

**BEFORE:**

**MR G HOBBS QC**

**IN THE MATTER OF THE TRADE MARKS ACT 1994**

**AND**

**IN THE MATTER OF APPLICATION NO 2068253 by  
KABUSHIKI KAISHA NAMCO (NAMCO LIMITED)**

**AND OPPOSITION NO 45735 THERETO BY  
THE EDGE INTERACTIVE MEDIA INC AND  
THE EDGE INTERACTIVE MEDIA LIMITED**

**APPEAL OF THE RESPONDENT FROM THE  
DECISION OF MR M KNIGHT**

**MR M EDENBOROUGH (instructed by Messrs Mewburn Ellis, Manchester)  
appeared as counsel on behalf of the Respondent**

**THE APPELLANT did not appear and was not represented**

**D E C I S I O N**

**(as approved the Appointed Person)**

Mr Hobbs: This is the adjourned hearing of an appeal by The Edge Interactive Media Inc and The Edge Interactive Limited against a decision issued by Mr Knight, Principal Hearing Officer acting for the Registrar of Trade Marks on 24 November 1998.

5 In that decision Mr Knight gave leave for the applicant in the substantive proceedings in the Registry to file evidence out of time in response to evidence which had been filed in support of an opposition by the current appellants before me.

The hearing of the present appeal was originally scheduled to take place on 29 March 1999.  
10 However, that hearing was adjourned until today in response to a last-minute request from the appellants for more time within which to prepare for the hearing and arrange appropriate representation. The adjournment was granted on the basis indicated in my letter of 29 March 1999 to the Treasury Solicitor's Department (copy annexed).

15 Although the appellants indicated that they wished to attend and be heard in connection with their appeal, nobody appears on their behalf today and I have no written submissions in response to the skeletons of argument which Mr Edenborough has submitted on behalf of the applicant for registration.

20 It may well be open to me in these circumstances to treat the appeal as withdrawn or abandoned. However, I do not propose simply to say that there is no support for the appeal by the persons on behalf of whom it is brought. I go further and say that I have read and considered the papers in this case and take the view that the Principal Hearing Officer was entitled to reach the decision he did on the materials before him in the exercise of his  
25 discretion under Rule 62(5) of the Trade Marks Rules 1994.

In those circumstances, I intend to order that the appeal shall be dismissed with costs and I now propose to hear representations from those before me as to what an appropriate order for costs might be.

30 Mr Edenborough: Sir, in that regard, we are fully cognisant of the fact that this is the

adjourned hearing. The other hearing was adjourned at the very last moment in essence upon the quite heated request of the appellant that he should be given the chance to appear before you, Sir. That caused dislocation not only in my camp, but also in my instructing agent's camp, in that he was already committed to travelling. He was on the train to London. Those costs therefore were wasted and thrown away, I would say. He has also now been forced to come down for a second time for this hearing.

Mr Hobbs: Where does your agent come from?

Mr Edenborough: Manchester. He is again here in person because we thought that, given the way in which the appellant vociferously asked for a hearing and indicated in the strongest terms that he was going to be present, he would be here. This is entirely indicative of the way in which this case has been run by the appellant. Costs have been wasted and thrown away at every stage.

I understand that we cannot make an application in respect of security for costs at this hearing. That is quite right. We put it in mainly to flag up the issue. We still need recompense, I would say, in the strictest and strongest possible terms that you can order so that this sort of thing does not happen again.

Mr Hobbs: What sort of figure do you propose? You know the way costs are generally awarded in these decisions.

Mr Edenborough: Yes, Sir. I would actually ask that costs be taken outside of that scale of costs. Costs are in your absolute discretion. Instead of being on the normal scale, which is not compensatory at all, they should be closer to a full indemnity.

Mr Hobbs: What would a full indemnity be?

Mr Edenborough: (Pause) Sir, on instructions I am told that the actual cost of travel for both journeys was £216 in total. Then there is approximately £800 for my trade mark agent's time

and then there is my brief fee, which I do not have to hand.

Mr Hobbs: You would be blushing any way, I suspect.

