

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE
MARKS IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

BETWEEN

YELL LIMITED¹

Applicant

and

TRUVO BELGIUM COMM.V.

Opponent

CONCERNING

**the Opponent's request to amend the notice of opposition filed against
Trade Mark Application No. 1996/04015 (209885)
THE ONE AND ONLY YELLOW PAGES**

Background

1. On 24 June, 1996, British Telecommunications plc, a British company of 81 Newgate Street, London EC1A 7AJ, England (predecessor in title of the Applicant) filed with the Controller documents purporting to be applications for the registration of the words THE ONE AND ONLY YELLOW PAGES as a trade mark in respect of a range of services in Classes 35, 38, 41 and 42. At the time, the registration of trade marks was governed by the Trade Marks Act, 1963, which did not provide for the registration of marks in respect of services. However, the Trade Marks Act, 1996 ("the Act"), which does so provide, had been enacted but not yet commenced and the Controller agreed to accept the documents filed and to hold them in abeyance pending the commencement of the

¹ an English company of Queen's Walk, Oxford Road, Reading, Berkshire RG1 7PT, United Kingdom

Act. The Act was subsequently brought into operation by Ministerial Order dated 27 June, 1996 with 1 July, 1996 fixed as the commencement date.

2. Upon commencement of the Act, the documents filed by the Applicant were treated as applications made under the Act and were accorded filing dates of 1 July, 1996. The applications were subsequently merged into a single application (under No. 1996/04015) pursuant to Rule 29(2) of the Trade Marks Rules, 1996 (“the Rules”). The merged application claims a right of priority pursuant to Section 40 of the Act based on an application for registration of the same mark filed in the United Kingdom on 1 May, 1996. The application was examined in accordance with the provisions of the Act and was accepted for registration, and advertised accordingly under No. 209885 in Journal No. 1869 on 28 July, 1999, in respect of the following services:

Class 35: *Business advisory, consultancy, research and information services; compilation, provision, storage and retrieval of business and commercial information; marketing, promotional and advertising services; data processing and database services; production, preparation and presentation of advertising matter; compilation of business directories; market analysis and research; compilation and transcription of data; preparation of business reports; sales promotion; database management services; interactive database information services direct mail advertising services; compilation of direct mailing lists; database, on-line and internet information, advisory and consultancy services all relating to the aforesaid services; all included in Class 35.*

Class 38: *Telecommunications services; digital communications services; services for the collection, transmission, processing and storage of messages and data; remote data access services; electronic data interchange services; telecommunication of information (including web pages), computer programs and any other data; provision of telecommunication access and links to computer databases and to the Internet; data communications services; communication by computer terminals; services for the transmission, provision or display of information for business or domestic purposes from a computer-stored data bank or via the Internet; on-line information services; advisory services, provision of information and preparation of reports, all relating to telecommunications;*

telecommunication and dissemination of information in audio or visual form.

Class 41: *Publishing services; publication of books, directories, guides, maps, magazines, manuals and printed matter; information and advisory services relating to education, training, entertainment, sport, recreation, news and publishing; arranging, conducting and organising seminars and educational, recreational and instructional conventions, conferences, congresses, exhibitions and demonstrations; entertainment services, including interactive entertainment services, all provided on-line; preparation of reports relating to publishing services; news programme services; database, interactive database, on-line and internet information, advisory and consultancy services all relating to the aforesaid services; all included in Class 41.*

Class 42: *Compilation, storage, analyses, retrieval and provision of information; computer services; leasing of access-time to computer databases and to on-line computer services; updating and design of computer software; information and advisory services, all relating to the aforesaid services; database, interactive database, on-line and internet information, advisory and consultancy services all relating to the aforesaid services all included in Class 42.*

