

O/027/12

TRADE MARKS ACT 1994

**TRADE MARK REGISTRATION 1 569 928
IN THE NAME OF MITCHELL'S OF LANCASTER (BREWERS)**

AND

**CONSOLIDATED APPLICATIONS FOR REVOCATION (No. 83685 AND 83876)
BY DANIEL THWAITES PLC**

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Background and Pleadings

1. Mitchell's of Lancaster (Brewery) is the registered proprietor (RP) of trade mark registration No 1 569 928 which is for the following trade mark:



2. The mark was registered on 7 July 1995 in respect of *beer, ale, lager and porter* in Class 32.
3. Daniel Thwaites Plc, the applicant seeks revocation of the trade mark on the grounds of non use or alternatively, its use is liable to mislead the public. Its grounds are based on sections 46(1)(b) and (d) of the Trade Marks Act 1994 ("the Act"). These are as follows:

LEGISLATION AND CASE-LAW

4. The relevant parts of section 46 of the Act read:

"46.-(1) The registration of a trade mark may be revoked on any of the following grounds –

- (a).....
-
- (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
- (c)

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

5. RP filed a counterstatement denying the allegations; it claims that there has been intention to use the mark and filed evidence in support.
6. During the proceedings, the RP filed Form TM22, the notice to surrender a trade mark registration. However, as the applicant had requested revocation from an earlier date, the proceedings continued. Prior to the filing of the Form TM22, the RP had informed the Registrar that it wished to withdraw its defence in the proceedings in respect of the non-use action and that it was content for application No. 1 569 928 to be revoked as of the date applied for on the statement of grounds by the applicants. This was, according to the letter, copied to the applicants. The relevant period claimed by the applicants is 1 January 1999 to 31st December 2003. Revocation is sought with effect from 1 January 2004. I note that, following the withdrawal of the defence by the RP and the filing of the Form TM22, the applicants went on to file evidence in these proceedings.
7. As the RP has withdrawn its defence and indicated that it is content for revocation to take place from 1 January 2004, I can confirm that the application for revocation of trade mark registration No 1 569 928 has been successful and that this revocation will take place from 1 January 2004.

COSTS

8. The applicant is the successful party in these proceedings and is entitled to a contribution towards its costs. Neither party sought costs off the normal scale and I am of course mindful that neither party sought a hearing. In the circumstances I award the applicant the sum of £1100 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing statements and considering the other side's statements - £400

Official fees for filing the revocations - £400

Considering Registered Proprietor's evidence - £300

Total - £1100

9. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Final Remarks

10. It will be noted that I have not made an award of costs in respect of the evidence filed by the applicant. This is because the applicant received a copy of the letter from the RP withdrawing its defence. The applicant is represented in these proceedings and should therefore have been aware that no evidence

was required from it. As such it would be inappropriate to put the RP to further cost in this manner. It may be that the Trade Marks Tribunal, during the proceedings, acted in a manner which contradicted the significance of the letter from the RP. However, this does not alter my decision as regards costs as the RP cannot be held responsible for this. Any complaint to the Trade Marks Tribunal about its handling of this issue in these proceedings should therefore be dealt with separately.

Dated this 30th day of January 2012

**Louise White
For the Registrar,
The Comptroller-General**