

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN INTERLOCUTORY HEARING IN RELATION TO  
OPPOSITION NO: 51597 BY AMERICAN CIGARETTE COMPANY (OVERSEAS)  
LIMITED TO TRADE MARK APPLICATION NO: 2190446 IN THE NAME OF  
WINFIELD SHOE CO LTD**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF** an interlocutory hearing in relation to  
opposition no: 51597 by American Cigarette Company (Overseas) Limited  
to trade mark application no: 2190446 in the name of Winfield Shoe Co Ltd

### **BACKGROUND**

1. On 1 March  
Ltd applied to  
trade marks in  
14, 20, 21, 24, 27,  
trade marks are



1999, Winfield Shoe Co  
register a series of four  
Classes 3, 6, 8, 9, 11, 12,  
30, 32, 37, 41 and 42; the  
reproduced below.

**WINFIELDS**

**WINFIELD'S**

**WINFIELD**

2. Following examination, the application was accepted on the basis of Honest Concurrent Use and on 26 July 2000 was published for a range of goods and services, details of which are included in Annex A to this decision.

3. On 25 October 2000, Withers & Rogers on behalf of their clients, American Cigarette Company (Overseas) Limited, (of which more later), filed Form TM7 Notice of Opposition, accompanied by a Statement of Grounds. On 17 January 2001, I held a Case Management Conference to consider a number of applications for trade marks consisting of the word WINFIELD and the word WINFIELD together with device elements applied for in the name of American Cigarette Company (Overseas) Limited and various oppositions thereto by Winfield Shoe Co Ltd. This Conference was attended by Mr Murch of Withers & Rogers and by Mrs Roome of Laurence Shaw & Associates. At this Conference the present application was discussed but at no point were the opponents' names queried or clarification sought. On 29 January 2001, Laurence Shaw & Associates on behalf of the applicants filed a Form TM8 accompanied by a Counter-Statement. In

an Official letter dated 1 February 2001, The Trade Marks Registry informed Withers & Rogers that Form TM8 and Counter-Statement had been received and under the provisions of Rule 13(7) set them a period of three months ie. until 1 May 2001 to file their evidence-in-chief.

4. On 25 April 2001, Withers & Rogers filed Form TM9 requesting an extension of time of three months ie. until 1 August 2001. In essence their reason for this request was that while evidence had been prepared, the parties were in negotiations with a view to settling the matter; in a letter dated 4 May 2001, Laurence Shaw & Associates objected to the Trade Marks Registry granting any additional time but did not request a Hearing. In an Official letter dated 15 May 2001, The Trade Marks Registry informed the parties that in view of the comments in Withers & Rogers's request, additional time would be allowed but only until 1 June 2001.

5. On 31 May 2001, the Trade Marks Registry received a letter from Withers & Rogers in which they commented as follows:

“We understand that the sheet attached to Form TM7 making reference to the second and third opponents as per the Statement of Grounds has been misplaced and as such a replacement is attached.”

6. On 31 May 2001, Withers & Rogers filed another Form TM9 requesting a further two weeks ie. until 15 June 2001 in which to file their evidence in chief. In a letter to Laurence Shaw & Associates dated 5 June 2001, the Trade Marks Registry issued a preliminary decision granting Withers & Rogers' request for additional time and commented as follows:

“I also refer to Withers & Rogers' letter which enclosed the continuation sheet to the Form TM7 which refers to the second and third opponents as per the Statement of Grounds. Please find attached a copy of this document for your records. All future evidence and correspondence filed should reflect the joint opponents”.

7. On 12 June 2001, the opponents filed their evidence in chief; this consisted of the Witness Statement of Michael Stanley Leathes together with exhibits MSL1 - MSL10.

8. In a letter to the Trade Marks Registry dated 18 June 2001, Laurence & Shaw commented:

“According to our records the Form TM7 in the above proceedings was filed in the name of American-Cigarette Company (Overseas) Limited of Liechtenstein only. We submit therefore that evidence submitted in the name of American-Cigarette Company (Overseas) Limited (London) and American-Cigarette Company (Overseas) Limited (Switzerland) is inadmissible”.

9. In a letter to Withers & Rogers dated 21 June 2001, the Trade Marks Registry commented:

“As discussed with Mr Murch the Form TM7 was filed in the name of American Company (Overseas) Limited (Liechtenstein) only and the continuation sheet shows the Switzerland

company and the Liechtenstein company again. As no reference has been made to the London company please can you supply an amended version of the continuation sheet”.

