

O-088-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN INTERLOCUTORY HEARING  
IN RELATION TO APPLICATION NOS. 2356807 AND 2356802  
IN THE NAME OF O2 HOLDINGS LIMITED**

**AND**

**OPPOSITION NOS. 94253 AND 94254 THERETO BY T-MOBILE (UK)  
LIMITED**

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to application Nos. 2356807 and  
2356802 in the name of  
O2 Holdings Limited and  
Opposition Nos. 94253 and 94254  
thereto by T-Mobile (UK) Limited**

### **Background**

1. Application No. 2356807 is for the trade mark BUSINESS ZONES FROM O2. Application No. 2356802 is for the trade mark BUSINESS ZONES. Both applications were filed on 26 February 2004 and stand in the name of O2 Holdings Limited.
2. Following their publication in the *Trade Marks Journal*, notices of opposition were filed on 29 March 2006 against each of the applications. These were filed by Alexander Ramage Associates on behalf of T-Mobile (UK) Limited. In each case, the opposition is founded on section 5(2)(b) of the Act based on Trade Mark registration Nos. 2101632 and 2101627.
3. I should perhaps point out at this stage that each of the earlier marks relied on by the opponent has been the subject of both revocation and invalidation proceedings. In each case the revocation and invalidation actions were filed by the same party, that party being the applicant in the current opposition proceedings. The revocation proceedings resulted in the two earlier marks being revoked with effect from 5 March 2004. As I understand matters, the applications for invalidation have recently been the subject of an interlocutory hearing where the Hearing Officer found the actions should not proceed and a full statement of the reasons for the Hearing Officer's decision is awaited.
4. Following receipt of the notices of opposition, the forms were processed and served on the applicant who subsequently filed Forms TM8 and counter-statements. These were then processed and served on the opponent. At this point in the proceedings the Trade Marks Registry reviewed the files in preparation for the issue of a Preliminary Indication. As a result of the review, a letter dated 3 August 2006 was issued to the parties. The letter stated:

“The cases have been reviewed and it appears that there is an issue that would prevent the oppositions from proceeding.

Revocations have taken place in respect of those registrations relied upon by the Opponent i.e. numbers 2101632 and 2101627. With the effective date of revocation being 5 March 2004 this means that the Proprietor did not show evidence of use for a period of five years prior to that date.

In the circumstances the Opponent in the above cases has been unable to provide a statement of use in relation to the two registrations as required by Rule 13(2)(e) of the Trade Marks Rules 2000 (as amended). Therefore the

registry's preliminary view is that no Preliminary Indication should be issued and that the oppositions should be deemed withdrawn.

A period of **14 days from the date of this letter** i.e. on or before 17 August 2006 has been allowed for either party to the proceedings to provide full written arguments against the preliminary view and to request a hearing under Rule 54(1)"

5. On 15 September 2006 the Trade Marks Registry issued a letter confirming that the oppositions had been deemed withdrawn "in accordance with Rule 13B(4)(a)".

6. The opponent then contacted the Trade Marks Registry to query the withdrawal of the oppositions. It forwarded a copy of a letter it had sent to the registrar and dated 16 August 2006 but which, for reasons unknown, had not previously been received. The letter disagreed with the registrar's preliminary view to deem the oppositions as withdrawn and sought a hearing.

7. The Trade Marks Registry responded by issuing a further letter, dated 26 September 2006, which stated:

" Without wishing to comment on the arguments about the proof of use which would validate the opponents revoked marks in these proceedings, it is accepted that the applicants did not explicitly request the opponent to provide proof of use on their Form TM8.

In view of the above, the preliminary view expressed in our letter date 03.08.2006 is reversed. Therefore the oppositions will continue with the preliminary indications in the above proceedings being issued in due course."

8. At this point the applicant sought to amend Forms TM8 and counter-statements. The amendment sought to put the opponent to proof of use of the marks it relied on in each of the opposition proceedings. Comments on the request were sought from the opponent. Despite the opponent's objection to the amendment, the registrar issued a preliminary view to admit the amended Forms TM8 and counter-statements. The opponent requested to be heard.

