

In the matter of an interlocutory hearing to consider a request to strike out evidence in proceedings in relation to application No. 2205212 in the name of Red Letter Days plc and opposition No. 51367 thereto by Redenvelope Inc

Background

1. Trade mark application No. 2205212 was applied for by Red Letter Days plc on 6 August 1999 and published for opposition purposes on 31 May 2000. Following publication, notice of opposition was filed by Redenvelope Inc. which was subject to some amendment following examination. The applicant subsequently filed a counterstatement defending the application.
2. After a number of extensions of the period allowed for so doing, the opponent filed evidence to support his opposition. The applicant was then set a period within which to file evidence in support of the application. Evidence was filed within the period allowed. That evidence included a statutory declaration of Alan Michael Fiddes dated 25 October 2001.
3. Following receipt of the applicant's evidence, the opponent was set a period within which to file any evidence in reply. The opponent subsequently requested an extension of this period, a request which ultimately resulted in an interlocutory Hearing where the Hearing Officer refused the request. That is now the subject of an appeal to the Appointed Person but that has no bearing on the matter before me. In the meantime, however, and by way of a letter dated 20 March 2002, the opponent alleged that the evidence filed by Mr Fiddes, and which they referred to as a witness statement, did not in fact adduce any evidence and, as it did not satisfy the requirements of rule 55(4) of the Trade Marks Rules 2000 and Rule 32.4.5 of the Civil Procedure Rules (CPR), should be struck out of the proceedings.
4. The registry issued a letter to the applicant inviting them to comment on the request for striking out. The applicant responded pointing out that the documentation filed was not a witness statement but a statutory declaration, that the rules referred to by the opponent did not relate to statutory declarations and were therefore inapplicable and that the reference to rule 32.4.5 of the CPR was, in any event an incorrect reference. Accepting that the documents did contain some comment, this was, they claimed relevant and in the nature of expert evidence. The applicant asserted that the statutory declaration was evidence and should be admitted into the proceedings.
5. The opponent wrote to the registry by way of a letter dated 3 July 2002 asking to amend the application to strike out, by substituting a reference to CPR rule 32.1 for CPR

rule 32.4.5. This letter crossed in the post with a letter from the registry also dated 3 July 2002, which stated in essence that the statutory declaration contained a mixture of submissions and evidence but refusing the application for striking out of the evidence.

6. The opponent wrote a further letter dated 11 July 2002 requesting clarification of which parts of Mr Fiddes' declaration were regarded as submissions and which evidence. The registry rather unhelpfully responded declining to clarify the matter. Before this letter was issued, however, the opponent sought to be heard. That hearing took place before me, via videoconference link, on 22 August 2002. Ms Cheng Tan of Field Fisher Waterhouse represented the opponent, Mr Fiddes of DLA represented the applicant. Both sides filed a skeleton argument. At the hearing, I determined that the statutory declaration of Mr Fiddes should be admitted into the proceedings subject to the striking out of certain paragraphs within that declaration, allowing only paragraphs 1,2,5 and 7 to remain. I am now asked to give a statement of my reasons for my decision.

Mr Fiddes' Declaration

7. Mr Fiddes' declaration runs to 14 paragraphs and has two exhibits. The declaration can be summarised as follows:

- Para 1: Mr Fiddes identifies himself,
- Para 2: confirms that he has read and reviewed the opponent's evidence,
- Para 3: alleges that a US application the opponent relies on in his notice of opposition is irrelevant to a UK opposition,
- Para 4: alleges that two community applications relied on by the opponent are irrelevant to this opposition,
- Para 5: contains commentary on the opponent's case and to the protection of marks under the Paris Convention. The paragraph also introduces the first exhibit, an extract from the USPTO database which the applicant says, show relevant dates rebutting the opponent's claims,
- Para 6: comments on the contents of the opponent's evidence and highlights alleged deficiencies in that evidence,
- Para 7: introduces the second exhibit. This is a database printout which seeks to rebut claims made by the opponent in his evidence regarding date of use,
- Paras 8-10: criticises part of the opponent's evidence,
- Para 11: criticises part of the opponent's evidence and asks for one of the opponent's exhibits to be deemed inadmissible,

- Para 12: criticises the totality of the opponent's evidence,
- Para 13: rejects one of the opponent's grounds of opposition,
- Para 14: comments on and rejects several of the opponent's grounds of opposition.

Submissions

8. Both parties filed a skeleton argument. The hearing was lengthy but the submissions from the parties can be summarised as follows. Ms Tan defined the meaning of evidence, referring to Phipson on Evidence (15th ed. Sweet & Maxwell), as being the means by which the court is informed as to the issues of fact. She referred me to rule 32.1 of the CPR which, she said, gave the power to exclude evidence. She went on to assert that no part of Mr Fiddes' statutory declaration constituted evidence; it was instead merely commentary and legal submissions. It was, she said, an abuse of process to admit submission at such an early stage in the proceedings and would be detrimental to the opponent's case to do so.

9. One of the exhibits filed by Mr Fiddes was, she said, a mere duplicate of what had already been referred to by the opponent in his evidence and there was therefore no need to file it again. Despite his earlier claims, she said, Mr Fiddes was not an expert witness, he was not independent and his submissions were not needed by the registrar at this stage in the proceedings. To accept the statutory declaration into the proceedings would mean the registry would be abdicating the decision in the case to a witness. It was, she said, an abuse of process and would prejudice the eventual Hearing Officer in his/her decision on the substantive issues.