10. In a letter to the Trade Marks Registry dated 29 June 2001, Withers & Rogers explained that the continuation sheet originally attached to the Form TM7 (a copy of which was provided in their letter of 31 May 2001) contained a clerical error, in that it mentioned the company based in Liechtenstein (already contained in Box 3 of Form TM7) instead of the company based in London and an amended continuation sheet was provided. In a letter to Laurence Shaw & Associates dated 3 July 2001, the Trade Marks Registry commented as follows:

“The registrar is satisfied that a clerical error occurred at the time of filing the opposition and it was the opponents’ intention that the proceedings be filed in the name of the three opponents as stated above. The registrar has also noted that the three opponents names and addresses were provided on the printouts of the trade marks being relied upon in the statement of case. Therefore a copy of the continuation sheet which should have been attached to the form TM7 at the time of filing the opposition is enclosed for the applicants information”.

11. In a further letter to Laurence Shaw & Associates dated 3 July 2001, the Trade Marks Registry accepted into the proceedings the opponents’ evidence-in-chief and in accordance with the provisions of Rule 13(9) allowed the applicants until 12 September 2001 to file their evidence-in-chief.

12. On 10 September 2001, Laurence Shaw & Associates filed Form TM9 in which they sought an extension of time of one month. In the accompanying letter they commented as follows:

“We refer to the official action of July 3, 2001 and we apply herewith for an extension of time of one month i.e. until October 12, 2001, in which to file evidence.... The reason for the request is that the Trade Mark Attorney representing the applicant is on extensive sick leave since her return from holiday. The Attorney for the opponents has agreed to this extension request”.

I note that this request did not contain any further comments on the issue of the opponents’ names, dealt with in the Trade Marks Registry’s letter of 3 July 2001. In an Official letter dated 14 September 2001, the Trade Marks Registry stated that their preliminary decision was that the request for the period for filing evidence to be extended until 12 October 2001 should be granted.

13. On 10 October 2001, Laurence Shaw & Associates filed a further Form TM9 in which they sought an extension of time of five days. In the accompanying letter they commented as follows:

“We refer to the official action dated September 14 2001 and we apply herewith for an extension of time of five days ie until October 17 2001, in which to file evidence.... The reason for the request is that the Trade Mark Attorney representing the applicant has returned recently from extended sick leave and is still in the process of finalising the

evidence to be submitted. ....”.

Again, I note that this request did not contain any further comments on the issue of the opponents' names.

14. On 17 October 2001 Laurence Shaw & Associates filed a further Form TM9 in which they sought an extension of time of one month. In the accompanying letter their comments (in so far as they are relevant) were as follows:

“The opponent, by its conduct before the Patent Office has introduced new matters which need to be addressed. These matters were not pleaded in the original statement of grounds and cast doubt on the admissibility of the opponents' evidence in chief.....”.

Again, I note that in this request no further comments were made on the issue of the names of the opponents. In an Official letter dated 22 October 2001, the Trade Marks Registry stated that their preliminary decision was that the requests for extensions of time until 17 October 2001 and 17 November 2001 should be granted.

15. On 13 November 2001, Laurence Shaw & Associates wrote two separate letters to the Trade Marks Registry in connection with this case. Once again, I note that neither letter contained comments on the issue of the names of the opponents.

16. On 16 November 2001, Laurence Shaw & Associates wrote to the Trade Marks Registry in the following terms:

“We refer to the official action of October 22, 2001, reporting that an extension of time has been granted until November 17, 2001. We seek leave to file a supplementary counterstatement to address irregularities in procedures and breaches of Section 38 and Rule 13(1) by the opponents(s).....”

and they enclosed a supplementary Counter Statement, Witness Statement and two exhibits in the name of Keith Leaman, together with Rule 13(9) evidence in the form of a Witness Statement and four exhibits also by Mr Leaman. Further evidence in the form of a Witness Statement and one exhibit by Richard McConn and a Witness Statement in the name of Steven Hartley were subsequently received. In a letter dated 3 December 2001, the Trade Marks Registry wrote to Withers & Rogers advising them that Laurence Shaw & Associates had filed evidence on behalf of the applicants, and under the provisions of Rule 13(10) set them a period of three months ie. until 19 February 2002 to file evidence strictly in reply. The letter also gave Withers & Rogers an opportunity to comment on Laurence Shaw & Associates' request to file a supplementary Counter-Statement. Comments were subsequently received in a letter from Withers & Rogers dated 17 December 2001, in which their comments (amongst others) were as follows:

“As far as we are concerned this matter has already been reviewed by Mr Knight and a decision was issued on 3 July 2001. If the applicants agent was unhappy with that decision,

the time to have objected was then and not some four and a half months later. To attempt “a second bite of the cherry” at this late stage is both inequitable and an abuse of the process”

And:

“If it was not for the honesty of the opponents’ agent in bringing what is an obvious clerical error to the attention of all parties, it is probable that the issue would have gone unaddressed”

And:

“In Mr Leaman’s evidence filed under Rule 13(9) he indicates at paragraph 6 that the applicants’ evidence will remain unchanged regardless of the number of opponents. As such the applicants’ agent has indicated that their client will not be prejudiced by the Registry confirming the original decision”.

17. On 9 January 2002, I wrote to Withers & Rogers, copied to Laurence Shaw & Associates in the following terms:

“Having reviewed the papers, I agree with the view expressed in the official letter of 3 July 2001 ie. that the Registrar accepts that it was always your intention to file these proceedings in the name of the three companies mentioned in your letter of 29 June 2001. In this regard, I note that all three companies are clearly identified in both the opponents’ Statement of Grounds and in the applicants’ Counter-Statement

In view of my decision above, the opponents in these proceedings will continue as American Cigarette Company (Overseas) Limited based in Liechtenstein, London and Switzerland. The supplementary Counter-Statement and Witness Statement of Keith Leaman dated 16 November 2001 will not in the circumstances be admitted into the proceedings”.

18. In a letter dated 8 February 2002, Laurence Shaw & Associates requested an Interlocutory Hearing. In the event, the Interlocutory Hearing scheduled for 28 February 2002 did not take place. However, Written Submissions dated 28 February 2002 were received from Laurence Shaw & Associates; nothing further was received from the opponents. Having reviewed the case again and having borne in mind the applicants’ written submissions, on 14 March 2002, I wrote to the parties informing them of my decision. A copy of my letter is attached as Annex B to this decision.

19. For the sake of completeness I should say that on 18 February 2002, Withers & Rogers filed Form TM9 requesting an additional eight days i.e until 1 March 2002 to file their evidence in reply; a request to which in an Official letter dated 25 February 2002 the Trade Marks Registry provisionally agreed and to which the applicants did not object (their letter of 28 February 2002 refers). In the event, I note that the opponents did not file any evidence-in-reply.

20. On 15 April 2002, Laurence Shaw & Associates filed Form TM5 requesting a Statement of

Grounds of Decision. I give my decision in this matter below.

## DECISION

21. Opposition proceedings before the Trade Marks Registry are governed by Section 38 of the Trade Marks Act 1994 and Rule 13 of the Trade Marks Rules 2000, the relevant parts of which are reproduced below:

“38.— (1) When an application for registration has been accepted, the registrar shall cause the application to be published in the prescribed manner.

(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 include a statement of the grounds of opposition.”

And:

“13. - (1) Notice of opposition to the registration of a trade mark shall be filed on Form TM7 within three months of the date on which the application was published under rule 12, and shall include a statement of the grounds of opposition; the registrar shall send a copy of the notice and the statement to the applicant”.

22. Although there has been a good deal of correspondence filed, the issue in dispute in these proceedings is a simple one: who is/are the opponent/opponents to the application for registration? In order to determine that I need answers to the following questions: is it beyond doubt that the opponents did not attach a continuation sheet to Form TM7 when the opposition was originally filed? and if they did not, what are the consequences? Also assuming the answer to the first question is yes, and it is not beyond doubt that the opponents did file a continuation sheet, are they then allowed to amend that continuation sheet to correct an error which occurred when it was originally prepared?

23. In my letter of 14 March 2002 to Laurence Shaw & Associates (attached), I commented as follows:

“In my view the key dates in these proceedings are as follows:

- the opposition to this application was filed on **25 October 2000**. In their Statement of Grounds attached to the Form TM7, the opponents clearly indicated that the opposition had been lodged in the name of the American-Cigarette Company (Overseas) Limited (Switzerland), (London) and (Liechtenstein);
- in their Counter-Statement dated **29 January 2001**, the applicants clearly

understood this to be the case because the name of the three companies were included in the heading of their counterstatement;

