

TRADE MARKS ACT 1994

**IN THE MATTER OF AN INTERLOCUTORY HEARING IN RELATION TO
APPLICATIONS FOR INVALIDATION AND REVOCATION BY DAVID
LAURENCE MELTON, STERLING SAFETY LIMITED AND FIRETRACE
LIMITED UNDER NOS: 12195 AND 12196 IN RELATION TO TRADE MARK
REGISTRATION NO: 1429595 STANDING IN THE NAME OF FIRETRACE
LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF an Interlocutory Hearing
in relation to Applications for Invalidation and Revocation
by David Laurence Melton, Sterling Safety Limited and Firetrace
Limited under Nos: 12195 and 12196 in relation
to trade mark registration no: 1429595
standing in the name of Firetrace Limited**

BACKGROUND

1. Registration No: 1429595, for the stylised word mark FIRETRACE, stands registered in the name of Firetrace Systems Limited and was placed on the register on 15 January 1992 in respect of: "Fire extinguishing apparatus included in Class 9".

2. On 16 January 2001, Dummett Copp on behalf of three joint applicants namely: David Laurence Melton, Sterling Safety Limited and Firetrace Limited filed Forms TM26(I) and TM26 (O) together with Statements of Grounds. These documents were forwarded by the Trade Marks Registry to Trade Mark Consultants Co (TMC) the registered proprietors' Attorneys under cover of official letters dated 19 January 2001. Under the provisions of Rules 32(2) and 33(2) of The Trade Mark Rules 2000, TMC were allowed until 2 March 2001 to file forms TM8 and accompanying counter-statements. In the event, no such documents were filed. On 9 March 2001 TMC wrote to the Trade Marks Registry. In this letter TMC explained why the official deadlines had been missed. These reasons can be summarised as follows:

(i) the assistant responsible for these cases left (suddenly) on 21/2/01 and no due dates were recorded. TMC were however well advanced in preparing the two counter-statements, and outline counter-arguments had been prepared (on 31 January and 1 February 2001); a conference with the clients had been conducted following receipt of the clients own written submissions of 5 Feb 2001;

(ii) the preparatory work of the assistant could not be followed up or supervised by TMC due to the ill health of TMC's Principal, and

(iii) TMC's offices were in a state of upheaval following refurbishment and many files including the files relating to these actions were temporarily mislaid.

TMC concluded their letter in the following terms:

" We therefore request that both proceedings be kept alive. If, by reason of Rule 68(3), there is no provision for filing the counter-statements late and because the filing of the counter-statements is optional anyway, we ask that the proceedings be advanced to the next stage and that the proprietors be given an opportunity to file evidence under Rules 32(8) and 33(8) respectively. Alternatively, we request the Registrar's sympathetic consideration by suggesting any other available method for enabling the proprietors to put their written arguments to save the registration".

3. In response to TMC's letter the applicants' Attorneys Dummett Copp wrote to the Trade Marks Registry on 15 March 2001. They provided background information on the dispute between the parties and requested that the Registrar exercise her discretion to treat the applications as being unopposed. In an official letter dated 27 March 2001 to TMC the Trade Marks Registry issued the following preliminary view:

“Your comments have been considered very carefully, however, the Registrar's preliminary view is that, as the forms TM8 and counter-statements were not filed within the time period allowed the reasons put forward are not sufficient to allow the proceedings to continue”.

4. On 30 March 2001 TMC requested a Hearing. At the same time they filed evidence from the registered proprietors in relation to the revocation proceedings. This consisted of a statutory declaration by Mr Cornelius William Quick dated 30 March 2001 and three exhibits. The Trade Marks Registry responded to this letter in the following terms in an official letter (incorrectly dated 30 June 2000) but dating (I deduce) sometime between 2 and 18 April 2001:

“The official letter of 27 March 2001 informed you that the Registrar's preliminary view was that the above proceedings could not continue, as the forms TM8 had not been filed within the prescribed period and the reasons put forward as to why they weren't filed were not considered sufficient enough to allow matters to continue, therefore, in accordance with this preliminary view opportunity to file evidence could not be afforded. As you have now submitted evidence it will now be held on file and the cases put forward for an interlocutory hearing to be appointed. Should it be decided that proceedings can continue then the evidence will be considered at the appropriate time”.

