

O-408-15

**TRADE MARKS ACT 1994
SUPPLEMENTARY DECISION**

**IN THE MATTER OF
CONSOLIDATED APPLICATION NOS 500465, 500466 & 500467
BY THE BRITISH BROADCASTING CORPORATION
FOR REVOCATION OF UK TRADE MARK REGISTRATIONS
1241754, 1241753 & 1213593 FOR THE MARK:**

TIMELORD

IN THE NAME OF WISEMAN INDUSTRIES LTD

1. On 30 June 2015 I issued a provisional decision in relation to this revocation, in which I stated the following:

“57. The applicant has requested costs in its favour. The proprietor states at the conclusion of its submissions dated 12 May 2015:

‘We wish to reserve our submissions on costs in these proceedings.’

58. Therefore I invite the proprietor to provide, within 28 days of the date of this decision, submissions with regard to costs.

59. The proprietor should copy its submissions to the applicant’s representatives.

60. The applicant will have 21 days from the date of receiving any such submissions in which to submit any written comments it wishes to have taken into account.

61. A final decision on costs will follow receipt of the proprietor’s submissions and any response from the applicant. The appeal period for the substantive and supplementary decisions will run from the date of the supplementary decision on costs.”

2. The proprietor filed submissions on 17 July 2015, in which it stated the following:

“1. These were applications for total revocation for non-use. (The all ‘goods and services’ ‘boxes were ticked on the forms TM26(N). The applicant had the opportunity in the light of the registered proprietor’s evidence to amend the applications to applications for partial revocation, but chose not to do so. Instead, the applicant filed submissions which in their inappropriately molecular approach to the evidence obliged the proprietor to explain the significance of several of the Exhibits, such as the delivery notes and the cheques which the applicant had said should be ‘disregarded’ (paragraphs 9 and 10 of its written submissions),

2. Moreover, these applications were filed without notice of any kind to the proprietor or its predecessor and, apparently, without any investigations having been conducted. In the result, the proprietor has had the expense of collating and filing evidence and responding to the applicant’s criticisms of it. It is submitted therefore that the proprietor should be awarded costs according to the guideline scale.

To re-iterate, these were applications for total revocation and as such have been unsuccessful, notwithstanding the Hearing Officer’s decision to proceed with partial revocation.”

3. In a letter dated 29 July 2015, the applicant responded in the following terms:

“The uses of the marks were professionally searched and there is no basis in the submissions made to assert the contrary. The investigation did not reveal use of any of the goods under the TIMELORD mark. Accordingly, it was appropriate to indicate on Form TM26N that the revocation applications were against all goods in the registrations.

The fact that the proprietor restricted their counterstatement to reflect their use does not require the Applicant to amend their revocation applications thereafter. Even the use claimed by the proprietor in their amended counterstatements may not have been sufficient and it is for the Hearing Officer to decide whether the use claimed is deemed genuine. In any event, the interim decision has narrowed the specification of each registration further than that which was claimed in the proprietor's counterstatements.

The interim decision issued by the Registry commercially and substantively revokes the registrations. The goods claimed in each registration were for that in a vast area of industry and have since been cut back to a very narrow subset. In substance, these are near total revocations of the registrations and the award of costs should reflect the balance of the revocations being in favour of the Applicant and the costs award should reflect this accordingly”.

4. The revocation applications were directed at three identical trademarks registered in respect of three different classes, as follows:

TM 1213593 - Class 1:

Chemical products for use in industry and science; chemical products included in Class 1 for use in agriculture; tempering substances; chemical preparations for soldering; adhesives included in Class 1.

TM 1241753 - Class 3

Cleaning preparations; abrasive preparations (not for dental use); soaps; perfumes; cosmetics; non-medicated toilet preparations; non-medicated preparations for the care of the hands; dentifrices.

TM 1241754 - Class 5

Pharmaceutical and sanitary preparations and substances; disinfectants (other than for laying or absorbing dust); insecticides; preparations for killing weeds and destroying vermin.

5. The proprietor sought to defend the following goods:

TM 1213593 - Class 1

Chemical preparations for use as corrosion inhibitors; chemical de-scaling preparations; chemical fluids for use as leak sealants.

TM 1241753 - Class 3

Soaps; cleansing solutions and glass cleaner.

TM 1241754 - Class 5

Medicinal creams for the protection of the skin; disinfectants.

6. In my preliminary decision I found that the proprietor was able to maintain its registrations in respect of the following goods:

TM 1213593 – Class 1

Chemical products for use in the plumbing and heating industries.

TM 1241753 – Class 3

Cleaning preparations for use with plumbing equipment; cleaning preparations for heating systems; glass cleaning preparations; soaps; non-medicated preparations for the care of hands.

TM 1241754 – Class 5

Medicinal creams for the protection of the skin; disinfectants (other than for laying or absorbing dust).

CONCLUSION

7. The proprietor did not seek to defend all of the goods contained within the specifications of its registered marks. Rather, it provided a reduced list of goods and having done so, was able to maintain the majority of those goods. Consequently, having considered both parties' pleadings and submissions, I find that both parties have achieved a measure of success and I consider both should bear their own costs.

Dated this 27TH day of August 2015

**Ms. Al Skilton
For the Registrar**