

TRADE MARKS ACT 1994

IN THE MATTER OF A REQUEST BY SUN MICROSYSTEMS INC. (THE APPLICANTS) FOR AN EXTENSION OF TIME WITHIN WHICH TO FILE EVIDENCE IN OPPOSITION PROCEEDINGS AND A MOTION TO STRIKE OUT OPPONENT'S GROUNDS OF OPPOSITION (Opposition m 50304) IN RELATION TO APPLICATION NUMBER 2187037

TRADE MARKS ACT 1994

IN THE MATTER of a request by Sun Microsystems Inc. (the applicants) for an extension of time within which to file evidence in opposition proceedings and a motion to strike out opponent's grounds of opposition (Opposition m 50304) in relation to application number 2187037

10 Following the receipt from the applicant of a request for an extension of time within which to file evidence in these opposition proceedings and also a motion to strike out the opponent's grounds of opposition, the Registrar replied by way of a letter dated 15 November 2000. In summary that letter stated that the Trade Mark Registrars preliminary view was that the opponent should be requested to remove their claim under Section 5(4) of the Act and also paragraph 4 of their statement of case, the opposition would then continue under Section 5(2)(b) only. Also that the extension of the period for the filing of evidence by three months was not seen as justified, this was restricted to one month, until 17 December 2000. The letter closed in the normal manner by stating that if either party disagreed they could request a hearing.

20 No such hearing was requested, however, the applicant has requested a statement of the reasons for this decision, as provided by rule 62(2) of the Trade Marks Rules 2000.

Background

25 Application number 2187037 was applied for on 25 January 1999 and, following examination, was published in the Trade Marks Journal on 21 July 1999. On 20 October 1999 Viglen Limited filed a Form TM7 and Statement of Grounds of Opposition to this application citing Sections 5(2)(b) and 5(4) of the Trade Marks Act 1994. See Appendix A, a copy of the statement of case.

30 The applicant filed their defence, by way of a Form TM8 and Counterstatement, on the 10 November 1999. This was sent to the opponent under cover of a letter dated 17 November 1999 and the period for filing evidence under Rule 13(4) of the Trade Mark Rules 1994 (as amended) commenced allowing three months from the date of the letter.

35 On 17 February 2000 the opponent requested, and was granted, an extension of three months, until 17 May 2000, for the filing of evidence, this was objected to by the applicant but these objections were not pursued. Also the issue of security for costs was raised by the opponent. This was the subject of an interlocutory hearing held on 27 July 2000 when it was decided that no order for the security of costs should be issued.

40 In the meantime the opponent filed evidence by telefacsimile on 17 May 2000 and the applicant was given until 17 August 2000 to file such evidence as they wished under Rule 13(9) of the Trade Marks Rules 2000 (which came into force on 17 February 2000).

45 On 17 August 2000 the applicant requested an extension of time of three months for the filing of their evidence, giving the reason as:-

“The Applicants need more time to collect and file evidence that will be relevant to that filed by the Opponents under Rule 13(7).”

This was initially refused but following a letter from the applicant, in which they argued that this was a first request, that refusal prejudiced the applicant, without explaining what this prejudice was, and that the opponents' evidence raised a number of legal issues which would have a bearing on the applicants' evidence, the preliminary decision was overturned and the request granted.

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Subsequently, on 25 October 2000, the applicant filed a Form TM9 seeking a further three months, from 17 November 2000, in which to file their evidence. They also attached a "Motion to strike out Opponent's Grounds of Opposition" (see Appendix B). The reason for the extension was given as:-

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"As the Registry's decision on the Applicant's Motion to Strike Out the Opponent's Grounds of Opposition will have a bearing on the Rule 13(9) evidence, this extension is requested pending the Registry's decision. We submit that it would be prejudicial for the Applicant to continue collecting further evidence until the registry issues its decision."

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The opponent responded by letter, dated 30 October 2000, making the following comments:-

"We were very surprised to receive the applicant's letter dated 25 October 2000, enclosing a Form TM9 and a request for "Motion to Strike Out the Opponent's Grounds of Opposition".

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The applicant has sought one extension of time to collate and file its evidence in support of its application, and no mention was made then of any alleged deficiencies in the opponent's evidence. In other words, it has taken the applicant over five months to write to the opponent and the Registry about this matter.

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The opponent believes that if the applicant finds fault with any of the opponent's grounds of opposition, then it should file such evidence under Rule 13(9). The "Motion" is therefore inappropriate."

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Having considered the applicants request and the comments from the opponent the registrar issued the letter of 15 November 2000, referred to above.