5. In a further letter dated 15 May 2001 in relation to Invalidation No: 12195, TMC filed evidence on behalf of the registered proprietors. This consisted of a Witness Statement by Mr George Myrants (their Trade Mark Attorney) dated 15 May 2001 and three exhibits. As in the Revocation proceedings TMC asked the Trade Marks Registry to keep this evidence on file pending the outcome of the interlocutory hearing. I note that in this letter TMC also challenged the applicants' statement of grounds. However this issue was not pursued at the hearing before me and I do not propose to make any further mention of it.

THE HEARING

6. The interlocutory hearing took place before me on 22 May 2001. Mr Simon Malynicz of Counsel instructed by Trade Mark Consultants Co represented the Registered Proprietors. Mr Hugo Cuddigan of Counsel instructed by Dummett Copp represented the Applicants for Invalidation/Revocation.

REGISTERED PROPRIETORS' SUBMISSIONS IN CHIEF

7. I do not propose to summarise the submissions in detail. The principle points emerging from Mr Malynicz's submissions were, in my view, as follows:

- that regardless of the Trade Marks Registry's view as to the proprietors conduct in

relation to the counter-statements, the registration cannot just be killed from the outset. The proceedings do have to continue;

- the reason for that is the presumption of validity contained in Section 72 of the Act, which the applicants' for revocation/invalidity had to overcome. It would not, in his view, be sufficient to simply state that certain grounds for revocation existed, those grounds had to be made out. Simply meeting prima facie with prima facie would not be sufficient;
- that the discretion to treat the proprietors' opposition to the application for revocation on the grounds of other than non-use and the application for invalidity as having been withdrawn is one that should be exercised very sparingly.

8. Having commented on the non-extendable nature of the time period for filing a response and the absence of discretion in opposition proceedings, Mr Malynicz commented on the different approach adopted in relation to revocation on the grounds of non-use. He said:

- “the point is that the position in relation to revocation on the grounds of non-use is, rightly, that a rather draconian approach is taken.....effectively because of Section 100.....”.

9. Having reviewed the wording of rules 31, 32 and 33 Mr Malynicz said:

- “That then raises the question, what is the extent of the discretion that ought to be exercised and how ought it to be exercised in relation to rules 32 and 33, which I say should be treated broadly the same and differently to oppositions or non-use revocations. I say first of all that it is a discretion which needs to be exercised sparingly. It should not be exercised in serious cases of delay and should not be exercised where there is prejudice on the part of the applicant. None of these are relevant considerations in this case. First of all, let me deal with the reasons why this discretion needs to be exercised very sparingly, apart from its differences to the non-use revocations. The first point is that we are talking here about trade mark registration. It is a property right and we are talking about depriving the proprietor of a property right on grounds of failure to comply with the procedural time limit”.

Mr Malynicz went on to say:

- “We say that in the circumstances of this case, it cannot be in accordance with the overriding objective [of the Civil Procedure Rules] to revoke or declare invalid a registration where there has been a failure by only a few days in effect. The deadline was 2nd March. On 9th March a letter was sent from attorneys for the proprietor to the Registry, out by only a few days of the procedural time limit to deal with the case. We say the matter would be different if this was serious delay - what used to be called contumelious delay in the rules of the court - and/or consequent prejudice to the applicant”.

