

1 UK INTELLECTUAL PROPERTY OFFICE

2 4 Abbey Orchard Street
3 London SW1P 2HT

4 Thursday, 23rd June, 2016

5 Before:

6 MISS EMMA HIMSWORTH, QC
7 (Sitting as the Appointed Person)
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9 In the Matter of THE TRADE MARKS ACT 1994

10 and

11 In the Matter of Trade Mark No. 01550700
12 for FURNITURELAND and Trade Mark No. 02183949B
13 for FURNITURELAND Device (series of six)
14 in the name of FURNITURE VILLAGE LIMITED

15 and

16 In the Matter of Cancellation Numbers 00500653 and 00500654
17 thereto by Furnitureland.co.uk Limited

18 -----
19 (Transcript of the Shorthand Notes of Marten Walsh Cherer Ltd.
20 1st Floor, Quality House, 6-9 Quality Court,
21 Chancery Lane, London WC2A 1HP
22 Telephone No: 020 7067 2900. Fax No: 020 7831 6864.
23 email: info@martenwalshcherer.com)

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25 MR. JIM DAVIES of Elevation Legal appeared for the Appellant.

MR. GUY TRITON (instructed by Bracher Rawlins LLP) appeared
for the Respondent.

RULING ON APPLICATION
TO ADJOURN

1 THE APPOINTED PERSON: This is an application for an adjournment
2 of the substantive hearing of the appeal. It is an
3 application that was made by email, timed at 14.45 on 20th
4 June 2016.

5 The application contained a statement as follows: "At
6 the heart of the application to revoke TM1550700 is the
7 unusual assertion by our client that the register failed to
8 show the mark as live and/or as having been assigned to the
9 present registrant in 2011, when previous successful non-use
10 proceedings were commenced by our client against related
11 marks. Since 2013, our client has sought information from the
12 IPO that would clarify whether there was anything on the file
13 that would assist in either confirming or disposing of this
14 assertion. We appeared to have reached the end of the road
15 with the IPO and have today filed a complaint to the ICO in
16 respect of this matter. A copy of that complaint will be
17 forwarded by separate email.

18 Our client does not wish to proceed on the false
19 premise, if there were no issues with the mark; nor, we
20 submit, should it have to without having the relevant
21 authority investigate the file and the handling of the
22 information it contains and contained."

23 There was an apology for the timing of the application,
24 which was made on the Monday when the hearing of the appeal
25 was due to take place at 10.30 on the Thursday of the same

1 week.

2 In order properly to deal with this application, it is
3 necessary to go into a little of the history of this case.
4 This is an appeal in relation to applications for revocation
5 on the basis of non-use for two trade marks, one of which is
6 UK1550700, which has, on occasion, been referred to by the
7 appellant as the 1993 mark. The application in respect of the
8 1993 mark was made on 16th October 2014 and revocation was
9 requested with effect from 11th March 2011.

10 The relevant form, TM26(N) to commence these proceedings
11 was, as already indicated, dated 16th October 2014, and
12 contained the following statement, "Section C supporting
13 statement. ...Non-use by the Registrant for the trade mark
14 FURNITURELAND has been established for the 5 year period
15 ending 10 March 2011. (Decision of the Appointed Person
16 Geoffrey Hobbs QC O-128-14). No evidence of use of this mark
17 during that non-use period was tendered in those proceedings.
18 This application would have been brought at the same time [the
19 same time as the previous application made before Mr. Hobbs
20 QC, which was dated 20th June 2011] had the register properly
21 shown the existence of this registration," this registration
22 being UK1550700.

23 The registered trade mark proprietor (the respondent to
24 this appeal) subsequently filed the Form TM8 as a defence to
25 the claim for revocation. Directions were given on behalf of

1 the registrar for the filing of evidence in that connection.
2 As is recorded in the decision of the Hearing Officer below in
3 this case, evidence was filed on behalf of the registered
4 proprietor in due time but no evidence was filed on behalf of
5 the applicant and, in particular, nothing was filed in support
6 of the assertion that had been made in the Form TM26(N) noted
7 above.

8 Just prior to the hearing of the substantive application
9 that had been set by the Hearing Officer for 2nd November 2015
10 there was an application by the applicant (the appellant) to
11 file late evidence and to cross-examine the registered
12 proprietor's witness. The Hearing Officer considered those
13 applications at what had originally been planned for the
14 hearing date of the substantive application. She considered
15 the evidence that had been sought to be admitted late and
16 refused its admission to the proceedings. That refusal forms
17 part of the appeal that is before me.

