

THE PATENT OFFICE

Room 2A,  
Harmsworth House,  
13-15 Bouverie Street,  
London, EC4Y 8DP.

Thursday, 3rd February 2000

Before:

MR GEOFFREY HOBBS QC  
(The Appointed Person)

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In the Matter of THE TRADE MARKS ACT 1994

and

In the Matter of Trade Mark Application Nos: 2117243A and  
2117243B by DAVID CHARLES PAGE to register the trade mark DAVID  
PAGE in Class 25.

and

Opposition thereto under Nos: 47998 and 48071 by PALMON  
(OVERSEAS) LIMITED

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An appeal to the Appointed Person from the decision of Miss Ann  
Corbett of 4th June 1999

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(Transcript of the Shorthand Notes of Marten Walsh Cherer Ltd.,  
Midway House, 27-29 Cursitor Street, London EC4A 1LT.  
Telephone No: 0171-405 5010. Fax No: 0171-405 5026.)

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MR T HINCHLIFFE (instructed by Messrs Barlin Associates) appeared  
as Counsel on behalf of the Appellant/Opponent.

THE APPLICANT did not appear and was not represented.

MR M KNIGHT appeared on behalf of the Registrar of Trade Marks.

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D E C I S I O N  
Approved by the Appointed Person

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1 MR HOBBS: In January 1996 a company called Ambiance Shirts  
2 Limited began trading as an importer and wholesaler of shirts  
3 from premises at Rainham in Essex, having purchased certain  
4 assets from the receivers of a company called Ambiance  
5 Clothing Limited.

6 David Charles Page was formerly the Managing Director of  
7 Ambiance Clothing Limited. He became the General Manager of  
8 Ambiance Shirts Limited in January 1996 and continued in that  
9 position until the 31st October 1996, or thereabouts. At that  
10 point his employment was terminated inter alia for competing  
11 with the company in breach of his duty to serve it faithfully  
12 and well in his capacity as a senior employee.

13 On 17th December 1996 Ambiance Shirts Limited applied to  
14 register a series of four marks for use as trade marks in  
15 relation to articles of clothing in class 25. The common  
16 feature of the four marks in the series was the name David  
17 Page.

18 The evidence before me indicates that the name David Page  
19 was being used by the company as a trade mark for shirts from  
20 April 1996 onwards. It seems unlikely that the company could  
21 have been using the name of its General Manager as a trade  
22 mark without his knowledge and consent.

23 The company's application for registration was accepted  
24 and in due course matured into trade mark registration number  
25 2118919 in September 1997, having been advertised for  
26 opposition purposes in June 1997. The registration was not  
opposed by Mr Page or anyone else for that matter.

1                   However, Mr Page had applied independently for  
2 registration of a series of two marks consisting of his name  
3 David Page represented, firstly, in ordinary letter press and,  
4 secondly, in stylised handwritten form. That application had  
5 been made on 2nd December 1996. The application was for  
6 registration of the name David Page for use as a trade mark in  
7 relation to clothing, footwear and head gear in class 25.

8                   In July 1997 the application was sub-divided into two  
9 applications at Mr Page's request under Rule 19 of the Trade  
10 Marks Rules. The application for registration of the name  
11 David Page in ordinary letter press proceeded under number  
12 2117243A. It was advertised for opposition purposes on 10th  
13 October 1997. The application for registration of the name  
14 David Page in stylised handwritten form proceeded under number  
15 2117243B. It was advertised for opposition purposes on 22nd  
16 October 1997.

17                   The divisional applications both retained a filing date  
18 of 2nd December 1996. That being so, they had seniority over  
19 the application filed by Ambiance Shirts Limited on 17th  
20 December 1996. It was therefore not possible for the  
21 company's registered trade number 2118919 to be asserted  
22 against Mr Page's applications as a basis of objection under  
23 sections 5(1), 5(2) or 5(3) of the Trade Marks Act 1994  
24 because it could not qualify for recognition as an earlier  
25 trade mark within the meaning of section 6 of the Act relative  
26 to those applications.

