O-362-01

The Patent Office

Court Room 3
Harmsworth House
13-15 Bouverie Street
London, EC4Y 8DP

Thursday, 28th June 2001

Before:

Mr Geoffrey Hobbs QC
(Sitting as the Appointed Person)

In the matter of THE TRADE MARKS ACT 1994

and

In the matter of Trade Mark Application No: 2053902 by
FASTBECK LIMITED

and

In the matter of Opposition thereto under Opposition No:
47490 by GISS LICENSING BV & FORMULA ONE ADMINISTRATION LIMITED
(Joint Opponents)

An appeal to the Appointed Person from the decision of
Mr M Reynolds dated 22nd November 2000

(Transcript of the Shorthand Notes of Marten Walsh Cherer Ltd.,
Midway House, 27-29 Cursitor Street, London EC4A 1LT
Telephone No: 020-7405 5010 Fax No: 020-7405 5026)

Mr J. Mellor (instructed by Messrs Mc Dermott Will & Emery) appeared
As Counsel on behalf of the Appellants/Opponents

Mr I. Bartlett (of Messrs W H Beck Greener Co) appeared
as Trade Mark Attorney on behalf of the Respondent/Applicant

D E C I S I O N
(As approved by the Appointed Person)

MR HOBBS: I do not think it is necessary to give a long reasoned judgment on this issue.

On 11th October 2000 Mr R A Jones, acting as hearing officer on behalf of the Registrar, agreed to allow into the proceedings, in truncated form, the statutory declaration of Jonathan Silverman which had been put forward by the applicant as further evidence. He gave the opponents seven days within which to file evidence in reply to the evidence of Mr Silverman, if so advised.

In accordance with what I understand to be the High Court practice, and in accordance with what I understand to be the practice that Mr R A Jones was subscribing to on that occasion, the opportunity to serve evidence in reply, if so advised, was not a carte blanche opportunity to revisit the case and put in evidence of a broad generality dealing with issues in controversy between the parties beyond those which could properly be said to relate directly to the "Accor evidence" given in Mr Silverman's declaration.

Looking at the statutory declaration of Lawrence Leader and its five exhibits, which were filed on behalf of the opponents by way of reply within the seven-day period, I am clear in my own mind that this evidence exceeds by a considerable margin the latitude which was being allowed by Mr R A Jones in his decision on 11th October 2000.

It is not possible to produce a perfect severance in a composite document of that which can be regarded as

legitimately directed to "Accor" and that which constitutes material which is unacceptable for its digression away from the "Accor" point raised by Mr Silverman in his evidence.

I can well understand why on the 24th October the hearing officer, Mr Reynolds, took the position that he did. He seems to have been motivated by a desire to allow in only such evidence as the applicant itself was willing to accept without further objection.

In following that course he adopted a process of severance which appears to have produced a degree of incongruity. The most obvious incongruity is the incongruity of allowing into the proceedings paragraph 4 of Lawrence Leader's statutory declaration but not the exhibit LL1, to which he refers. That incongruity has, however, been cured at the hearing before me on the basis that the applicant has agreed that exhibit LL1 can be treated as appendant to paragraph 4 and introduced in evidence accordingly.

It seems to me that with that adjustment, the position adopted by Mr Reynolds at the hearing on the 24th October, is substantially correct. It was a decision he took in the exercise of his discretion. Moreover it was a decision directed to effective case management. In accordance with the prevailing practice, an appeal tribunal should be slow to interfere with a discretionary determination of that kind. I do not think the hearing officer misdirected himself in principle and whilst his decision may have produced a

patchwork of evidence in the form of an abridged version of Lawrence Leader's statutory declaration, which is not perfect, I do not think it is so unsatisfactory that it cannot be lived with for the purposes of this opposition proceeding. In the circumstances, I propose to dismiss the appeal.

Does anyone want to say anything about costs?

MR BARTLETT: No, sir.

MR HOBBS: The costs of this hearing?

MR MELLOR: Sir, I resist that on the obvious basis that we had to come to this hearing to achieve the level of agreement that you outlined in your decision about LL1. We made it perfectly clear right back in the notice of appeal, so it has been clear throughout, that we were pointing out these incongruities and it was open to the applicants to say "OK, you can have LL1 in." They did not. They only did it when put under pressure at this hearing.

MR HOBBS: You make me sound a little bit non-human rights in that respect. I think he was a volunteer rather than a pressed man.

MR MELLOR: You have to take a realistic view of what is going to happen. If you choose to stand on what you perceive to be your rights and you are not quite successful, then that has an effect on costs.

MR HOBBS: You would not have been satisfied solely with that, I think. Indeed, you were not satisfied solely with that.

MR MELLOR: Bearing in mind, we are here and I have already argued

the point. It is not as though I was going to say "Thanks very much. We can go home now." It is not, in my submission, that relevant a point.

MR HOBBS: All right. So what shall I do about costs?

MR MELLOR: I cannot in all truthfulness say it is a score draw, but it is not a win. It is somewhere between the two.

MR HOBBS: What do you say?

MR BARTLETT: I say it is a win, sir. A substantial proportion of the legal declaration remains out.

MR HOBBS: I take this view. It is an interlocutory appeal in a procedural matter. The utility of the appeal is in many ways tied to the utility of the proceedings themselves. I think the right course here is to reserve the question of how and by whom the costs of this appeal should be paid and in what quantum to the decision of the Registrar in due course. In other words, the costs of this part of the procedure will be treated as costs incurred in connection with the opposition proceeding to which this appeal belongs.

MR MELLOR: Costs in the opposition then?

MR HOBBS: Effectively, yes. Thank you.

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