10. Having drawn my attention to the Civil Procedure Rules Parts 12 & 13 which relate to default judgements and their setting aside, Mr Malynicz then took me through what in his view should

have been the Trade Marks Registry's approach to these cases commenting; "... in this case the defendant has always had an intention to defend this registration". He suggested that the proceedings should be progressed by the applicants filing their evidence in support of the various grounds. The proprietors should then in his view be allowed to submit evidence in response - possibly under rules 32(8) and 33(8), adding that the applicants ought then to be allowed a further round of evidence in reply - also under rules 32(8) and 33(8). Mr Malynicz correctly identified that adopting such an approach would result in evidence being filed by both sides but with pleadings filed only by the applicants. In order to overcome this problem and to assist the applicants, Mr Malynicz suggested that the proprietors be allowed to file a defence (on some basis) setting out the basis of the proprietors defence to the attack. This approach was, he said, consistent with the comments of Mr Justice Pumfrey in the **FRISKIES** trade mark case [2000] RPC 536 which related to the Registrar's inherent jurisdiction to regulate procedures before her.

APPLICANTS' SUBMISSIONS IN CHIEF

11. Again I do not propose to summarise the submissions in detail but the main points emerging from Mr Cuddigan's submissions, were as follows:

- he accepted that there was no obvious prejudice to his clients as a result of the proprietor missing the deadline for opposition to the applications.

Mr Cuddigan commented as follows:

- " In summary this is how we say the rules should work. I apply to revoke a registered trade mark or have it declared invalid. I file the appropriate notices of application with a statement of grounds, that being my pleading. The Registry acknowledges these applications and the proprietor then has six weeks in which to file a counter-statement. As a matter of fact I understand that no counter-statement has yet been filed. The point is that this period is not extendible. My learned friend suggested that there was a distinction between opposition and revocation or invalidity on this matter. If you look at Rule 68(3), you will see there is no distinction. They are referred to as rules excepted from paragraph (1). With respect to the discretion to extend time periods, there is no distinction made whatsoever. With respect to the present case, no extension of time can be allowed. The rules are clear. They may be harsh; they may seem draconian in certain situations but they are undoubtedly clear. So what is the situation when no counter-statement is filed? There is no provision in the rules for any counter pleading whatsoever. There is, in effect, no opposition to the application. That does not mean the application goes through on the nod. I still have to make out my contentions as stated in my statement of grounds. I still have to provide evidence and satisfy the Registry that the mark should be revoked or declared invalid. What is clear, however, is that there is no provision for the proprietor to file a pleading"
- In so far as the registrar's inherent jurisdiction to regulate procedures before her, Mr Cuddigan drew my attention to the comments of Pumfrey J in the **FRISKIES** case when he said:

".....I have no doubt that the registrar has the power to regulate the procedure before

her in such a way that she neither creates a substantial jurisdiction where none existed, nor exercises that power in a manner inconsistent with the express provisions conferring jurisdiction upon her”.

he submitted that Mr Malynicz was suggesting that the Registrar did precisely that.

12. Mr Cuddigan concluded his submissions in chief in the following terms:

- “In conclusion my learned friend has talked at length about the Registrar’s discretion. We say it is clear from the rules that, whatever we may think about it, however fair it may seem there is no such discretion. His only hope is to take the slightly loose drafting of rules 32(3) and 33(3) and use that draft to shoehorn on to rule 68(3) a discretion to effectively extend a time limit. If you look at the two rules, rule 68(3) is crystal clear. The remainder of rules 32 and 33 are crystal clear. We say in construction that those rules 32(3) and 33(3) are also clear. My learned friend has elegantly argued on the basis of the background to the rules. He states there should be a different approach for revocation and invalidation and he makes a convincing argument for alteration of the rules. However his arguments are quite irreconcilable with those rules. They are clear. There is no discretion. There should be no counter-statement and there should be no opposition”.

DECISION

13. The position governing the operation of proceedings relating to applications for revocation (on grounds other than non-use) under sections 46(1)(c) or (d) of the Act and invalidation under section 47 of the Act are to be found in rules 32 and 33. These are reproduced below:

“**32.** - (1) An application to the registrar for revocation under section 46(1)(c) or (d) of the registration of a trade mark shall be made on Form TM26(O) together with a statement of the grounds on which the application is made; the registrar shall send a copy of the application and the statement to the proprietor.

