

TRADE MARKS ACT 1994
IN THE MATTER OF:
APPLICATION NO. 2232064
TO REGISTER A TRADE MARK
IN CLASSES 16, 35, 36 AND 42
IN THE NAME OF
BRIT GROUP SERVICES LTD.

DECISION

1. On 10th May 2000 Brit Group Services Ltd applied to register the designation ALPHA as a trade mark for use in relation to various goods and services in Classes 16, 35, 36 and 42.
2. The Registrar raised objections to registration under Section 5(2) of the Trade Marks Act 1994 on the grounds identified in an examination report issued on 8th June 2000.
3. A period of six months was allowed for the Applicant to respond to the objections under Section 38(3) of the Act. At the request of the Applicant that period was extended by three months to 8th March 2001.
4. The Applicant did not respond (or ask for more time within which to respond) to the objections to registration. The application was therefore refused in accordance with the provisions of Section 37(4) of the Act on 25th April 2001.

5. On 2nd May 2001 the Applicant applied for more time within which to respond to the Registrar's objections under Section 37(3). This request was refused on the basis that the relevant application for registration had, without irregularity, been refused on 25th April 2001 in accordance with the provisions of Section 37(4) and thereupon ceased to be an application in respect of which the period specified under Section 37(3) could be extended under Rule 68 of the Trade Mark Rules 2000 cf. T's Application [1982] FSR 172 (C.A.)

6. The Applicant gave notice of appeal to an Appointed Person under Section 76 of the Act on 2nd July 2001. In its Statement of Case in support of the Appeal it contended that the decision of 25th April 2001 should be set aside so as to revive the application for registration and pave the way for the desired extension of time within which to respond to the Registrar's objections under Section 37(3).

7. There were difficulties in the way of that contention, as indicated in the decision of Mr. Simon Thorley Q.C. sitting as the Appointed Person in Everest Trade Mark (25th January 2000) and my decision in Postperfect Trade Mark [1998] RPC 255. The Treasury Solicitor's department was asked to bring those decisions to the attention of the Applicant.

8. The appeal was given a hearing date of 1st November 2001.

9. In the afternoon on 31st October 2001 the agents for the Applicant confirmed that the appeal would proceed at the allotted time on the following day. In the evening on 31st October 2001 I received a message indicating that the Applicant had decided not to proceed with its appeal. The hearing fixed for the following day was therefore vacated.

10. The Registrar subsequently asked for an award of costs in respect of the abandoned appeal. The request was made on the basis stated in a letter of the 5th November 2001 from Mr. Allan James, the Principal Hearing Officer who had been due to appear on behalf of the Registrar at the hearing of the Appeal:

“I understand that the appeal against the Registrar’s decision to refuse this application has been withdrawn. I further understand that the withdrawal was communicated to you by telephone late on the afternoon of 31 October 2001. Unfortunately, the message did not reach me, via the Hearings Clerk in London and Newport, until 9.00 a.m. on 1 November upon the completion of my journey to London to represent the Registrar at the appeal hearing.

The Registrar does not usually ask for her costs before the Appointed Person. However, given the applicants failure to take any steps to communicate the withdrawal of the appeal to the Registrar, the Registrar requests the Appointed Person to order the applicant to pay the Registrar the sum of £200.

This represents £132, being the cost of a first class return rail ticket from Newport to London, and £68, being a contribution towards the cost of wasted time I spent travelling to and from a non-existent hearing.”

11. The Applicant was invited to respond to the Registrar’s request for an award of costs. It did so (in a letter from its agents dated 27th November 2001) in the following terms:

“I note the Registrar’s comments, we certainly apologise for any inconvenience that may have been caused. The Appeal was withdrawn only at a very late stage due to last minute communication from the clients, and I was not aware that the communication of the withdrawal of the Appeal had to be communicated to the Registrar in the circumstances.”

12. It does not appear from the Applicant's response that it has any objection to an award of costs in favour of the Registrar in the sum claimed. I see no reason why the Registrar should carry the burden of the costs needlessly inflicted upon her by the inadequately notified abandonment of the Appeal at a very late stage. It seems to me that the sum claimed is reasonable and appropriate for the time and travel in question. I therefore direct the Applicant to pay the Registrar £200 as a contribution towards her costs of the abandoned appeal.

Geoffrey Hobbs Q.C

12th December 2001