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THE PATENT OFFICE

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

Tuesday, 18th September 2001.

THE APPOINTED PERSON  
(Mr. Geoffrey Hobbs QC)

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IN THE MATTER OF UK TRADE MARK APPLICATION NO. 2169994 BY  
STYLE HOLDINGS PLC

and

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 49938 BY  
WILSON SPORTING GOODS CO.

and

IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON UNDER THE  
TRADE MARKS ACT 1994 AGAINST THE DECISION OF THE HEARING  
OFFICER (MR. G. J. ATTFIELD) DATED 5TH FEBRUARY 2001.

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(Transcript of the Stenograph 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)

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MR. MICHAEL HICKS (counsel instructed by Messrs. Courts & Co)  
appeared on behalf of the Applicant.

MR. MICHAEL EDENBOROUGH (counsel instructed by Messrs. D. Young &  
Co.) appeared on behalf of the Opponent.

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DECISION

1 THE APPOINTED PERSON: On 18th June 1998 Style Holdings plc  
2 applied to register the word "Willson" as a trade mark for  
3 use in relation to "articles of clothing, suits, jackets,  
4 trousers, jeans, shirts, sweatshirts, T-shirts, cardigans,  
5 jumpers, sweaters, pullovers, knitted articles of clothing,  
6 overcoats, footwear, gloves, belts, all included in class  
7 25."

8 The application for registration was advertised for the  
9 purposes of opposition on 31st March 1999. Notice of  
10 opposition was filed by Wilson Sporting Goods Company of  
11 Chicago, Illinois on 30th June 1999.

12 The grounds of opposition raised objections to  
13 registration on absolute grounds under sections 3(1)(a) and  
14 3(1)(b) of the Trade Marks Act 1994. They also raised  
15 objections to registration on relative grounds under sections  
16 5(2)(b) and 5(4)(a) of the Act.

17 Thirteen earlier trade mark registrations and one  
18 earlier Community trade mark application were cited in  
19 support of the objection under section 5(2). Copies of the  
20 journal advertisements were attached as annex 1 to the  
21 grounds of opposition.

22 The applicant filed a counterstatement on 31st  
23 August 1999. It admitted the existence of the earlier trade  
24 mark registrations referred to in the grounds of opposition.

25 Beyond that, it joined issue with the opponent on the

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1 objections raised under sections 3 and 5.

2 The evidence in support of the opposition was due to be  
3 filed by 2nd December 1999. On 25th November 1999, the  
4 opponent requested an extension of time for service of its  
5 evidence. The period requested was three months, which would  
6 take the time for service to 2nd March 2000. The reasons for  
7 the request were stated to be as follows:

8 "Active steps are being taken to prepare and complete  
9 evidence in support of the Opposition in the form of  
10 Statutory Declarations by a principal officer of the  
11 Opponents and from a representative of the Opponents' United  
12 Kingdom operation. Draft Declarations are under  
13 consideration by the opponents and the necessary evidence in  
14 support of the Opposition is expected to be received from the  
15 opponents' UK operation very shortly. Further time is  
16 required within which to arrange for the finalisation and  
17 execution of the proposed evidence."

18 The request was granted without objection from the  
19 applicant. The official letter (dated 3rd December 1999)  
20 informing the opponent of the extension stated:

21 "You should note that no further extension of this  
22 period will be granted unless you can support the request  
23 with detailed and compelling reasons in writing."

24 On 2nd March 2000 the opponent filed a second request

25 for extension of time. The request was for a further period

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1 of three months up until 2nd June 2000.

2 The reasons for the request were stated to be as  
3 follows:

4 "Preparation of the evidence in support of the  
5 opposition is underway and we are awaiting further details  
6 from our contact at the opponent's United Kingdom operation.  
7 Once we have this further information, we will be able to  
8 complete the draft declaration for review by the opponents.  
9 We fully expect this exercise to be completed within the  
10 period of time now requested."

