O-106-08

TRADE MARKS ACT 1994

IN THE MATTER OF AN INTERLOCUTORY HEARING IN RELATION TO OPPOSITION NO. 95651 TO APPLICATION NO 2451198 IN THE NAME OF G P AND C A GRANT

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IN THE MATTER OF an interlocutory hearing held in relation to opposition No. 95651 to application No. 2451198 in the name of G P and C A Grant.

Background

1. Application No 2451198 stands in the name of G P and C A Grant and was published for opposition purposes in Trade Marks Journal 6697 on 17 August 2007.

2. On 14 November 2007 a Form TM 7, notice of opposition, was filed at the Trade Marks Registry (TMR) together with the appropriate fee.

3. Box 3 of that Form requires the full name and address (including postcode) of the opponent. The form was completed by hand and details for the opponent were given as follows:

TIM BOOTH
IWANTONEOFTHOSE.COM LTD
UNIT C11
PARKHALL TRADING ESTATE
40 MARTELL ROAD
LONDON
SE21 8EN

4. Box 4 of the form requires the filer to provide details of any agent. This was left blank. Box 8 of the same form requires the name and daytime telephone number of the person who should be contacted in case of a query. This indicated the contact to be Tim Booth.

5. On 16 November 2007 a letter was sent, by the TMR, to Graham F. Coles, the applicants' agent notifying it of the opposition. The opponent was identified as Tim Booth, Iwantoneofthose.com LTD.

6. Following receipt of this letter Mr Coles, of Graham F. Coles, telephoned the TMR requesting clarification of the name of the opponent. As a result of that telephone conversation the TMR telephoned Tim Booth, as the nominated contact, to confirm the position.

7. Mr Booth confirmed that his name had been included on the form for contact purposes only and that the opponent was IWANTONEOFTHOSE.COM LTD. The TMR, via the telephone, notified Mr Coles of this and issued a letter to both parties showing IWANTONEOFTHOSE.COM LTD as the opponent. The letter indicated that the relevant date for the applicant to file any Form TM 8 and counterstatement remained 16 February 2008 (and these were subsequently filed within this period).

8. Notwithstanding the above, the TMR received a letter, dated 30 November 07, from Mr Coles indicating that two named officers at the TMR had previously confirmed that the opponent was Tim Booth and that a confirmation letter to that effect would be sent to him. I mention in passing that I cannot comment on any such telephone conversations; I am required to consider matters afresh. His letter goes on to state:

> "I would respectfully draw your attention to the Law Practice Direction of the Office entitled 'Substitution of Opponents in Inter Partes Proceedings' and in particular the final paragraph which states 'where the Registrar is asked to allow a new party to be added or substituted as the opponent and the request is not due to a transfer of the rights to a pending application or a registered mark this may not be allowed'
>
> In the light of this, and particularly as the opposition period had already expired, it seems extraordinary that the Office would contact who you refer to as 'the Opponent' (presumably Mr Booth, but we are not too confused to be sure of this) and agree to substitute Iwantoneofthose. Com Ltd as the opponent.
>
> Notwithstanding what Mr Booth (or whoever it was that you contacted) may or may not say about what he intended, the Opponent's name and address were given on the TM7 as:
>
> TIM BOOTH
> IWANTONEOFTHOSE.COM LTD
> UNIT C11
> PARKHALL TRADING ESTATE etc.
>
> Although it might be argued that this could conceivably include joint opponents Tim Booth and Iwantoneofthose.com Ltd, both of the same address, it clearly does not indicate that Iwantoneofthose.com Ltd is the sole Opponent, if at all.
>
> Furthermore, Iwantoneofthose.com LTD is not the name of any Limited Company registered in the United Kingdom. There is a UK Registered Company under a slightly different name "I Want One Of Those.com Limited" but this is at a different address to that given in the TM7.
>
> It is therefore unclear whether Iwantoneofthose.com LTD is a trading name of Mr Booth (and that the Opponent is in fact Mr Booth operating under a different name) or whether it is a legal entity in its own right and if the latter, what its precise identity is. In all of these circumstances, it is submitted that the Opponent has not been properly identified.
>
> Since Iwantoneofthose.com Ltd did not identify itself as the Opponent originally or within the opposition period, and since furthermore the identity of Iwantoneofthose.com LTD is unclear, the Applicant does not accept that the opposition can be valid in the name of Iwantoneofthose.com LTD.

