

BL O/0689/25

IN THE MATTER OF THE TRADE MARKS ACT 1994

**AND IN THE MATTER OF UK Trade Mark
Application No. UK00003773100**

MOORES ROWLAND (words)

Applied for in Classes 35, 36, 45 in the name of PT MRI Indonesia

AND IN THE MATTER OF

OPPOSITION No. 000438931 thereto

by Dr. Curtis N. Rhodes, Jr.

DECISION OF THE APPOINTED PERSON

1. This is an appeal from the decision of the Hearing Officer Andrea Rossi dated 23 September 2024.
2. PT MRI Indonesia (who are the Appellant before me and I shall refer to as "the Applicant") were represented by Ms Eleanor Coates of Murgitroyd and Company represents. The Opponent, Dr Curtis N Rhodes junior, a US citizen, is no longer represented and does not take part in this appeal.
3. The facts can be shortly stated. The Applicant filed for UK Trade Mark Application No. UK00003773100 for the word mark MOORES ROWLAND in Classes 35, 36 and 45 on 1 April 2022 and the application was published on 28 October 2022. I will call this 'the Later Mark'.
4. Dr. Rhodes ('the Opponent') filed a Notice of Opposition on 30 January 2023 under Section 5(2)(a) and (b) on the basis of his UK Registration No. UK00916952161 for the word mark MOORES ROWLAND in Classes 35, 36 and 45

(‘the Earlier Mark’). The Earlier Mark had been filed on 5 July 2017 and registered on 23 October 2017.

5. The marks were identical and the services were either similar or identical. It was held that there was a likelihood of confusion between them. No issue arises on this on appeal.
6. Where s6A of the Trade Marks Act 1994 applies, an earlier mark can only be relied on to prevent the registration of a later mark if the earlier mark is proved to have been used in the United Kingdom. However, this provision only applies to earlier marks which completed their registration process more than 5 years before the date of application of the later mark. See s6A(1A).
7. In this case, however, the date of registration of the earlier mark was 23 October 2017, and the date of application of the later mark was 1 April 2022. Section 6A therefore did not apply.
8. The Opposition was determined on the papers by the Hearing Officer Andrea Rossi in a Decision issued on 23 September 2024. He upheld the Opposition and refused registration of the Later Mark.
9. On 10 November 2022 (that is to say before the Opposition was even brought), the Applicant had filed a Cancellation Action seeking to revoke the Opponent’s Earlier Mark for non-use. The Applicant made the Hearing Officer aware of this in their written submissions of 1 February 2024. However, there was no application for a stay of proceedings. The submissions merely asked that the decisions in the Opposition and the Cancellation proceedings be given at the same time, apparently so the Applicant could take into account the result of the Cancellation proceedings when deciding whether to appeal.

10. The Hearing Officer went ahead and dealt with the Opposition in the ordinary way, handing down the Decision (as I have said) on 23 September 2024. The Cancellation Action had not been resolved by this time. It was ultimately resolved in the Applicant's favour by Decision 0114524 issued on 29 November 2024, cancelling the Earlier Mark.
11. Under s46(6) of the Act a mark is revoked from the date at which the grounds for revocation existed. Here, those grounds existed from the 5th anniversary of the date at which the mark had completed its process of registration. In this case, therefore, the Earlier Mark was cancelled with effect only from 24 October 2022. This was of course more than 6 months after the date of application of the Later Mark. As of that date it was therefore still an 'earlier trade mark' under the definition in s6(1)(a) of the Act, and thus capable of barring registration under s5(1) and (2).
12. The Hearing Officer fully understood the relevance of the dates. In paragraph 8 of his Decision he stated as follows:

'On 10 November 2022 the applicant filed a revocation action for non-use against the opponent's Earlier Mark number UK00916952161 (CA000505551). According to case law, where the revocation date of an earlier mark falls after the filing date of a contested mark, an opponent can still rely upon its earlier mark within opposition proceedings against that mark because it was still a valid registration when the contested mark was filed. [here he cited the decision of Prof Ruth Annand in Tax Assist BL O/220/12]. In this case, the cancellation applicant requested revocation to take effect from 24 October 2022. Therefore, in the eventuality the revocation is successful, at the filing date of the contested mark (1 April 2022) the Earlier Mark would constitute a valid mark for the purposes of this opposition. The outcome of the revocation action mentioned within the opponent's statement of grounds therefore has no impact on these proceedings.'

13. He therefore took no account of the prospects of the revocation action against the earlier mark succeeding and went on to deal with the Opposition on the merits.
14. Before me, Murgitroyd & Co on behalf of the Applicant say that the subsequent revocation of the Earlier Mark has created an injustice. They say that the Opposition ought not to have been determined prior to the Cancellation. And they say that because the Earlier Mark has now been found to have had no effect as at the date of publication of the application for the Later Mark, and/or as at the date of the determination of the Opposition, it would be appropriate for me to set aside the Decision to allow the Opposition.
15. I do not accept this submission for the following reasons.
16. First, it should be remembered that this is an appeal. Events subsequent to the decision of the Hearing Officer cannot render the Decision itself wrong. The Hearing Officer can only decide the case on the basis of the facts before him or her. At that time the Earlier Mark was still in force. If the Applicant had wished to seek an adjournment, they should have applied to do so and appealed any refusal. Whilst they did ask in their submissions for the matters to be heard together, there was no application to this effect and they therefore took the risk that the Opposition would be resolved before the Cancellation.
17. Second, and more fundamentally, I do not accept that there was any good reason for the Hearing Officer to have delayed his decision to see what happened in the cancellation action. I agree with the Hearing Officer's account of the legal position in paragraph 8 of his Decision, set out above.
18. I have not been assisted in understanding the Applicant's case on this by the failure of Ms Coates to provide a proper account of the relevant authorities on the point. The Hearing Officer, as I have said, cited the decision of Prof Annand in Tax