(2) Within six weeks of the date on which a copy of the application and statement is sent by the registrar to the proprietor, the proprietor may file a counter-statement, in conjunction with notice of the same on Form TM8; where such a notice and counter-statement are filed within the prescribed period, the registrar shall send a copy of the Form TM8 and the counter-statement to the applicant.

(3) Where a notice and counter-statement are not filed by the proprietor within the period prescribed by paragraph (2), the registrar may treat his opposition to the application as having been withdrawn.

(4) Within six weeks of the date upon which a copy of the counter-statement is sent by the registrar to the applicant, the applicant may file such evidence as he may consider necessary to adduce in support of the grounds stated in his application and shall send a copy thereof to the proprietor.

(5) If the applicant files no evidence under paragraph (4) above in support of his

application, he shall, unless the registrar otherwise directs, be deemed to have withdrawn his application.

(6) If the applicant files evidence under paragraph (4) above or the registrar otherwise directs under paragraph (5) above, the proprietor who has filed a notice and counter-statement under paragraph (2) above may, within six weeks of the date on which either a copy of the evidence or a copy of the direction is sent to him, file such evidence as he may consider necessary in support of the reasons stated in the counter-statement and shall send a copy thereof to the applicant.

(7) Within six weeks of the date upon which a copy of the proprietor's evidence is sent to him under paragraph (6) above, the applicant may file evidence in reply which shall be confined to matters strictly in reply to the proprietor's evidence, and shall send a copy thereof to the proprietor.

(8) No further evidence may be filed, except that, in relation to any proceedings before her, the registrar may at any time if she thinks fit give leave to either party to file such evidence upon such terms as she may think fit.

(9) Upon completion of the evidence the registrar shall request the parties to state by notice to her in writing whether they wish to be heard; if any party requests to be heard the registrar shall send to the parties notice of a date for the hearing.

(10) When the registrar has made a decision on the application she shall send the parties to the proceedings written notice of it, stating the reasons for her decision; and for the purposes of any appeal against the registrar's decision the date when the notice of the decision is sent shall be taken to be the date of the decision.

33. - (1) An application to the registrar for a declaration of invalidity under section 47(1) or (2) of the registration of a trade mark shall be made on Form TM26(I) together with a statement of the grounds on which the application is made; the registrar shall send a copy of the application and the statement to the proprietor.

(2) Within six weeks of the date on which a copy of the application and statement is sent by the registrar to the proprietor, the proprietor may file a counter-statement, in conjunction with notice of the same on Form TM8; where such a notice and counter-statement are filed within the prescribed period, the registrar shall send a copy of the Form TM8 and the counter-statement to the applicant.

(3) Where a notice and counter-statement are not filed by the proprietor within the period prescribed by paragraph (2), the registrar may treat his opposition to the application as having been withdrawn.

(4) Within six weeks of the date upon which a copy of the counter-statement is sent by the registrar to the applicant, the applicant may file such evidence as he may consider necessary to adduce in support of the grounds stated in his application and shall send a copy thereof to the proprietor.

(5) If the applicant files no evidence under paragraph (4) above in support of his application, he shall, unless the registrar otherwise directs, be deemed to have withdrawn his application.

(6) If the applicant files evidence under paragraph (4) above or the registrar otherwise directs under paragraph (5) above, the proprietor who has filed a notice and counter-statement under paragraph (2) above may, within six weeks of the date on which either a copy of the evidence or a copy of the direction is sent to him, file such evidence as he may consider necessary to adduce in support of the reasons stated in the counter-statement and shall send a copy thereof to the applicant.

(7) Within six weeks of the date upon which a copy of the proprietor's evidence is sent to him under paragraph (6) above, the applicant may file evidence in reply which shall be confined to matters strictly in reply to the proprietor's evidence, and shall send a copy thereof to the proprietor.

(8) No further evidence may be filed, except that, in relation to any proceedings before her, the registrar may at any time if she thinks fit give leave to either party to file such evidence upon such terms as she may think fit.

(9) Upon completion of the evidence the registrar shall request the parties to state by notice to her in writing whether they wish to be heard; if any party requests to be heard the registrar shall send to the parties notice of a date for the hearing.

