

## THE HIGH COURT

2005 No. 35 SP

**IN THE MATTER OF THE TRADE MARKS ACT 1963  
AND IN THE MATTER OF TRADE MARK APPLICATION NO. 171850 SUNSMILE UNDER THE TRADE MARKS ACT 1963  
IN THE NAME OF SUNRIDER CORPORATION AND  
OPPOSITION THERETO BY UNILEVER PLC.**

BETWEEN

UNILEVER PLC

PLAINTIFF

AND

**THE CONTROLLER OF PATENTS, DESIGNS AND TRADE MARKS  
AND SUNRIDER CORPORATION**

DEFENDANTS

**Judgment of Miss Justice Laffoy delivered on 21st November, 2005.**

1. The substantive proceedings in this matter are an appeal by the plaintiff (Unilever) from part of the decision of the first defendant (the Controller) dated 30th November, 2004 whereby he dismissed the opposition entered by Unilever to the application of the second defendant (Sunrider) for registration of trade mark No. 171850 SunSmile and device under certain provisions of the Trade Marks Act 1963 (the Act of 1963) in respect of goods in class 3, which includes household cleaning preparations such as dishwasher detergents.

2. The chronology of the proceedings before the Controller was as follows:

- On 6th April, 1995 the application was filed by Sunrider in the Trade Marks Office.
- On 1st April, 1997 Unilever entered a notice of opposition.
- On 15th July, 1997 a counter-statement was filed by Sunrider.
- On 16th January, 1998 Katrina Burchell, Senior Trade Marks Manager of Unilever, made a statutory declaration in support of Unilever's opposition which was left with the Controller in accordance with Trade Mark Rules, 1963 (S.I. No. 268 of 1963).
- On 1st October, 1998 Oi-lin Chen, the President of Sunrider, made a statutory declaration in support of Sunrider's application, which was left with the Controller.
- On 14th April, 1999 Nicola Hope, Trade Mark Manager of Unilever, made a statutory declaration on behalf of Unilever in reply, which was left with the Controller.
- On 20th May, 2004 a hearing of the opposition took place before the Controller.
- On 17th November, 2004 the parties were notified of the Controller's decision to dismiss Unilever's opposition to the SunSmile application. The reasoned decision of the Controller, which was given by Tim Cleary on behalf of the Controller, was dated 30th November, 2004.

3. The application to the Controller was decided under the provisions of the Act of 1963 and the appeal is also governed by the provisions of the Act of 1963. The appeal is brought under s. 57 of that Act. This application is an application by Unilever to bring forward further material for the consideration of the court on the appeal and is brought under s. 26(9) of the Act of 1963 which provides as follows:

"On the hearing of an appeal under s. 57 of the Act against a decision of the Controller under this section any party may, either in the manner prescribed or by special leave of the court, bring forward further material for consideration of the court."

4. Appeals to this court in relation to, *inter alia*, trade marks are governed by Order 94 of the Rules of the Superior Courts, 1986. Insofar as it is relevant for present purposes, rule 48 of Order 94 provides as follows:

"Every such appeal to the Court shall be by way of re-hearing; and ... every ... appeal shall be heard on the same evidence as that used at the hearing before the Controller. No further evidence shall be given nor further material brought forward for the consideration of the Court on the hearing of any appeal without special leave of the Court granted on an application made at or before the hearing ..."

5. One of the items which Unilever seeks leave to bring forward for the consideration of the court, in my view, does not present any difficulty. It is the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (OHIM) of 13th December, 2004, on an application by Sunrider to register the SunSmile mark as a Community trade mark. The decision at first instance, which was dated 13th February, 2004, was cited as authority before the Controller, but the decision on appeal post-dated the decision of the Controller. Counsel for Sunrider told the court that Sunrider will not object to the citation of the decision of the OHIM Appeal Board on the hearing of this appeal. The position of the Controller, as outlined in an affidavit sworn by Mr. Cleary on 27th September, 2005 in response to this application, was that the OHIM appeal decision is irrelevant to the appeal in this court on a number of grounds. It is open to the Controller to make this point on the hearing of this appeal. Therefore, this item need not be considered further.