Decision

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With regards to the Motion to Strike Out the Opponent's Grounds of Opposition, it must be borne in mind that these proceedings were commenced prior to the introduction of The Trade Marks Rules 2000 and the practice of examining statements of case, which was not fully developed until the issue of Tribunal Practice Notice 4/2000. On 4 October 2000 Tribunal Practice Notice 4/2000 was issued which formally notified users of the trade mark registration system of the standards required for statements of case and counterstatements given the development of the practice following introduction of The Trade Marks Rules 2000. This is the background against which the Registrar may invite the opponent to amend their statement of case.

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In the Motion to Strike Out the Opponent's Grounds of Opposition the applicant correctly states that under the Civil Procedure Rules the Court has discretion to strike out, from a statement of case, any matters which fail to comply with either a rule, a practice direction or a court order. However, as was determined in the *St Trudo* case, [1995] RPC 370, the Rules of the Supreme Court, the precursor of the Civil Procedure Rules, have no part to play before the Registrar. Notwithstanding this the Registrar has the discretion to regulate proceedings before her and where no provision is made under the Trade Marks Rules can look for guidance to the Civil Procedure

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Rules in exercising this discretion and can therefore strike out from a statement of case when she thinks fit.

5 The motion also refers to the Registry's Tribunal Practice Notice 1/2000 in which, at paragraphs 15 to 19, the issue of statements of case was addressed in broad terms, this was effectively superceded by the Tribunal Practice Notice 4/2000 which specifically addressed the issue of what the Registrar expected of a statement of case.

10 The statement of case, at paragraph one, clearly states the registered marks upon which the opponent wishes to rely, this is not in dispute.

15 In the Motion to Strike Out it is argued that, in the first instance, the grounds put forward in paragraph two are insufficient to make the opponents case out in as far as they merely reiterate the relevant provisions of Section 5(2)(b) of the Act, do not particularise the perceived similarity and do not particularise those goods covered by the registrations that the opponent regards as similar to those of the applicant.

20 In dealing with this it must be understood that it is not unusual for the opponent in proceedings before the registrar to enter sections of the Act, verbatim, into their statements of case, it neither adds to nor detracts from the real content of the pleadings. Under the practice notice issued it would not appear to be a requirement for the opponent to particularise any perceived similarity. Having established which marks they are choosing to rely upon for the purposes of opposition under Section 5(2) and which specific subsection they are choosing to rely upon, it is the tribunal that then has to decide the merits of the case. But I understand that under the auspices of Tribunal Practice Notice 4/2000 the Trade Marks Registry's Law Section do now ask opponents to indicate whether their grounds are based upon all or only some of the goods or services of the earlier trade marks.

30 In addition the applicants state that the opponent has not provided evidence of actual confusion, has not provided actual evidence of use of their marks and goes on to describe the evidence supplied, declaring this to be inadequate to support the opposition.

35 It is accepted practice that proceedings under Section 5(2) do not require evidence and can proceed to a decision on the basis of the information supplied in the notice of opposition, therefore there is no requirement upon the opponent to provide evidence of confusion. Likewise there is no requirement under the Trade Marks Act 1994 for the opponent to provide evidence of use, the existence of a registration is sufficient to support a ground of opposition based on Section 5(2) of the Act.

40 I do not intend to review the content of the evidence supplied by the opponent as that is the province of the tribunal who will determine the outcome of the case, but note a decision by Simon Thorley QC, sitting as the Appointed Person, on the appeal in the *ACADEMY* case (unreported, SRIS O/169/00), in which he stated at paragraph 9 of his decision:-

45 Since I am aware that the question of whether or not a document in this form should be accepted by the Registry is the subject of debate in other proceedings and since I do not believe it makes any difference for present purposes whether the document is an affidavit or merely submissions, I propose to make no further comment on this question in these proceedings save only to say this: that it is as important in proceedings before the Registry as in any other proceedings that a proper

line is drawn between that which is truly evidence, which should be the subject of a properly prepared affidavit, statutory declaration or witness statement as the case may be, and submissions or arguments in relation to the matter in dispute which need not. To allow the two to be present in the same document is bound to lead to confusion and misunderstanding.

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A great deal of what is supplied to the Registrar under the heading of “evidence” is actually “submission” and it is for the tribunal to give due weight accordingly when arriving at a final determination of the case. From the description of the opponents evidence, supplied at paragraph 4 (iii) of The Motion to Strike Out the Opponent’s Grounds of Opposition, it can be surmised that some of this “evidence” is actually “submission” but this cannot be a basis for summary judgement against the opponent.