9. The hearing took place before me on 23 January 2007. Mr Stobbs of Boulton Wade Tennant represented the applicant. Mr Malynicz of Counsel represented the opponent. The hearing was to consider the registrar's preliminary view to accede to the applicant's request and allow the amendment of the Forms TM8 and counter-statements so as to include a specific request that the opponent provides proof of use of the earlier marks relied upon in both proceedings and the consequences thereof.

10. Following the hearing, I issued a letter to the parties dated 24 January 2007 which stated:

The determination of the request to amend the counter-statement requires me to consider, amongst other things, the content of the Forms TM7 Notices of Opposition and statements of grounds as filed by the opponent. Both parties referred to these forms in their submissions.

Despite the opponent's submissions that the pleadings stages of these proceedings are closed, I made it clear at the hearing, and I do not understand either party to disagree, that I am required to look at matters afresh.

The oppositions are based on the grounds of Section 5(2)(b) of the Act. The opponent relies on two earlier marks which, at the date on which the applications were published, had been registered for more than five years. Section 6A of the Act therefore applies to these proceedings. Whilst both of the earlier marks relied on have been subject to revocation, the relevant period under Section 6A of the Act covers a period which pre-dates the effective date of revocation.

In my opinion, and contrary to Mr Malynicz's submissions, the statement in paragraph 11 of the opponent's statements of grounds accompanying Forms TM7, that the earlier marks "continue to be of commercial relevance to the Opponent..." cannot be considered to be a statement of use as required by rule 13(2)(e) of the Trade Marks Rules 2000 (as amended). Specifically, the opponent has not provided any detail stating whether any, either or both of the earlier marks have been put to genuine use, in relation to each of the goods and services for which it was registered, during the relevant period or whether there are proper reasons for non-use. That being the case, I do not consider it appropriate for the applicant to be allowed to amend his Form TM8s and counter-statements to include a specific challenge to the statement of use and the request is therefore refused.

If, on any appeal, I am found to be wrong in my interpretation of the requirements of rule 13(2)(e) and the claims in paragraph 11 of the opponent's statements of grounds as set out above are determined to be an adequate statement of use, then, in my view, the applicant's counter-statements dated 24 July 2006 include a denial in relation to paragraph 11 of the opponent's statement of grounds which is a sufficient challenge to put the opponent to proof of its use such that no amendment of the counter-statements is required.

In all the circumstances, and subject to any appeal, I further decide that the Forms TM7 Notices of Opposition and statements of grounds filed on 29 March 2006 are deficient as they do not include a statement of use as required by rule 13(2)(e). I therefore allow the opponent a period of one month from the date of this letter to submit amended Forms TM7 Notices of Opposition and statements of grounds to the registrar and which meet each of the requirements of rule 13(2). Any such documentation would then be examined and, if appropriate, served on the applicant with a period set for the filing of Forms TM8 and counter-statement. Should the opponent fail to file the amended Forms TM7 etc as required, then the oppositions against the applications shall be deemed withdrawn.

The question of costs in relation to this matter will fall to be determined on conclusion of these proceedings."

11. On 23 February 2007, a Form TM5 was filed on behalf of the opponent requesting a statement of the reasons for my decision. These I now give.

### **Applicant's submissions**

12. Mr Stobbs began by submitting that his principal argument was that the amendment was not needed however the actions taken by the registrar had left the applicant with no choice but to make the request in order to preserve its position.

13. Mr Stobbs said that the question to be answered in the current proceedings is whether the opponent can prove use of its earlier marks. The opponent had based its oppositions on two earlier registrations which themselves have been subject to revocation actions based on the grounds of non-use of those marks.

14. Mr Stobbs referred me to section 6A of the Act and indicated that as the marks relied on by the opponent had been registered for more than five years at the relevant date, the proof of use requirements applied. He went on to refer to what he called the key provision of rule 13(2)(e). The opponent was required to file a statement of use of the earlier marks relied on or provide proper reasons for non-use which should be supported by evidence at a later stage if the statement was challenged by the applicant.

15. Taking me to the Forms TM7 filed by the opponent, Mr Stobbs submitted that they contained no statement of use as required. The form provides a space for a statement of use, but what had been written by the opponent in that space was "see attached statement of case". The attached statement of case consists of thirteen paragraphs but, despite the opponent's claims as to its form, Mr Stobbs submitted that it does not contain any reference to past or future use of the earlier marks or reasons for non-use sufficient for it to be considered a statement of use.

