

Arnold J Clarifies the Meaning of Consent in the Context of Trade Mark Applications

Dalsouple Société Saumuroise Du Caoutchouc v Dalsouple Direct Ltd & Another [\[2014\] EWHC 3963 \(Ch\)](#)

The High Court dismissed the appeal brought by Dalsouple Société Saumuroise Du Caoutchouc (“Dalsouple France”) against Dalsouple Direct Limited (“Dalsouple UK”). The judgment of Mr Justice Arnold provides useful guidance on a number of substantial and evidential issues, particularly in relation to “consent” to register a trade mark (s.5(5) of the Trade Marks Act 1994). The judgment can be read [here](#).

Dalsouple UK were the UK distributor of rubber flooring products made by Dalsouple France. In 1998, Dalsouple UK obtained a UK trade mark registration for “DALSOUPLE”. In 2011 Dalsouple France sought to register “DALSOUPLE” in the UK. Dalsouple UK opposed this registration on the basis of their earlier mark, which Dalsouple France in turn sought to invalidate. The Hearing Officer found that Dalsouple France had consented to Dalsouple UK registering the earlier mark, was thus barred from obtaining a declaration of invalidity, and the opposition succeeded.

Before considering the grounds of appeal, Arnold J emphasised that an appeal court must be especially cautious to interfere with decisions which are essentially value judgements or multi-factorial assessments. He added that as the Trade Mark Registry is a specialist tribunal, its decisions should be respected unless it is quite clear that they have misdirected themselves in law.

The key issue on appeal was whether the test for consent enshrined in *Zino Davidoff SA v A&G Imports Ltd* [Case C-414/99](#), which relates to consent in parallel imports cases in infringement proceedings, should be applied as the test for consent to register a trade mark where earlier rights were asserted. *Zino Davidoff* requires that consent be unequivocally demonstrated, and had hitherto not been applied in the context of trade mark application.

In this decision, Arnold J held that the approach to consent in *Zino Davidoff SA* equally applies to determining whether there had been consent to an application to register a trade mark. Thus consent must be unequivocally demonstrated. However, express consent is unequivocal consent. Arnold J made it clear that in determining whether express consent was given, even if the consent is oral, it must be determined as a matter of fact in accordance with the normal English rules of procedure governing burden and standard of

proof. It was not necessary for the tribunal to have clear evidence of what was said, particularly if such occurred many years ago. It simply had to be determined whether it was more likely than not that consent was given taking into account the passage of time, failing memories and other relevant matters.

In relation to attacking the credibility of a witness on appeal, Arnold J held that it was not open to Dalsouple France to contend that the evidence of one of Dalsouple UK's witnesses was untruthful when this was not put to him in cross-examination. There had previously been some doubt as to whether it is necessary in Trade Mark Registry proceedings to put the case in cross-examination before challenging the veracity of a witness' evidence. However, Arnold J accepted Dalsouple UK's submissions and held that it was not open to Dalsouple France to attack the credibility of the witness having not done so at the hearing.

The successful respondent was represented by [Guy Tritton](#) instructed by **Carpmaels & Ransford LLP**.

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