- on **31 May 2001**, Withers & Rogers wrote to the Trade Marks Registry providing a replacement copy of the “misplaced” continuation sheet;
- on **5 June 2001**, the Trade Marks Registry wrote to your firm confirming their acceptance of the continuation sheet;
- on **18 June 2001**, your firm wrote to the Trade Marks Registry querying the inclusion of the company’s based in London and Switzerland but did not request a Hearing in the matter;
- on **29 June 2001**, Withers & Rogers explained that the continuation sheet originally attached to the Form TM7 contained a clerical error, in that it duplicated the Liechtenstein address included in Box 3 of the Form TM7, explaining that the London address should have been included;
- on **3 July 2001**, the Trade Marks Registry accepted this explanation and wrote to your firm accordingly;
- on **16 November 2001**, (over four months later), your firm wrote to the Trade Marks Registry seeking leave to file a supplementary Counter-Statement together with a Witness Statement and exhibits”

I also said:

“What is clear however, is that in their letters of 31 May and 29 June 2001, Withers & Rogers clearly indicate that such an attachment was provided when the Form TM7 was filed (see the references to a “replacement” copy). I should be slow indeed to treat such a statement from a respected firm of Trade Mark Attorneys at anything other than face value. Indeed all of the documentation which supports the opposition is consistent with this statement referring as it does to the American-Cigarette Company (Overseas) Limited (Switzerland), (London) and (Liechtenstein)”.

And:

“In the circumstances of these proceedings and given the assurances of Withers & Rogers and the absence of compelling evidence to the contrary, I am satisfied that on the balance of probability and bearing in mind the supporting documentation that was filed at the time the Form TM7 was filed, that when the Form TM7 was originally filed it included with it a continuation sheet in which the names of the American-Cigarette Company (Overseas) Limited (Switzerland) and (erroneously) (Liechtenstein) appeared. I am also satisfied that in the light of this supporting documentation the inclusion of the company based in



Liechtenstein resulted from a clerical error which is capable of being corrected (by deleting the duplicate reference to the Liechtenstein company and adding the London company), without altering the scope of the opposition as originally filed.

I also note that notwithstanding a number of exchanges of correspondence between the Trade Marks Registry and your firm following the official action of 3 July 2001, no action was taken by your firm in respect of the names of the various opponents until you wrote to the Trade Marks Registry on 16 November 2001. Had your firm wished to challenge the Trade Marks Registry's view on this issue, it would I think have been reasonable to expect you to do so in a timely fashion.

I also take account of the fact that in responding to the opposition your firm on behalf of your clients acknowledged in the Counter Statement that there were three opponents, and the fact that your clients' evidence is not dependant upon whether or not there are joint opponents; this goes to the lack of prejudice to your clients".

24. In answering my first question mentioned above, namely is it beyond doubt that the opponents did not attach a continuation sheet to Form TM7 when the opposition was originally filed, and if they did not what are the consequences? there is in my view simply insufficient information on which to draw a clear conclusion. In his various written submissions Mr Leaman has pointed to the discrepancy between the numbers of pages attached to the Form TM7. In my letter of 14 March 2002. I commented on this point in the following terms:

" I note that the applicants refer to the Form TM7 filed by the opponents and point out that when this Form was originally filed it indicated that there were 27 sheets attached to it. They note that all these sheets are present and conclude that when the Form was originally filed there could not have been attached to it the continuation sheet on which the names of the additional opponents are said to have appeared. Clearly this is one interpretation. Equally possible is that the continuation sheet was included but the number of additional sheets attached to the Form TM7 were incorrectly counted. Put simply it is impossible to say".

25. In addition I have the confirmation of the opponents' agents Withers & Rogers that the Form TM7 when filed did include the continuation sheet indicated. In all the circumstances, and for the reasons indicated above, I am not prepared to accept such a statement at anything other than face value. That being the case I am prepared to accept that on the balance of probabilities, and bearing in mind all the surrounding documentation provided, that when the Form TM7 was originally filed it was accompanied by a continuation sheet on which the names of American Cigarette Company (Overseas) Limited, based in Switzerland and Liechtenstein appeared - the latter of which appeared erroneously. Undeniably there appears to be an inconsistency between the numbers of sheets attached to the Form TM7 and the number which ought to have been attached had the continuation sheet been included. However, I am not prepared to infer from this fact alone that the continuation sheet was not included when the Form TM7 was originally filed. That being the case, I do not need to go on and consider the alternative arm of my first question.