11 In an official letter dated 13th March 2000, the  
12 Registry indicated that the Registrar was prepared to grant  
13 the request for an extension until 2nd June 2000. However,  
14 on 22nd March 2000 the agents for the applicant wrote to the  
15 Registrar pointing out at some length that the opponent had  
16 failed to provide detailed and compelling reasons of the kind  
17 envisaged on the previous occasion. In the circumstances, it  
18 was submitted that the request for an extension of time  
19 should be refused.

20 That led to a letter of 31st March 2000 from the  
21 Registry to the opponent in which the Registrar indicated  
22 that, in the light of the written representations which had  
23 been made, the request for an extension of time would be  
24 refused. The official letter offered the opponent the

25 opportunity to make representations against that provisional

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1 decision at a hearing to be appointed in due course.

2 The opponent requested a hearing and that took place  
3 before Mr. G.J. Attfield acting on behalf of the Registrar of  
4 TradeMarks on 1st June 2000.

5 On the basis of the representations made to him orally  
6 on behalf of the opponent, the hearing officer decided that  
7 the time for service of the opponent's evidence should be  
8 extended over until the following day, 2nd June 2000. His  
9 reasons for granting the extension were subsequently reduced  
10 to writing in an official decision issued on 5th February  
11 2001.

12 In his written decision the hearing officer said that  
13 he was satisfied that the opponent had been making progress  
14 but had been hampered by the commercial set-up of the  
15 opponent company. He noted that at the hearing the  
16 opponent's agent had expanded and clarified the reasons for  
17 the request and had done so to his satisfaction. He went on  
18 to say that it was not unusual for a multinational  
19 corporation such as the opponent to be domiciled outside the  
20 United Kingdom and for its major executives and legal  
21 representatives to be involved in the vetting and completion  
22 of evidence relating to their business. He observed that  
23 this could lead to problems of communication and  
24 prioritisation when the party outside the United Kingdom did

25 not understand the urgency with which matters needed to be

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1 progressed in the Registry proceedings. He recognised that  
2 there is a public interest in allowing proceedings to go to a  
3 hearing in circumstances where the validity of a new  
4 statutory monopoly is in issue (as it is in opposition  
5 proceedings) and he noted the opponent's contention that if  
6 its request for an extension of time was not granted, the  
7 result would be that it would, in due course, file an  
8 application for cancellation of any registration which  
9 ensued. For all of these reasons, he granted the extension  
10 of time.

11 The applicant appealed to an appointed person against  
12 the decision to grant the extension of time. In substance,  
13 it was contended that the hearing officer had erred in  
14 principle by granting an extension of time without detailed  
15 and compelling reasons in writing for doing so. The  
16 applicant requested that the decision should be set aside and  
17 that no leave for the filing of evidence out of time should  
18 be granted.

19 The evidence filed by the opponent on 2nd June 2000  
20 consisted of a statutory declaration of Mr. Havelock, its  
21 United Kingdom trade mark attorney, and an affidavit with  
22 three exhibits dated 31st May 2000 which had been made by its  
23 general counsel and assistant secretary Mr. Berens.

24 Mr. Havelock's statutory declaration stated:

25 "2. I have inspected the file relating to the

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1 above-numbered application which includes evidence filed in  
2 support of the application. In my professional opinion, this  
3 does not show use of the mark applied for in respect of the  
4 specification as published in the Trade Mark Journal which  
5 is, again in my professional opinion, unjustifiably broad.

6 "3. As an amateur racket sports player and runner, I  
7 am aware of, and have myself used and worn articles of  
8 clothing sold under and bearing the Trade Mark WILSON in the  
9 United Kingdom for many years. I became aware of such use in  
10 at least the early 1980s. The articles in question included  
11 footwear, socks, caps, articles of leisurewear, T-shirts,  
12 sports visors and wristbands.

13 "4. When major sporting events such as The Open Golf  
14 and Wimbledon Championships are held, leading players  
15 invariably take part using WILSON sporting equipment and  
16 wearing articles of clothing and carrying bags bearing the  
17 WILSON Trade mark. These events are seen on television by  
18 millions of people.

19 "5. Because of such exposure and through widespread  
20 advertising and publicity, the Trade mark WILSON is, in my  
21 professional opinion, a well-known trade mark in the United  
22 Kingdom and as such is entitled to protection under the terms  
23 of the Paris Convention Article 6 bis."