16. Mr Stobbs went on to refer to the counter-statements as originally filed by the applicant. He accepted that these did not contain any specific acceptance or denial by the applicant of any use the opponent might have claimed of its earlier mark as indicated in rule 13C(1)(b)(ii) but argued that this was because the opponent had not included a statement of use of the earlier marks as part of the Forms TM7 and attached statements. At best, he said, the applicant had remained silent though he submitted that it was clear the applicant disputed any claimed use by the opponent.

17. The applicant had requested leave to amend the counter-statements for obvious reasons of clarification. Mr Stobbs accepted that the Form TM8 contains, at box 5, a specific space for an applicant to indicate whether the statement of use made by the opponent in its Form TM7 is accepted or not. His principal argument on this point was that no statement of use was provided by the opponent, but if the documentation filed by the opponent with the Forms TM7 is to be regarded as a statement of use, then the statement is unclear or even hidden and the applicant had no choice but to leave section 5 of the Forms TM8 blank.

18. Mr Stobbs went on to say that should the registrar consider that amendment of the Forms TM8 and counter-statements were needed, then the application for leave to

amend was made in a timely fashion following the registrar's actions in these proceedings.

### **Opponent's submissions**

19. Mr Malynicz's primary position was that the applicant had provided no proper or true reasons to support the request to amend the Forms TM8 and counter-statements. The request by the applicant did no more than dress up the fact that there had been an oversight when it completed the Forms TM8.

20. Mr Malynicz submitted that what the applicant now sought would lead to a double abuse of process. The first abuse referred to the filing of invalidation actions which had been launched by the applicant against the earlier, now revoked, marks, those invalidation actions now having been stopped by a recent decision of the registrar. The current opposition proceedings are at the stage where Preliminary Indications are due in each case. Mr Malynicz went on to say that the content of the pleadings, which are procedural issues involving the filing of Forms TM7 and TM8 and accompanying documents, are closed and the clock could not be turned back. At this point, I indicated that it was open to me to consider matters in these proceedings afresh and Mr Malynicz accepted this.

21. Mr Malynicz referred me to Tribunal Practice Notice 4/2000 and said that the registrar has indicated his aim to give favourable consideration to requests for amendment of pleadings in order to avoid a multiplicity of proceedings. But allowing the applicant to amend the pleadings in these cases would, he said, lead to a multiplicity of proceedings despite the fact that it was the opponent who launched these proceedings.

22. Mr Malynicz went on to say that the published practice does not give parties carte blanche to raise something that could have been raised earlier. There is no guarantee that an amendment will be allowed if the registrar considers it could have been raised earlier.

23. Mr Malynicz submitted that use of the earlier marks must already have been in issue because these are proceedings which rely on earlier marks to which Section 6A applies. Mr Malynicz referred me to paragraph 11 of the statements of grounds accompanying the Forms TM7 and the wording therein that "The trade marks subject of the Earlier Rights continue to be of commercial relevance to the Opponent...". He accepted that this has been challenged by the registrar as not being a statement of use but said that following an exchange of correspondence where the opponent insisted it was a statement of use "as a matter of form" the registrar had allowed proceedings to continue. The applicant could have challenged the adequacy of the statement but had not.

24. At this point, I interrupted Mr Malynicz and asked him to clarify whether he was arguing that this sentence in the statements constitute a statement of use sufficient to meet the requirements of rule 13(2)(e). He responded to my question by indicating that it did not matter whether it complied with the rule as the registrar had decided the matter and the applicant was not entitled to review it again. I shall return to this in due course.

25. I then referred Mr Malynicz to paragraph 10 of the applicant's counterstatements which began with a sentence denying paragraph 11 of the opponent's statement of case. Mr Malynicz accepted the paragraph contained a denial but submitted that the denial was in relation only to the invalidation actions the applicant had launched against the earlier marks relied on by the opponent in the current proceedings. As far as these proceedings are concerned, he submitted that the appropriate box on the Forms TM8 had been left blank. The applicant could have completed that box by denying, admitting or not admitting the opponent's statement of use. Leaving the box blank was equivalent to being silent and silence does not put the matter in issue, he said. He submitted that because the applicant had failed in the invalidation actions, they were not in a position to challenge the use of the earlier marks. As no challenge had been made, it was not in issue in these proceedings.