26. I now need to answer the second of my questions, namely: assuming the answer to the first question is yes, that is to say that it is not beyond doubt that the opponents did file a continuation sheet, are they then allowed to amend that continuation sheet to correct an error which occurred when it was originally prepared? The answer to this question is, I would suggest, less debatable. In my letter of 14 March 2002 attached, I answered this question in the following terms:

“What then of the opponents request to amend the continuation sheet to delete the duplicated reference to the Liechtenstein company and replace it with the London company? Given the opponents assurances that the continuation sheet was attached to Form TM7 when it was originally filed and bearing in mind the totality of the supporting documentation ie. the names of the three companies mentioned in the opponents’ Statement of Grounds and the earlier rights relied upon by the opponents in those Grounds, I have little hesitation in concluding that this was a clerical error on the part of the opponents which the Trade Marks Registry has the authority to allow the opponents to correct”.

In the **Pharmedica case** [2000] RPC 536 case Mr Justice Pumfrey said:

“Notwithstanding the fact that the Registrar is, like the County Court, a tribunal which is established by statute, I have no doubt that the Registrar has the power to regulate the procedure before her in such a way that she neither creates a substantial jurisdiction where none existed, nor exercises that power in a manner inconsistent with the express provisions conferring jurisdiction upon her”.

## **CONCLUSION**

27. For the reasons given above, I consider it reasonable to allow the opposition to proceed in the name of American Cigarette Company (Overseas) Limited based in Liechtenstein, Switzerland and London; the supplementary Counter-Statement, Witness Statement and associated exhibits contained in Laurence Shaw & Associates’ letter of 16 November 2001 shall not therefore be admitted into the proceedings. In reaching a decision in these proceedings, I have considered all of the documentation on the Official file and have paid full regard to the applicants’ Written Submissions.

**Dated this 29<sup>TH</sup> Day of April 2002**

**M KNIGHT  
For the Registrar  
The Comptroller-General**

## **Annex B in paper copy**

### **ANNEX A**

**Class 3** - Cleaning, polishing, scouring and abrasive preparations; soaps; perfumery; essential oils, cosmetics, hair preparations; bubblebath, cotton wool for cosmetic purposes; nail polish, nail preparations; dentifrices.

**Class 6** - Metal toolboxes, metal badges, metal keyrings, metal plaques, metal bins, cashboxes, clothes hooks, door furniture of metal; parts and fittings for all the aforesaid goods.

**Class 8** - Hand tools and instruments; soldering apparatus; cutlery; knives, forks, spoons; shaving razors; blades; garden tools; shears, secateurs; parts and fittings for all the aforesaid goods.

**Class 9** - Apparatus for recording, transmission or reproduction of sound or images; radios; cassette players; CD players; video cassettes; CD discs; blank and pre-recorded cassette tapes; electronic books and publications; instructional and teaching apparatus and instruments; electronic games, computer games; electrical and video amusement apparatus and instruments; cameras; computer peripherals; computer software; irons; scales; electric cables; plugs, sockets; telephone apparatus; calculators; sunglasses; sunglass cases; bicycle helmets; floats for swimming; water wings, water rings; goggles; batteries; electrical apparatus for use with the hair; parts and fittings for all the aforesaid goods.

**Class 11** - Apparatus for lighting, cooking and sanitary purposes; bath fittings; barbecues; coffee percolators; coffee machines; electric cooking utensils; deep fryers, hair dryers; electric lamps, lamp shades; torches; toasters, sandwich makers; food steamers; grills; electric kettles; drinking water filters; electric blankets; parts and fittings for all the aforesaid goods.

**Class 12** - Pushchairs; prams; bicycles; parts and fittings for all the aforesaid goods.

**Class 14** - Clocks, watches, jewellery.

**Class 20** - Furniture; chairs, drawers, picture frames, mirrors, table mats; pillows; cushions; garden furniture.

**Class 21** - Household or kitchen utensils and containers; combs and sponges; brushes; glassware, porcelain and earthenware; vases; buckets, mops; lunch boxes; saucepans, flasks; figurines; bins.

**Class 24** - Textiles and textile goods; bed and table covers; towels, tea towels; cushions, throws; curtains; handkerchiefs; travelling rugs; sleeping bags.

**Class 27** - Rugs, carpets, floor coverings.

**Class 30** - Confectionery, biscuits, ice cream, ices; cakes; pastries.

**Class 32** - Non-alcoholic drinks and preparations for making such drinks; fruit juices.

**Class 37** - Shoe repair services; clothing repairs.

**Class 41** - Organisation, and presentation of events for entertainment purposes; provision of recreational facilities; provision of leisure facilities; presentation and provision of fun days; museum services; provision of exhibition services; provision of display of vintage motorcycles.

**Class 42** -Catering services; restaurant services; café services; providing facilities for exhibitions.