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The Motion to Strike Out the Opponent’s Grounds of Opposition goes also to the grounds of opposition under Section 5(4) of the Act, which the opponent requested be disregarded in paragraph three of their evidence, and paragraph four of the statement of case, which reads:-

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“Registration of the mark applied for will obstruct or prejudice the legitimate conduct of the Opponent’s business.”

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The registrars preliminary view was that the opponent should be asked to remove these grounds on the basis that they have, in their evidence, volunteered to remove the grounds under Section 5(4) and the grounds in paragraph four of their statement of case does not relate to any section of the Act. Thus the proceedings are now based solely on Section 5(2)(b) of the Act.

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The Motion to Strike Out the Opponent’s Grounds of Opposition also refers to paragraph seven of the statement of case which is a request for security for costs. This issue has already been dealt with separately. Finally the applicant makes a request for costs associated with this Motion, I will not make any such award and will leave it for the tribunal to decide the merits of the issue of costs at the conclusion of these proceedings.

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Dealing with the requested extension of time, the power vested in the Registrar to grant extensions to certain periods of time determined in the Trade Marks Rules is discretionary, the periods allowed for the filing of evidence are not excluded from this discretionary power. The breadth of the discretion afforded the Registrar was dealt with by the Appointed Person in the *Liquid Force Trade Mark* appeal, [1999] RPC 429, at pages 437 & 438, and allows that where any relevant circumstances are brought to her attention the registrar can exercise this discretion.

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It was clearly stated in the *SAW* case [1996] RPC 507, and confirmed in *Levy’s* case [1999] RPC 291, that six months is a long time for the filing of evidence. In these proceedings the applicant has had the initial period of three months, this was extended by three months and they have then requested a further three months.

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As the applicant did not request a hearing I have only the papers previously filed in these proceedings on which to base this decision

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This request under consideration was solely based on the Motion to Strike Out the Opponent’s Grounds of Opposition and alleged that it would be prejudicial to their case if they were forced to continue collecting evidence. However, the opponents statement of case only gave two Sections of the Act under which they were pursuing the action, Sections 5(2)(b) and 5(4), and the

latter was declared in their evidence as to be disregarded. Therefore, irrespective of the outcome of their Motion, the applicants are only facing action under Section 5(2)(b) which, as stated above, does not require the filing of evidence for the tribunal to determine the proceedings.

5 The legal issues referred to in support of the first request for an extension of time must be the Motion attached to the second request and whilst this may be perceived as a basis for summary judgement this could have been filed at an earlier date. From the papers before me there is no indication that the applicant has been progressing with the compilation of evidence and I regard the decision to allow an additional one month for the completion and filing of evidence as being
10 generous.

The applicant did not avail themselves of the opportunity to argue their case at an interlocutory hearing and instead filed a Form TM5 requesting a statement of grounds of the decision in the
15 registrars letter of 15 November 2000.

Dated this 19th. day of March 2001

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**Mr G J Attfield
Hearing Officer
For the Registrar, the Comptroller-General**

TRADE MARKS ACT, 1994

IN THE MATTER OF Trade Mark
Application No. 2,187,037 in the name of
SUN MICROSYSTEMS, INC.

AND

IN THE MATTER OF Opposition thereto by
VIGLEN LIMITED

STATEMENT OF GROUNDS UNDER RULE 13

1. VIGLEN LIMITED ("the Opponent") is, inter alia, a manufacturer and merchant of computer products and the proprietor of:
 - a) Trade Mark Registration No. 1,095,661 GENIE, Journal No. 5334, page 2268;
 - b) Trade Mark Registration No. 1,488,896 GENIE, Journal No. 5984, page 4606;
and
 - c) Community Trade Mark Registration No. 111,013 GENIE, Journal No. 36/98,
page 81.

The Grounds of Opposition are as follows:

2. It is submitted that the Applicant's mark is similar to the Opponent's earlier trade marks and is to be registered for goods that are identical with or similar to those for which the Opponent's earlier trade marks are protected and there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the Opponent's earlier trade marks. As such, the Applicant's mark offends against the provisions of Section 5(2)(b) of the Act and should be refused registration accordingly.

3. The Opponent has made substantial use of its marks and in so doing has accrued significant goodwill and reputation. In view of this goodwill and reputation enjoyed by the Opponent, part of which is attributable to its marks, registration of the Applicant's mark will offend against the provisions of Section 5(4) of the Act.
4. Registration of the mark applied for will obstruct or prejudice the legitimate conduct of the Opponent's business.
5. The Opponent has drawn the Applicant's attention to its objections prior to the filing of the Opposition and the Applicant has failed to amend or withdraw its application.
6. The Opponent requests an award of costs in its favour.
7. The Opponent requests security for costs.

Dated this *20th* day of *October* 1999

Trade Mark Consultants Co.