26. Mr Malynicz submitted that the applicant had said that it had been impossible for it to put the statement of use in issue when it filed its Forms TM8 and counter-statement but was now seeking to do just that even though nothing had changed in the meantime. This was, he said, an absurd position. If it is possible now, it was possible then but for some reason it was not done. The matter was, he said, no more than an elaborate charade-if the applicant had thought the statements of use were inadequate it could and should have said so and should not have left the relevant boxes on the Forms TM8 blank.

27. Mr Malynicz went on to say that the request to amend the Forms TM8 and counter-statements was a double abuse of process. The applicant had applied to revoke the opponent's earlier marks and had then filed applications for invalidation. These latter applications had been struck out. It was not possible for a decision to be reached in these proceedings if that meant it would go against the decision reached in the invalidation actions. Use of the earlier marks are relevant to both invalidity and opposition proceedings. Whilst the issues are identical, he said, the relevant dates differ though the periods overlap. The invalidity proceedings had been found to be an abuse of process. He queried how the current request to amend the counter-statements could not be regarded as an abuse of process just some twenty months or so later.

28. Mr Malynicz submitted that the applicant had failed properly to formulate its revocation actions against the earlier marks. It had then sought to invalidate the registration in order to wipe them from the register. If those actions had succeeded, the current opposition proceedings would not have been launched. But the invalidation actions had failed and in seeking to amend the Forms TM8 and counter-statements to include a challenge to the use of the earlier marks, the applicant was guilty of a double abuse of process. It was open to the opponent to challenge the applicant's marks and that is why it had filed the notices of opposition.

29. Mr Malynicz also submitted that the registrar had accepted the notices of opposition and was now *functus officio*. It was not possible to turn back the clock. Although the Trade Marks Registry had initially found that no statements of use had been provided, the opponent had challenged this. The Trade Marks Registry's letter of 26 September 2006 was extremely important because it accepted the applicant had not explicitly challenged the statements of use and indicated that Preliminary Indications would be issued. The applicant had not sought to be heard and therefore the matter

was closed and the issue resolved. It was right, he said, that the Preliminary Indications should now be issued.

### **Applicant's submissions in reply**

30. Mr Stobbs submitted that it was within the registrar's power to consider afresh whether the opponent had filed statements of use in these proceedings. Despite open correspondence with and a detailed skeleton argument from the opponent, the statements made by Mr Malynicz at the hearing had been the first time the opponent had indicated that paragraph 11 of the statements of case was intended, "as a matter of form", to be a statement of use. He went on to say that the statement of use must comply with the requirements of rule 13(2)(e) but what had been filed by the opponent did not do so. Contrary to the opponent's submissions, the matter was relevant. Neither the Forms TM7 nor the statements of case included a statement of use, whether "as a matter of form" or not. The definition of what a statement of use required was set out in the rule. The fact that the earlier marks continue to be of commercial relevance because the opponent had filed new applications for the marks means nothing as in filing new applications that applicant is not required to have used the marks.

31. Mr Stobbs denied there was a double abuse of process. It was inconceivable that the differing relevant dates involved in separate proceedings did not matter. It had been impossible for the applicant to raise the matter of use of the opponent's earlier marks under the provisions of section 6A previously as that section was not relevant to either revocation or invalidity actions. Whatever may have gone on in the earlier actions, did not alter the fact that the opponent had to provide an adequate statement of use in the opposition proceedings.

32. As to the opponent's submissions that the registrar was *functus officio*, Mr Stobbs submitted that this was not the case. He went on to say that there had been no need to seek amendment of the Forms TM8 and counter-statements earlier than it had because until that point the registrar had indicated that the Forms TM7 and statements of case did not contain a statement of use.

33. Mr Stobbs pointed out that the opponent had not claimed its statements of case included adequate statements of use of the earlier marks and indeed could not do so as there was no basis for such a claim. If the statements were adequate then the applicant's denials as currently presented in its counter-statements were also adequate. The issue for decision was simple: either the opponent's statements of case included a statement of use in which case the applicant had denied it or the statements of case did not include a statement of use in which case the applicant had nothing to challenge.

