

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITIONS 95314, 95606 AND 95607

IN THE NAME OF DIAGEO DISTILLING LTD

TO TRADE MARK APPLICATIONS 2432800, 2463987 AND 2463989

IN THE NAME OF PAVEL MASLYUKOV

AND IN THE MATTER OF:

OPPOSITION 95679

IN THE NAME OF PAVEL MASLYUKOV

TO TRADE MARK APPLICATION 2437240

IN THE NAME OF DIAGEO SCOTLAND LTD

**DETERMINATION UNDER SECTION 76(3)
OF THE TRADE MARKS ACT 1994**

The Hearing Officer's Decision

1. For the reasons given in a written decision issued by Mr. David Landau on behalf of the Registrar of Trade Marks under reference BL O-188-09 on 7 July 2009:

- (1) the above-numbered trade mark applications in the name of Mr. Maslyukov were refused pursuant to the above-numbered oppositions in the name of Diageo Distilling Ltd ('**DDL**'); and

(2) the above-numbered opposition in the name of Mr. Maslyukov to the above-numbered trade mark application in the name of Diageo Scotland Ltd ('DSL') was rejected.

2. Mr. Maslyukov's trade mark applications were successfully opposed by DDL under Section 3(6) of the Trade Marks Act 1994. DDL had also objected to the trade mark applications under Sections 3(1)(c), 3(3)(a), 3(3)(b) and 5(4)(a) of the Act. Those objections were dismissed.

The Parallel Appeals

3. On 3 August 2009, Mr. Maslyukov appealed to an Appointed Person under Section 76 of the 1994 Act against the refusal of his trade mark applications and also against the rejection of his opposition to DSL's trade mark application.

4. On 4 August 2009, DDL filed an Appellant's Notice in the High Court in London (under Reference CH/2009/APP/0445) claiming a declaration to the effect that Mr. Maslyukov's trade mark applications should have been refused by the Hearing Officer additionally or alternatively under Sections 3(1)(c), 3(3)(b) and 5(4)(a) of the 1994 Act.

5. The solicitors acting for DDL and DSL were informed of the existence of Mr. Maslyukov's appeal to an Appointed Person when they enquired of the Trade Marks Registry by telephone on 6 August 2009. They received a copy of his Notice and Grounds of Appeal on 14 August 2009.

6. On 20 August 2009, DDL and DSL filed a Respondents Notice under Rules 71(4) to (6) of the Trade Marks Rules 2008 in relation to Mr. Maslyukov's appeal. In their Respondents Notice they maintained that Mr. Maslyukov's trade mark applications should have been refused by the Hearing Officer additionally or alternatively under Sections 3(1)(c), 3(3)(b) and 5(4)(a) of the 1994 Act. They relied in that regard upon the Grounds of Appeal and Skeleton Argument filed in support of DDL's appeal to the High Court under Reference CH/1009/APP/0445.

The Requests for Reference

7. The Respondents Notice was filed under cover of a letter asking for Mr. Maslyukov's appeal to be referred to the High Court under Section 76(3) of the 1994 Act with a view to it being listed for hearing at the same time as DDL's appeal pursuant to its Appellant's Notices filed on 4 August 2009. I note that DSL is not a party to that appeal.

8. By letter dated 27 August 2009 the Treasury Solicitors Department notified me that:

The Registrar of Trade Marks would request that under Section 76(3)(b) of the Trade Marks Act 1994 the Appointed Person refer the appeal filed by Mr. Maslyukov to the High Court as the Opponent has filed an appeal to the High Court and it is felt that one Tribunal should dispose of all the issues.

Directions for Case Management

9. The requests for reference fell to be dealt with in accordance with the provisions of Section 76(3) of the Act and Rule 72 of the 2008 Rules. Rule 72(4) set a period of 28 days for the making of representations as to whether the appeal filed by Mr. Maslyukov on 3 August 2009 should be referred to the Court.

10. However, the Act and the Rules are silent as to: (1) whether such representations may be made initially or only in writing or optionally or additionally at a hearing appointed for the purpose; (2) whether the opportunity to make representations should include the opportunity to make representations in reply to those made by other parties or the Registrar; (3) whether the Registrar should have the opportunity to make representations in reply to those made by the parties; (4) whether representations may only be taken into account if they are made within the period of 28 days prescribed by Rule 72(4) or any extension thereof which may be granted under Rule 77.