3. Notice of opposition to the registration of the mark was filed pursuant to Section 43 of the Act on 27 October, 1999 by Promedia GCV (now called Truvo Belgium Comm.V.), a company organised and existing under the laws of Belgium, of Antwerp Tower, De Keyserlei 5, Box 7, B2018, Antwerp, Belgium. The Applicant filed a counter-statement on 2 February, 2000 and evidence was subsequently filed by the parties under Rules 20, 21 and 22 of the Rules. The filing of the evidence was not completed until 15 November, 2006, it having been represented to the Controller that the parties were negotiating with a view to a settlement. A hearing was then appointed for 31 May, 2007 but was deferred at the request of the Applicant and with the agreement of the Opponent.
4. The matter eventually became the subject of a hearing before me, acting for the Controller, on 6 March, 2008 at which the Opponent was represented by Paul Coughlan, BL instructed by Eugene F. Collins, Solicitors and the Applicant by Jonathan Newman, BL instructed by MacLachlan & Donaldson, Trade Mark Agents. In opening the case for the Opponent, Mr. Coughlan stated that he

proposed to rely on a number of earlier trade marks referred to in the notice of opposition and on at least one which was not mentioned in the notice of opposition but which was referred to in the Opponent's evidence filed in November, 2001 under Rule 20. Mr. Newman objected on the basis that the inclusion in the proceedings of a ground of opposition based on a mark not mentioned in the notice of opposition would constitute an unjustified retrospective amendment of the notice of opposition. Following some argument on the point, I directed that the hearing be adjourned to allow the Opponent to make a written request for amendment of the notice of opposition, specifying the precise nature of the amendment required and the reason why the material sought to be introduced had not been included in the notice as originally filed. The Applicant was to have the opportunity to furnish any written observations that it wished to make in response, following which a hearing would be appointed on the specific matter of the request for amendment of the notice of opposition.

5. The Opponent duly applied to amend the notice of opposition by letter dated 27 March, 2008. The Applicant gave written observations as to why that request should be refused by letter dated 29 April, 2008. That matter then became the subject of a hearing before me on 16 July, 2008 at which the Opponent was represented by Gary Compton, BL and the Applicant was again represented by Jonathan Newman, BL, the instructing solicitors/agents being the same as before.
6. The parties were notified on 12 September, 2008 that I had decided to allow the amendment of the notice of opposition in the manner sought by the Opponent. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Opponent in that regard pursuant to Rule 27(2) filed on 8 October, 2008.

The notice of opposition as filed

7. The material parts of the notice of opposition insofar as the present matter is concerned are to be found in paragraphs 2, 3, 10 and 11 thereof. At paragraph 2, it is stated that the Opponent is the proprietor of certain trade mark registrations, the details of which are set out in Annex 1 of this statement. At paragraph 3 it is stated that the Opponent is also the proprietor of a number of trade mark

applications, the details of which are set out in Annex 2 below. At paragraph 10, it is alleged that the mark applied for is identical with, or similar to, “*the Opponent’s Trade Marks*”² and that the goods (*sic*) for which registration is sought are identical or similar to those for which the Opponent’s trade marks are protected to the extent that there exists a likelihood of confusion on the part of the public. At paragraph 11, it is further alleged that, even if the respective goods (*sic*) are not similar, use of the mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent’s trade marks. Those objections arise under Section 10(2) and section 10(3) of the Act, respectively.

The nature of the proposed amendments

8. In its letter of 27 March, 2008, the Opponent seeks leave to amend the notice of opposition as follows:

(i) by the addition of the following wording at paragraph 2:

*“The Opponent is also the proprietor of the Community Trade Mark registration for **GOLDEN PAGES** in Classes 9, 16, 35 & 38 applied for on 1st April 1996 under number 000161000”*

and

(ii) by the addition of the following to the list of the Opponent’s trade mark applications in paragraph 3:

*“96/06611 for **YELLOW PAGES** in Classes 9, 16, 35 & 38 converted from Community Trade Mark application number 000161034 dated 1st April, 1996”.*

9. The Opponent’s solicitors go on to state in that letter that the person who originally handled the matter left their office in 2000 and now resides abroad and

² a reference, presumably, to the trade marks that are the subjects of the registrations and applications mentioned in the notice of opposition, although this is not made explicit

that it is not clear from their file why the abovementioned marks were not included in the notice of opposition but that it appears that, at the time of filing of the notice of opposition, they had not received instructions regarding those marks.