### **Decision**

34. Clearly, there is something of a history between the two parties however, as I made clear at the hearing whatever may or may not have occurred in the previous revocation and invalidation proceedings, the issue I was required to decide was the applicant's request to amend its Forms TM8 and counter-statements filed as part of the opposition proceedings and the consequences of that decision.



35. It was not disputed that the registrar has the power to allow amendments such as had been requested. The question for determination was whether it was appropriate to allow the amendment in the circumstances of these proceedings. In making that determination, I took into account the purpose a Form TM8 and counter-statement plays in opposition proceedings. As the Vice Chancellor said in *Club Europe Trade Mark* [2000] RPC 329:

“Notices of opposition and counterstatements play the part of pleadings in contested trademark registration applications.”

36. In *Demon Ale* [2000] RPC 345, Mr Geoffrey Hobbs QC sitting as the Appointed Person stated:

“ Considerations of justice, fairness, efficiency and economy combine to make it necessary for the pleadings of the parties in Registry proceedings to provide a focussed statement of the grounds upon which they intend to maintain that the Tribunal should or should not do what it has been asked to do.”

37. It is clear from these cases that both a Form TM7 (Notice of opposition and statement of grounds) and a Form TM8 (Notice of Defence and counterstatement) play a vital rôle in setting out the extent of the dispute between the parties.

38. The Form TM8 and counter-statement is, in simple terms, a response to the Form TM7 and statement of grounds. In my opinion, in order for me to consider whether the requested amendment of the counter-statement was justified, it was necessary for me to consider, amongst other things, the content of the Forms TM7 and statements of grounds filed by the opponent.

39. I did not accept the opponent’s submission that the registrar was not entitled to review the pleadings again. If the pleadings are deficient in some way, it seems to me that the earlier this is identified and resolved, the less likelihood there is of wasted time and effort and the clearer the issues will be between the parties. The issue of whether the documentation filed by the opponent contained a statement of use had been raised by the Trade Marks Registry in its letter of 3 August 2006 but despite later correspondence as detailed above, had not been, to my mind, satisfactorily resolved. Indeed it seemed to me that the issue effectively had been sidelined by the Trade Marks Registry. This was clearly an irregularity in procedure.

40. Rule 66 reads:

“Subject to rule 68 below, any irregularity in procedure in or before the Office or the registrar, may be rectified on such terms as the registrar may direct.”

41. The purpose of the pleadings is to minimise wasted time, effort and expense by setting out in clear terms, the extent of the dispute between the parties. But in addition to setting out the extent of the dispute, the content of the pleadings must comply with any requirements set out in the Act and rules.

42. 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 included a statement of the grounds of opposition.

(3).....”

43. 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 person may, within three months of the date on which the application was published, give notice to the registrar of opposition to the registration on Form TM7 which shall include a statement of the grounds of opposition.

(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;

(c) the classes in respect of which that mark is registered;

(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)(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) Where the opposition is based on an unregistered trade mark or other sign which the person opposing the application claims to be protected by virtue of any rule of law (in particular, the law of passing off), there shall be included in the statement of the grounds of opposition a representation of that mark or sign and the goods and services in respect of which such protection is claimed.
- (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”.

44. There is no dispute that the Forms TM7 were filed in accordance with the requirements of rule 13(1) as the forms were filed within the relevant periods and each was accompanied by a statement of grounds. There is also no dispute that the forms and statements of grounds contained the information required by rules 13(2)(a), (b), (c) and (d).

45. As regards the requirements of rule 13(2)(e), the dates of publication of the applications were 13 January 2006 (No. 2356807) and 10 February 2006 (No. 2356802). In respect of both of the marks relied on by the opponent, the registration procedures were completed on 5 March 1999. The registration procedures were completed before the start of the period of five years ending with the date of publication of the applications such that the requirements of section 6A(3)(a) and rule 13(2)(e) come into effect.

46. Section 6A states:

“**6A** (1) This section applies where –

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the condition set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) .....

(5) ....

(6) ...

(7) ...”