                  I understand from exhibit MW.1 to the statutory

1 declaration of Michael Watson dated 15th July 1998 that  
2 Ambiance shirts Limited ceased trading on 30th June 1997. The  
3 evidence before me indicates that a deed of assignment dated  
4 1st May 1997 was executed by the company in favour of Palmon  
5 (Overseas) Limited and that this conveyed to the assignee the  
6 entirety of the assignors rights in the trade mark DAVID PAGE  
7 and the goodwill of the business to which the trade mark was  
8 appurtenant. I have not seen a copy of the deed of  
9 assignment. It appears to have been processed by the Trade  
10 Marks Registry in December 1997 with an effective date of 13th  
11 November 1997 so far as it concerned the assignment of  
12 registered trade mark 2118919 from Ambiance Shirts Limited to  
13 Palmon (Overseas) Limited. I should mention at this point  
14 that Palmon was at all material times the owner of all of the  
15 issued share capital of Ambiance Shirts Limited.

16 Palmon then proceeded to file oppositions under Rule 13  
17 of the Trade Marks Rules to the registration of the marks that  
18 Mr Page had applied for on 2nd December 1996. The grounds of  
19 opposition to application 2117243A were pleaded in the  
20 following terms:

- 21 "1. The opponents are the successors in business of  
22 Ambiance Shirts Limited. By assignment dated 1st  
23 May 1997 the opponent has acquired the rights in the  
24 trade mark DAVID PAGE arising from their use of said  
25 trade mark and also the benefit of trade mark  
26 registration no. 21181919 advertised in the Trade  
Marks Journal No. 6178 at page 6198.

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2. The opponent's predecessors have used the mark applied for in the United Kingdom in relation to inter alia shirts.
  3. Mr David Charles Page, the applicant for registration of mark no. 2117243A was the de facto Managing Director of Ambiance Shirts Limited and their predecessors and the trade mark DAVID PAGE was taken into use by said predecessors with the consent of Mr David Page and at his direction. The said trade mark is an asset which has now been acquired by the opponents.
  4. Registration of the mark applied for would be contrary to the provisions of Section 5 of the Act in that it is so similar to the opponents trade mark and it is proposed to be used and registered for goods identical and/or similar to the goods for which the trade mark is registered and has protection. Use of the mark applied for would lead to a likelihood of confusion on the part of the public and/or to a likelihood of association with the opponents.
  5. Registration or use of the mark applied for would obstruct or prejudice the legitimate conduct of the opponents business. Registration of the mark applied for should be refused as being contrary to the provisions of the Act, in accordance with the exercise of the Registrar's judgment and/or

discretion.

- 1           6.    The opponent has notified the applicant of its  
2                   objection to the use and registration of the trade  
3                   mark in suit but the applicant has failed to  
4                   withdraw the application in suit."

5           The grounds of opposition to application 2117243B were  
6           pleaded in substantially similar, but not quite identical  
7           terms:

- 8           "1    The opponents are the successors in business of  
9                   Ambiance Shirts Limited. The trade mark DAVID PAGE  
10                  was adopted and used by Ambiance Shirts Limited in  
11                  relation to certain garments prior to the date of  
12                  application no. 2117243B such that at such date the  
13                  said trade mark indicated the goods of Ambiance  
14                  Shirts Limited and no other. By assignment dated 1st  
15                  May 1997 the opponent has acquired the rights in the  
16                  trade mark DAVID.PAGE arising from such use of said  
17                  trade mark and also the benefit of trade mark  
18                  application no. 21181919 advertised in the Trade  
19                  Marks Journal No. 6178 at page 6198 and the  
20                  registration resulting therefrom.

- 21           2.    The opponent's predecessors have used the mark DAVID  
22                   PAGE in the United Kingdom in relation to inter alia  
23                   shirts.

- 24           3.    Mr David Charles Page, the applicant for  
25                   registration of mark no. 2117243B was the de facto  
26                   Managing Director of Ambiance Shirts Limited and

1 their predecessors and the trade mark DAVID PAGE was  
2 taken into use by said predecessors with the consent  
3 of Mr David Page and at his direction. The said  
4 trade mark is an asset which has now been acquired  
5 by the opponents.