> The applicant therefore requests that the opposition should not be permitted to proceed."

9. In a letter, dated 15 January 2008, the TMR informed Mr Coles that the comments of his letter had been noted, but it was the TMR's preliminary view that the opponent in these proceedings is Iwantoneofthose.com Ltd, and that Mr Booth only stated his name in Box 3 of the Form TM7 for contact purposes.

10. In a letter to the TMR, dated 29 January 2008, Mr Coles disagreed with the preliminary view and requested a hearing under Rule 54(1) of the TM Rules 2000 as amended. He provided reasons as to why he disagreed with the preliminary view, the main points are summarised below:

- As completed the Form indicates the opponent is Tim Booth:
- The claim by Tim Booth that his name was added for contact purposes is not credible since a contact name is required in Box 8 of the Form, therefore including it in Box 3 is superfluous:
- If Iwantoneofthose.com was intended to be the sole opponent the information should have been represented as: IWANTONEOFTHOSE.COM LTD c/o Tim Booth etc:
- As filed the opponent is either Tim Booth or Tim Booth and Iwantoneofthose.com as joint opponents:
- The removal of the name Tim Booth is not allowed in view of the Law Practice Direction entitled 'Substitution of Opponents in Inter Parte Proceedings:

11. Also in this letter, at paragraph 2, Mr Coles provides details of the telephone and letter exchanges that took place between the TMR and himself between 16 and 21 November 07.

12. Given Mr Cole's objection to the registrar's preliminary view a hearing was appointed and took place before me on 6 March 2007. Ahead of the hearing, on 18 February 2008, the TMR received a Form TM33 appointing Hammonds as agent for the opponent. At the hearing Mr Cole represented the applicant and Mr Mcleod, of Hammonds, represented the opponent. The issue before me was whether the removal of the name 'Tim Booth' from the TM 7 should be allowed.

13. At the conclusion of the hearing I reserved my decision. Having taken all relevant material and submissions into account I advised the parties of my decision by letter, which was initially sent by fax, the following day. The letter dated 7 March 08, stated:

> "It is my view that the removal of the name 'Tim Booth' from the form TM 7 does not constitute a substitution of opponent, but merely clarifies who is the opponent in these proceedings. I consider that it would have been prudent for the Registry to have sought this clarification before serving the TM7 on the applicant.

14. The applicant filed a Form TM 5, on 7 March 2008, seeking a full statement for my decision. This I now give.

The Hearing and submissions

15. Both parties filed skeleton arguments prior to the hearing. At the hearing Mr Coles took me through the skeleton argument and did not introduce any additional points for consideration, other than costs which I will deal with later in the decision.

16. The opening paragraph of Mr Coles' skeleton indicates that the applicants' seek clarification as to the identity of the opponent. Much of the skeleton consists of an account of the events since the Form TM 7 was served on the applicant, and this has been summarised above. In addition, Mr Cole submits, at paragraph 14 of the skeleton, that 'Box 3 of the TM7 is unambiguous in calling for the name and address of the Opponent. Its completion requires no specialist knowledge or skill other than a basic understanding of the English language…'. Paragraph 16 states that the applicant received no notice of intention to oppose prior to the opposition being filed; I did not consider this a relevant factor in deciding the matter in hand. Paragraphs 17 through to 19 are stated as follows:

> "17. In subsequent correspondence with us initiated by Hammonds, the representative of IWOOT, (shortened by Mr Coles from Iwantoneofthose.com Ltd) they have suggested that it is clear that it is IWOOT rather than Mr Booth that has the commercial interest in this case and this shows that the company and not Mr Booth should be the Opponent.
>
> Since the grounds of Opposition are based only on Section 3 of the Trade Marks Act, the Opposition can be filed by a person as provided by Section 38(2) of the Trade Marks Act 1994 and there is no requirement for that person to have any commercial interest in the Application.
>
> 18. It might nevertheless be thought that IWOOT has a greater commercial interest in opposing this particular Application than has Mr Booth personally; making it more likely that IWOOT is the intended Opponent.
>
> However, Mr Booth is not only the director of IWOOT, but also at least three other companies: I Want One of Those Limited, I Want Lots of Those. Com Limited and Online Shopping Services Limited and is furthermore Company Secretary of Broadstar Creative Consultants Limited.
>
> It is entirely possible that Mr Booth's personal commercial interests include these and other businesses. Prima facie therefore Mr Booth personally may well have more reasons to oppose the Application than does IWOOT.
>
> 19. Hammonds have further indicated in correspondence with us that Mr Booth's interests and those of IWOOT are fully aligned and that IWOOT would fully support Mr Booth should he be confirmed as the Opponent. In these circumstances we cannot see that either IWOOT or Mr Booth would suffer any disadvantage arising from the confirmation of Mr Booth as the Opponent, irrespective of his original intentions."

17. Mr Macleod's skeleton argument states, *inter alia*,

> "On the basis of the factual evidence I WANT ONE OF THOSE.COM LTD is the correct opponent in these proceedings. I WANT ONE OF THOSE.COM LTD and Tim Booth both intend, and have always intended, that I WANT ONE OF THOSE.COM LTD should be the opponent.
>
> If Tim Booth made a mistake when completing the TM 7 rendering the identity of the opponent ambiguous, this should be treated as a procedural irregularity before the office which the Registrar has the discretion to rectify under rule 66 of the Trade Marks Rules 2000 in such manner as it may direct.
>
> As far as the opponent is aware, whether the opponent is Tim Booth or I WANT ONE OF THOSE.COM LTD will make little difference to the conduct of these proceedings. However, in light of the applicant's insistence that the opponent must be Tim Booth and its failure to provide any further explanation as to the basis for this, the opponent has been forced to presume that there is a motive of which it is unaware. It has therefore felt unable to agree that the opponent could be Tim Booth.
>
> If despite the Registry's preliminary ruling and the opponent's arguments, Tim Booth is found to be the correct opponent, the names of the parties should be substituted. The opponent disagrees with the applicant's argument that substitution is not permitted by the Law Practice Direction of the Office entitled "Substitution of opponents in inter parte proceedings". This direction is derived from Pumfrey J's decision in *Pharmedica GmbH's trade mark application ([2000] RPC 536)* and this High Court judgement makes it clear that the Registrar has a wide discretion to permit substitution where the circumstances are appropriate.
>
> On receiving notification of the hearing date the opponent contacted the applicant by telephone in an attempt to understand its arguments and its request for the hearing. Despite this telephone call and the correspondence that ensued, the opponent has been unable to resolve the matter, it is still unclear as to the applicant's reasoning and, as explained above, has therefore been unable simply to agree that the opponent should be Tim Booth. The opponent's view is that I WANT ONE OF THESE.COM LTD is the correct opponent and that this hearing was completely unnecessary. The applicant should have clarified its argument in an attempt to resolve this matter without the need for a hearing."

18. In paragraphs 6 to 9 of the skeleton Mr Mcleod provides what appears to me be a satisfactory explanation regarding the legal status and address of Iwantoneof those.com LTD, which was raised in correspondence by Mr Cole (see paragraph 8 above). Since Mr Coles has made no further mention of this issue, in either his skeleton argument or in oral submissions at the hearing, I interpret that as indicating that the issue is no longer being pursued, and therefore make no further reference to it in this decision.