The effect of the proposed amendments

10. The effect of the proposed amendments is significant. Because the application for registration claims the priority of a filing in the United Kingdom made on 1 May, 1996, that is the relevant date for the purpose of the assessment of whether or not the application is precluded from registration because of the existence of earlier trade marks in the proprietorship of the Opponent. The only earlier trade marks identified in the notice of opposition as filed are Nos. 112371 (device mark only), 112372 (golden pages & device) and 113451 (GOLDEN PAGES), all registered in respect of goods in Class 16. The proposed amendment would have the effect of introducing into the notice of opposition a Community Trade Mark registration in respect of GOLDEN PAGES in Classes 9, 16, 35 and 38 and, more significantly, an application for registration of the trade mark YELLOW PAGES in those classes, both of which pre-date the date of priority of the present application.

The arguments of the parties

11. Mr. Compton argued at the hearing that Rule 75 of the Rules confers on the Controller a general power to permit the amendment of documents for the amending of which no specific provision is made in the Act or Rules and that the present case is a suitable one in which to exercise the discretion given by the Rule to allow the amendment of the notice of opposition in the manner sought. He asserted that the application for leave to amend the notice of opposition pursuant to Rule 75 was analogous with an application under Order 28, Rule 1 of the Rules of the Superior Courts, 1986 for leave to amend an indorsement or pleadings in proceedings before the High Court and that it should be treated in like manner as such an application. In that regard, he referred me to the decision of the Supreme Court in *Walter Croke –v- Waterford Crystal Limited and Irish Pensions Trust Limited*, [2005] IR 383, and he asserted that the amendment proposed in this case was necessary for the purpose of determining the real issue in controversy between the parties, namely, whether the mark applied for is registrable in light of

the Opponent's earlier rights. A decision on that question made by reference only to the trade marks of the Opponent mentioned in the notice of opposition as filed would be an incomplete decision, leaving open the possibility of further proceedings between the parties before the Controller in which a registration of the Applicant's mark, if allowed, could be sought to be declared invalid on the basis of the pre-existence of the Opponent's trade marks that are the subject of the present application for amendment of the notice of opposition. Nor can the Applicant seriously claim to be prejudiced by the proposed amendment given that it has been on notice of the existence of the trade marks in question since the filing in November, 2001 of the Opponent's evidence under Rule 20, in which the marks are explicitly cited.

12. In response, Mr. Newman referred to the provisions of Section 43(2) of the Act and Rule 18 of the Rules, which require persons desiring to oppose an application for registration to give notice of opposition, *including a statement of the grounds relied upon*, within three months of the publication of the application in the journal. That three-month period constitutes an immutable time limit, which is specifically excluded from the general power to enlarge time given to the Controller under Rule 63. In light of those provisions, Mr. Newman questioned whether Rule 75 could serve to confer on the Controller a discretion to permit the amendment proposed in this case given that the effect of the amendment would be to introduce new grounds of opposition, which appear to have been available to the Opponent but not relied on at the time of filing of the notice of opposition, long after the time stipulated in Rule 18 had expired. He refuted Mr. Compton's assertion that the present proceedings were analogous with proceedings before the High Court and that the application for leave to amend the notice of opposition should be treated analogously with an application for amendment under Order 28, Rule 1. Rule 75 of the Rules does not require the making of all and any amendments as may be necessary for the determination of the real questions in controversy between parties to proceedings before the Controller. The Rule must be read in the context of the provisions of the Act and Rules generally with regard to the conduct of such proceedings, in particular, those governing time periods. The purpose of Order 28, Rule 1 is to ensure that, in proceedings before the High Court, which of their nature involve a full and final determination of the issue in

dispute between the parties to the proceedings, all matters pertinent to that issue may be brought to the notice of the Court. The present situation is different. The Opponent may, if it wishes, institute invalidation proceedings against the registration of the Applicant's mark, if allowed. Rather than being regarded as undesirable, the possibility of such further proceedings should be seen as supporting the case for refusal of the application for amendment of the notice of opposition filed in the present proceedings. No proper reason has been given as to why the notice of opposition did not include mention of the trade marks now sought to be introduced to it and it appears that the Opponent itself has not even been asked by its legal advisers to furnish a reason.

The law

13. The following provisions of the Act and Rules are relevant to the question under consideration:

of the Act

Section 43 – (1) When an application for registration has been accepted, the Controller shall cause the application to be published in the Journal.