24 Mr. Berens' affidavit consisted of six paragraphs. In

25 paragraph 1 he introduced himself and explained his capacity

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1 to make the affidavit on behalf of the opponent company. In

2 paragraph 2 he stated baldly:

3 "My company is one of the world's leading manufacturers  
4 of sports equipment and related goods. The trade mark WILSON  
5 has been used in the United Kingdom and throughout the world  
6 and is one of the most famous sports brands."

7 In paragraph 3 he listed the earlier trade marks and  
8 the community trade mark application which had already been  
9 identified in the grounds of opposition. He did so  
10 notwithstanding that their existence had been admitted by the  
11 applicant for registration in its counterstatement. In  
12 paragraph 4 he set out figures for the turnover of what he  
13 described as Wilson products in the United Kingdom over the  
14 last few years without actually identifying what those  
15 products were.

16 In paragraph 5 he produced as his exhibit RMB-2 copies  
17 of catalogues illustrating the range of goods sold in the  
18 United Kingdom under his company's trade mark Wilson. His  
19 exhibit consisted of five catalogues, three of which were  
20 dated 1999 and two of which apparently dated from 1998. In  
21 paragraph 6 he produced as exhibit 3 an extract from the  
22 United Kingdom Trade Marks Journal showing the publication of  
23 the trade mark application in suit and observed that he  
24 considered that there would be confusion if that mark was



25 used in the United Kingdom in relation to the goods specified

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1 in the application.

2 I can see no good reason why the evidence ultimately  
3 tendered on behalf of the opponent should not have been filed  
4 during the period of six months generously allowed as a  
5 result of the request for the first extension of time. As  
6 against that, the reasons put forward by the opponent in  
7 support of its applications for extension of time do not  
8 appear to me to have been reasons which could have been  
9 applicable to the evidence that ultimately came to be filed  
10 on 2nd June. I am left with the impression that the  
11 opponent wished and intended to file considerably more  
12 comprehensive evidence than it did in support of its  
13 opposition but eventually failed to do so for reasons which  
14 are not exposed in the materials before me.

15 As noted in Liquid Force Trade Mark [1999] RPC 429 at  
16 438 the absence of good reason for failure to comply with a  
17 time limit is not always and in itself sufficient to justify  
18 refusal of an extension of time. The true position is that  
19 it is for the party in default to satisfy the tribunal that,  
20 despite his default the discretion to extend time should  
21 nevertheless be exercised in his favour, for which purpose he  
22 can rely on any relevant circumstances.

23 In his decision dated 9th October 2000 in Siddiqui's  
24 Application, Mr. Simon Thorley QC (sitting as the appointed

25 person) emphasised that it is incumbent on the party applying

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1 for the extension of time to put forward facts which merit

2 the requested extension. He said:

3 "In a normal case this will require the applicant to  
4 show clearly what he has done, what he wants to do and why it  
5 is that he has not been able to do it. This does not mean  
6 that in an appropriate case where he fails to show that he  
7 has acted diligently but that special circumstances exist an  
8 extension cannot be granted. However, in the normal case it  
9 is by showing what he has done and what he wants to do and  
10 why he has not done it that the registrar can be satisfied  
11 that granting an indulgence is in accordance with the  
12 overriding objective and that the delay has not been used so  
13 as to allow the system to be abused." I agree.

14 The official letter of 3rd December 1999 had emphasised  
15 the need for detailed and compelling reasons to be provided  
16 in writing in support of any request for a further extension  
17 of time. The reasons put forward in writing on 2nd March  
18 2000 were neither detailed nor compelling. The Registry  
19 should not have indicated in its letter of the 13th March  
20 2000 that it was willing to grant the requested extension of  
21 time and, having been prompted to do so by the applicant's  
22 letter of 22nd March 2000, it was correct in its letter of  
23 31st March 2000 to adopt the position that the opponent had  
24 shown no sufficient basis for the exercise of discretion in

25 its favour.

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1 The offer of a hearing at which to consider the matter  
2 appears to have been treated as the offer of an opportunity  
3 for the opponent to do orally what it had failed to do in  
4 writing: provide detailed and compelling reasons for the  
5 extension of time it required.