(10) When the registrar has made a decision on the application she shall send the parties to the proceedings written notice of it, stating the reasons for her decision; and for the purposes of any appeal against the registrar's decision the date when the notice of the decision is sent shall be taken to be the date of the decision”.

14. Rule 68 relating to the alteration of time limits is also relevant. The relevant paragraphs are reproduced below.

“68. - (1) The time or periods-

(a) prescribed by these Rules, other than the times or periods prescribed by the rules mentioned in paragraph (3) below, or

(b) specified by the registrar for doing any act or taking any proceedings,

subject to paragraph (2) below, may, at the written request of the person or party concerned, or on the initiative of the registrar, be extended by the registrar as she thinks fit and upon such terms as she may direct.

(2).....

(3) The rules excepted from paragraph (1) above are rule 10(6) (failure to file address for

service), rule 11 (deficiencies in application), rule 13(1) (time for filing opposition), rules 13(3) and 13(5) (time for filing counter-statement), rule 13(4) (cooling off period) save as provided for in that rule, rule 23(4) (time for filing opposition), rule 25(3) (time for filing opposition), rule 29 (delayed renewal), rule 30 (restoration of registration), rule 31(2) (time for filing counter-statement), rule 32(2) (time for filing counter-statement), rule 33(2) (time for filing counter-statement), and rule 47 (time for filing opposition)”.

15. It was common ground that while rule 68(1) allows for time periods to be extended on written request, a number of time periods are specifically excluded from this provision by rules 68(1)(a) and 68(3). Among the time periods specifically excepted from paragraph (1) are rules 32(2) and 33(2) ie. the time periods allowed for the filing of counter-statements in revocation (other than non-use) and invalidation proceedings. That being the case, it is clear that I have no discretion to extend the time periods for the proprietor to file their counter-statements.

16. Both Counsel also agreed that irrespective of my findings in relation to what (if any) further part the proprietors may play in these proceedings, the registration can not simply be revoked or declared invalid. The basis of this submission is the presumption of validity contained in Section 72 of the Act. This section reads as follows:

“72. In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it”.

17. In this respect I agree with Counsel’s view. It is not sufficient to simply allege that a registration offends either section 46 or 47 of the Act without doing more to prove that the allegation has substance. That said, when an application for revocation (other than non-use) or invalidation is made and the registered proprietors choose not to respond to such a request, I do not think that it is necessary for the applicants in those circumstances to have to fully substantiate their allegations beyond providing evidence which supports a prima facie case. In reaching this conclusion I am mindful of the decision in the **Fontaine Converting Works Incorporated’s Patent (Revocation)** [1959] RPC 72 (at page 73) where the Assistant Comptroller stated:

“In the case before me the Patentee has made no response whatever to the case made by the Applicants for Revocation although he has been allowed very generous time in which to do so. He has not even asked the Comptroller to decide the case in his absence: I must read the Agent’s letter of the 21st of November as saying no more than that in the absence of instructions the Agents can give no assistance in the prosecution of this case. In these circumstances I must hold that the Comptroller has no duty to consider the merits of the case. If he were to attempt to do so, he must give the Applicants’ for Revocation an opportunity to develop their case, by the appointment of a hearing or otherwise. It is not reasonable that they should be put to this trouble and expense, and that official time should be wasted, on a case which the Patentees have, in effect, allowed to go by default. And it would be intolerable that the interests of the Applicants for Revocation and the public in

general should be prejudiced for an indefinite period by the refusal of the Patentees to enter any defence in the action brought against them, whether the reason be that they can see no defence, or that they wish to delay a decision on the case as long as possible”.

18. The position under the 1994 Trade Marks Act is somewhat different. As mentioned above Section 72 of the Act does provide that registration of a trade mark is considered prima facie evidence of its validity. As such, even in revocation (other than non-use) and invalidation proceedings where the proprietor does not contest the application, there is in my view still an onus on the applicants to make out at least a prima facie case.