Agent for the Opponent

Trade Mark Consultants Co.
54 Hillbury Avenue
Harrow
Middlesex HA3 8EW

TRADE MARKS ACT 1994

IN THE MATTER OF Trade Mark
Registration No. 2187037 JINI in the
name of Sun Microsystems, Inc and
Opposition No. 50303 thereto by Sun
Microsystems, Inc.

MOTION TO STRIKE OUT OPPONENT'S GROUNDS OF OPPOSITION

Formal application is hereby made to strike out all the Grounds of Opposition
filed by the Opponent on the 20th day of October 1999.

1. By CPR 3.4(2)(b) the Court has a discretion to strike out a statement of case in circumstances in which it fails to comply with a) a rule, b) a practice direction or c) a court order.
2. The Applicant also relies upon the interpretation placed upon the provisions of the Registry's Tribunal Practice Note 1/2000 by Lifesavers [1997] RPC page 567 and Demon Ale [2000] RPC 345 in which it was stated:

"that a statement of case 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."

3. As regards paragraph 2 of the Opponent's Statement of Grounds, we submit that it has breached the provisions of CPR 3.4.2(b)

Particulars

- (i) it claims to rely upon section 5(2)(b) of the Trade Marks Act 1994 and does so by repeating the provisions of the section without furnishing any facts to support it.
- (ii) it fails to particularise how the respective trade marks of Applicant and Opponent are similar.
- (iii) it fails to identify which of the goods covered by the three registrations relied upon for the purposes of section 5(2)(b) that the Opponent considers are similar

to the goods listed in the Applicant's trade mark applications.

4. Further, paragraph 2 of the Opponent's Statement of Grounds has no prospects of success contrary to CPR 3.4 and/or 3PD-001, 1.7 of the Civil Procedure Rules which provides:

"A party may believe he can show without trial that an opponents case has no real prospect of success on the facts, or that the case is bound to succeed or fail, as the case may be, because of a point of law,... is bound to fail. In such case the party concerned may make an application under rule 3.4 or Part 24 (or both) as he thinks appropriate."

Particulars

- (i) The Opponent has failed to submit any evidence of confusion between the trade marks it relies on to support its opposition and the Applicant's trade mark.
- (ii) The Opponent has not produced any evidence that it has used the trade mark which they rely on to support their opposition.
- (iii) The Opponent's remaining evidence consists purely of:
 - a. reference to the state of the Trade Marks Register contrary to the finding in British Sugar plc v James Robertson and Sons Ltd [1996] RPC 281 and Bonus Gold Trade Mark [1998] R.P.C 859 that such evidence should be disregarded.
 - b. extracts from the Encyclopaedia Britannia and Collins Dictionary as to the alleged semantic common origin of the Applicant's and Opponent's trade mark which is of no greater relevance than the assertion that the words "bus" and "coach" will cause confusion in the minds of the public.
 - c. the Opponent's agents own views as to the phonetic similarity of the two trade marks is evidence of a type disregarded in Parfums Givenchy SA and another v Designer Alternatives Limited and another [1994] RPC 243, C.A.

5. In seeking to rely on Section 5(4)(b) of the Trade Marks Act, 1994, the Opponent states in paragraph 3 of its Statement of Grounds:

"The Opponent has made substantial use of its marks and in so doing has accrued significant goodwill and reputation. In view of this goodwill and reputation enjoyed by the Opponent, part of which is attributable to its marks, registration of the Applicant's marks will offend against the provisions of Section 5(4) of the Act."

In line with the statements of the Appointed Person in Wild Child Trade Mark [1998] RPC 455 at page 459, the Opponent has made no attempt to identify the precise subsection of the Section 5(4) upon which it intends to rely. We are currently uncertain as to whether the Opponent is relying upon subsection (a) rule of law or (b) earlier right.

Further, we ask the Registrar to take account of the fact that in paragraph 3 of Simon Walter's Declaration sworn in support of the Opponent's Statement of Grounds, he withdraws the section 5(4) allegation.

6. In paragraph 4 of its Statement of Grounds the Opponent states:

"Registration of the mark will obstruct or prejudice the legitimate conduct of the Opponent's business."

This claim discloses no obvious legal basis upon which opposition proceedings can be grounded. We would request, on that basis alone, the Registry strike out the claim in its entirety. This is a clear breach of the provisions of CPR 3.4.2(b) and 3PD-001.

7. By Paragraph 7 of the Statement of Grounds, the Opponent makes reference to an application for security for costs which it has twice pursued and lost and in respect of which the Opponent has been ordered to satisfy a wasted costs application made against it.

8. The Applicant requests costs of this Motion

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25 October, 2000