11. This appeared to me to be a recipe for chaos. I therefore considered it necessary to impose some order on the proceedings by exercising my powers of case management under Rules 62 and 73(4) of the Trade Mark Rules 2008.

12. To that end I gave directions in writing on 9 September 2009 in the following terms:

- (1) save for the purpose of determining whether it should be referred to the Court under Section 76(3) of the 1994 Act, the appeal filed by Mr. Maslyukov on 3 August 2009 is stayed;
- (2) the appeal will remain stayed pending determination of the question whether it should be referred to the Court under Section 76(3) unless otherwise directed in the meantime;
- (3) the need for a case management conference at which to consider whether the appeal should be referred to the Court under Section 76(3) will be assessed in the light of the written representations received pursuant to paragraphs (5) to (9) below;
- (4) if any directions are considered necessary or appropriate for the efficient and effective conduct of any case management conference they will be notified to the parties and the Registrar at the same time as they are notified of the date and time appointed therefor;
- (5) any representations which the parties or the Registrar may wish to make in relation to the question whether the appeal should be referred to the Court under Section 76(3) should be sent to me by email (clerks@oeclaw.co.uk) or fax (020 7583 0118) within the period of 28 days prescribed by Rule 72(4);
- (6) any written representations sent to me under paragraph (5) above should at the same time be copied to the other persons entitled to submit written representations

under that paragraph and also to the Treasury Solicitors Department (Reference MT 9/2459J/ AGP/4E);

- (7) any application made or intended to be made to the High Court by or on behalf of Mr. Maslyukov for an order suspending or terminating the appeal currently pending under Reference CH/2009/APP/0445 should be identified with precision in any written representations submitted by him or on his behalf under paragraph (5) above;
- (8) any application made or intended to be made to the High Court by or on behalf of DDL or DSL for an order suspending or terminating the appeal to an Appointed Person filed by Mr. Maslyukov on 3 August 2009 should be identified with precision in any written observations submitted on its or their behalf under paragraph (5) above;
- (9) the parties and the Registrar have permission to apply for further directions and generally in relation to the directions given above.

13. A copy of my order for directions was forwarded to Chancery Listing for inclusion in the Court file relating to DDL's appeal to the High Court in London under Reference CH/2009/APP/0445.

The Written Representations

14. The Registrar made no further representations. DDL and DSL submitted a Witness Statement of Paul Walsh (of their solicitors, Bristows) dated 17 September 2009

together with written representations of the same date in which they emphasised the desirability in all the surrounding circumstances of having all issues between the parties determined at the same time by the High Court in London.

15. They inferred from the absence of any provision in the 1994 Act empowering the High Court to refer an appeal to an Appointed Person that Parliament must have intended the Appointed Person to exercise his or her power of referral under Section 76(3) so as to ensure that the Court becomes seized of all issues in dispute between the parties in the event of parallel appeals.

16. With a view to reducing the disparity between the (heavier) burden of costs on appeal to the Court and the (lower) burden of costs on appeal to an Appointed Person they made the following offer:

Diageo is conscious of the relative means of the parties and does not seek to secure by a reference to the Court any higher costs recovery (in the event it should succeed in the appeals) than it would secure if the both appeals had been made to the Appointed Person. Accordingly, Diageo is willing to agree with Mr Maslyukov, if he so wishes, that costs recovery in the appeals should be so limited.

17. Mr. Maslyukov submitted written representations on 16 September 2009 and 18 September 2009. On the first occasion he observed:

Basically I suppose that it is now for the Appointed Person and for the UK IPO to transfer documents and the whole trademarks' case file to the High Court...All I ask them is to let the hearing be held before the High Court without my side charged by the Court Fees because no fee is required for the hearing before the Appointed Person and it is not my selection but Diageo's willing to gather "another Forum"

after detailed decision in their favor was already handed down by the UK IPO.

In the alternative be proposed that DDL should suspend its appeal to the High Court with a view to enabling his appeal (and presumably the Respondents Notice) to proceed to a final determination before the Appointed Person. On the second occasion (having by then received the Witness Statement and written representations filed on behalf of DDL and DSL) he stated:

Agree to satisfy the Respondent's desire and formally ask the Appointed person to transfer the case with my own appeal to the High Court as Bristows wants.

