

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 90599

IN THE NAME OF UNITERS SpA

TO APPLICATION No. 2199661A

IN THE NAME OF KML INVEST AB

DECISION

1. On 20th May 2002 Uniters SpA (*“the Opponent”*) filed a Notice of Opposition on Form TM7 to Trade Mark Application 2199661A proceeding in the name of KML Invest AB (*“the Applicant”*). The Notice was accompanied by a Statement of Grounds of Opposition as required by Rule 13(1) of the Trade Marks Rules 2000. The Statement of Grounds was amended on 12th June 2002 in response to a request for clarification raised by the Registrar.

2. On 17th June 2002 the Registrar sent copies of the Notice and amended Statement of Grounds to the Applicant. The Applicant then had a legislatively prescribed period of 3 months expiring on 17th September 2002 within which to defend the opposition by filing a counter-statement *“in conjunction with notice of the same on Form TM8”*: Rule 13(3). The prescribed period of 3 months could not be extended: see Rules 68(1) and 68(3).

3. On 17th September 2002 the Applicant inadvertently filed a Counter-Statement without the Form TM8 that was intended to accompany it. The Registry informed the Applicant that its failure to file a Form TM8 within the prescribed period left the Registrar with no alternative but to treat the opposed application for registration as withdrawn in accordance with the provisions of Rule 13(6): *“where a notice and counter-statement are not filed by the applicant within the period prescribed by paragraph (3) he shall be deemed to have withdrawn his application for registration”*.

4. The Applicant requested a hearing at which to argue against the imposition of the sanction for default. The hearing took place before Mr. C J Bowen acting on behalf of the Registrar. For the reasons given in a written decision issued on 2nd April 2003 the hearing officer held that there had been a default under Rule 13(3) which could not be cured, thus allowing no escape from the conclusion that Application 2199661A must be deemed withdrawn under Rule 13(6).

5. The Applicant gave notice of appeal to an Appointed Person contending: (i) that it had, in substance, complied with the requirements of Rule 13(3); and (ii) that even if it had not, it could and should be granted relief or dispensation from the provisions of Rule 13(6) so as to enable it to rely on the Notice on Form TM8 which it had sent to the Registry out of time under cover of a letter dated 25th September 2002. The arguments on which it relied were essentially the same as those which the hearing officer had rejected in the decision under appeal.

compliance?

6. The Applicant's Counter-Statement filed on 17th September 2002 was said to have satisfied the requirement in Rule 13(3) for the filing of "***a counter-statement in conjunction with notice of the same on Form TM8***" on the basis that it could be combined with the letter under cover of which it had been sent to the Registry so as to provide an acceptable alternative to Form TM8 within the latitude allowed by Rule 3(2).

7. Section 66 of the Trade Marks Act 1994 provides:

Power to require use of forms

66. (1) The registrar may require the use of such forms as he may direct for any purpose relating to the registration of a trade mark or any other proceeding before him under this Act.

(2) The forms, and any directions of the registrar with respect to their use, shall be published in the prescribed manner.

Rule 3 of the Trade Marks Rules 2000 further provides:

Forms and directions of the registrar under s.66

3. (1) Any forms required by the registrar to be used for the purpose of registration of a trade mark or any other proceedings before her under the Act pursuant to section 66 and any directions with respect to their use shall be published and any amendment or modification of a form or of the directions with respect to its use shall be published.

(2) A requirement under this Rule to use a form as published is satisfied by the use either of a replica of that form or of a form which is acceptable to the registrar and contains the information required by the form as published and complies with any directions as to the use of such a form.

8. The purpose of Rule 3(2) is to allow inexact equivalents of the prescribed forms to be used with the approval of the Registrar. The essential features and functions of the prescribed forms must be preserved. The Registrar is able to decide whether departures from the prescribed forms are acceptable, but cannot exempt anyone from the obligation to use an acceptable form as and when required by the substantive provisions of the Act and the Rules.