6. The other two items which Unilever seeks leave to bring forward on the hearing of the appeal are affidavits to be sworn by Paul O'Sullivan and Maedhbh Quinn, drafts of which have been put before the court.

7. Mr. O'Sullivan is Faculty Director at the Business School of Dublin Institute of Technology. He has over twenty years' experience in lecturing and researching in the area of marketing communications and advertising. The draft of his proposed affidavit indicates that Mr. O'Sullivan would propose to aver that he has reviewed the evidence filed before the Controller, including that of sales, marketing and use of the "SUN" brand, filed on behalf of Unilever. Additionally he would propose to aver that he is familiar with Unilever's brand "SUN" and the detergent product sold under the "SUN" brand and has been familiar with the brand since prior to 1995. He would then

propose, after making assertions of fact, to express his opinion on some of the issues which arise on the appeal, for example, the strength of the "SUN" brand, whether the use by Unilever of the "SUN" brand developed a "SUN" family of brands consisting of the "SUN" prefix with different suffixes such as Rinse Aid, Tablets and so on, the issue of confusion and the issue of damage to the reputation of Unilever's "SUN" brand. The Controller opposed this application on the ground that the two assertions of fact that Mr. O'Sullivan would propose to make, that there were a "limited number" of dishwasher detergent tablets on sale prior to 1995 and that "SUN" was the leading brand, are not substantiated.

8. Ms. Quinn is a marketing consultant. She would also propose to aver that she has been familiar with the "SUN" brand since prior to 1995 and that she has reviewed copies of the evidence filed before the Controller, including information about sales, marketing and the use of the "SUN" brand and related brands, filed by Unilever. She would propose averring as to her opinion on the issues on the appeal which Mr. O'Sullivan would propose addressing.

9. Apart from his objections to the content of the proposed affidavit of Mr. O'Sullivan, the Controller opposed the application on the ground that the evidence sought to be adduced now could have been adduced before the Controller. He contended that Unilever has failed to advance proper or persuasive reasons as to why it should be allowed to introduce the evidence at this stage. Counsel for the Controller characterised the approach of Unilever as using the decision of the Controller as an advice on proofs for the prosecution of the appeal, an approach to which the Controller objects in principle.

10. No affidavit in response to the application was filed on behalf of Sunrider.

11. Apparently, there is no authority in this jurisdiction on when it is appropriate to grant special leave to bring forward further material under s. 26(9). Counsel for Sunrider referred the court to a decision of the English High Court on a similar application under a statutory provision the substance of which is precisely the same as s. 26(9). In that case, *Hunt-Wesson Inc.'s Trade Mark Application* [1996] R.P.C., 233, which, as here, was an application by an opponent appealing against the dismissal of the opposition, Laddie J. listed the factors which he considered likely to be relevant on an application of this type but made it clear that the list was non-exhaustive. The factors he identified were as follows:

- (i) Whether the evidence could have been filed earlier and, if so, how much earlier.
- (ii) If it could have been, what explanation for the late filing had been offered to explain the delay.
- (iii) The nature of the mark.
- (iv) The nature of the objections to it.
- (v) The potential significance of the new evidence. (vi) Whether or not the other side would be significantly prejudiced by the admission of the evidence in a way which could not be compensated, e.g., by an order for costs.
- (vii) The desirability of avoiding multiplicity of proceedings.
- (viii) The public interest in not admitting on the register invalid trade marks.

12. As a general proposition, I think that the sum of the foregoing factors, if they were accepted as being applicable in this jurisdiction, would provide for a more liberal regime for the introduction of evidence on an appeal from a decision of the Controller than the principles laid down by the Supreme Court in *Murphy v. The Minister for Defence* [1991] 2 I.R. 161, in relation to the admission of further evidence on an appeal from the High Court to the Supreme Court. This application has been addressed by Sunrider on the basis that the onus on Unilever is to meet the criteria in the *Hunt Wesson Inc.* case rather than the more arduous requirements of *Murphy v. The Minister for Defence*. Accordingly, that is the basis on which the court will decide the issue.