19. Having reached the above views, what then is the position in relation to these cases? Mr Malynicz argued that the wording of rules 32(3) and 33(3) both of which include the words “.....the registrar may treat his opposition to the application as having been withdrawn” clearly affords the registrar a discretion. He argued that this discretion ought to be exercised sparingly and ought not to be exercised in cases where serious delays had occurred or prejudice suffered by the applicants. In his view neither were relevant considerations in these proceedings. The latter was expressly accepted by Mr Cuddigan and I did not understand him to disagree with the former. In addition, Mr Malynicz urged me to consider the nature of a trade mark registration. Not to allow a proprietor to defend a registration (where there was a clear intention to do so) merely because they had failed to comply with a procedural time limit (by some seven days) may deprive them of a property right to which they are entitled. Mr Cuddigan for his part was unequivocal. In his view the position is quite clear, there was no discretion and as such the applications should proceed unopposed, albeit with the applicants having to make good their various contentions.

20. In my view the position is not quite as straightforward as Mr Cuddigan suggests. If rules 32(3) and 33(3) had within them the word “shall” in the context of what the Registrar had to do in the event of the registered proprietor failing to file a notice and counterstatement then there would have been no doubt that in default of doing so, the registered proprietors would have no further role to play in the proceedings. Any opposition they may have had to the application for revocation (or a declaration of invalidity) would have to be treated as withdrawn. But the wording of rules 32(3) and 33(3) and the use of the word “may” in those rules, in my view, clearly confers on the Registrar a discretion. When then should it be exercised? Given the way in which the rules are written the legislature envisaged that a registered proprietor sufficiently concerned to defend their registration against attack should have a fixed period in which to respond to a notice of an application for revocation or a declaration of invalidity. This, presumably, provides a degree of certainty for all concerned. Therefore, any failure by the registered proprietors to conform with the request to file a response within an unextendable deadline must be regarded as a deliberate action, unless it can be shown that that was not the case. It is not appropriate to provide examples but before the Registrar can be persuaded that the registered proprietors should be allowed to continue as a party to the proceedings there must be a very good explanation for their failure to date and therefore for the Registrar to exercise her discretion in their favour.

21. So, is this a situation where this discretion should be exercised favourably in the registered proprietors favour? It is clear from the various correspondence referred to above that it was always the registered proprietors intention to defend this registration. It was a number of unrelated

incidents and circumstances not within their direct control that led to the forms TM8 and counter-statements not being filed in time. It seems to me that the responsibility for the failure by the registered proprietors to file their responses to these actions by the applicants for revocation and declaration of invalidity lies directly with their Trade Mark Attorneys. Their assistant's failure and the lack of supervision/control of that person together with the loss of files during refurbishment suggest a set of circumstances which, whatever might be said about the organisation or otherwise of the office of the Trade Marks Attorneys, should not be laid at the door of the registered proprietors. The answer to the question therefore is yes. The registered proprietors always had the intention to defend their registration and the gross failure of the Trade Marks Attorneys on their behalf should not prevent them from doing so. In reaching that view I have had regard also to the extent of the delay which occurred and the potential prejudice to the applicants. In this regard I have noted Mr Cuddigan's comments to the effect that the applicants suffered no prejudice. I also bear in mind that the delay amounted to five working days. In summary therefore I agree with Mr Malynicz that the discretion under rules 32(3) and 33(3) must be exercised sparingly but that the case before me is such a case, where the registered proprietors should be allowed to continue as a party to the proceedings despite not having filed the required forms TM8 and counterstatements. In the circumstances I am prepared to exercise my discretion under rules 32(3) and 33(3) to allow the registered proprietors to become a party to these proceedings. In reaching this conclusion I should record that I do not consider that I have fallen foul of the comments of Pumfrey J in the FRISKIES trade mark case. I am not allowing an extension of time to an unextendable time limit, I am simply exercising a discretion as provided for in the rules.

