

## O-284-15

In the matter of THE TRADE MARKS ACT 1994

and

In the matter of TRADE MARK REGISTRATION 1332605 IN THE NAME OF SHENZHEN SHANLING DIGITAL TECHNOLOGY DEV. CO. LIMITED

AND

In the matter of AN APPLICATION TO RECTIFY THE REGISTER (UNDER NO. 84215)  
BY ADAM WILLIAM JOHN WORSFOLD

and

In the matter of AN APPEAL AGAINST THE DECISION OF  
MR MARK BRYANT DATED 25 NOVEMBER 2014

### INTERIM DECISION

1. On 25 October 2011, Mr Adam Worsfold applied for rectification of the register so as to record himself as the proprietor of trade mark number 1332605 ONIX which stands in the name of Shenzhen Shanling Digital Technology Dev Co (“Shanling”), a company based in China.
2. The application for rectification was heard by the Hearing Officer for the Registrar, Mr Bryant, on 5 November 2014. Mr Bryant produced his written decision on 25 November 2014. He concluded that the application for rectification succeeded.
3. Shanling lodged a notice of appeal to the Appointed Person on Form TM55 on 15 December 2014 and the appeal has been set down to be heard by me on 29 May 2015. This is an interim decision in the appeal relating to (a) security for costs and (b) an application for an adjournment.
4. **If the effect of this interim decision is not clear to Shanling, it should immediately take professional advice about it.** I note that during the course of these proceedings Shanling has previously had a number of different professional representatives.

## O-284-15

5. The TM55 was accompanied by some documents and Shanling indicated through its representative Mr Michael O'Brien, who lodged the TM 55 on its behalf, that it wished to rely upon those documents in support of the appeal.
6. The solicitors acting for Mr Worsfold wrote to the Treasury Solicitor before the papers were sent to me, making a number of points:
  - a. The appeal appeared in essence to seek a rehearing not a review of the Hearing Officer's decision and/or did not challenge the essence of the Hearing Officer's reasons and so should be struck out;
  - b. Shanling apparently wished to rely upon fresh evidence; and
  - c. If the appeal was to proceed, Mr Worsfold asked for security for his costs, such security having been ordered in relation to the hearing below.
7. On 29 April 2015 I informed Mr Worsfold's solicitors that I was not prepared to dismiss the appeal without a hearing but indicated that there were two matters which in my view required attention prior to the hearing:
  - a. I required Shanling to make a formal application to rely on the apparent fresh evidence and directed that it should provide a witness statement whether from Mr O'Brien or a proper officer of Shanling exhibiting any new evidence, stating whether the evidence could have been obtained with reasonable diligence for use at the hearing before Mr Bryant, and if not why not, and explaining the significance of the evidence. I required that the statement be filed by 5 PM on Tuesday, 12 May 2015 and gave permission for Mr Worsfold to respond by 5 PM on Friday, 22 May 2015.
  - b. I asked that Mr Worsfold's solicitors should provide me with an explanation of the basis of the application for security for costs.
8. I received a response to the latter request from Mr Worsfold's solicitors by return, as a result of which I ordered (also on 29 April) that security for costs should be provided by Shanling in the sum of £2000 by 5 PM on Tuesday 12 May 2015 unless I received by that same time/date reasoned submissions in writing from Shanling contesting the making of such order.
9. There followed a certain amount of rather confused e-mail correspondence in the course of which Mr Worsfold's solicitors queried Mr O'Brien's status as the representative of Shanling. I do not now need to go into the details of that issue. However, in the light of that concern,

## O-284-15

Mr Worsfold's solicitors took care to copy their e-mails to Mr Pan, an employee of Shanling who represented at the hearing before Mr Bryant, and all further e-mails have been copied to him as well as to Mr O'Brien. In the circumstances, whether or not Mr O'Brien has been Shanling's representative in the UK throughout this period, I am satisfied that Shanling must have been aware of the Order which I had made and of the need to comply with it.

10. On 6 May, Mr O'Brien e-mailed in relation to the new evidence, suggesting that it was unclear to him whether Shanling needed to provide a witness statement in addition to the documents already filed, and indicating that he was confused as to who was the appellant and who was a witness, and as to the security for costs. He did not give any indication at that date that he would not be available for any period between then and the hearing of the appeal, but wrote again on Friday 8 May indicating that he would be out of the UK from May 12-22 and would only be picking up his e-mails occasionally. The latter email was forwarded to me on 12 May.
11. I was not in Chambers on 6 May and was not able to respond to Mr O'Brien's e-mails of 6 and 8 May until my return to chambers on 12 May, at which point I asked the Treasury Solicitors to email the parties, and to remind Shanling of the need to comply with my previous Order either to provide security for costs in the sum of £2000 or to provide reasoned submissions in writing as to why security should not be ordered by close of business on 12 May. I have been informed by Mr Worsfold's solicitors that they did not receive the sum of £2000 on 12 May, nor have I received any submissions as to why security should not be ordered against Shanling. I have not received a witness statement dealing with the application to adduce fresh evidence on the appeal.
12. Mr Worsfold's solicitors have therefore invited me to strike out the appeal forthwith.
13. In addition, on 11 May 2015, Mr Pan wrote to the Treasury Solicitor asking for an adjournment for the following reasons:
  - (1) One of Shanling's witnesses, Mr Pu, is on holiday and could not be reached; and
  - (2) It was possible that Shanling would need to appoint a representative who would need time for preparation.Shanling did not specify how long an adjournment it sought.