6 4. Registration of the mark applied for would be  
7 contrary to the provisions of section 5 of the Act  
8 in that it is so similar to the opponents' trade  
9 mark and it is proposed to be used and registered  
10 for goods identical and/or similar to the goods for  
11 which the trade mark is registered and has  
12 protection. Use of the mark applied for would lead  
13 to a likelihood of confusion on the part of the  
14 public and/or to a likelihood of association with  
15 the opponents. The applicant has acted in bad faith  
16 in making an application to register the trade mark  
17 DAVID PAGE in his own name.

18 5. Registration or use of the mark applied for would  
19 obstruct or prejudice the legitimate conduct of the  
20 opponents' business. Registration of the mark  
21 applied for should be refused as being contrary to  
22 the provisions of the Act, in accordance with the  
23 exercise of the Registrar's judgment and/or  
24 discretion.

25 6. The opponent has notified the applicant of its  
26 objection to the use and registration of the trade  
mark in suit but the applicant has failed to

withdraw the application in suit."

1 It will be noted that the discrepancies (identified by  
2 the underlining above) between the two sets of grounds of  
3 opposition related to an allegation of bad faith (presumably  
4 made with reference to the provisions of section 3(6) of the  
5 Trade Marks Act 1994). That allegation was made explicitly in  
6 the second set of grounds of opposition, but not in the first  
7 set of grounds of opposition. Beyond that, the opponent's  
8 pleadings were really rather obscure as to the precise basis  
9 of objection that was being raised on relative grounds under  
10 section 5 of the Trade Marks Act 1994. They also included a  
11 request for the favourable exercise of a discretion which the  
12 Registrar no longer possesses; see **EUROLAMB TM** [1997] R.P.C.  
13 279.

14 Generally uninformative counter statements were filed on  
15 behalf of Mr Page within the period prescribed by Rule 13(2)  
16 of the 1994 rules.

17 In a letter of 3rd July 1998 Palmon's agents asked the  
18 Registrar to consolidate the oppositions on the basis that the  
19 issues raised by the grounds of opposition were identical.  
20 That request was duly granted. Palmon filed evidence in  
21 support of the consolidated oppositions in July 1998. That  
22 evidence consisted of the statutory declaration of Mr Michael  
23 Watson with four exhibits dated 15th July 1998.

24 In paragraph 10 of his statutory declaration Mr Watson  
25 summed up his evidence in the following terms:

26 "In the premises I submit that Mr Page in making



1 application for registration of the trade mark DAVID  
2 PAGE under number 2117243A and 2117243B has acted in  
3 bad faith and that such applications should be  
4 denied."

5 Mr Page filed no evidence in answer and on 5th January  
6 1999 his agent sent a letter to the Trade Marks Registry with  
7 a copy to Palmon's agents stating:

8 "We are unable to obtain the applicant's  
9 instructions on this matter and we must presume that  
10 the applicant does not intend to continue the  
11 proceedings."

12 That statement was ambiguous, in my view, as to what Mr  
13 Page's intentions actually were with regard to his own  
14 applications and with regard to the conduct of the pending  
15 oppositions.

16 I do not think it was open to the Registrar, simply on  
17 the basis of that letter, to deem the applications to have  
18 been withdrawn. The consolidated oppositions remained liable  
19 to be considered on their merits. The provisions of Rule 13  
20 do not empower the Registrar to reject an application for  
21 registration without considering the evidence filed under Rule  
22 13(3) in circumstances where the applicant for registration  
23 has defended the opposition by filing a counter statement  
24 within the period prescribed by Rule 13(2)

25 Hot on the heels of the letter of the 5th January from Mr  
26 Page's agents there came a letter from Palmon's agents written  
to the Registry in the following terms:

1 "We have today received from R G C Jenkins & Co a copy of  
2 their letter to you dated 5th January 1999 in the above  
3 matters. As the applicant is no longer contesting the  
4 oppositions, we hereby request an immediate decision  
5 based on the papers of record."

6 It is suggested that the writer of the letter was  
7 requesting a formal administrative dismissal of the  
8 applications based on withdrawal by the applicant. However,  
9 the letter seems to me to presuppose the existence of  
10 continuing proceedings in which there is a need for a decision  
11 to be taken. That would not be the situation in a case where  
12 the application in suit had been withdrawn: withdrawal would  
13 then be the act volutary of the applicant under section 39 of  
14 the 1994 Act and there would be no need for a formal decision  
15 of the Registrar to approve or secure the fact of withdrawal.