(2) Any person may, within the prescribed time from the date of publication of the application in the Journal, give notice to the controller of opposition to the registration; and any such notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(3) Where an application has been published in the journal, any person may, at any time before the registration of the trade mark, make observations in writing to the Controller as to whether the trade mark should be registered; and the Controller shall inform the applicant of any such observations.

(4) A person who makes observations as mentioned in subsection (3) shall not thereby become a party to proceedings on the application.

Section 45 – (1) *Where an application has been accepted and –*

- (a) no notice of opposition has been given within the period referred to in section 43(2), or*
- (b) all opposition proceedings have been withdrawn or decided in favour of the applicant,*

the Controller shall register the trade mark unless it appears to him, having regard to matters coming to his notice since accepting the application, that it was accepted in error.

of the Rules

Rule 18. (1) *Notice of opposition under section 43 shall be sent to the Controller within three months of the date of publication of the application in the Journal.*

(2) The notice of opposition shall be submitted in duplicate accompanied by the prescribed fee or evidence of payment thereof, and shall include a statement of the grounds of opposition.

(3) The Controller shall on receipt of the notice of opposition send a copy to the applicant.

Rule 63. (1) *The time or periods:*

- (c) prescribed by these Rules, other than the times or periods prescribed by the rules mentioned in paragraph (2) below, or*
- (d) specified by the Controller for doing any act or taking any proceedings,*

may, at the request of the person or party concerned, be extended by the Controller if he or she thinks fit, upon such notice to any other person or party affected and upon such terms as he or she may direct.

(2) The Rules excepted from paragraph (1) are Rule 10(3) (failure to file address for service), Rule 12 (time limit for payment of application fee), Rule 18(1) (time for filing opposition to registration), Rule 19(1) (time for filing counter-statement), Rule 39 (delayed renewal) and Rule 40 (restoration of registration).

Rule 75. *Any document for the amending of which no special provision is made by the Act or these Rules may be amended, and any irregularity in procedure which in the opinion of the Controller may be obviated without detriment to the interests of any person may be corrected, if and on such terms and in such manner as the Controller thinks fit; provided that, without prejudice to the Controller's power to extend any time or periods under Rule 63 and except where such irregularity is attributable wholly or in part to an error, default or omission on the part of the Office, the Controller shall not direct that any period of time specified in the Act or Rules shall be altered.*

14. In light of the foregoing provisions and of the arguments made on behalf of the parties, it is clear that two questions fall to be decided, namely, (i) does the Controller have discretion to allow an amendment of the notice of opposition in the manner sought?, and, (ii), if he does, should that discretion be exercised favourably to the Opponent having regard to the circumstances of the case?

Is there discretion to allow the amendment?

15. There is no question but that a notice of opposition is a document for the amending of which no special provision is made by the Act or Rules and that, to that extent, it falls within the scope of Rule 75. Nor can there be any doubt, in my opinion, but that an amendment of a notice of opposition may be allowed pursuant to Rule 75 even though the effect of the amendment may be to introduce new

grounds of opposition after the elapse of the time prescribed in Rule 18 within which a prospective opponent must state the grounds of his opposition. A situation may easily be envisaged in which a person, having opposed an application for registration and stated the grounds of his opposition within the prescribed time, might subsequently discover new facts giving him further grounds on which to oppose the application. Indeed, such previously unknown facts might come to the opponent's notice from the counter-statement or evidence filed by the applicant in the course of the proceedings. In such a scenario, it would not have been possible for the opponent to state the relevant grounds when filing his notice of opposition and Rule 75 could be invoked to allow an amendment of the notice of opposition so as to introduce into it the additional grounds of opposition, the basis for which had come to light at a later stage. In my opinion, the exercise in favour of an opponent of the discretion given to the Controller by Rule 75 in that scenario could not be said to constitute a direction on the Controller's part that a period of time specified in the Act or Rules (i.e., the time specified in Section 43 and Rule 18) should be altered. It would, rather, be consistent with a proper and correct application of the relevant provisions whereby Rule 75 operates to allow an opponent, who had given notice of his opposition within the prescribed time and stated the grounds on which he relied *at the relevant time*, to subsequently amend the notice of opposition so as to introduce further grounds not known to him at the relevant time.