### Security for costs

## O-284-15

14. The Appointed Person has power to require a party to provide security for costs of an appeal pursuant to sections 68 and 76 of the Trade Marks Act 1994 and rule 68 of the Trade Mark Rules 2008. In particular, the Appointed Person may treat a party who has failed to provide security as ordered as having withdrawn their appeal.
15. As I have already indicated, I consider that it is appropriate to order Shanling to provide security for costs in this case because it is based in China and because it has previously failed to comply timeously with costs orders made against it in Mr Worsfold's favour. The time limits for compliance were fairly short, in order not to jeopardise the hearing of the appeal.
16. I do not consider it appropriate to treat this appeal as having been withdrawn at this stage for failure to provide the security for costs or respond properly to my Order to explain why security for costs should be not be provided. The Order which I made on 29 April did not provide that the appeal should be forthwith deemed to have been withdrawn if Shanling failed to provide the security for costs or respond to the application for security for costs. I do not consider that it would be appropriate to deem the appeal as having been withdrawn forthwith, without having made such an Order previously, and without having made it clear to Shanling that its failure to comply with my Order of 29 April might have that effect.
17. I propose to give Shanling a further opportunity to provide security for costs of the appeal in the sum of £2000. I will order it to do so by 5 PM (in the UK) on Friday 22 May 2015. If it has any doubt about how to provide that security, it must immediately inform me and Mr Worsfold's solicitors.
18. Alternatively, Shanling may provide me with its reasoned objections to providing such security, or may provide evidence explaining any difficulties it may have in providing such security, which it must do by 5 PM (in the UK) on Tuesday 19 May 2015.
19. If such objections are received by that date and I accept them, Shanling will not need to provide the security for costs. If Shanling provides me with evidence that it cannot comply with the order for security, I may dispense with the need to provide security or vary the amount to be paid or the time for payment. Otherwise, if Shanling fails to provide £2000 by way of security by 5 PM (in the UK) on Friday 22 May 2015, I will deem the appeal to have been withdrawn and will so order.

## O-284-15

20. Again, if Shanling does not understand paragraph 19, it should immediately take advice about it.

### Adjournment

21. I am not prepared to grant an adjournment on the basis of the reasons given by Mr Pan in his e-mail of 11 May. I do not understand the reference to Mr Pu as one of Shanling's witnesses. Mr Pu attended the hearing before Mr Bryant but did not give evidence and no witness statement was filed from him. None of the documents attached to the Notice of Appeal appear to relate to or emanate from Mr Pu and there is no explanation as to why he would be a relevant witness on the appeal.
22. Shanling has had ample time to appoint a representative for the hearing of the appeal, and still has time to appoint a new representative if it wishes to do so. Mr Worsfold's solicitors have provided me with various documents showing frequent changes of representation by Shanling over the course of the rectification proceedings and indeed over the appeal, some of which may have led to earlier adjournments. If Shanling does appoint a new representative, I do not exclude a further, reasoned application for an adjournment once the new representative has been put in place, but I would be extremely reluctant to adjourn the hearing, in particular because it appears to me that if Shanling appoints a fresh representative immediately, such representative should have ample time to prepare for the appeal on 29 May.

### Order

23. For these reasons, **I make the following Order:**
- (1) Shanling shall either
- a. provide security for costs of the appeal in the sum of £2000 by 5 PM (in the UK) on Friday 22 May 2015, by transferring £2000 into the bank account of Mr Worsfold's solicitors; or
  - b. provide reasoned objections to providing such security, or evidence of any difficulty in giving such security, by 5 PM (in the UK) on Tuesday 19 May 2015.

## **O-284-15**

- (2) If such objections/evidence are received by Tuesday 19 May 2015, the requirement to provide security for costs may be dispensed with or varied by further Order.
- (3) If no such objections/evidence are received by 5 PM (in the UK) 19 May 2015, and Shanling fails to provide the security by 5 PM (in the UK) on Friday 22 May 2015, the appeal will be deemed to have been withdrawn.
- (4) Shanling's application dated 11 May 2015 for an adjournment of the appeal is refused.

Amanda Michaels  
The Appointed Person  
14 May 2015