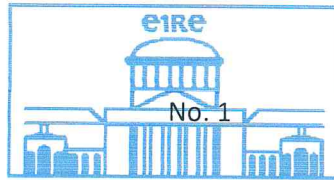


O. 58, r. 15



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Record No:

Application for Leave to Appeal

Part I

The information contained in this part will be published. It is the applicant's responsibility to also provide electronically to the Office a redacted version of this part if it contains information the publication of which is prohibited by any enactment or rule of law or order of the Court

1. **Date of Filing:** 25 February 2019
2. **Title of the Proceedings:** [As in the Court of first instance]

THE HIGH COURT

Record Number 2013/641 Sp

IN THE MATTER OF THE TRADE MARKS ACT, 1963,

AND IN THE MATTER OF THE TRADE MARKS ACT, 1996

AND IN THE MATTER OF APPLICATION NUMBERS 177240 AND 177245
DATED 11 JANUARY 1994 PURSUANT TO THE TRADE MARKS ACT, 1963,

BY DIESEL SPA

FOR REGISTRATION OF DIESEL AND DIESEL (DEVICE) AS TRADE MARKS

IN CLASS 25 OF THE REGISTER OF TRADE MARKS

Between:-

DIESEL SPA

Plaintiff

-and-

THE CONTROLLER OF PATENTS, DESIGNS & TRADE MARKS

First Defendant

AND

MONTEX HOLDINGS LIMITED

Second Defendant

3. Name of Applicant:

Diesel SpA

What was the applicant's role in the original case: [Plaintiff, Defendant, Applicant, respondent etc]

Plaintiff

4. Decision of Court of Appeal (where applicable):

Record No: 2017/14

Date of Order: 3 October 18

Perfection Date: 5 February 2019

Date of Judgment: 2 October 2018

Names of Judges: Hogan, Peart and Baker JJ

5. Decision of the High Court:

Record No: 2013/641Sp

Date of Order: 20 December 2016

Perfection Date: 11 January 2017

Date of Judgment: 9 June 2016

Names of Judge(s): Binchy J

Where this application seeks leave to appeal directly from an Order of the High Court has an appeal also been filed in the Court of Appeal in respect of that Order?

Yes No

6. Extension of Time:

Yes No

If an application is being made to extend time for the bringing of this application, please set out concisely the grounds upon which it is contended time should be extended.

7. Matter of general public importance:

If it is contended that an appeal should be permitted on the basis of matter(s) of general public importance please set out precisely and concisely, in numbered paragraphs, the matter(s) alleged to be matter(s) of general public importance justifying appeal to the Supreme Court.

This section should contain no more than 500 words and the word count should appear at the end of the text.

- (1) The Court of Appeal (Hogan J, Peart and Baker JJ concurring) firstly determined the scope of an appeal from the Controller to the High Court under Section 57 of the Trade Marks Act 1963, determining that it is "*in substance similar to the appeal from the High Court [to the Court of Appeal] on appeal*" (paragraph 34).
- (2) This decision was reached *per incuriam*, overlooking the judgment of the former Supreme Court in *Philadelphia Storage Battery Co. v Controller* [1935] IR 575, where the Chief Justice stated at page 593 in respect of the previous trade mark legislation that the Court was free to form its "*own opinion untrammelled by*" the views of the Controller, which judgment was followed in *Hamilton Cosco Inc* [1966] IR 266, *LRC International v Controller*, 13 July 1975 and *Seven Up v Bubble Up* [1990] ILRM 204. The Court of Appeal was referred to these judgments, and no submission was made on behalf of the Controller or Montex that they should be departed from.
- (3) Based upon its view as to the scope of an appeal, the Court then determined that it would be "*somewhat artificial to say that the Murphy [v Minister for Defence [1991] 2 IR 161 principles in respect of the admission of additional evidence on appeal from the High Court to the Supreme Court/Court of Appeal] do not, in effect, bind this Court*" (paragraph 34), which consequential conclusion was therefore also reached *per incuriam*.
- (4) The Controller maintained that the decision of the High Court (and the Court of Appeal) in respect of Diesel SpA's application would have ramifications for the approach to be adopted in future in respect of the exercise by parties of their entitlements regarding the submission of further evidence: paragraph 33 of the Affidavit of the Controller of 28 October 2014.
- (5) Further, the conclusion of the Court of Appeal as to the status of decisions of the Controller, and the scope of appeal therefrom, will be an authority in future appeals from decisions of the Controller, and will impact upon this appeal.
- (6) Accordingly, the law in respect of both the scope of appeal from the Controller to the High Court, and in respect of the admission of additional evidence, has now been determined by the Court of Appeal, but it would appear on a *per incuriam* basis. The law in this regard needs to be definitively clarified.