16. Of course, that is not the position in the present case. It is not suggested, nor could it be, that the Opponent did not know of the existence of its own Community Trade Marks when it filed its notice of opposition against this application for registration. Is it the case, therefore, that the request for amendment of the notice of opposition is really just a request for an extension of the time prescribed by Rule 18 within which the Opponent had to state the grounds of its opposition? If so, does the proviso to Rule 75 exclude the request from the scope of the Rule and remove the power that the Controller would otherwise have to accede to it? I think not. If it did, then there would be no scope within the Act or Rules to allow the correction of an honest mistake on the part of an opponent or its advisors in preparing a notice of opposition and the scope of opposition proceedings would have to be limited to the grounds stated in the

notice of opposition as filed even in circumstances where the applicant did not object to the proposed amendment of the notice but actively supported it. I do not think that that can be the intention or the effect of the Act and Rules. In my opinion, Rule 75 should be given a purposive interpretation and the proviso to it should be construed strictly so as to only prohibit the Controller from directing an actual alteration of a period of time specified in the Act or Rules in purported exercise of his power under the Rule. The Opponent has not sought an alteration of the time prescribed in Rule 18 and I do not regard it as necessary to direct an alteration of that time in order to accede to its request for amendment of the notice of opposition. I have decided, therefore, that the Controller has discretion under Rule 75 to allow the requested amendment, notwithstanding that the time prescribed in Rule 18 has elapsed and that the grounds now sought to be introduced to the notice of opposition were known to the Opponent when it filed the notice.

Should the discretion be exercised favourably to the Opponent

17. In deciding whether to allow the requested amendment of the notice of opposition, I have considered the Opponent's contention that, in the present circumstances, Rule 75 may be seen as having the same purpose as Order 28, Rule 1 of the Rules of the Superior Courts, 1986, namely, to achieve a determination of the real issue in controversy between the parties. Rule 75 does not, however, express its purpose in the same terms as Order 28, Rule 1. Rather, it permits the amendment of documents and the correction of irregularities to the extent that "the Controller thinks fit". I take the view, therefore, that the purpose of the Rule should be construed by reference to the Controller's statutory functions generally and that the discretion given by the Rule to permit amendments and corrections should be seen as for the purpose of facilitating the performance by the Controller of his statutory functions in a comprehensive, efficient and effective manner.

18. It seems to me that that is an even broader discretion than that which was argued for on behalf of the Opponent. In this case, as in all opposition cases, the issues in controversy between the parties are defined and delimited in the notice of opposition and the counter-statement. As regards Section 10 of the Act, it is clear from the notice of opposition and the counter-statement that the issue in

controversy is whether or not the Applicant's mark should be registered in light of the Opponent's earlier trade marks *specified in the notice of opposition itself*. I emphasise this because it would be bizarre, in my opinion, to suggest that a ground of opposition could be expressed by reference to Section 10 in the absence of any identification of the earlier trade mark or trade marks on which it is based. That could not constitute a proper pleading or particularisation of the ground of objection in such a way that the applicant could understand it and, if necessary, refute it. If, as argued by the Opponent, the discretion to permit an amendment of the notice of opposition under Rule 75 was for the purpose of determining the real issue in controversy between the parties, then I would refuse the request for leave to amend because I do not accept that the earlier trade marks now sought to be introduced to the notice of opposition are relevant to the issue in controversy as originally set out in the notice and the counter-statement filed in response thereto.

19. As I have indicated, however, I interpret Rule 75 as having a wider purpose, in the light of which I think it appropriate to allow the proposed amendment. In terms of the registration of trade marks, the Controller's statutory function may be described as being to register marks that qualify for registration and to refuse to register those that do not. As regards the present application for registration, the existence of the trade mark registration and application which the Opponent seeks to introduce into the notice of opposition are clearly potentially relevant to the question of whether the application should be allowed or refused. Section 43((3) provides a mechanism, which is still open to the Opponent, whereby the Opponent may bring the existence of those trade marks formally to the notice of the Controller by making observations as to whether the Applicant's mark should be registered. In any event, these opposition proceedings and, in particular, the present application for amendment of the notice of opposition in the manner sought by the Opponent have, in fact, brought the existence of the relevant trade marks to the notice of the Controller. Section 45 (1) requires the Controller to have regard to matters coming to his notice since his acceptance of the application before proceeding to register the trade mark. It appears, therefore, that the proper performance by the Controller of his statutory functions requires consideration of whether the present application should proceed to registration in light of the existence of the trade marks that the Opponent wishes to introduce to the notice of