47. The opponent is therefore required to include in its statements of grounds a statement detailing whether the marks relied on have 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 within the period of five years ending with the date of publication of the application.

48. The opponent submitted that paragraphs 11 of its statements of grounds constituted such a statement “as a matter of form”. I therefore went on to consider the content of paragraph 11 which reads:

“In consequence, at the date of the Applicant’s mark, an Earlier Right existed, in relation to which the conditions set out in Section 5(2) of the Act pertained. Herein, the Opponent relies upon the reasoning of Mr Allan James, acting for the Registrar in the case of “Franco’s Ices” (0-214-03). In the present circumstances, although 5<sup>th</sup> March 2004 is the earliest date from which the Earlier Rights could be revoked, as Mr James commented, one should resist speculation, as to the possible outcome had circumstances been different, for example, as to the outcome if the Applicant had delayed filing Applicant’s marks until after 5<sup>th</sup> March 2004. The trade marks subject of the Earlier Rights continue to be of commercial relevance to the Opponent, as evidenced by Application No 2389216 and Application No 2389265.”

49. Despite very careful and repeated reading of this paragraph, nowhere in it can I identify anything that would constitute a statement of use as required by rule 13(2)(e) whether as a “matter of form” or substance. There is no indication of whether any, either or both marks the opponent relies on, have been put to genuine use during the relevant period nor is there any indication of whether any such use was in relation to any, some or all of the goods and services on which the opposition is based. Neither is there any indication that there are proper reasons for any non-use of any, either or both of the marks the opponent relies on. I therefore found that the opponent had not filed a statement of use as required by rule 13(2)(e).

50. Whilst it is clear the same parties have been involved in previous revocation and invalidation proceedings, those earlier proceedings were launched by O2 Holdings Ltd who is the applicant in these proceedings. The current opposition proceedings were launched by the T-Mobile (UK) Ltd and it seeks to rely on its earlier registrations despite them having been subject of successful revocation actions. It therefore brought the use of these earlier marks into the arena. Given this, coupled with the different relevant periods appropriate to the revocation, invalidation and opposition proceedings, I fail to see there can be any abuse of process by the applicant seeking to challenge the use of those earlier marks as part of these proceedings. In any

event, having launched the opposition proceedings, it is the opponent who bears the responsibility for ensuring that its notices of opposition and statements of grounds comply with the necessary requirements.

51. Having found that the opponent had not filed a statement of use as required, I went on to find it was not appropriate for the applicant to be allowed to amend its Forms TM8 and counter-statements so as specifically to challenge the opponent's statements of use because no statements of use existed. I therefore refused the applicant's request. I went on to find, however, and as set out in my letter issued following the hearing that if, on any appeal, I was found to be wrong in my interpretation of the requirements of rule 13(2)(e) and the claims in paragraph 11 of the opponent's statements of grounds were determined to be adequate statements of use, then the amendment requested by the applicant would not be necessary. This is because the counter-statements as originally filed included, at paragraph 10, a clear denial of paragraph 11 of the opponent's statements of grounds.

52. Having found that the opponent's statements of grounds did not contain a statement of use as required by rule 13(2)(e) and were therefore deficient, I went on to consider the consequences of that decision. Having done so, I further decided that the opponent should be allowed an opportunity to correct the deficiency.

53. Rule 57 states:

“ At any stage of any proceedings before the registrar, she may direct that such documents, information or evidence as she may reasonably require shall be filed within such period as she may specify.”

54. Under the provisions of rules 57 and 66, and subject to any appeal, I therefore allowed the opponent a period of one month from the date of my letter (i.e. until 24 February 2007) to submit amended Forms TM7, Notices of Opposition and statements of grounds which would meet each of the requirements of rule 13(2)(a)-(e). As indicated in my letter, any such documentation received would then be examined and, if appropriate, served on the applicant who would then be allowed a period to file amended Forms TM8 and counter-statements as it considered necessary. I went on to indicate that should the opponent fail to file the amended documentation as required, the oppositions against the applications shall be deemed withdrawn.

### **Costs**

55. I further decided that the question of costs in relation to the interlocutory hearing would fall to be determined on conclusion of the opposition proceedings.

**Dated this 27th day of March 2007**

**ANN CORBETT  
For the Registrar  
The Comptroller-General**