13. In relation to the application of the first and second factors listed by Laddie J. to the facts of this application, counsel for Sunrider agreed with the submission of the Controller that the evidence could have been adduced before the Controller and that there was no explanation advanced for the delay. In my view, that submission is correct. The thrust of the case made in the affidavit grounding this application is that, while the evidence before the Controller on the various issues arising on the opposition supported Unilever's case, Unilever wishes to adduce additional evidence to augment its case on appeal. That is not a basis for granting special leave to adduce further material.

14. In relation to the third, fourth and eighth factors, counsel for Sunrider submitted that the dispute here is a pure inter partes dispute, by contrast to the issue on the *Hunt Wesson Inc.* application, which was for registration of the mark "SWISS MISS" for making hot and cold chocolate or cocoa beverages and such like which, he suggested, was an attempt to appropriate a designation of origin and involved a broad public policy dimension. Further, he pointed out that Sunrider has registered quite a few trade marks comprising "sun" in this jurisdiction already. In distinguishing the type of appeal in issue in the *Hunt Wesson Inc.* case from an ordinary appeal in *inter partes* civil litigation, in his judgment Laddie J. stated as follows at p. 241:

"An opposition may determine whether or not a new statutory monopoly, affecting all traders in the country, is to be created. Refusing permission to an opponent who files evidence late affects not only him but also may penalise the rest of the trade. This is particularly the case where, as here, it is alleged that the applicant is trying to monopolise a well known geographical location."

15. In my view, the Unilever appeal does not raise public policy considerations of the type mentioned in that passage.

16. On the fifth factor, counsel for Sunrider submitted that the potential significance of the proposed evidence of Mr. O'Sullivan and Ms. Quinn is deflated by the absence of hard fact and detail. There is no empirical data outlined to support the opinions they propose to express – no evidence of sales, turnover, market share and such like of the brands at issue. That submission, in my view is correct. The type of evidence which Laddie J. in the *Hunt Wesson Inc.* case considered arguably could have a significant impact on the outcome of the appeal and which he allowed the opponent to adduce was evidence of the manner in which the applicant had packaged and promoted its "SWISS MISS" products in the United States, which he suggested might well raise serious questions as to the reliability of evidence adduced at first instance from a deponent who averred that over many years he had never come across a trade customer or a member of the public who assumed that the "SWISS MISS" products came from Switzerland or had anything to do with Switzerland. Unilever has not established that the evidence sought to be adduced here has that probative quality.

17. In relation to the sixth factor, counsel for Sunrider admitted that, even though Sunrider would have an opportunity to respond to

the further evidence, there is a real prejudice here because the appeal has to be decided on the facts as of the date of the application, that is to say, April, 1995. It was submitted that Sunrider would be put in an impossible situation in having to answer historical market analysis and evidence as vague as the proposed further evidence. While it is true, as counsel for Unilever pointed out, that Sunrider has made no case in relation to the prejudice it will suffer if the further evidence is admitted on affidavit, I think it is a reasonable inference that Sunrider would encounter difficulty.

18. In relation to the seventh factor, counsel for Sunrider submitted that the grounding affidavit supporting this application does not suggest there would be a multiplicity of proceedings. I do not attach any weight to that submission.

19. In summary, I am not satisfied that Unilever has discharged the onus of establishing that circumstances exist which would justify the court in giving leave to adduce affidavits sworn by Mr. O'Sullivan and Ms. Quinn in the form of the drafts on the hearing of the appeal. Apart from that, I am of the view that it would create a bad precedent to grant leave on the facts of this case. It would leave an impression that an opponent, in deciding what evidence to adduce on the opposition before the Controller, could take comfort from the fact that it would have an opportunity to mend its hand on an appeal to this court, having seen the decision of the Controller. That is clearly not what the legislature intended in enacting s. 26(9).

20. Finally, in the affidavit grounding this application it is asserted that in the replying affidavit sworn by Ms. Chen in these proceedings Sunrider has purported to put additional evidence before the court without seeking leave of the court. This assertion is strongly contested by Sunrider. That dispute is a matter for the trial judge.

21. I refuse the application for leave to bring forward further material.