Assist. However, Ms Coates did not refer to Tax Assist at all in her skeleton argument before me. Nor did she refer to any of the numerous other relevant authorities both of the UK Courts and of the Court of Justice which are cited in Tax Assist as supporting Prof Annand's reasoning.

19. Prof Annand cites a number of decisions of the Appointed Person including *NOWWIRELESS*, BL O/338/10 and *RAPIER*, BL O/170/07. She also quotes the decision of the Court of Justice in Case C-542/07 P *Imagination Technologies Ltd v. OHIM* which stated as follows:

50. In so far as the appellant seeks to challenge the literal interpretation of Article 7(3) of Regulation No 40/94 by submitting that that interpretation does not make it possible for events which might occur after the application for registration has been filed to be taken into consideration, it is sufficient to point out that the appellant's argument does not state in what respect an amendment to the specification or withdrawal of the application for registration might affect the date to be taken into account in assessing the distinctive character of a trade mark. That argument must therefore be rejected.

51. Furthermore, as the Court of First Instance correctly held in paragraph 77 of the judgment under appeal, such a literal interpretation of Article 7(3) of Regulation No 40/94 is the only one compatible with the logic of the system of absolute and relative grounds for refusal in regard to the registration of Community trade marks, according to which the date of filing of the application for registration determines the priority of one mark over another.

20. The thrust of all these authorities is that questions of priority of one mark over another are to be determined as of the date of application of the later mark, and that the right to rely on the earlier mark to oppose the later mark does not cease to exist simply because it is revoked at a later date. I consider that this is correct.

Under English law, the extinction of a property right does not generally affect the legal rights under it which belonged to the owner before its extinction. See for example Lord Millett in On Demand Information plc (in administrative receivership) v. Michael Gerson (Finance) plc [2002] UKHL 13 at [38]-[39] (another case cited by Prof Annand). In the case of a trade mark, the rights of the proprietor include the entitlement to oppose registration of the same or confusingly similar marks for the same goods.

21. I should say that in Tax Assist Prof Annand did not explicitly deal with the situation in which the earlier mark had been revoked from a date prior to the date on which the Application for a declaration of invalidity commenced. In Tax Assist itself as in many of the authorities which she cited, the date of revocation was after the date of commencement of the Application to revoke. However, I am at a loss to understand why this distinction could matter. If the relative rights as between the proprietors of conflicting marks are to be decided as of the date of application of the Later Mark (which is the correct and logical position given the wording of s6(1)), there is no obvious reason why it should matter that the Earlier Mark had ceased to exist by the the date of commencement of Opposition proceedings, any more than it should matter that it had ceased to exist by the date of the Decision.

22. Third, I cannot see how the result of this case causes any injustice. All rights in the Later Mark including the right to sue for damages would have taken effect from its date of application, so it is only just and proper that its validity should be considered as of that date. A strict adherence to dates also provides certainty and presented no real difficulty for a party seeking to obtain a mark. They are able to search the Registry in advance of their application and discover the existence of earlier rights which might conflict with it. If they believe the earlier right has not been used, they can of course wait until the expiry of the relevant period of 5 years before applying for their own mark. Here, the Appellant jumped the gun when they could have waited a further 6 months and had a perfectly valid

application. Even if they believed that any Opposition would fail for other reasons, it was open to them to make a protective application after the relevant date (23 October 2022) against which the earlier mark could not have been asserted.

23. Although Ms Coates failed to cite Tax Assist or any of the cases cited therein, she heavily relied on a Decision of Mr Allan Knight in a case called TRANSPAY [2001] RPC 191. Here Mr Knight considered (in an *obiter* passage) that the Registry may take into account events occurring between the filing of an application and the date of issuance of a decision. In particular he seemed to consider that this could include dismissing an Opposition based on an earlier mark which had allowed to lapse in the course of the Opposition process. This was said to be a matter of ‘*common sense*’ and that a ‘*great deal of unfairness and inconvenience*’ would follow from not allowing such events to be taken into account. The only clear example of this which he gave was the difficulty that the parties would not in such a case be able to agree a compromise by means of a ‘part cancellation’ of the earlier mark so as to allow the later mark to proceed. I do not really understand this reasoning. If the parties have compromised the proceedings, then the relative grounds objection would fall away anyway under s5(5), the very point made by counsel for the Opponent in that case, Mr Graham. I do not think this is a strong authority, and in any event it turned on the construction of s6(3) of the 1994 Act, since repealed, specifically dealing with marks which lapsed or expired. For what it is worth, it seems to me that there is no unfairness or inconvenience in a case like the present.

24. I therefore reject the Appeal. Mr Rhodes has taken no part in the proceedings, so there will be no order for costs.

25. I do not propose to make a formal Order unless asked to do so.

THE APPOINTED PERSON

23 JULY 2025