O-535-15

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. 1520976

OF THE TRADE MARK

WOODLAND

IN THE NAME OF UK DISTRIBUTORS (FOOTWEAR) LTD

AND THE APPLICATION FOR REVOCATION THERETO UNDER NO. 500596

BY M/S. AERO CLUB

Background and pleadings

1. On 26 August 2014, M/s. Aero Club ("the applicant") filed an application for the revocation, on the grounds of non-use, of trade mark registration number 1520976. The registration is now owned by UK Distributors (Footwear) Ltd ("the proprietor"), having been assigned to the proprietor on 4 March 2010. The registration is for the mark WOODLAND and it stands registered for "Boots, shoes, slippers and sandals; all included in Class 25."

2. The registration procedure was completed on 10 December 1993. The applicant seeks revocation of the registration in full under sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 ("the Act"). Under section 46(1)(a), it claims that no genuine use was made between 11 December 1993 and 10 December 1998, seeking an effective revocation date of 11 December 1998. Under section 46(1)(b), the applicant claims that no genuine use was made of the mark between 26 August 2009 and 25 August 2014 , seeking an effective revocation date of 26 August 2014.

3. The proprietor filed a defence and counterstatement in which it states that it has been using the mark since November 2012 on boots and shoes. The proprietor states that it wished to rely upon section 46(3) of the Act, so that it is unnecessary to demonstrate use within the section 46(1)(a) period, as use within the section 46(1)(b) period will save the mark.

4. The proprietor's counterstatement states that the proprietor did not receive notice that the application for revocation may be made. The applicant's notice of application (Form TM26(N)) states that notice was given to the proprietor on 24 February 2014 that the application would be made. This dispute was originally part of a wider dispute involving two oppositions brought by the proprietor in February 2014 against the applicant's applications for two trade marks[1], which were later consolidated with these revocation proceedings. The oppositions were based upon the registration the subject of these revocation proceedings. The applicant withdrew its two trade mark applications shortly before the hearing, which was held on 27 October 2015 by video conference. The proprietor did not attend, but filed written submissions in lieu of attendance via its trade mark attorneys, Serjeants LLP. The applicant was represented at the hearing by Mr Christopher Benson of Taylor Wessing LLP.

Evidence

5. The only evidence in these proceedings has been filed by the proprietor. The evidence is from Mr James Periam Marlow in the form of witness statements dated 18 June 2014 (and exhibits) and 21 May 2015. At the time of filing of the first witness statement, the revocation application had not been made. The first witness statement covered the dates for which the applicant requested proof of use, 14 December 2008 to 13 December 2013. The second witness statement was 'top-up' evidence to cover the extra period of time put in play by the revocation application (i.e. for the period 14 December 2013 to 25 August 2014). The second witness

