BL O/0455/2 4

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 435699 IN THE NAME OF ISDIN S.A.

TO:

TRADE MARK APPLICATION No. 3782937 IN THE NAME OF GLAXOSMITHKLINE CONSUMER HEALTHCARE (UK) IP LTD

DECISION

Abbreviations

1. In this Decision:

> **"Opposition (1)"** refers to Opposition No. 435699 filed by Isdin S.A. (**"Isdin"**) on 19 August 2022 to Trade Mark Application No. 3782937 filed by GlaxoSmithKline Consumer Healthcare (UK) IP Ltd (**"GS KCH"**) on 29 April 2022.
>
> **"Opposition (2)"** refers to Opposition No. 437363 filed by Gap (ITM) Inc. (**"GII"**) on 22 November 2022 to Trade Mark Application No. 3792566 filed by GSKCH on 26 May 2022.

The Error

2. In email correspondence between GSKCH and GII on 17 March 2023 it was agreed that Opposition (2) would be resolved by the voluntary withdrawal of GSKCH's Trade Mark Application No. 3792566.

3. To that end, a trade mark paralegal employed by GSKCH sent an email to the Trade Marks Registry on 27 March 2023 stating:

> We refer to our previous correspondence and advise that following discussions with the other party, we have agreed to withdraw our application. **Please proceed accordingly and we look forward to receiving your confirmation shortly.**

4. That email was cc'd to three people: two named individuals at the firm of trade mark attorneys acting for GII and the person at GSKCH who had instructed the trade mark paralegal to withdraw the contested application.

5. No one appears to have noticed that the subject line in the heading of the email sent to the Registry referred to: **Opposition No: OP000435699 against UK Trade Mark No: UK00003782937 – Opponent: ISDIN, S.A [84178819]**. That is to say, instead of referring to Opposition (2) as agreed and intended by the parties to that Opposition, it mistakenly referred to Opposition (1).

6. The email was not cc'd to Isdin's professional representatives as would ordinarily have happened in line with standard practice in the Registry if there had been an agreement and intention to terminate Opposition (1).

7. The Registry proceeded to remove Trade Mark Application No. 3782937 from the Register. Having done so, it wrote to the parties to Opposition (1) on 31 March 2023 using the reference numbers applicable to that Opposition stating:

> I can now confirm that the above application has been withdrawn as requested in your letter dated **27 March 2023**.

8. That did not trigger any reaction from GSKCH. It did, however, result in Isdin's professional representatives writing to the Registry on 20 April 2023 noting that Trade Mark Application No. 3782937 "*is the basic application on which International Registration No. 1695502 was based and the UKIPO is the Office of Origin*" and adopting the position that: "*As the basic application was withdrawn in its entirety, the Opponent respectfully requests the Registry to inform WIPO of the total withdrawal of the basic application and requests WIPO to cancel the International Registration No. 1695502 in its entirety and inform the designated national offices*."

9. This was met by a request from GSKCH on 24 April 2023 for its Trade Mark Application No. 3782937 to be reinstated for having been withdrawn in error. The Registry responded on 25 April 2023 with a preliminary view indicating that it was willing to accede to the request for reinstatement. Isdin disagreed with the Registry's

preliminary view and on 27 April 2023 requested a hearing at which to contest the matter.

The Hearing in the Registry

10. The hearing requested by Isdin took place on 26 May 2023 before Ms Heather Harrison acting on behalf of the Registrar of Trade Marks. The question for determination was whether the Registrar could and, if so, whether he should exercise the power conferred on him by r.74 of the Trade Marks Rules 2008 so as to reinstate the mistakenly withdrawn application for registration.

11. Rule 74 provides as follows:

> **Correction of irregularities in procedure**
>
> 74.— (1) Subject to rule 77, the registrar may authorise the rectification of any irregularity in procedure (including the rectification of any document filed) connected with any proceeding or other matter before the registrar or the Office.
>
> (2) Any rectification made under paragraph (1) shall be made — (a) after giving the parties such notice; and (b) subject to such conditions, as the registrar may direct.

12. Isdin contended, in essence, that the withdrawal of the trade mark application was irrevocable, that the identification of Opposition (1) instead of Opposition (2) in the subject line of GSKCH's email to the Registry dated 27 March 2023 did not amount to or involve "*any irregularity in procedure"* within the scope of r.74(1) and that even if it did, the Registrar should not reinstate the application in the exercise of the discretion conferred by that rule.