18 The substantive decision in these proceedings was given
19 by Mrs. Corbett on 20th January 2016 following a hearing on
20 15th December. On 17th February 2016, the TM55 was filed by
21 the appellant and on 1st April 2016 Mr. Hobbs QC issued some
22 directions setting a deadline of 2nd May 2016 for the
23 appellant to file a skeleton argument in support of the
24 grounds of appeal that were contained in the TM55.

25 That deadline was not complied with and on 11th May 2016

1 a notice of default was issued providing that the appeal would
2 be deemed withdrawn unless a skeleton of argument was filed,
3 in accordance with the direction of Mr. Hobbs, by 20th May
4 2016. That default notice also provided for further
5 directions extending time for the respondents to the appeal to
6 likewise file their written submissions.

7 On 20th May 2016, a skeleton of argument was filed on
8 behalf of the appellant and subsequently a skeleton of
9 argument was filed on behalf of the respondent. Paragraph 6
10 of the appellant's skeleton of argument contained the
11 following statement: "Since the hearing and decision
12 Furnitureland (the appellant) has filed a further Freedom of
13 Information Act request and received two replies which they
14 consider interim at present. Further enquiries are ongoing."

15 This was the latest of a line of Freedom of Information
16 Act requests made of the UK IPO on behalf of the appellant
17 relating to the Registry file for the 1993 trade mark. The
18 first such request of the UK IPO for documents relating to
19 that trade mark were made on behalf of the appellant in
20 November 2013. There was subsequent correspondence between
21 the UK IPO and the appellant and in January 2014 a copy of the
22 entire file was provided to the appellant under cover of a
23 letter from Mr. Denahay, dated 7th January 2014.

24 Subsequent correspondence ensued between those acting on
25 behalf of the appellant and the UK IPO, which culminated with

1 an email of 16th April 2014 from Mr. Rowan, Divisional
2 Director of Trade Marks and Design. For present purposes it
3 is important to note that Mr. Rowan stated as follows:
4 "Turning to your second point, according to our records trade
5 mark number 1550700 has always been shown as Registered on the
6 official Register and would have been picked up by a search of
7 the Register. All relevant renewal fees were paid and we have
8 no reason to believe that it has not appeared as Registered at
9 any time. We did migrate the data contained in the Register
10 over to a new IT system in 2013 but we are unaware of any
11 problems with this migration and there have been no other
12 examples brought to our attention of existing marks not shown
13 as Registered. If you could inform us of any dates when you
14 believe the trade mark did not appear in any search we can
15 conduct a further enquiry of our records."

16 That was some considerable time before the evidence in
17 the present proceedings was due to be filed, which was in June
18 2015, but there was no follow-up at that stage with the UK IPO
19 as to the absence of any further documents. In fact, no
20 further correspondence on this topic with the UK IPO seems to
21 have taken place until a new request was raised on 22nd April
22 2016 at 17.29, on behalf of the appellant. That was some two
23 days after the parties were notified of the hearing of the
24 appeal being fixed to take place on 23rd June 2016.

25 In the 2016 request to the UK IPO it was said that the

1 documents that were considered by the appellant to be relevant
2 had not been provided and it was put that, "the need to find
3 out what happened to this trade mark remains live".

4 The UK IPO responded to the request in various
5 letters/emails after that date. On 17th June 2016, in an
6 email to the UK IPO it was stated on behalf of the appellant:
7 "We also propose that we apply to adjourn next week's hearing
8 pending the hearing of our client's planned complaint to the
9 ICO," that is, the Information Commissioner's Office. That
10 suggestion of an adjournment or the absence of what were said
11 to be further relevant documents was not communicated at any
12 time prior to 20th June 2016 to the respondent, or indeed to
13 myself. It would now appear that an application was made to
14 the ICO, also dated 20th June 2016, late into the evening, the
15 email being sent at 21.40.

16 The application before me for an adjournment is on the
17 basis that the complaint to the ICO is liable to produce
18 further documents or information. There are two preliminary
19 points to be made in relation to this application. First of
20 all, it is an application that has been made very late where
21 such an application was not foreshadowed at any time and,
22 second of all, it follows on from a course of dealing between
23 those acting for the appellant and the UK IPO where there was
24 silence on the part of the appellant from April 2014 to April
25 2016 on this issue, in circumstances where during that period

1 there was an opportunity for the appellant to file evidence
2 before the Hearing Officer, which it chose not to do at the
3 relevant time, and two hearings took place before the Hearing
4 Officer in December 2015 one of which was to consider the
5 admission of further evidence.