It thus appears that the parties and the Registrar are agreed as to the appropriateness of an order for reference to the Court.

Determination

18. In the circumstances there is no need for a case management conference to consider whether Mr. Maslyukov's appeal should be referred to the Court.

19. I am clear in my own mind that the Notice and Grounds of Appeal filed by Mr. Maslyukov and the Respondents Notice filed on behalf of DDL and DSL would be sufficient between them to enable the Appointed Person to determine all issues in dispute between the parties. However, it would be wrong for the Appointed Person to proceed to a final determination on that basis in the absence of a successful application to the High Court for an order suspending or terminating the appeal currently pending under Reference CH/2009/APP/0445.

20. An order to that effect would be necessary in order to meet the requirement in Section 49(2) of the Supreme Court Act 1981 that:

‘Every Court ..., subject to the provisions of this or any other Act, shall so exercise its jurisdiction in every cause or matter before it as to secure that, as far as possible, all matters in dispute between the parties are completely and finally determined, and all multiplicity of legal proceedings with respect to any of those matters is avoided.’

If the High Court had thought it right to provide for Mr. Maslyukov’s appeal and the Respondents Notice filed on behalf of DDL and DSL to proceed to a final determination before an Appointed Person, it could have made an order with a view to achieving that objective under Section 49(3) of the Supreme Court Act 1981:

‘Nothing in this Act shall affect the power of the Court of Appeal or the High Court to stay any proceedings before it, where it thinks fit to do so, either of its own motion or on the application of any person, whether or not a party to the proceedings.’

21. I allowed for that possibility in paragraphs (7) and (8) of the directions I gave on 9 September 2009 (see paragraph 12 above). However, there is now a consensus to the effect that DDL’s appeal to the High Court under Reference CH/2009/APP/0445 should proceed and I understand that it is presently listed for hearing on 16 February 2010. In the circumstances, it would clearly not be right for the Appointed Person to require the parties to pursue the present appeal proceedings before him or her in parallel with those pending before the High Court: see Financial Systems Software (UK) Ltd’s Trade Mark Application [2001] RPC 41 (CA) at paragraphs 27 to 29 per Chadwick LJ.

22. I therefore determine that Mr. Maslyukov's appeal and the Respondents Notice filed on behalf of DDL and DSL (which in substance and reality raises a cross-appeal) should be and are hereby referred to the High Court under Section 76(3) of the Trade Marks Act 1994 with a view to their being heard at the same time as DDL's appeal to the High Court under Reference CH/2009/APP/0445.

23. For the sake of good order, I now reproduce the provisions of paragraph 25 of the Practice Direction to CPR Part 63 (see the Second Supplement to the White Book at pp.226, 227):

Reference to the court by an appointed person

25.1 This paragraph applies where a person appointed by the Lord Chancellor to hear and decide appeals under section 77 of the 1994 Act, refers an appeal to the Chancery Division under section 76(3) of the 1994 Act.

25.2 The appellant must file a claim form seeking the court's determination of the appeal within 14 days of receiving notification of the decision to refer.

25.3 The appeal will be deemed to have been abandoned if the appellant does not file a claim form within the period prescribed by paragraph 25.2.

25.4 The period prescribed under paragraph 25.2 may be extended by–

- (1) the person appointed by the Lord Chancellor; or
- (2) the court

where the appellant so applies, even if such application is not made until after the expiration of that period.

The parties will wish to consider their next steps in the context of these provisions.

24. I anticipate that Mr. Maslyukov will wish to take up the offer made by DDL and DSL in relation to the recovery of costs in connection with the High Court proceedings (see paragraph 16 above). In the expectation that the parties will reach an agreement on

costs as proposed by DDL and DL, I make no order for costs in respect of the proceedings before me.

25. A copy of this determination is being forwarded to Chancery Listing for inclusion in the Court file relating to DDL's appeal under Reference CH/2009/APP/0445.

Geoffrey Hobbs Q.C.

7 October 2009

Mr. Maslyukov represented himself.

DDL and DSL were represented by their solicitors, Bristows.