who could truthfully claim to have a bona fide intention that DEMON ALE should be used (by him or with his consent) as a trade mark for beer. His application for registration included a claim to that effect. However he had no such intention and could not truthfully claim that he did. That was enough, in my view, to justify rejection of his application under Section 3(6). I see no reason to doubt that Section 32(3) is compatible with Community law. The 8th recital to the Directive specifically confirms that *“in order to reduce the total number of trade marks registered and protected in the Community ... it is essential to require that registered trade marks must actually be used or, if not used, be subject to revocation”*. I am satisfied that this is not a case which tests the limits of Section 3(6) of the Act (Article 3(2)(d) of the Directive) from the point of view of Community law.

What troubles me about this finding of bad faith is that the Applicant and his representative, Mr. Weaving, were not disposed to dispute it once the legal and factual basis for it had been explained to them. I am troubled by that because it makes me think that they

might well have accepted the situation at a much earlier stage in the opposition proceedings if the superseded objections (to which they had reacted) had been formally excluded from consideration and the unpleaded objection (to which they had not reacted) had been formally notified to them in terms they could reasonably have been expected to understand. Unfortunately, the pleadings in this case have at all stages overlooked or ignored the particular objection that led the hearing officer to reject the application for registration.

Considerations of justice, fairness, efficiency and economy combine to make it necessary for the pleadings of the parties in Registry proceedings to provide a focused statement of the grounds upon which they intend to maintain that the tribunal should or should not do what it has been asked to do. The statement should not be prolix. It should, however, be full in the sense indicated by Mr. Simon Thorley QC in Coffeemix TM [1998] RPC 717 at 722: “It must be full in the sense that it must outline each of the grounds ... relied upon and state the case relied upon in support of those grounds. It should be as succinct as possible, but it must be complete”. If a party fails to provide sufficient information in his pleadings as to the nature or extent of the grounds upon which he relies, the Registrar “*may direct that such information as he may reasonably require should be filed within such period as he may specify*” under Rule 51 of the Trade Marks Rules 1994. The Appointed Person has the same power by virtue of Rule 59(2) of the 1994 Rules. A direction may be given under Rule 51 by the Registrar (or the Appointed Person) of his own motion or upon the application of a party to the proceedings before him.

It has been recognised that the problem of inadequate pleadings in Registry proceedings is sufficiently serious to require corrective action. In Nasa TM (16th June 1999) the Vice-Chancellor Sir Richard Scott expressed concern as to the state of the pleadings before him on appeal from a decision of the Registrar in opposition proceedings under the continuing provisions of the 1938 Act. He said:

“A Notice of Opposition is, for the purpose of registration proceedings before the Registrar, in effect a pleading. That is the function it ought to serve. A Counter Statement was then put in by Mr. Higgins. That stands as his pleading. The Notice of Opposition put in by NASA is, judged by ordinary pleading criteria, a fairly hopeless document. This is a point which I have made within the last two weeks in regard to other trade mark proceedings. If the function of pleadings is, and it is, to identify the issues between the parties, so that the preparation for trial can be efficient and so that the judge at trial can deal with the real issues between the parties, then the Notice of Opposition filed on behalf of NASA US is, as I have already said, hopeless. It did not do that.”

Later in the same judgment he said:

Part of the problem, in my view, is the procedural practice that seems to have grown up in the past - although I am very relieved to hear from counsel that it is in the process of being, if it has not already been, cured - of not preparing proper pleadings with proper particulars of the parties' contentions. If the pleadings do not identify the right issues, the issues the parties propose to argue about, then it cannot be expected that with any consistency the right evidence will be adduced at the hearing.

The pleadings are supposed to identify the issues to which the evidence will be directed. If the pleadings do not properly identify the issues someone, sooner or later, is going to be taken by surprise.

In Club Europe TM (28 June 1999) the Vice-Chancellor reiterated that:

It is the function of pleadings to define the issues between the parties. Notices of Opposition and Counterstatements play the part of pleadings in contested trade mark registration applications. To some extent supporting Statutory Declarations may be regarded as complementing that pleading function. But in the present case neither the Notices of Opposition, nor the Counterstatements, nor the Statutory Declarations identified or defined the issues between the parties.

He went on to allow an application to admit further evidence on appeal:

I have no doubt that this is a case in which the additional evidence ought to be admitted. The need for it is, in my opinion, a direct result of the failure of the pre-hearing procedures properly to define the issues between the parties. In any type of litigation, a failure to define the issues at an early stage will lead to unnecessary waste of time and of costs. That has happened here. I am not, in this judgment, going to attempt to prescribe procedural remedies. But that some must be prescribed I have no doubt. The Civil Procedure Rules Committee will, during the course of this year, be looking at the procedures for specialist areas of litigation. It is essential that procedures be followed that will prevent parties arriving at a hearing before the Principal

Hearing Officer not knowing what are the real issues in the case. It is also essential that something be done about the delays that have been evidenced by the chronology in this case. That may be more a matter of resources than of procedural rules. The two may need to advance together.

The paper which Mr. Knight delivered to the Institute of Trade Mark Attorneys on 20th October 1998 made it clear that the Registrar intended to address the problem of inadequate pleadings as part of the Registry's response to the reform of civil procedure in the courts.

I have referred to these matters at length because they have a direct bearing on the course that I propose to take in relation to the costs of the present opposition proceedings. I am not willing (even if I am able) to let the unsatisfactory state of the pleadings deflect me from upholding the relevant objection under Section 3(6). However, I think that the justice of the case requires the costs of the successful objection, which was not pleaded, to be set against the costs to which the Applicant was prima facie entitled upon failure of all of the many objections unsuccessfully pleaded in the Opponent's statement of grounds. On a broad view of the matter (and bearing in mind that the application for registration has been rejected) I think that these costs should simply be taken to cancel each other out. The Applicant's appeal will therefore be allowed to the extent that it relates to the hearing officer's order for costs and that order for costs will be set aside. Save to that extent, the appeal will be dismissed.

The paperwork filed on behalf of the Applicant in connection with the appeal was deficient in terms of the requirements of Rule 57 of the 1994 Rules. However, the deficiencies did not render the appeal ineffective or a nullity as contemplated by the Opponent in its letter of objection dated 20th May 1999. They gave rise to a need for elucidation. The Applicant was not well-placed in that connection because he and Mr. Weaving did not properly understand the basis upon which the Registrar's decision had gone against them. In the circumstances I can see no useful purpose in requiring the Applicant to remedy the deficiencies of the paperwork filed on his behalf under Rule 57 or condemning him in costs for not filing better paperwork in the first place.

No award of costs was requested by the Applicant or the registrar in relation to the appeal. As previously noted, the Opponent chose not to be represented at the hearing before me. In that state of affairs I will make no order as to the costs of the appeal.

Geoffrey Hobbs Q.C.

28th September 1999

Mr. Weaving represented the Applicant.

Mr. Knight, Principal Hearing Officer, appeared on behalf of the Registrar.