

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
AN INTERLOCUTORY HEARING IN RELATION TO  
OPPOSITION No. 96494 TO APPLICATION No. 2455718  
IN THE NAME OF EUROFINANCE CONFERENCES LIMITED**

**AND IN THE MATTER OF  
AN APPEAL TO THE APPOINTED PERSON  
AGAINST THE DECISION OF MR. M. BRYANT  
DATED 8 AUGUST 2008**

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**DECISION**

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1. Rule 10 of the Trade Marks Rules 2000, as amended, provided:

*Address for service (Form TM33)*

**10.** – (1) For the purposes of any proceedings under the Act or these Rules, an address for service shall be filed by-

- (a) an applicant for the registration of a trade mark;
- (b) any person who opposes the registration of a trade mark in opposition proceedings;
- (c) any person who applies for revocation, a declaration of invalidity or rectification under the Act;
- (d) the proprietor of the registered trade mark who opposes such an application.

(2) The proprietor of a registered trade mark, or any person who has registered an interest in a registered trade mark, may file an address for service on Form TM33.

(3) Where a person has provided an address for service under paragraph (1) or (2), he may substitute a new address for service by notifying the registrar on Form TM33;

(4) An address for service filed under paragraph (1)(a) or (2) shall be an address in the United Kingdom, another EEA State or the Channel Islands.

(5) An address for service filed under paragraph (1)(b) to (d) shall be an address in the United Kingdom, unless in a particular case the registrar directs otherwise.

2. Rule 11 of The Trade Marks Rules 2008 is to similar effect. In particular, paragraphs (1), (4) and (5) are the same.
3. On 16 May 2007, EuroFinance Conferences Limited applied under number 2455718 for registration of the trade mark EUROFINANCE figurative in Classes 16, 35 and 41.
4. The Application was published on 30 November 2007. On 28 February 2007, notice of opposition was filed in the name of Nordnet Securities Luxembourg SA of 70 Grand-Rue, L-1660 Luxembourg. The name and address of the Opponent's agent was stated to be Office Ernest T. Freylinger SA, 234, route d'Arion, PO Box 48, L-8001 Strassen, Luxembourg.
5. The Trade Marks Registry considered that the notice of opposition did not comply with Rule 10(1) and 10(5) of the Trade Marks Rules 2000, as amended, and requested in accordance with Rule 10A that the Opponent supply an address for service in the UK within two months.
6. There followed correspondence between Office Ernest T. Freylinger SA and the Registry, which culminated in an interlocutory hearing before Mr. Mark Bryant, acting for the Registrar, on 12 June 2008. In the meantime, a "care of" address in the UK had been appointed and notified to the Registry in order to protect the Opponent's position on opposition.
7. Office Ernest T. Freylinger SA challenged the requirement for an address for service in the UK (as opposed to its address in Luxembourg) on the following grounds. In short:
  - (a) Rule 10(1) and (5) of the Trade Marks Rules 2000, as amended, and the Registry's request for an address for service in the UK were contrary to Article 49 EC, which guarantees freedom of movement of services within the European Union. The decision of the Court of Justice of the European Communities in Case C-478/01, *Commission of the European Communities v. Grand Duchy of Luxembourg* [2003] ECR I-02351 was particularly relevant.
  - (b) Royal Mail guaranteed postal services at a comparable cost from the UK to EEA destinations, coupled with the fact that Office Ernest T. Freylinger SA had experienced no difficulty in communicating with the UK Trade Marks Registry meant that the Registrar should exercise his discretion under Rule 10(5) to allow the Luxembourg address for service.
8. In a decision issued on 8 August 2008 under reference number BL O/226/08 the Hearing Officer dismissed both those arguments. He decided, in brief:
  - (a) To the extent that Rule 10(1) and (5) of the Trade Marks Rules 2000, as amended, constituted a restriction on the freedom of movement of services, the provisions were justified in the public interest and proportionate (*Galileo*, BL O/177/06). The circumstances of Case C-

478/01, *Commission of the European Communities v. Grand Duchy of Luxembourg* were distinguishable.

- (b) A “particular case” under Rule 10(5) had not been made out. Moreover, it had not been proved that the delivery of items from the UK to another EEA territory was comparable to delivery within the UK in terms of cost, guaranteed delivery times and the availability of online tracking.
9. On 5 September 2008, Office Ernest T. Freylinger SA filed notice of appeal to an Appointed Person under section 76 of the Act. The first and second grounds of appeal were concerned with the legality of Rule 10. The third and fourth grounds of appeal were against the exercise of the Hearing Officer’s discretion under Rule 10(5).
  10. In a letter dated 14 November 2008, The Treasury Solicitors communicated to me the Registrar’s request to refer the appeal to the High Court. The Registrar considered that insofar as the first and second grounds were that UK law was incompatible with the EC Treaty, the appeal clearly raised a matter of general legal importance.
  11. A preliminary hearing on whether the appeal should be referred to the court was appointed for 19 January 2009.
  12. In the meantime, I had become aware of a European Commission press release dated 16 October 2008 (IP/08/1518), which stated that the Commission had decided to send a letter of formal notice under Article 226 EC to the UK over its rules on trade marks and patents. The Commission’s view was that the requirement for parties to have an address for service in the UK for actions relating to trade marks and patents was disproportionate and obstructed the freedom of movement of services as guaranteed under Article 49 EC. I requested through The Treasury Solicitors to see a copy of the Commission’s Reasoned Opinion if such was available.
  13. The Registrar responded to my request in a letter to The Treasury Solicitors dated 8 January 2009. He stated that the UK Government had recently notified the Commission that it intended to bring forward amended legislation permitting without restriction an address for service anywhere in the EEA in contested proceedings before the UK Intellectual Property Office. It was proposed that such changes should take effect on 6 April 2009. It was not proposed that there should be any transitional provisions preserving the existing Rule for actions started prior to 6 April.
  14. Given those developments, the Registrar requested that I stay the appeal until the change in the Rule took effect and thereafter remit the opposition to the Registrar for further processing.
  15. In a letter dated 7 January 2009, Office Ernest T. Freylinger had similarly requested a stay of the appeal pending the UK Government’s response.

16. On 9 January 2009, I gave directions in writing through The Treasury Solicitors that I was minded to stay the appeal in the terms requested by the Registrar. I invited the parties and the Registrar to let me have any written submissions on that proposed course of action by 14 January 2009. The preliminary hearing scheduled to take place on 19 January 2009 would be adjourned unless either party or the Registrar requested otherwise again by 14 January. The only response I received was from Wilbore & Gibbons, the Applicant's trade mark attorneys, agreeing to my proposal.
17. Accordingly, I will order that the present appeal be stayed until 6 April 2009 or the amended legislation described at paragraph 13 of my decision comes into effect. Thereafter, Opposition number 96494 by Nordet Securities Luxembourg SA to Trade Mark Application number 2455718 in the name of Eurofinance Conferences Limited shall be remitted to the Registrar for further processing in accordance with the Act and the Rules. In the meantime, the parties and the Registrar shall be at liberty to reapply to me if the need arises.
18. There will be no order as to costs.

Professor Ruth Annand, 19 January 2009