

## SUPPLEMENTARY DECISION

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 2180339

BY CHANNEL F1 LIMITED

TO REGISTER A TRADE MARK

IN CLASSES 3, 4, 9, 14, 16, 18, 25, 28, 32, 35, 38, 41 & 42

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NUMBER 50334

BY CHANEL LIMITED

### DECISION

1) In my decision dated 19 June 2002 I made a provisional finding in favour of the opponent under Section 3(6) of the Trade Mark Act 1994 as the applicant had not specifically addressed the allegation made by the opponent that:

“At the time of filing, contrary to the requirements of Section 32(3), there appears to have been no bona fide intention on the part of the applicant that the mark the subject of application No 2180339 should be used by the applicant or with his consent in respect of a wide range of goods and services covered by the application.”

2) However, I also found that the ground of opposition arose in the amended grounds of opposition and that the applicant had not been requested to submit an amended counterstatement, due to an error by the Registry. The opponent amended their grounds of opposition to include Section 3(6) on 27 February 2001 after the applicant had filed its evidence. I therefore allowed 28 days from the date of my decision for the applicant to file an amended counterstatement detailing their position on the Section 3(6) allegation.

3) The applicant has filed a statutory declaration dated 16 July 2002 by Mr Philip William Joseph Hooley, a solicitor, who represents the applicant. Although this document is not headed as a counterstatement it is clearly in response to my decision and is a specific answer to the bad faith allegation.

4) In the business plan attached to the declaration Mr Hooley is described, at page 18, as being the Chief Operating Officer of the company. In an earlier declaration in this case Mr Hooley stated that: “I have represented the applicant since 1997. I am well acquainted with its commercial activities, purpose and operation. I know the facts and matters deposed herein to be true from my representation of the applicant and from their records, to which I have access.” I therefore accept that Mr Hooley is able to respond to the allegations of bad faith as at the date of the application.

5) In his declaration Mr Hooley states that plans had been laid to licence the trade mark to various companies. The applicant had sought to attract companies as sponsors, partners or co-investors initially with a view to these companies then being licensed to use the trade mark. This is set out in the applicant’s business plan which is provided at exhibit PWJH1 along with

letters to various companies offering them the opportunity of joining the venture. Although the business plan is dated March 2000, after both the application date (16.12.98) and the date of the opposition being filed (27.10.99) Mr Hooley states that the plans had been formulated prior to the application for registration and the plan merely crystallised these ideas.

6) The opponent was given an opportunity to provide submissions on the applicant's response, and did so in a letter, dated 3 September, from its Trade mark Attorneys. The opponent stated that the applicant had been professionally advised for most if not all of the proceedings. They contended that the Registry should not have provided the applicant with an opportunity to respond to an allegation after the formal hearing had taken place. They also state that the applicant has responded with a declaration not an amended counter-statement.

7) The opponent also questions whether the declaration was filed within the time limits set and comment on the fact that the declaration was not copied to the opponent. They also contend that:

“Section 2.6 on merchandising does show an intention to use the mark CHF1 on some goods which “will be available from the site”. However, the range of goods on which that mark is intended to be used is very limited. It is not clear to what extent, if any, the mark the subject of the opposed application is intended to be used, and nowhere is there any mention of intend to use in any way in relation to some of the goods to which opposition has been filed, for example, the goods in Class 3.”

8) Whether the applicant was or was not professionally represented is not at issue. When the Registry agreed to the opponent's request to file an amended Statement of Grounds the applicant should have been asked to file an amended counter-statement. Although the applicant ultimately responded with a declaration this is clearly in response to the request for an amended counter-statement. The response from the applicant was received on 16 July 2002, and so was timely.

9) Having considered the applicant's response it is my view that the applicant has shown that at the date of filing the application it had plans to utilise the mark applied for even though the final draft of these plans was not completed until March 2000. Whilst they do not detail plans for use on all of the goods specified I am satisfied that there was a bona fide intention to use the mark on the goods included in the specification.

10) I note that in a recent case, *Wyeth v. Knoll Aktiengesellschaft* [EWHC 2002 899 (CH)] Neuberger J. stated:

“34. It may therefore be that, if a proprietor loses (or is refused) a UK trade mark, or, indeed a UK extension of an international registration, purely because of the width of the specification claimed, pursuant to the requirements of section 32(3) of the 1994 Act, that may be inconsistent with the Directive. Indeed, I think there may be an argument to the effect that the provisions of section 32(3) of the 1994 Act are of questionable validity in these circumstances, but that is not a point which it is appropriate for me to consider further in this application. All I would say is that the fact that there is no equivalent of section 32(3) of the 1994 Act in the Directive means

that this Court should be reluctant, rather than eager, to find in favour of the sort of argument raised by the claimant here.”

11) The provisional finding in favour of the opponent under Section 3(6) cannot be maintained. The ground of opposition under Section 3(6) fails.

12) As the ground of opposition under Section 3(6) has failed the opposition to the application has failed in toto. The applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £1635. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14<sup>TH</sup> day of October 2002

George W Salthouse  
For the Registrar  
The Comptroller General