9. In Re M's Application [1985] RPC 249 the importance of insisting upon the use of prescribed forms was explained by Falconer J. at p.260 in the following terms:

“..... it means that the Office knows at once how to process a document coming in. If there were not prescribed forms for the very many steps which have to be taken, an application or a step in an application might be taken in any form at all and, as it was put, the Office could not as a practical matter operate and the only sensible system is to have prescribed forms for the various steps which have to be taken, as a matter of practicality and, indeed, workability. However that may be, under the statute it is mandatory that the prescribed form shall be used, and it is mandatory that you pay the prescribed fee; and I cannot regard mandatory requirements under the statute as being matters of form and not of substance.”

In the same case on appeal, Oliver LJ observed at p.271:

The whole rationale of prescribing forms for time-critical documents is that they have to be received and filed, as a matter of ordinary Office administration, by staff who have neither the time nor the qualification to read, digest and reply to letters. Thus substantially all the time limits which are laid down by the Rules are related to the filing of forms or documents, rather than correspondence. Mr. Laddie has submitted that this is really what underlies the whole system.

The failure to file a prescribed form at the Patent Office within the specified period was held to be an irregularity which could not be cured under the rules applicable to the proceedings in question.

10. Most (perhaps all) of the information which would have been set out in a duly filed Form TM8 could be gleaned from the Applicant's Counter-Statement and covering letter. However, it could not be said that such information was presented to the Registry in a form which was either a replica of the required Form TM8 or an inexact but acceptable equivalent of it. In reality, the Counter-Statement and the covering letter did not separately or together constitute "*a counter-statement in conjunction with notice of the same on Form TM8*" and the Applicant did not intend or expect them to perform the function of a Form TM8 when it sent them to the Registry on 17th September 2002. I agree with the hearing officer in thinking that the Registrar had no alternative on 18th September 2002 but to apply the sanction specified in Rule 13(6) to Application 2199661A because the Applicant had not done everything necessary to comply with the requirements of Rule 13(3) within the legislatively prescribed period of 3 months.

relief or dispensation?

11. Rules 68(1) and 68(3) leave no room for the suggestion on behalf of the Applicant that the time for filing the required Form TM8 could (even though the time for filing a counter-statement "*in conjunction*" with it could not) be extended by the Registrar.

12. There is also no room for the suggestion that Rule 57 or Rule 66 could and should have been used to save Application 2199661A from deemed withdrawal under Rule 13(6).

13. Rule 57 provides that:

At any stage of any proceedings before the registrar, she may direct that such documents, information or evidence as she may reasonably require shall be filed within such period as she may specify.

The Registrar could not reasonably require an applicant for registration to file a Form TM8 in defence of opposition proceedings at a time when the application in suit was deemed withdrawn under Rule 13(6).

14. Rule 66 provides as follows:

Subject to Rule 68 below, any irregularity in procedure in or before the Office or the registrar, may be rectified on such terms as the registrar may direct.

The power conferred by this Rule is expressly subject to Rule 68 (which prevents extension of the period for filing a Form TM8 in defence of opposition proceedings). It is also interstitial: it cannot be used to thwart the intended effect of other provisions of the Act and the Rules: E's Application [1983] RPC 231 (HL). It therefore cannot be used to provide the Applicant with relief or dispensation from the unequivocally expressed provisions of Rule 13(6).

15. I regret that I am unable to grant the Applicant relief or dispensation. I would have allowed it to rely on the Form TM8 which it sent to the Registry on 25th September 2002 if I could have found a way of enabling it to do so in accordance with the Act and the Rules. However, the provisions of Rules 13(3), 13(6), 68(1) and 68(3) are too stringent and explicit to be denied their full meaning and effect.

Conclusion

16. At the end of the hearing before me, I dismissed the Applicant's appeal for reasons to be given in writing in due course and directed the Applicant to pay the Opponent £875 by 27th January 2004 as a contribution towards its costs of the unsuccessful appeal. That order and direction are hereby confirmed.

Geoffrey Hobbs QC

20th January 2004

Mr. Doug McCall of Messrs W.P. Thompson & Co appeared on behalf of the Applicant.

Mr. Simon Malynicz instructed by Clifford Chance LLP appeared as Counsel for the Opponent.

The Registrar was not represented.