16 The letters of 5th January and 6th January created a  
17 situation in which there was at least some degree of  
18 misunderstanding between the applicant for registration, Mr  
19 Page, and the opponent, Palmon. The confusion might well have  
20 been dispelled if the Registry had communicated with the  
21 parties in the terms envisaged by Rule 13(9) of the 1994  
22 Rules:

23 "Upon completion of the evidence the registrar shall  
24 request the parties to state by notice to him in writing  
25 whether they wish to be heard; if any party requests to  
26 be heard the registrar shall send to the parties notice  
of a date for the hearing."

1 That did not happen. The Registry informed the parties  
2 in a letter of 22nd April that a decision was being prepared  
3 and would be issued in due course. This was all rather  
4 unfortunate because it seems to have left in place a situation  
5 in which the applicant, the opponent and the Registry were  
6 communicating with one another on different wave lengths.

7 Ms Ann Corbett, acting as Hearing Officer for the  
8 Registrar proceeded to issue a decision on 4th June rejecting  
9 the oppositions on their merits. I think that she did so on  
10 the basis of the request in Palmon's letter of 6th January  
11 1999 believing, that by means of that letter, Palmon had  
12 waived what would otherwise have been its right to an oral  
13 hearing.

14 In her decision issued on 4th June 1999, the Hearing  
15 Officer attempted to decipher the grounds of opposition filed  
16 on behalf of Palmon with a view to identifying the statutory  
17 basis of the objections relied on. She concluded that the  
18 only objection of substance notified by the statements of  
19 grounds was an objection under section 5(2)(b) of the 1994 Act  
20 based upon registered trade mark 2118919. She dismissed that  
21 objection as unsustainable because, as I have noted above,  
22 that registration was not available for citation as an earlier  
23 trade mark against the applications in suit.

24 The Hearing Officer appreciated that Mr Watson's  
25 statutory declaration was directed to an allegation that the  
26 applications in suit had been made in bad faith and were, for  
that reason, objectionable under section 3(6) of 1994 Act. She

said however:

1 "That was not a ground pleaded when the Notice of  
2 Opposition was filed and there has been no subsequent  
3 request by the opponents or their representatives to  
4 amend the statement of grounds of opposition. I take no  
5 account therefore of this evidence insofar as the  
6 opposition is concerned."

7 In expressing that view she can fairly be said to have  
8 been half wrong and half right. She was half wrong because  
9 the second statement of grounds filed in opposition to  
10 application 2117243B did refer to bad faith in terms which  
11 indicated that a section 3(6) objection was being taken. She  
12 was half right because the first statement of grounds filed in  
13 opposition to application 2117243A did not focus upon the  
14 question of bad faith in the same terms.

15 However, as counsel on behalf of Palmon has pointed out  
16 in his submissions before me this afternoon, bad faith is an  
17 objection which, if it applies at all, must in this case apply  
18 to the undivided application in its entirety and must  
19 therefore, if it be a good objection, be sustainable in  
20 relation to the sub-divided applications claiming the filing  
21 date of the original application.

22 The net result is that I find a situation in which  
23 confusion and misunderstanding appears to have been piled upon  
24 confusion and misunderstanding with the result that the main  
25 objection raised by Palmon, that is to say the objection under  
26 section 3(6) of the Act, was not considered on its merits.

1 The question I ask myself now is: what do I do about  
2 that state of affairs? I do not think it is appropriate to  
3 determine the bad faith objection de novo on appeal. What I  
4 propose to do, having considered the matter, is to set aside  
5 the Hearing Officer's decision and remit the oppositions to  
6 the Registrar for further consideration upon the basis of the  
7 objections currently pleaded, leaving it to the Registrar's  
8 Hearing Officer to determine whether and, if so, to what  
9 extent the pleadings can and should be amended in due course  
10 to enable the opponent to put forward the main objection upon  
11 which it has sought to rely. That is my decision.

12 Do you want to address me on costs?

13 MR HINCHLIFFE: Sir, I seek no order as to costs.

14 MR HOBBS: That is perceptive of you. I shall say nothing on the  
15 question of costs then. Thank you both very much.

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