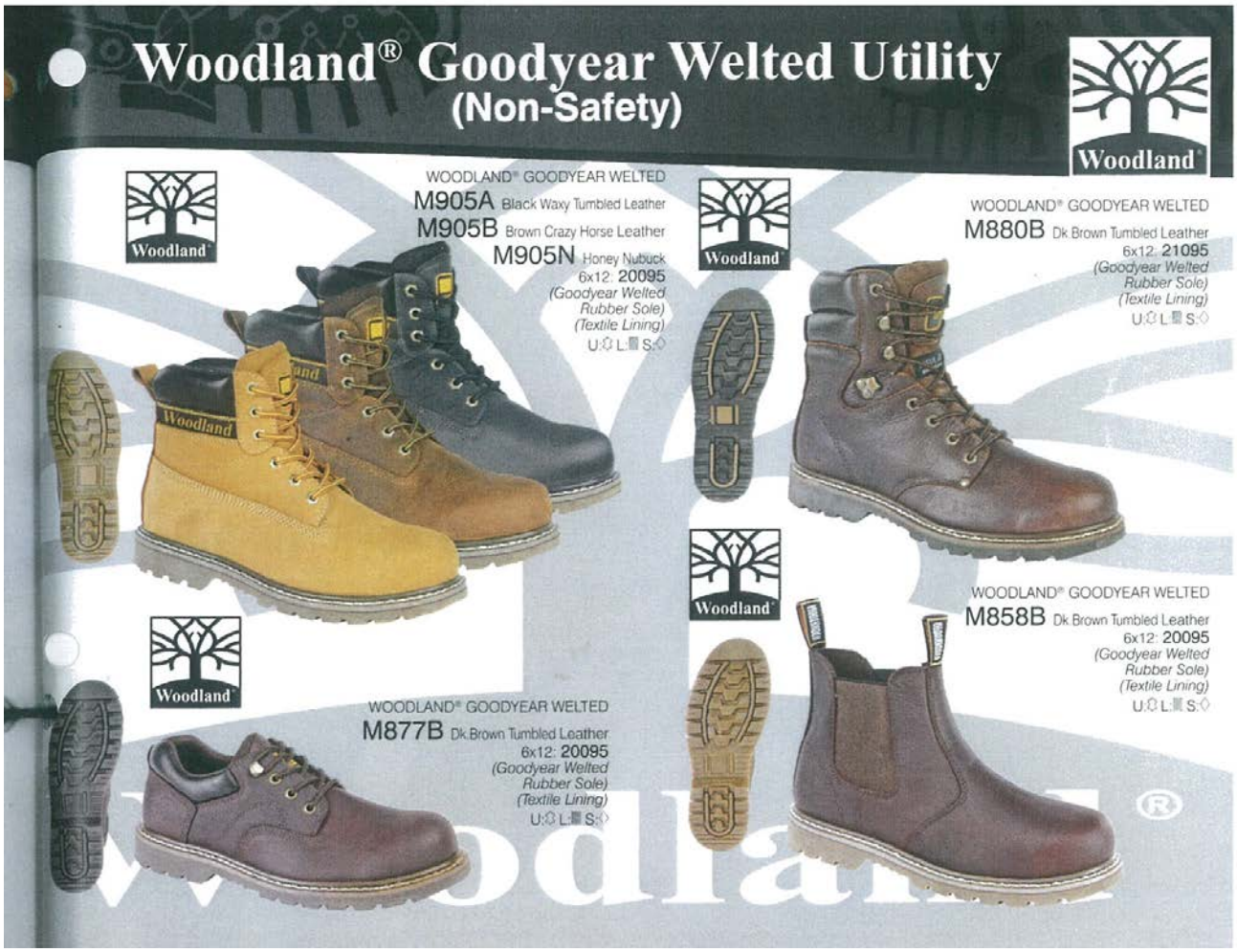
[1] Numbers 3023710 and 3023714 (oppositions 401703 and 401704).

statement simply confirms that the proprietor wishes to rely upon the first witness statement and exhibits.

6. Mr Marlow has been the proprietor's Managing Director since 19 December 2000. He states that in November 2012 orders were placed with a manufacturer to produce a range of Wellington boots bearing the mark. These were advertised in the proprietor's 2013 catalogues, UKD and Grafters. The proprietor received the first delivery of the goods in March 2013 and use of the mark has continued ever since. Mr Marlow states that the mark is used in conjunction with a logo on the goods and on the packaging, as shown in Exhibit JPM1:

7. Approximately 6,000 catalogues (3,000 of each) were distributed throughout the UK in January and February 2013 to existing and potential customers. Copies of the front covers and product pages showing the goods are provided in Exhibit JPM2. The front cover of the 2013 UKD catalogue shows the mark as it appears on the photograph above. It also appears on two product pages, along with "WOODLAND® QUALITY'" next to the pictures of the goods. The goods are Wellington boots, and various product codes such as W258E appear in the item descriptions. The same items and product codes appear in the 2013 Grafters catalogue, and the composite logo appears on the product pages, along with "WOODLAND® Neoprene Gusset'" next to the goods. A screenshot from the proprietor's website dated 26 September 2013 from the internet archive (the 'Wayback Machine') shows Wellington boots, the composite logo and the word WOODLAND next to the goods, along with the codes beginning with W (as in W258E).