13. GSKCH contended, in essence, that the words "*any irregularity in procedure (including the rectification of any document filed) connected with any proceeding or other matter before the registrar or the Office*" were as broad as they needed to be to permit rectification of the subject line of its 27 March 2023 email and that the Registrar should, on the facts of the present case, authorise the requested correction in the exercise of his discretion so as to reinstate the mistakenly withdrawn application for registration.

The Outcome of the Hearing

14. The Hearing Officer decided for the reasons she gave in a Decision letter issued on 01 June 2023 that the withdrawal of the trade mark application should be reversed under r.74(1) with the result that the proceedings in Opposition (1) would resume on a timeline requiring Isdin to file its evidence in support of the Opposition by 09 June 2023.

15. In summary, she determined:

(1) on the evidence and materials before her, there was no reason to think the withdrawal of the trade mark application was anything other than a mistake: para. [11];

(2) r.74(1) enables an irregularity in procedure **connected with** any proceeding or other matter **before** the Registrar or the Office to be corrected without requiring it to be an irregularity attributable to a mistake **by** the Registrar or the Office: paras [15], [16];

(3) the rule can, as decided in Andreas Stihl AG's Trade Mark Application [2001] RPC 215, BL O/379/00, be used to correct errors in procedure which do not qualify for rectification under s. 64 of the Trade Marks Act 1994: para. [17];

(4) in the present case, there was an irregularity in procedure capable of correction under r.74 as a result of the application for registration having been withdrawn without authorisation by a trade mark paralegal who had no instructions to withdraw it: paras. [16] and [17];

(5) when deciding whether it would be right to make a correction of the kind sought by GSKCH in the exercise of the discretion conferred by the rule, it was necessary to take account of all relevant circumstances, including the prejudice to the parties, the timeliness of the request for correction and the impact that alteration of the status of the trade mark from 'withdrawn' to 'live' may have on third parties: paras [18] to [20];

(6) it was clear from the evidence that the irregularity had occurred because the paralegal concerned failed to check with sufficient care the details of the trade mark which were included in the subject line of the 27 March 2023 email and the responsibility for that lay with GSKCH's then-representatives: para. [21];

(7) although the error was not noticed immediately, once it was noticed immediate action was taken: para. [21];

(8) if the trade mark application was not reinstated the consequences would be serious for GSKCH, whereas reinstating the application for registration and Isdin's Opposition to it would involve no substantial prejudice to Isdin or discernible detriment to any third party: paras. [23] to [26].

16. No conditions were imposed on the reinstatement of the application under r.74(2)(b).

The Appeal

17. Isdin appealed with the permission of the Registrar given under r.70(2) of the 2008 Rules. In its Grounds of Appeal dated 27 June 2023, it renewed its contentions to the effect noted in para. [12] above and maintained that the Hearing Officer's Decision to the contrary should be set aside for being wrong in point of law and wrong in point of fact.

18. In its Respondent's Notice dated 20 July 2023, GSKCH contended that the Appeal should be dismissed on the basis that the Hearing Officer's Decision was, for the reasons she gave, correct in point of law and correct in point of fact.

19. Both sides developed and refined their submissions in the course of oral argument at the hearing before me.

20. The difference between them on the interpretation of r.74(1) ultimately boiled down to this: the subject line of the email sent to the Registry by GSKCH on 27 March 2023 clearly and unambiguously referred to Opposition (1); that was sufficient according to Isdin, but not sufficient according to GSKCH, to prevent the email from being a procedurally irregular request for withdrawal of the trade mark application in issue in that Opposition.

21. The difference between them as to the exercise of discretion under r.74(1) ultimately boiled down to this: according to Isdin, but not according to GSKCH, the Hearing Officer under-stated the harm to Isdin and third parties of reinstating the mistakenly withdrawn trade mark application and over-stated the harm to GSCKH of not reinstating it, thus adopting a skewed approach to the balance of justice under the rule.

Analysis

22. The withdrawal of a pending application for registration is a procedural step which a trade mark applicant may unilaterally take at any time under s.39(1) of the 1994 Act without paying a fee or complying with any formal requirements i.e. it is a step which can be taken simply by sending the Registrar an appropriately worded notification of withdrawal.