10. Mr Fiddes argued that the opponent's objections were an attempt to delay the proceedings. He accepted that his statutory declaration did contain some commentary, but stated that it was intended to assist the Hearing Officer and was a matter for that Hearing Officer deciding the substantive issue to decide what weight to give that evidence. In any event, he said, key elements of his statutory declaration were statements of fact and there were no reasons why previously filed documents could not be refiled. He agreed that the evidence was prejudicial to the opponent's case but that was, he said, because it showed they had no case. There was, he said, nothing in the declaration which should not be admitted as evidence.

11. In reply, Ms Tan argued that it was prejudicial for the applicant to talk about the opponent seeking to delay the proceedings. The opponent is entitled to challenge what it regards as inappropriate use of evidence. The opponent, she said, was neither intending to delay matters nor to add costs. It was not an abuse of process to bring the best case for a client.

Decision

12. Taking account of all the submissions made, I reached the view that the statutory

declaration would be admitted into the proceedings but would be subject to some striking out. I decided that only paragraphs 1,2,5 and 7 should remain. In reaching this decision, I made it clear that I was making no comment on the weight that would be attached to those remaining paragraphs, this remained a matter for the Hearing Officer who will eventually hear the substantive action.

13. Evidence is accepted by the registry in a number of different forms. In this case, and despite some initial confusion on the opponent's behalf, the evidence the applicant seeks to adduce has been filed in the form of a statutory declaration. Having been filed in this form, I did not regard the reference to rule 55(4) of the Trade Marks Rules as relevant to my consideration of the application to strike out. This is because rule 55(4) refers to witness statements and statements of truth rather than statutory declarations.

14. I was also referred to CPR Rule 32.1 (1) which sets out the Court's power to give directions to control evidence. I did not consider that this was relevant to my considerations. The Trade Marks Rules contain specific powers to allow the filing of evidence by statutory declaration (rule 55(1)). And it is well established that the Registrar has an inherent jurisdiction to regulate procedures before her, including procedures involving the filing of evidence. I believe these specific and inherent powers are sufficient to enable me to consider the application to strike out evidence.

15. Whichever form in which it appears, evidence is the means, apart from argument and inference, intended to prove or disprove a matter of fact. I referred the parties to Laddie J's comments in *Dualit Ltd v Rowlett Catering Appliances Ltd* [1999] FSR 865 where he said:

“the function of the Registry is [-] to consider oppositions, and [-] the parties must put before the Registry the material which is to be relied upon in support of their cases”.

He went on to say:

“it is [-] important that it is brought home to litigants that they must put the best evidence available to them before the Registry”.

16. It is, of course, a matter for the parties themselves to determine what comprises their “best evidence”. But whatever “best evidence” may be, it is well accepted that evidence is not the appropriate vehicle for legal submissions.

17. Mr Fiddes admitted that his statutory declaration does contain some commentary but he went on to say that it also contains factual information. He argued that the evidence as a whole was intended to assist the Hearing Officer reach his decision and ensure that the real facts of the opposition were concentrated upon.

18. The Registry's Hearing Officers are experienced and highly trained individuals. They are well able to identify the issues to be decided, to review evidence and to determine the relevant merits of the parties respective cases based on that evidence. Ms Tan referred me

to the case of *Alex Lawrie Factors Ltd v Morgan and others* (The Times, 18 August 1999) to support her view that evidence is not the place for complex legal argument. I agree with this view. But this does not mean that submissions and opinion have no place in opposition proceedings. It is simply that the filing of evidence is not the proper place. I am supported in this by the comments of Geoffrey Hobbs QC sitting as the Appointed Person in the case of *Mary Wilson Enterprises Inc v Lynda Lawrence and Scherrie Payne* (26 February 2002, unreported) where he said;

“it is an unhealthy practice in registry proceedings for submissions and rhetoric [-] to come in in statutory declaration form. I am not in favour of it”.

19. The proper place for submission and argument is in skeleton argument and via oral representation at a hearing or, alternatively, via written submissions in lieu of attendance where a decision is being taken from the papers and without recourse to a hearing.

20. On Mr Fiddes’s own admission, his statutory declaration contains commentary and submission. Leaving aside paragraphs 1 and 2 which contain preamble of a general nature, the statutory declaration contains 12 “substantive” paragraphs. I had no hesitation in rejecting the majority of these paragraphs as mere commentary. It seemed to me, however, that there is at least an arguable case that paragraphs 5 and 7 contain something which may be more than mere commentary. I cannot assume how the applicant intends to rely on the evidence he adduces but it seems to me that as there is at least an arguable case that these two paragraphs seek to adduce evidence of a factual nature, being database printouts containing dated information, they should be admitted into the proceedings.

21. In determining that all paragraphs except paragraphs 1, 2 5 and 7 should be struck out, I made it clear to the parties that I made no comment on the weight to be attached to these remaining paragraphs. That remains a matter for the Hearing Officer who eventually hears the substantive issues, taking into account all the evidence admitted into these proceedings.

Dated this 12th day of November 2002

Ann Corbett
Hearing Officer
For the Registrar, the Comptroller General