8. Mr Marlow states that, after 13 December 2013[2], the proprietor increased its product range to include other styles of boots, bearing the mark. He exhibits (at JPM4) the UKD 2014 catalogue front page and product pages which show boots, shoes, and Wellington boots (reproduced below). The composite logo and word only WOODLAND appear in the same way as in the 2013 catalogues, as described above. Additionally, the word Woodland appears below the cuff on some of the boots shown on the page below.



[2] This was the end of the five year proof of use period in the oppositions.

9. Mr Marlow states that the proprietor supplies footwear to over 3000 retail outlets based all over the UK. Customers place orders either directly with the proprietor by telephone or through the proprietor's website using product codes. The codes he

refers to in his witness statement are all Wellington boot codes. They appear at the top of pages in exhibit JPM5, which comprise a sales summary for sales up to 26 September 2013. The codes also appear on copies of invoices in Exhibit JPM6, to customers in Essex (March 2013), Worcestershire (March 2013), Coleraine, Northern Ireland (June 2013), Perthshire (June 2013), Ceredigion (July 2013) and Devon (September 2013). By 26 September 2013, the proprietor had sold 3618 pairs of WOODLAND Wellington boots.

10. A further sales summary is provided in Exhibit JPM7 from 26 September 2013 to 27 April 2014. At the time of Mr Marlow's statement, the sales from 14 December 2013 to 27 April 2014 were, strictly speaking, irrelevant because they were after the relevant period for proving use of the mark for the oppositions. However, this period is now in issue because it falls within the section 46(1)(b) period pleaded by the applicant. Mr Marlow states that, for this period, 7115 pairs of Woodland Wellingtons had been sold. He does not give figures for the extended range of goods in the 2014 catalogue. A list of customer orders bearing Wellington codes is shown in Exhibit JPM8. Mr Marlow states that, up to 27 April 2014 the wholesale sales value, excluding VAT, was £121,519.27.

Decision

11. Section 46 of the Act states:

> "(1) The registration of a trade mark may be revoked on any of the following grounds—
>
> > (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
> >
> > (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
> >
> > (c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;
> >
> > (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.
>
> (2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made.

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that——

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from——

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date."

12. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch), Arnold J commented on the case law of the Court of Justice of the European Union ("CJEU") in relation to genuine use of a trade mark:

"In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider* v *OHIM* [2006] ECR I-4237):

"(1) Genuine use means actual use of the mark by the proprietor or a third party with authority *Ansul*, [35] and [37].

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]"

13. The onus is on the proprietor to show use when a challenge arises because Section 100 of the Act states:

> “If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

14. The proprietor states that it relies upon section 46(3) of the Act, pursuant to which, if the evidence does not establish use during the first of the periods pleaded, that is to say the Section 46(1)(a) period, the proprietor will still have a defence if it can show commencement or resumption of use in the later, section 46(1)(b), period[3].

15. The Form TM26(N) states that the applicant gave the proprietor notice on 24 February 2014 that it may seek to revoke the mark. The counterstatement said that no notice was given that the application may be made. At the hearing, Mr Benson confirmed that the applicant gave the said notice in a letter dated 24 February 2014, which it sent to the applicant. The proprietor did not attend the hearing. I intend to proceed on the basis that notice was given in the letter referred to by Mr Benson.

16. The fact that notice of the application was given may have been relevant in relation to section 46(3) because of the proviso to that section:

> "3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made.
>
> Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made."

In these proceedings, the provisions of section 46(3) are relied upon in relation to the 46(1)(a) period, but is is clear that the use began before the three month period so the disregard provision does not apply. All of the use filed by the proprietor can be taken into account.

17. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He said:

> "63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL* Trade Mark [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

[3] *Philosophy Inc v Ferretti Studio Srl* [2003] RPC 15, paragraph 7.

> "… I do not think there is anything technical about this: the consumer is not expected to think in a pernickety way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. … Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within this description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider belong to the same group or category as those for which the mark has been used and which are not in substance different from them. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks

which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered."

18. Although the proprietor ticked the box in its notice of defence which says it was defending all of its goods, its counterstatement makes a positive statement that it has been using the mark on boots and shoes. It does not mention slippers and sandals. It has filed no use in relation to slippers and sandals. These are coherent categories or sub-categories of footwear, for which no use has been shown. The registration is therefore revoked for slippers and sandals from the earliest pleaded date, 11 December 1998.