5 Mr Edenborough: I have no idea.

Mr Hobbs: Your security for costs figure for this hearing is set at, say £1000. I am not sure whether that included the travel costs for the last hearing as well.

10 Mr Edenborough: No, Sir.

Mr Hobbs: the other thing though, there was a question mark over the last hearing as to whether the requisite number of days notice had been given under Rule 48. It could have been argued that there was one day short, in which case, it would have been a decision you would not necessarily have wanted to have because it could have been attackable on the basis that it was irregularly entered. Is there anything more you would like to say, Mr Edenborough, on the subject of costs?

15 Mr Edenborough: No, Sir.

20 Mr Reynolds: As you know, Sir, the Registry does not normally ask for its costs in respect of these proceedings. I have to say I intend, in this particular case, to say that the Registrar would actually look for costs. It so happens that we have had three different Hearing Officers who have had to prepare for this hearing. It is partly a question of juggling priorities within the Registry, but last time round, as you probably know, Sir, it was Allan James who was due to take the hearing. Mike Knight was due to take this scheduled hearing, but because of a speaking engagement he could not be certain he could be here and so I said that I would come up and take it. As far as I am concerned, I had no other business today and so it has actually been my sole purpose for a visit to London today.

25 Mr Hobbs: You will be returning tonight?

Mr Reynolds: Yes. Although we do not normally ask for costs, I would ask for at least a nominal sum.

Mr Hobbs: What would your train fare be?

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Mr Reynolds: The train fare is around £120 from Newport.

Mr Hobbs: If I can say so, with no disrespect, your time is, if you like, at public expense anyway, is it not?

10

Mr Reynolds: I was going to suggest a figure of £200.

Mr Hobbs: Why should I top it up over the travelling expenses?

15

Mr Reynolds: Because different people had to be here for the hearing.

Mr Hobbs. I see. Mr James was here the last time.

20

Mr Reynolds: He was in London for other purposes and had ex-parte appeals before you so I would make no claim in respect of his travelling. He was here anyway. Clearly, he had to prepare for the hearing prior to that.

25

Mr Hobbs: That is true. In principle I have a slight degree of reluctance about, if you like, the time and the costs of the preparation because Hearing Officers, if they were not doing this, would be doing something else.

Mr Reynolds: I will not press that point, Sir. In a sense it is to give a message to parties who do this. The money goes into the Treasury coffers.

30

Mr Hobbs: I understand. Is there anything else you would like to say?

Mr Reynolds: No.

Mr Hobbs: I remind myself that the main function of an order for costs is to provide appropriate compensation for expenditure which has actually been incurred and that it is not  
5 the purpose when awarding costs to punish the paying party.

My impression is, looking at these papers and looking at the way this case has gone, that costs have unnecessarily been increased by the way in which the appellants have conducted themselves in relation to this appeal. In the circumstances I propose to take the exceptional  
10 course of directing that they pay a contribution towards the Registrar's costs. In the light of the submissions that have been made to me, I would direct that the sum of £120 be paid by the appellants as a contribution to the Registrar's costs.

So far as the costs of the respondents to the appeal are concerned, it is not possible to do  
15 more than rough justice on these occasions and there is a long tradition that costs in connection with proceedings such as these are not awarded on an indemnity basis. Applying, as I have called it, rough justice, in this connection I would direct the unsuccessful appellants pay the respondents to the appeal the sum of £650 as a contribution towards their costs.

20 Is there anything else I need to do?

Mr Edenborough: No, Sir.

Mr Hobbs: thank you very much. I am terribly sorry it turned into a wasted hearing for you.  
25

**Copy of letter sent to the Treasury Solicitor's Department**

A.G. Prior.,  
The Treasury Solicitor's Department,  
Queen Anne's Chambers,  
28 Broadway,  
LONDON SW1H 9JS

Your Ref: L98/8353F/AGP/B2

29<sup>th</sup> March 1999

Dear Mr. Prior.