The Decision

19. Opposition against registration of an application is provided for under Section 38 of the Trade Marks Act 1994. It states:

> **"38.**- (1) …..
>
> (2) Any person may, within the prescribed time from the date of the publication of the application, give notice to the registrar of opposition to the registration.
>
> The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.
>
> (3)….."

20. Section 38 is underpinned by Rule 13 of the Trade Marks Rules 2000 (as amended) which states:

> "**13 Opposition proceedings: filing of notice of opposition; s38(2) (Form TM7)**
>
> (1) Any notice to the registrar of opposition to the registration, including the statement of grounds of opposition, shall be filed on Form TM7.
>
> (1) (A) The time prescribed for the purposes of Section 38(2) shall be the period of three months beginning with the date of which the application was published.
>
> (2) Where the opposition is based on a trade mark which has been registered, there shall be included in the statement of the grounds of opposition a representation of that mark and-
>
> (a) the details of the authority with which the mark is registered;
> (b) the registration number of that mark;
> (d) the goods and services in respect of which-
> (i) that mark is registered; and
> (ii) the opposition is based; and
> (e) where the registration procedure for the mark was completed before the start of the period of five years ending with the date of publication, a statement detailing whether during the period referred to in section 6A(3)(a) the mark has been put to genuine use in relation to each of the goods and services in respect of which the opposition is based or whether there are proper reasons for non use (for the purposes of rule 13C this is the "statement of use").
>
> (3) Where the opposition is based on a trade mark in respect of which an application for registration has been made, there shall be included in the statement of the grounds of opposition a representation of that mark and those matters set out in paragraph (2)(a) to (d), with references to registration being construed as references to the application for registration.

(4) ….

(5) The registrar shall send a copy of Form TM7 to the applicant and the date upon which this is done shall, for the purposes of rule 13A, be the "notification date"."

21. For the purposes of this decision it is boxes 3 and 8 of the Form TM7 that are relevant. Box 3 required the full name and address (including postcode) of the opponent. It was completed, by hand, in the following way:

TIM BOOTH
IWANTONEOFTHOSE.COM LTD
UNIT C11
PARKHALL TRADING ESTATE
40 MARTELL ROAD
LONDON
SE21 8EN

22. Box 8 requires the name and daytime phone number of the person the TMR should contact in case of query. The name TIM BOOTH was given along with a contact telephone number.

23. On 16 November 2007 the TMR served the Form TM7 on the applicant, in accordance with Rule 13. On receipt of this letter Mr Coles queried the identity of the opponent with the TMR. Following a telephone conversation with the nominated contact, identified on the Form TM7, the TMR confirmed the identity of the opponent to be IWANTONEOFTHOSE.COM LTD and informed Mr Coles that the name TIM BOOTH had been included in Box 3 in error.

24. Having considered all the relevant facts in this case, and taking into account the submissions made by both parties, it is my view that the way in which Box 3 of the Form TM7 was originally completed left room for doubt as to the identity of the opponent. This was not initially queried by the TMR but, as indicated in my after hearing letter, I consider that it would have been prudent for this matter to have been clarified before the notice of opposition was served on the applicant. Mr Booth subsequently confirmed that his name had been included in error and that he was the nominated contact only and I accept that explanation. The fact that contact details are requested in Box 8 of the form is not to my mind sufficient reason to doubt the credibility of his information. Mr Mcleod made the point at the hearing that Mr Booth is a lay person, not an attorney or lawyer, and is therefore unfamiliar with the forms of the Registry. He explained that Mr Booth is a company director who has no inherent awareness of the significance of including his name, unlike professional users. Whilst I accept that Mr Booth may not be well versed in trade mark opposition matters, he was the person completing the form and he therefore assumed the responsibility to act competently.