opposition. The only real issue is whether that consideration takes place on an *ex-parte* basis with the Applicant or as part of the proceedings currently underway between the Applicant and the Opponent. It is more desirable, in my opinion, that the matter should form part of the proceedings already underway because that will facilitate a full and final airing before the Controller of all matters relevant to it. For this reason, I have decided to allow the amendment of the notice of opposition in the manner sought by the Opponent. The steps to be taken consequential upon that decision, including as regards any amendment of the counter-statement and filing of additional evidence, will have to be the subject of correspondence with the parties in due course.

20. It will be apparent from the foregoing that I have not decided the present matter by reference to the behaviour of the parties in the conduct of the proceedings. If I had, then I would not have allowed the request for amendment as I regard the approach to the matter taken by the Opponent as highly undesirable. There can be little doubt, in my opinion, that the Opponent and its professional advisors realised the significant omission of the trade marks in question from the notice of opposition at some time between the filing of the notice on 27 October, 1999 and the filing of evidence under Rule 20 on 8 November, 2001. It behoved the Opponent, immediately upon realising its error, to make an application for leave to amend the notice of opposition. It did not do so. Instead, it sought to have the marks introduced into the proceedings “under the radar” by instructing its barrister to seek to rely on them when the case finally came on for hearing this year. I do not regard that as a proper approach to take to proceedings before the Controller and nor do I accept the argument advanced on behalf of the Opponent to the effect that the Applicant had little cause for complaint, having been aware of the existence of the trade marks since the filing of Rule 20 evidence in November, 2001. It is not for the Applicant to anticipate the expansion of the issues beyond those set out in the notice of opposition in the absence of any application in that regard by the Opponent. If the question turned only on the extent to which the respective parties had conducted the proceedings with due care and candour, then I would have agreed with the Applicant that the requested amendment should not be allowed. As it is, I have had to set aside considerations of the Opponent’s

behaviour in order to arrive at a decision which I believe to be merited by the other circumstances of the case.

Tim Cleary,
Acting for the Controller
16 October, 2008



**Trade Mark Registrations referred to in Paragraph 2 of the Notice of
Opposition, as filed**

Number	Date	Mark	Classes/Goods
112371	09/11/ 1971		16 – printed directories containing information about telephone subscribers
112372	09/11/1971		as above
113451	23/11/1983	GOLDEN PAGES	as above

**Trade Mark Applications referred to in Paragraph 3 of the Notice of Opposition,
as filed**

Number	Date	Mark	Classes/Goods/Services
1996/02990	02/05/1996	YELLOW PAGES	09 – Magnetic Data Carriers (software); disc shaped data and sound carriers; analogue and digital data, vision and sound carriers
1996/02991	02/05/1996	YELLOW PAGES	16 - Paper and products made thereof (not included in other classes), cardboard and products made thereof (not included in other classes); printed matter; publications, books, guides, newspapers, periodicals and other reproductions mainly in relation to publicity, more in particular, telephone books with advertisements; book-binding materials, photographs; adhesives for paper; artists' materials; paint brushes; playing cards, printers' types; printing blocks.
1996/02992	01/07/1996	YELLOW PAGES	35 – all services included in Class 35
1996/02993	01/07/1996	YELLOW PAGES	38 – all services included in Class 38
1996/02994	01/07/1996	YELLOW PAGES	41 – all services included in Class 41
1996/02995	01/07/1996	YELLOW PAGES	42 – all services included in Class 42
1998/00688 ³	24/02/1998	GOLDEN PAGES	09, 35, 38, 41 – various goods/services

³ subsequently registered under No. 219970

1998/00689 ⁴	24/02/1998		09, 35, 38, 41 – various goods/services
1998/00690 ⁵	24/02/1998		09, 35, 38, 41 – various goods/services

⁴ subsequently registered under No. 219971

⁵ subsequently registered under No. 219972