**APPEAL TO THE APPOINTED PERSON  
TRADE MARK APPLICATION NO 2068253  
BY KABUSHIKI KAISHA NAMCO (NAMCO  
LIMITED) AND OPPOSITION THERETO  
BY THE EDGE INTERACTIVE MEDIA INC  
AND THE EDGE INTERACTIVE MEDIA LIMITED**

I have considered the letter dated 26<sup>th</sup> March 1999 in which The Edge Interactive Media Inc and The Edge Interactive Media Limited ("the Opponents") request an adjournment of the hearing of the above appeal from 29<sup>th</sup> March 1999 to a date which, according to their letter of 2<sup>nd</sup> March 1999, should preferably be "at least two weeks later".

I note that the Treasury Solicitor's Department can find no trace of having received the Opponents' letter of 2<sup>nd</sup> March 1999. I also note from the Decision under appeal that there is a common thread running through the Registry file relating to the present opposition proceedings that documents sent to the Opponents' address for service in the United Kingdom do not appear to be coming to the Opponents' attention sufficiently soon after arrival at that address to enable them to respond promptly when a response is required.

I understand that Kabushiki Kaisha Namco ("The Applicant") has indicated through its representatives that it is unwilling to consent to the Opponents' request for an adjournment. I understand that the Registrar adopts a neutral position in this connection.

Against this background my assessment of the prevailing situation is as follows.

[A] Rule 10(1) of the Trade Marks Rules 1994 provides that:

"For the purposes of any proceedings before the Registrar under these Rules or any appeal from a decision of the Registrar under the Act or these rules an address for service in the United Kingdom shall be filed by -

(a) every applicants for the registration of a trade mark

(b) every person opposing an application for a trade mark

- [B] The Opponents' address for service in the United Kingdom is P.O. Box 153, Kidlington, Oxon OX5 1DU
- [C] By letter from the Treasury Solicitor's Department dated 15<sup>th</sup> March 1999 the Opponents were notified at that address that their appeal from the Decision issued by Mr Knight (Principal Hearing Officer acting for the Registrar) on 24<sup>th</sup> November 1998 would be heard by me sitting as the Appointed Person at the Patent Office, Southampton Buildings, 10 Furnival Street, London EC4 on Monday 29<sup>th</sup> March 1999 at 4.30 p.m.
- [D] The letter was sent to the Opponents at that address in accordance with Rule 10(4) of the 1994 Rules which provided that:
- “Anything sent to any applicant, opponent, intervener or registered proprietor at this address for service shall be deemed to be properly sent.”
- [E] The combined effect of Rules 48(2) and 59(2) of the 1994 Rules is to require that the parties to an appeal under Section 76 of the Act are given at least 14 days notice of the time when they may be heard unless they consent to shorter notice.
- [F] The Opponents have not consented to shorter notice and it is questionable whether the Treasury Solicitor's letter of 15<sup>th</sup> March 1999 can be taken to have given them “at least 14 days notice” of the hearing scheduled for 29<sup>th</sup> March 1999.
- [G] Whether or not the requisite period of notice was given, the Opponents have indicated that they wish to be represented at the hearing of their appeal, but cannot be represented if the hearing taken place on 29<sup>th</sup> March 1999.

In all the circumstances I propose to accede to the Opponents' request for an adjournment on the basis that:

1. The hearing scheduled to take place on 29<sup>th</sup> March 1999 will be re-scheduled to take place before me at the Patent Office, Southampton Buildings, 10 Furnival Street, London EC4 on 20<sup>th</sup> April 1999 at 4.30p.m.
2. All questions relating to the costs of adjourning the hearing from 29<sup>th</sup> March 1999 to 20<sup>th</sup> April 1999 will be reserved for consideration at the re-scheduled hearing.
3. Any Skeleton of Argument on behalf of the Opponents in response to the Applicant's Skeleton of Argument dated 25<sup>th</sup> March 1999 should be served on the Applicant (and copied to me and the Registrar) no later than 3 days prior to the date fixed for the re-scheduled hearing.



4. The contents of this letter are to be communicated to the parties at their respective addresses for service and additionally (in the case of the Opponents) by fax to the fax number stated in the penultimate paragraph of their letter dated 26<sup>th</sup> March 1999.

Yours sincerely,

Geoffrey Hobbs Q.C.