23. The notification of withdrawal is "*connected with any proceeding or other matter before the registrar or the Office*" and as a "*document filed*" in that connection (see r.2(3) of the 2008 Rules) it may be amended in the exercise of the power conferred upon the Registrar by r.74 to authorise "*the rectification of any irregularity in procedure"*.

24. The power conferred by r.74 is interstitial and cannot be exercised inconsistently or incompatibly with the intended effect of any other provisions of the Act and the Rules.

25. That principle effectively limits the application of r.74 to situations in which the "*irregularity in procedure*" can be rectified without purporting to authorise non-compliance with mandatory provisions: Energy Conservation Devices Inc's Applications [1983] RPC 231 (HL); Prangley's Application [1987] RPC 187 (CA).

26. It does not require the application of r.74 to be further restricted to situations in which the "*irregularity in procedure"* involved or gave rise to non-compliance with specifically identifiable provisions of the Act or the Rules. And, in my view, the language of r.74 as a whole is agnostic as to whether that may or may not have been the case with regard to any particular "*irregularity in procedure*" sought to be rectified under that rule.

27. I am aware that the expression "*irregularity in procedure*" as used in r.100 of the Patents Rules 1978 ("*Any document filed in any proceedings before the comptroller may, if he thinks fit, be amended, and any irregularity in procedure in or before the Office may be rectified, on such terms as he may direct*") was taken by the House of Lords in Energy Conservation Devices Inc's Applications (above) at p.250 per Lord Diplock to mean "*simply a failure to observe procedural rules, whatever the cause of the failure may be*".

28. That was sufficient to support the substantive ruling in that case to the effect that the power conferred on the Comptroller by r.100 of the 1978 Rules could not be used to authorise non-compliance with the mandatory provisions of rr. 85(1)(a) and 110(1), (2) applying "the well-established canon of construction *generalia specialibus non derogant*" (pp. 250, 251). It was not, so far as I can see, intended to be an exhaustive definition of what can qualify for recognition as an "*irregularity in procedure*."

29. In Prangley's Application (above) the Court of Appeal (Fox, Bingham and Russell L.JJ) decided that even though r.100 of the 1978 Rules could not be used to authorise non-compliance with mandatory provisions (p.191) an applicant for a patent could rely on it to amend his demand for international preliminary examination or rectify the irregularity which his failure to elect the United Kingdom in his demand had caused (p.195).

30. Significantly for present purposes, the Judgment of the Court delivered by Bingham LJ differentiated between making a request which contains an error and failing to comply with prescribed filing requirements:

> "He is simply seeking to amend a document filed in proceedings before the Comptroller, namely his demand for international preliminary examination, by adding the United Kingdom to his list of elected states or to rectify the irregularity in procedure which he caused by framing his demand in terms which differed from his original PCT application. It is accepted that such amendment or rectification would give effect to the applicant's intention at the time when the demand was made. No-one will be prejudiced. Common justice plainly requires that he should obtain this relief. It is of course true that the consequence of a retrospective amendment or rectification is to entitle the applicant to the 25-month instead of the 20-month time limit and thus to validate his submission of fees and forms in December 1983. So be it. Happily the applicant observed

> the 25-month time limit and so no extension of time as such is called for."

31. The reasoning of the Court of Appeal in that case supports the view that the mistake made by GSKCH in the present case is properly classifiable as an "***irregularity in procedure***."

32. CPR r.3.10 analogously provides that: "*Where there has been an error of procedure such as a failure to comply with a rule or practice direction — (a) the error does not invalidate any step taken in the proceedings unless the court so orders; and (b) the court may make an order to remedy the error*."

33. The Court of Appeal (May, Tuckey and Dyson L.JJ) considered the scope of the expression "*error of procedure*" as used in that rule in Steele v Mooney [2005] 1 WLR 2819; [2005] EWCA Civ 96. The claimant in that case had intended to issue an application notice for an extension of time "*for the service of the particulars of claim and supporting documentation including the claim form*", but mistakenly omitted the words "*including the claim form*" from the application notice.

