

1 THE PATENT OFFICE

2 Tribunal Room 2  
3 Harmsworth House,  
4 13-15 Bouverie Street,  
5 London, EC4Y 8DP.

6 Friday, 30th April 2004

7 Before:

8 MR. G. HOBBS Q.C.  
(Sitting as the Appointed Person)

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10 In the Matter of the Trade Marks Act 1994

11 and

12 In the Matter of Trade Mark Application No. 2317497 by  
13 THE PROCTER & GAMBLE COMPANY

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15 Appeal of Appellants from the decision of Mr. Rose'Meyer  
acting on behalf of the Registrar dated 28th January 2004.

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17 (Computer Aided Transcript of the Stenograph Notes of Marten  
18 Walsh Cherer Ltd., Midway House, 27/29 Cursitor Street,  
London, EC4A 1LT. Telephone No: 0207 405 5010.  
19 Fax No: 0207 405 5026.)

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21 MISS D. McFARLAND (D. Young & Co) appeared on behalf of the  
Appellant.

22 MR. JAMES (representing the Registrar) appeared for the  
23 Comptroller-General of Patents etc.

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25 DECISION ON APPLICATION TO ADDUCE FRESH EVIDENCE

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2 DECISION ON APPLICATION TO ADDUCE FRESH EVIDENCE  
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4 THE APPOINTED PERSON: The case law clearly establishes that it is  
5 necessary in appeals under section 76 of the Trade Marks Act  
6 for due deference to be given to the decisions of the  
7 Registrar's hearing officers. For that to be a workable  
8 approach, all parties to Registry proceedings must exercise  
9 due diligence in the preparation and presentation of their  
10 cases at first instance. It has been emphasised on more than  
11 one occasion that proceedings before the Registrar are not to  
12 be regarded as a dry run for the purpose of deciding how a  
13 case might subsequently be improved on appeal.

14 In the present case it is said on behalf of the appellant  
15 that the need for evidence was not fully appreciated, either  
16 until the hearing officer's decision was issued on 28th January  
17 2004, or until the antecedent hearing took place on 2nd  
18 September 2003. However, looking at the official letter of  
19 14th April 2003 setting out the Registrar's objection to  
20 registration under section 3(1)(b), and looking at the note of  
21 the Registry hearing on 2nd September 2003, it appears to me  
22 that the Registrar's position was sufficiently and  
23 satisfactorily made clear to the appellant to enable it, if it  
24 wished to do so, to file evidence in refutation of the  
25 objection that was being taken against its application for  
26 registration.

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Two factors seem to have intruded here. The first is that the appellant's representative preferred to proceed on the basis that there was something in the nature of an onus on the Registrar's hearing officer to explain why the objection to registration should be maintained in the face of her submissions. The second is that a decision appears to have been taken in the aftermath of the hearing on 2nd September 2003 to ask for a formal decision of rejection so as to pave the way for an appeal at which the question of registrability could be debated afresh.

I wish to emphasise that it is a misconception to assume or suggest that the Registrar's hearing officers are under a duty in relation to objections to registration to support their position with evidence. They are under an obligation to make the basis of objection clear and to give the applicant a fair and reasonable opportunity to deal with it. It is then a matter for the applicant to decide whether he can improve his position by putting forward evidence that the Registrar may find persuasive. These principles are clear on the authorities as they currently stand. I refer to the decision in EUROLAMB Trade Mark [1997] RPC 279 at 288 which was endorsed by the Court of Appeal in Procter & Gamble's Trade Mark Application [1999] RPC 673 at 675 per Robert Walker LJ, and also to later cases, such

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2 as Case C-104/01 Libertel Groep BV (6th May 2003) in which the  
3 European Court of Justice emphasised the need for stringent and  
4 full examination by the registration authorities, and the later  
5 judgment in Case C-363/99 Postkantoor (12th February 2004)  
6 where, in paragraphs 121 to 126, the same point was made and it  
9 was further emphasised that there is nothing in the nature of a  
10 benefit of the doubt operating in favour of applicants for  
11 registration.

11 I think it is clear that there was an adequate  
12 opportunity for the appellant to file evidence in support of  
13 its position, if it wished to do so, and it chose, for reasons  
14 of its own, not to avail itself of that opportunity.

15 The important factors in relation to the current  
16 application for leave to adduce further evidence are, firstly,  
17 the absence of any satisfactory explanation as to why the  
18 evidence was not filed in the Registry at the due time and,  
19 secondly, that the evidence has minimal, if any, relevance in  
20 relation to the issues that fell to be decided by the hearing  
21 officer and fall to be considered by me, bearing in mind that  
22 the matter in question is the registrability of a mark in the  
23 absence of any claim to distinctiveness acquired through use.  
24 The application contemplates a relaxed approach to evidence and  
25 procedure that I am not prepared to condone. I therefore

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2 propose to exercise my discretion adversely to the  
3 appellant by refusing the application to adduce  
4 fresh evidence on appeal.

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