22. As I have decided to allow the registered proprietors to defend their registration and given that no defence has been filed by them (but evidence has been sent to the Trade Marks Registry) how does one proceed? At the hearing I mentioned the use of rule 57. Rule 57 states:

“57. At any stage of any proceedings before the registrar, she may direct that such documents, information or evidence as she may reasonably require shall be filed within such period as she may specify”.

23. Given my decision above, it is in my view preferable for the applicants and the Trade Marks Registry to have set out the basis on which the registered proprietors intend to defend their registration. With that in mind, and given the powers available to me under Rule 57, I direct that within 1 month of the date of this decision the registered proprietors provide to the applicants and the Trade Marks Registry by way of a letter, the basis of their defence to the allegations contained in the application for revocation and the declaration of invalidity. On receipt of that letter, which must be copied directly to the applicants, the registered proprietors' evidence the details of which are set out earlier in this decision will be admitted in to the proceedings. On receipt of that letter the Trade Marks Registry will set the applicants, under rules 32(4) and 33(4), a period of six weeks to file their evidence in chief. Clearly the filing of the registered proprietors evidence “out of turn” (such evidence having already been copied to the applicants) causes some difficulty. But I assume that the applicants' evidence in chief will inevitably in some measure consist of a reply to the registered proprietors' evidence. That being so, I think it is appropriate to say that the Trade Marks Registry should be ready to move directly to a decision from the papers or a hearing as soon as the applicants' evidence is to hand.

24. In so far as costs were concerned Mr Malynicz said:

- “I have no particular submissions to make on costs. It is fair to say, in favour of the applicant, that the applicant did not bring us here today. The applicant, so far as we are aware, did not weigh in on this question one way or the other. It was really a matter between the proprietor and the Registrar. So, perhaps, to be fair to the applicant, costs should probably be in the case in these circumstances”.

25. Tribunal Practice Notice (TPN) 2/2000 dated 19 April 2000 deals specifically with the issue of costs in proceedings before the Comptroller. In particular paragraphs 12 &13 of that notice read as follows:

“Timing of costs awards and their payment

12. Users have remarked that the Office should be encouraged to award costs at any stage of proceedings and to order that an identified sum be paid immediately or within a limited and defined number of days. The Office agrees that in the current post-Woolf climate a regime which associates costs more closely with their cause is desirable. It is too easy when costs are, as now, generally rolled over into the final decision, for the reason they were awarded to be lost sight of, for example when an award is made to penalise the taking of a purely technical point to a preliminary hearing.

13. The Office therefore intends, far more frequently than in the past, to make costs orders as the cause of them arises. Examples of situations in which such an award might be made are:

- (a) where “blame” can be attached to one or the other party, *eg* a missed deadline
- (b).....”

26. I also note Section 68(1) of the Act which states:

“68. (1) Provision may be made by rules empowering the registrar, in any proceedings before him under this Act

- (a) to award any party such costs as he may consider reasonable, and
- (b) to direct how and by what parties they are to be paid”.

27. While strictly speaking it was not necessary for the applicants to attend this hearing (as Mr Malynicz pointed out it was really a matter between the registered proprietors and the Trade Marks Registry), one can fully understand that they wished to be present to protect their position. In addition their submissions at the hearing assisted me in reaching my decision. Given Mr

Malynicz's fair and realistic concession and in view of the guidance provided in TPN 2/2000, I feel that the applicants are entitled to a contribution towards their costs. But in the context of this case I believe that these should be met directly by those whose actions (or inactions) were the cause of this preliminary dispute. Therefore having regard to Section 82 of the Act which states:

“82. Except as otherwise provided by rules, any act required or authorised by this Act to be done by or to a person in connection with the registration of a trade mark, or any procedure relating to a registered trade mark, may be done by or to an agent authorised by that person orally or in writing”,

28. I order the registered proprietors' Trade Mark Attorneys, Trade Mark Consultants Co, to pay to the applicants the sum of £500. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this issue if any appeal against this decision is unsuccessful.

Dated this 28th day of June 2001

**M KNIGHT
For the Registrar
The Comptroller-General**