34. Significantly for present purposes, the Court emphasised in para. [27] that "*There is a difference between (a) making an application which contains an error, and (b) erroneously not making an application at all*". The claimant's request for correction of the error under r.3.10 was allowed on the basis identified in para. [20]:

> "… procedural errors are not confined to failures to comply with a rule or practice direction. A party may take a procedural step which is permitted by the rules and practice directions, but which he takes in error. A party may by mistake do X when he intended to do Y, where both X and Y are procedural steps and both are permissible. … If a claimant applies for an extension of time for service of the particulars of claim when he intends to apply for an extension of time for service of the claim form, he makes an error of procedure. The judge's distinction between a procedural error and a drafting error is not well founded. In a case such as the present, the drafting error **is** the error of procedure. The error lies in the fact that the applications were wrongly drafted."

35. The reasoning of the Court of Appeal in that case supports the view that the mistake made by GSKCH in the present case is properly classifiable as an "***error of procedure***."

36. The same is true of the reasoning in Toplain Ltd v Orange Retail [2012] EWHC 4254 (Ch) where a party to two different sets of proceedings pending before the Central London County Court intended to serve a notice of discontinuance in one set of proceedings, but mistakenly served it in the other set of proceedings. The notice as served was a perfectly regular notice and there was nothing on the face of it or in the letter under cover of which it was served to suggest any error: "*That could be material to the exercise of discretion under rule 3.10, but not to the question of jurisdiction*" (para. [12]). Roth J upheld the decision of HHJ Dyke at first instance to the effect that the mistaken service of the notice of discontinuance was an "*error of procedure*" which could and should be remedied in the exercise of the power conferred by CPR r.3.10.

37. I could only distinguish the present case from the Steele and Toplain cases by insisting that they were applying a rule which provides for rectification of "*an **error** of procedure **such as a failure to comply with a rule or practice direction***" (r.3.10) whereas I am dealing with the application of a rule which provides for rectification of an "***irregularity** in procedure (**including the rectification of any document filed**) **connected with any proceeding or other matter before the registrar or the Office***" (r.74).

38. I am not prepared to do that. In context, the word "***irregularity***" as used in r.74 and the word "***error***" as used in r. 3.10 both appear to me to connote procedural defects and deficiencies and to provide for them to be rectified in essentially the same way to essentially the same effect.

39. The amendment of GSKCH's notification of withdrawal simply for the purpose of correcting an error in the identification of the trade mark application intended to be withdrawn was not inconsistent or incompatible with any other provisions of the Act and the Rules and the Registrar had the power to authorise it under r.74.

40. The discretionary power conferred by r.74 could still be exercised by the Registrar notwithstanding that the Registry had implemented the erroneous notification of withdrawal by the time GSKCH applied for rectification: see PARIS BREAKFAST TEA Trade Mark BL O/396/15 (17 August 2015) at paras [17] to [19] and the Registrar's commitment recorded in the third recital to the Order of Laddie J annexed to that Decision.

Decision

41. The Hearing Officer correctly decided that the Registrar had the power under r.74 of the Trade Marks Rules 2008 to rectify the error in the identification of the trade mark application which GSKCH intended to withdraw by, in effect, authorising it to amend the subject line of its notification of withdrawal dated 27 March 2023 to read: "**Opposition No: OP000437363 against UK Trade Mark No: UK00003792566 — Opponent: Gap (ITM) Inc.**" instead of "**Opposition No: OP000435699 against UK Trade Mark No: UK00003782937 — Opponent: ISDIN S.A. [84178819]**".

42. Having reviewed the papers on file and considered the parties' written and oral submissions, I am satisfied that it was open to the Hearing Officer on the evidence and materials before her to conclude, as she did, that if Trade Mark Application No. 3782937 was not reinstated the consequences for GSKCH would be serious, whereas reinstating the Trade Mark Application and Isdin's Opposition to it would involve no substantial prejudice to Isdin or discernible detriment to any third party. The slowdown in procedure which rectification of the error entailed would really only result in Isdin doing things somewhat later than it would otherwise have done to progress its reinstated Opposition to GSKCH's reinstated trade mark application.

43. For the reasons I have given, Isdin's Appeal is dismissed. Since I consider that the usefulness of the interim proceedings before me is from a practical point of view liable to depend on the outcome of the proceedings as a whole, I direct that that the costs of the Appeal be treated as costs incurred in the registry proceedings and dealt with by the Registrar in the usual way at the conclusion of Opposition No. 435699.

Geoffrey Hobbs KC

20 May 2024

Ms Rachel Wilkinson-Duffy of Baker & McKenzie LLP appeared on behalf of GSKCH

Mr Julius Stobbs of Stobbs (IP) Ltd appeared on behalf of Isdin