6 Against that background I have to decide whether there
7 should be an adjournment pending the outcome of any decision
8 of the ICO complaint. It seems to me that on balance, having
9 heard from the detailed submissions of the parties and
10 considered the papers before me that it is highly unlikely,
11 that anything said by the Information Commissioner can be of
12 relevance to what I have to decide: firstly, because it is a
13 complaint and that complaint will deal with the procedural
14 aspects and the record-keeping of the UK IPO and, secondly,
15 because there has already been confirmed from the UK IPO on a
16 number of occasions that they have no further documents that
17 fall within the requests made on behalf of the appellant.

18 It is true that certain documents were produced by the
19 UK IPO as a result of the request earlier this year, a request
20 which although made very late in the day did result in the
21 production of some further documents. I have looked at those
22 documents, one of which relates to a change of proprietor's
23 details in 2008 and was produced not from the original file
24 that was the subject of an earlier request, but as I
25 understand it, from another related file and, second of all,

1 what are referred to as, "Optics", which are documents said by
2 the appellant to raise further questions and which are said on
3 behalf of the respondent to be totally irrelevant.

4 It has been said on behalf of the appellant that the
5 relevant dates that they are concerned with are dates between
6 20th June 2011 when the application was made in the related
7 proceedings that were ultimately determined by Mr. Hobbs, that
8 is 0-128-14, and at the latest November 2013 when a first
9 request was made of the UK IPO for information relating to the
10 1993 mark. It is further said for the first time today that
11 one of the questions in issue, as far as the appellant is
12 concerned, is whether or not a renewal fee was paid in respect
13 of the 1993 mark in or about 2010 and whether that was the
14 reason, it is said, the 1993 mark did not appear on the
15 register between those dates.

16 As to the dates are which are said by the appellant to
17 be of importance it is those dates of which complaint is made
18 as to the record-keeping on behalf of the UK IPO. It is of
19 note that the documents produced by the UK IPO in response to
20 the 2016 request, which the appellant seeks to say are very
21 important, and which the respondent says are not, are optics
22 for "Name and Address Clean Up Process" and "Search for
23 Associated Name and Address Details" for Furniture Village
24 Limited that are dated outside the periods that are said by
25 the appellant to be of relevance, that is, July 2008, and

1 therefore it seems to me that those cannot have any direct
2 relevance to the case that is before me.

3 On the basis of the materials before me does not seem to
4 me that there is any proper reason to think that there are
5 further relevant documents at the UK IPO. In any event, the
6 result of any complaint will not lead, in my view, to the
7 production of any other documents. The Intellectual Property
8 Office has been quite clear as to what they have and have not
9 retained and, as Mr. Tritton puts it, the Information
10 Commissioner cannot cause documents that have been destroyed
11 to be recreated, and that was accepted, quite rightly, by Mr.
12 Davies this morning.

13 The result of any complaint to the Information
14 Commissioner can at best, it seems to me, produce the result
15 that says the UK IPO record-keeping is not perhaps what it
16 should be. I express no view on that except to note that the
17 UK IPO has already apologised to the appellant with respect to
18 the one error that would have appeared to have occurred.

19 The question that is now for me is should the hearing of
20 the appeal be adjourned and I have come to the view that it
21 should not be. It does not seem to me the outcome of the
22 complaint that was made on 20th June this year can have any
23 bearing on what I have to decide. I have to decide whether
24 the Hearing Officer was correct to come to the decisions that
25 she did. It does not seem to me to be appropriate at this

1 stage in the proceedings, to wait to see if a complaint which
2 would appear only to deal with whether the UK IPO's
3 record-keeping is sufficient, is going to assist me in that
4 connection.

5 I should also make clear, as was rightly pointed out to
6 me by Mr. Tritton, that it would appear that the issue of the
7 trade mark renewal and the payment of the trade mark renewal
8 have only been raised for the first time on behalf of the
9 appellant at the hearing today. It was said on behalf of the
10 appellant that that was because it had not occurred to them to
11 request the documents relating to the payment of renewal fees
12 prior to this point.

13 I am somewhat surprised that it is only at this very
14 late stage that the appellant has considered this point in
15 circumstances where the proceedings that had been commenced on
16 16th October 2014, and where first of all, Mr. Rowan expressly
17 confirmed back in April 2014 in his email that all the renewal
18 had been paid, and, second of all, as I have been shown by the
19 respondent, the electronic historical details of the trade
20 mark 1550700 show, as the appellant rightly accepted, that the
21 1993 trade marks was renewed and, indeed, recorded various
22 other transactions.

23 I have also had regard to the fact, as submitted to me
24 on behalf of the appellant, that the mark is currently on the
25 register and therefore there is no prejudice to the respondent

