

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATIONS NOS. 3828657, 3829141 AND 3829134 IN THE NAME OF MARADONA GLOBAL LIMITED TO REGISTER THE FOLLOWING TRADE MARKS



**DIEGO ARMANDO MARADONA**

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IN CLASSES 3, 9, 14, 16, 18, 21, 25, 28, 29, 30, 31, 32, 33, 35, 36, 38, 41, 42 AND 45

AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO UNDER NOS. 439518, 440908 AND 440909

BY DIEGO ARMANDO MARADONA SINAGRA, DALMA NEREA MARADONA VILLAFañE, DINORAH GIANINNA MARADONA VILLAFañE, DIEGO FERNANDO MARADONA OJEDA AND JANA MARADONA

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF T PERKS DATED 15 MAY 2025.

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DECISION  
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### **Introduction**

1. I am dealing with an application by Podium Icons Limited (formerly Maradona Global Limited) ("**Appellant**") to transfer an appeal from the Appointed Person to the High Court. The underlying appeal is in respect of the decision of Teresa Perks dated 15 May 2025 ("**Decision**") which held that the Oppositions brought by Diego Armando Maradona Sinagra, Dalma Nerea Maradona Villafañe, Dinorah Gianinna Maradona Villafañe, Diego Fernando Maradona Ojeda, and Jana Maradona ("**Respondents**") to the Appellant's applications for the marks shown above ("**Applications**") were successful.
2. On 20 June 2025 the Appellant filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994. The appeal was allocated to me, and on 8 July 2025 I provided the parties (via the Appointed Persons Secretariat Manager) with a list of potential dates for the hearing of the appeal. The Appellant responded on 22 July 2025 to say "*In accordance with Rule 72(1)(b) of the Trade Marks Rules 2008 we request that the Appointed Person refer the case to the High Court*". No reasons for the requested transfer were provided.
3. The Secretariat wrote to the Respondents representative on my behalf to seek the Respondents' views on transfer to the High Court, and also sought the Registrar's views. The Respondents' representatives said "*The Opponent does not wish to make any representations*

in relation to whether the matter should be heard before the Appointed Person or the High Court". The Registrar said:

*"I can confirm that we have no particular or strong view as to whether the Appointed Person should exercise his discretion by transferring this case to the High Court.*

*That notwithstanding, the Registrar also considers there to be no obvious or particular reason why referring to the Court is necessary for effective resolution of the case and the issues it raises. Furthermore, there is no public or policy importance to the issues raised".*

4. This decision is made following my consideration of the Decision, the Appellant's Grounds of Appeal, and the Respondents' and Registrar's views.

#### **Legal principles governing referral of an appeal from the Appointed Person to the High Court**

5. Section 76 of the Trade Marks Act 1994 provides:

"(1) An appeal lies from any decision of the registrar under this Act, except as otherwise expressly provided by rules. For this purpose "decision" includes any act of the registrar in exercise of a discretion vested in him by or under this Act.

(2) Any such appeal may be brought either to an appointed person or to the court.

(3) Where an appeal is made to an appointed person, he may refer the appeal to the court if--

(a) it appears to him that a point of general legal importance is involved,

(b) the registrar requests that it be so referred, or

(c) such a request is made by any party to the proceedings before the registrar in which the decision appealed against was made.

Before doing so the appointed person shall give the appellant and any other party to the appeal an opportunity to make representations as to whether the appeal should be referred to the court.

(4) Where an appeal is made to an appointed person and he does not refer it to the court, he shall hear and determine the appeal and his decision shall be final."

6. The principles applicable to a decision to transfer have been considered a number of times by the Appointed Person. In *Parkair Trade Mark O/065/09*, Amanda Michaels acting as the Appointed Person reviewed the earlier decisions including *A.J. AND M.A. LEVY's trade mark (No. 2)* [1999] R.P.C. 358, *Academy trade mark* [2000] R.P.C. 35, *Royal Enfield trade mark O/273/01*, *EBC trade mark O/132/03*, and *Elizabeth Emanuel Trade Mark* [2004] RPC 15. Ms Michaels summarised the applicable principles as follows:

- The Appointed Person has an unfettered discretion under s. 76(3);
- Any consensus reached between the parties about referring the appeal to the court is not determinative;
- The power to refer appeals to the court should be used sparingly, otherwise the clear object of the legislation to provide a relatively inexpensive, quick and final resolution of appeals by a specialist tribunal would be defeated;

- It will be very rare to make a reference in circumstances where a point of general legal importance cannot be identified;
- The cost and expense to the party not seeking to refer should be taken into account; this is a matter which may be of particular significance in a case where the party in question is an individual or small company or partnership;
- Regard must be had to the public interest generally. There is a public interest in having any uncertainty as to the state of the register resolved as soon as possible. On the other hand there is a public interest in having important points of law decided by the higher courts;
- The attitude of the registrar is important but not decisive.