6 By not simply confining the hearing to the question  
7 whether the reasons put forward in writing on 2nd March 2000  
8 were adequate as a basis for the exercise of discretion in  
9 the opponent's favour, the hearing officer effectively  
10 allowed the opponent to renew its request orally on 1st June  
11 2000 (one day less than three months after the expiry of the  
12 extension of time granted in December 1999) and to do so on  
13 the basis of facts and matters which had not previously been  
14 brought to the attention of the Registrar or the applicant.

15 Since the point does not appear to have been raised  
16 before the hearing officer, I propose to leave on one side  
17 the question whether the reasons put forward on 2nd March  
18 2000 were so perfunctory that significant expansion or  
19 clarification of them must inevitably have amounted to the  
20 making of a substantive request after the expiry of the  
21 previously granted extension of time.

22 I take the view that if it was appropriate to allow the  
23 opponent to expand and clarify the written reasons for its  
24 request, it was no less appropriate to require it to reduce

25 the intended expansion and clarification to a true and

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1 accurate statement in writing.

2 I think it is regrettable that the Registrar did not  
3 insist that if the opponent intended to offer an amplified  
4 explanation with regard to the preparation of the evidence  
5 and the reasons for the delay in filing it, it should do so  
6 in writing in advance of the hearing so that the request for  
7 an extension of time could be fully and effectively  
8 considered against the background of a properly stated case.

9 I think it was unsatisfactory for the applicant and for  
10 the hearing officer that this was not done. Nevertheless, in  
11 the absence of a written explanation of the kind I have  
12 described, I do not feel able to say that it was not open to  
13 the hearing officer to exercise the discretion available to  
14 him in the way that he did on the basis of what he considered  
15 to have been the merits of the oral representations made to  
16 him on that occasion. It is not suggested on behalf of the  
17 applicant that the extensions of time which were granted were  
18 granted on the basis of any misrepresentation on the part of  
19 the opponent. These factors, together with the fact that I  
20 am very disinclined on appeal to indulge in what would look  
21 like a game of snakes and ladders by setting aside the  
22 hearing officer's decision, lead me to conclude, with some  
23 reluctance, that I ought not to interfere with the hearing  
24 officer's decision in the present case.

25 In the circumstances, the appeal will be dismissed.

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1 What about costs?

2 MR. EDENBOROUGH: In my submission, it is a normal case, a normal  
3 appeal, so therefore on scale, back to the Registry's scale.

4 THE APPOINTED PERSON: What do you say about the costs,  
5 Mr. Hicks?

6 MR. HICKS: That would be the normal case. I would say that, in  
7 light of your ruling there, you have noted it was regrettable  
8 that there were not detailed reasons given, and it may be  
9 appropriate in that case to simply let the costs lie where  
10 they fall.

11 THE APPOINTED PERSON: What do you say about that,  
12 Mr. Edenborough?

13 MR. EDENBOROUGH: There is no doubt you expressed that criticism,  
14 but that does not lie, in essence, with the applicant's trade  
15 mark attorneys. The fault, if there is any fault, sir, lies  
16 with the hearing officer not asking for it and then, if it  
17 had not been supplied, not demanding it. The opponent's  
18 trade mark attorneys put in reasons, then went to a hearing,  
19 then made submissions which were found to be persuasive. He  
20 has done everything that he ought to have done to have  
21 discharged his duty to his client and proved successful. It  
22 would be, in my submission, fair and improper to penalize him  
23 for what seems to be a failure on behalf of the Registry.

24 THE APPOINTED PERSON: I think that the right course in the

25 present case is for the costs of the hearing before me to be

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1 treated as costs in the proceedings below. They will  
2 therefore be at the disposal of the hearing officer in due  
3 course when the matter comes to be concluded upon its merits.  
4 It is a matter for the discretion of the hearing officer at  
5 that stage to decide whether any, and if so what, allowance  
6 should be made in respect of these costs. Thank you both.  
7 Very much.

8 MR. HICKS: Thank you for dealing with it today.

9 MR. EDENBOROUGH: Yes; thank you.

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