The Applicant is concerned that the Supreme Court might be prejudiced against this application by the implied view expressed at paragraph 8 of the judgment of Hogan J: the comments are not understood, as the longest single delay in these court proceedings was approximately one year in the handing down of judgment because the learned High Court Judge was indisposed; whilst in respect of the proceedings before the Controller, after the 2001 Supreme Court judgment, the longest single period of delay appears to have been almost three years pending the appointment of a hearing officer.

Word count – 498

8. Interests of Justice:

If it is contended that an appeal should be permitted on the basis of the interests of justice, please set out precisely and concisely, in numbered paragraphs, the matters relied upon.

This section should contain no more than 300 words and the word count should appear at the end of the text.

- (1) The allowing of the appeal produces a serious unfairness and lack of even-handedness which may result in the unjust exclusion of the Diesel SpA mark from the Register:-
- as appears from the judgments in *Montex v Controller* [2000] 1 IR 577 & [2001] 3 IR 85, Montex was, when it filed its application to register DIESEL in 1994, challenged to provide a bona fide explanation of its adoption of that mark;
 - no explanation for the adoption of the mark was tendered by Montex in evidence at any point in those lengthy proceedings;
 - as noted by the Court of Appeal at paragraph 5 of its judgment, in 2001 the Supreme Court upheld the decision of the Controller to refuse registration to Montex by reason of the likelihood of its DIESEL mark being confused with Diesel SPA's mark as of 1994;
 - neither the Controller nor the courts in those proceedings expressed any doubts as to the quality of Diesel SPA's evidence as to its reputation in the State in the relevant period;
 - as noted by the Court of Appeal at paragraph 10, the Controller greatly facilitated Montex in mending its hand as to the quality of its evidence, allowing it to introduce for the first time in 2004 evidence as to its adoption of the DIESEL name some 20 years after that explanation was sought;
 - nonetheless, the Controller subsequently refused leave to Diesel SPA to adduce additional evidence to demonstrate what had previously gone unquestioned, namely the extent of its reputation, after unexpected criticism of its evidence by the hearing officer in 2013.
- (2) The High Court correctly said that in these unusual circumstances to exclude the absolutely central evidence of the Diesel SpA distributor in Ireland in a critical period would be "unfair and wrong" (paragraph 59).

Word count - 297

9. Exceptional Circumstances: Article 34.5.4:

Where it is sought to apply for leave to appeal direct from a decision of the High Court, please set out precisely and concisely, in numbered paragraphs, the exceptional circumstances upon which it is contended that such a course is necessary.

This section should contain no more than 300 words and the word count should appear at the end of the text.

Word count -

10. Grounds of Appeal

Please set out in the Appendix attached hereto the grounds of appeal that would be relied upon if leave to appeal were to be granted. See attached.

11. Priority Hearing:

Yes

No

If the applicant seeks a priority hearing please set out concisely the grounds upon which such priority is sought.

This section should contain no more than 100 words and the word count should appear at the end of the text.

Word count -

12. Reference to CJEU:

If it is contended that it is necessary to refer matters to the Court of Justice of the European Union please identify the matter and set out the question or questions which it is alleged it is necessary to refer.