### **Discussion – application to transfer**

7. Unusually in my experience, it is the Appellant, rather than the Respondent, who is seeking transfer in this instance. Martin Howe QC (as he then was), sitting as the Appointed Person in *Truscott O-391-18* said:

*“Although it is unusual to say the least for an appellant who has elected to appeal to the Appointed Person to change its mind and ask for a transfer of the appeal to the High Court, I do not consider that that bars a transfer being made or indeed that it is a particularly strong factor against a transfer if there are good grounds for making it. The fact that the appellant has been somewhat tardy in realising that those good grounds exist may not really matter, particularly if those grounds are based on public interest considerations. If costs have been caused to the respondent by the appellant’s unnecessary detour into an Appointed Person appeal followed by a procedural application to transfer that would not have been necessary if the appeal had been brought to the High Court in the first place, then the respondent could be compensated with an appropriate order for payment of the wasted costs”.*

8. Although the above was in the context of an appeal concerning designs, nothing turns on that, and I respectfully agree with all that Mr Howe QC said. I will therefore give little weight to the fact that it is the Appellant, not the Respondents, who seeks transfer, notwithstanding that it was the Appellant who chose to appeal to the Appointed Person in the first place.
9. It is clear from §6 above that the primary point to consider is whether or not a point of general legal importance can be identified in this appeal. Having reviewed the Appellant’s Form TM55, it is immediately apparent that it raises no point of general legal importance. The oppositions were based on ss. 5(1), 5(2)(a), 5(2)(b), 5(3), 5(4)(a) and 3(6) of the 1994 Act. In addition to the detailed grounds in the Respondents’ Forms TM7, the Respondents filed evidence in support of their oppositions.
10. The Appellant chose not to file any evidence in the proceedings below. Furthermore, the Appellant’s Forms TM8 contained no substantive defences to the oppositions. As the Hearing Officer noted at §§16-17:

*“16. The applicant filed a defence and counterstatement in each proceeding denying the claims made and putting the opponents to proof of use of the second earlier mark in the second and third oppositions. Each denial consists of a brief sentence which merely denies the opponents’ claims but does not give any detail of the applicant’s defences. In*

particular, in response to the allegation of bad faith, in each case the applicant states as follows:

“8. We deny that the Application was filed in bad faith. This is a serious allegation that the Opponents will have to make out.

9. The Applicant is the legitimate owner of the trade mark rights in the Applicant's mark.

10. The Application does not offend against Section 3(6) of the Trade Marks Act 1994 and the opposition on this ground should be dismissed in its entirety.”

17. Notably, the applicant's defences:

(a) Do not engage in any substantive argument as to why the applicant is “the legitimate owner” of the trade mark rights in the contested marks.

(b) Whilst denying the claim that there is a likelihood of confusion and that the opponents enjoy a reputation and goodwill in the earlier signs, the applicant's defence do not deny the claims that DIEGO ARMANDO MARADONA is the name of a famous football player well-known worldwide, including in the UK, and that the UK public is likely to associate the contested marks directly with him.

(c) Do not deny that the applicant had prior knowledge of the opponents' ownership of the earlier marks.

(d) Contain denials of claims which are self-evidently true. For example, the applicant denies that the goods and services covered by the specifications of the respective 3829134 and 902243947 marks (the DIEGO MARADONA marks) are similar, notwithstanding both specifications cover identical terms such as cosmetics; soaps; perfumery (in class 3) and Clothing; headgear; footwear (in class 25)”.

11. Rule 18(1) of the Trade Marks Rules 2008 states “The applicant shall, within the relevant period, file a Form TM8, which shall include a counter-statement”. No further guidance as to the contents of the counter-statement are set forth in the Rules. However, section 3.1.6 of the Trade Marks Manual states:

“The applicant has two months beginning immediately after the “notification date” in which to file a TM8, notice of defence, (no fee required), which should incorporate a counter-statement. The purpose of the counter-statement is to admit, deny with explanation or indicate that proof is required of any of the grounds set out by the opponent in its statement of grounds. If no TM8 is filed and there is no request for a “cooling off” period (see section 3.1.7 below) within this two month period, the applicant is deemed to have abandoned his application for registration”. (my underlining)

12. Whereas the Trade Marks Manual has no force in law, the section underlined above is in accordance with the CPR, Part 16.5(2) of which states:

“Where the defendant denies an allegation—

(a) they must state their reasons for doing so; and

(b) if they intend to put forward a different version of events from that given by the claimant, they must state their own version.

13. Consequently, by failing to provide a substantive defence to any of the Respondents' contentions, the Appellant was (at best) putting the Respondents to proof on their oppositions. As such, the question faced by the Hearing Officer was straightforward – have the Respondents put forward sufficient arguments and evidence to make good their oppositions? The issue on appeal is similarly straightforward – has the Hearing Officer, in holding that the Respondents did make good their oppositions, made an error of principle or a decision that is wrong?
14. It seems to me, therefore, that the issues of law raised in this appeal are straightforward, and have no wider impact on the public more generally.
15. Dealing with the other factors listed above, there is no consensus between the parties, albeit the Respondent is neutral as to transfer. The costs of proceeding in the High Court would undoubtedly be substantially greater than if this matter remained before the Appointed Person. An appeal before the High Court would also take substantially longer than it would before the Appointed Person. The Registrar is neutral, albeit contends (as do I) that there is no particular reason why the appeal should be heard in the High Court.
16. Taking all the above into account, there is no good argument in favour of transfer to the High Court, and the appeal should therefore remain before the Appointed Person.

#### **Conclusion**

17. The Appellant's application to transfer the appeal to the High Court is dismissed. The parties should, forthwith, select a date for the hearing from those already offered.

#### **Costs**

18. The costs of this application are reserved to the appeal.

**Dr. Brian Whitehead**

**7 August 2025**

#### **Representation**

Sanjay Wadhvani, Director of the Appellant, in person

Stevens Hewlett & Perkins for the Respondents