25. Mr Coles suggested that the removal of the name TIM BOOTH should not be allowed as it constitutes a substitution of opponent that is outside the scope of that allowed, as detailed in the published TMR Law Practice Direction. This practice states that:

Where there is a transfer of interest in a mark:

An opponent may cite the existence of an application or registration in their ownership in their grounds of opposition, or may claim to have rights in a mark for which no application has been made. If they later sell or assign these rights, the new owner may ask for their name to be substituted as opponents. If there is an application to record the transfer as a registrable transaction or they can provide suitable documentation to confirm the transfer, the Registrar will usually allow the request subject to any comments made by the applicant. If the applicant objects it may prove necessary to arrange an interlocutory hearing. If the transfer is to be allowed, the new opponent will be asked to provide written confirmation that they:

- have had sight of any forms or evidence filed, if not, they will have to make arrangements with the original opponent
- stand by the grounds or statements made in the Notice of Opposition/evidence and confirm that where the name of the original opponent appears this should be read as though it is made in their name
- are aware of and accept their liability for costs for the whole of the proceedings in the event of the opposition being unsuccessful, to the extent that the new opponents will be asked to provide Security for Costs of an amount to be determined by the Registrar

The new opponent must also provide details of an address for service in the UK.

The transfer will not be allowed until such time as the Security for Costs have been provided.

If the written confirmation as detailed above, and the Security for Costs are not provided, the substitution will not be allowed.

Where there is no transfer of interest:

Where the Registrar is asked to allow a new party to be added or substituted as the opponent and that the request is not due to a transfer of the rights to a pending application or a registered mark, the request may not be allowed.

26. In my view this Practice Direction is not relevant to this decision because I do not consider that there has been any substitution of opponent. The Form TM7 as filed contained two names in the relevant box. The effect of my decision merely removes one of them.

27. In so far as the registrar's inherent jurisdiction to regulate procedures before him, Mr McLeod drew my attention to the comments of Pumfrey J in the **FRISKIES** case ([2000] RPC 536) when he said:

> ".....I have no doubt that the registrar has the power to regulate the procedure before her in such a way that she neither creates a substantial jurisdiction where none existed, nor exercises that power in a manner inconsistent with the express provisions conferring jurisdiction upon her".

28. I accept that the name of TIM BOOTH had been entered in Box 3 of the Form TM7 in error. I therefore use my inherent powers to strike out the name TIM BOOTH from the Notice of Opposition thereby leaving IWANTONEOFTHOSE. COM LTD as the sole opponent.

29. In my after hearing letter I informed the parties that I would arrange for the TMR to serve the Form TM 8 on the opponent and confirm the initiation date unless a request for a full statement of reasons was made. In the event such a request has been made and thus the Form TM 8 regrettably remains unserved pending a possible appeal.

Costs

30. Both parties made submissions on costs. Mr Mcleod was of the view that the hearing had been unnecessary; he stated that it had been made clear in communications between the parties that the opposition would go ahead even if the Registry's preliminary view was reversed and the opponent was deemed to be Tim Booth. Mr Cole on the other hand considered that Mr Mcleod's attendance at the hearing was not obligatory and that the sole reason for requesting the hearing was to obtain clarity as to the name of the opponent. In the event I decided that no costs should be awarded for the reasons stated in my letter dated 7 March 08 and reproduced below:

> Finally I heard submissions on costs. It was the original ambiguity on the Form TM7 completed by Mr Booth that led to this interlocutory dispute, an ambiguity which, in my view, it was perfectly reasonable for the Applicant to have clarified before the proceedings were allowed to continue. Equally, it was entirely appropriate in my view, for Mr Mcleod to attend the hearing to protect his client's position. The clarification of the identity of the Opponent was, I accept, not well handled by the TMR, had it been better handled, I doubt this interlocutory hearing would have been required. Taking all of these factors into account, I do not consider it appropriate to make an award of costs to either party."

31. I have nothing to add to this on the subject of costs.

Dated this 11th day of April 2008

Lynda Adams
For the Registrar
The Comptroller-General