19. There is no doubt that there has been genuine use on Wellington boots. The question is whether the proprietor can retain the wider term 'boots', and also the term 'shoes', which are the two terms remaining in its specification.

20. The evidence suffers from the fact that it was originally filed to prove use of the mark in the oppositions, up until 13 December 2013. The mark had been assigned to the proprietor in 2010 and it commenced use of the mark in March 2013, having placed orders with the manufacturer in November 2012. It appears that during the opposition proof of use period, up until 13 December 2013, the proprietor had only used the mark on Wellingtons. It had extended its range of goods after the relevant date of 13 December 2013, but it was not required to prove this for the oppositions as this was after the relevant date.

21. The revocation action was not filed until 26 August 2014, after the proprietor had filed its evidence as the opponent. The proprietor was given the opportunity to file top up evidence to cover the 'extra' revocation period, i.e. from 14 December 2013 to 25 August 2014. This was done by way of the very brief second witness statement, dated 21 May 2015, from Mr Marlow, the operative part of which reads:

"**Use between 26 August 2009 and 25 August 2014**

1. As these proceedings have been consolidated, I wish to rely on my witness statements filed in Opposition proceedings OP000401703 and OP000401704 against the trade mark applications UK00003023714 & UK00003023710 regarding the Company's use of its trade mark registration no. UK00001520976.

2. The aforementioned witness statements show evidence of use from November 2012 and 27 April 2014. I trust this evidence is sufficient to prove that the Company has been using the Mark during the relevant period for the Cancellation proceedings.

3. The mark has been used on goods for which it is registered within the last 5 years prior to 25 August 2014. Use has been frequent, regular and ongoing."

22. There were no exhibits filed with the second statement.

23. The applicant submits that should I find that genuine use of the mark has been made on Wellingtons (which I do find), genuine use stops there. The applicant submits that this is all the registration should be retained for and that it should be revoked for all goods other than Wellingtons.

24. The revocation application was made after the opponent/proprietor had filed its use for a period relevant to the opposition dates, during which it had only used its mark on Wellingtons. However, the proprietor was afforded the opportunity to top up that evidence once the revocation action was on foot. Having mentioned in its first evidence the expanded range of goods and having mentioned dates which post-dated the relevant opposition proof of use dates, the second witness statement (21 May 2015) was the proprietor's opportunity to expand upon the brief mention of the extended range in the first witness statement (18 June 2014), since the mention in the first statement was not intended to prove use on other goods because this took place after the relevant opposition proof of use date. It could have fleshed this out in order to prove that there had been genuine use of the mark in relation to the extended range of goods. In *Laboratoire De La Mer Trade Marks* [2002] FSR 51, Jacob J observed that "[t]hose concerned with proof of use should read their proposed evidence with a critical eye – to ensure that use is actually proved – and for the goods or services of the mark in question. All the t's should be crossed and all the i's dotted."

25. The summary of the principles from *SANT AMBROEUS Trade Mark*, quoted by Arnold J and set out in paragraph 12 of this decision, refers to real commercial exploitation which can be either to maintain or to create an outlet for the goods. Examples of creating an outlet include preparations to put goods on the market. The CJEU stated, in *Ansul*, that "Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns" (paragraph 37 of the judgment). All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark. In these proceedings, the relevant facts and circumstances include the fact that the current proprietor was assigned the mark in 2010, placed orders with the manufacturer in November 2012, commenced selling Wellingtons bearing the mark in March 2013, had sold over £67,000 worth of Wellingtons six months later, a figure which near-doubled in the next seven months to 27 April 2014, which falls within the section 46(1)(b) period. The picture provided by the evidence is that the success of the Wellington business was followed by plans by the new proprietor to expand the WOODLAND range into other types of boots, and also shoes, as shown in the 2014 brochure, whilst continuing with the Wellingtons. Although there are no sales details for those goods, this was a clear example of preparations to secure customers for the expanded range of Woodland goods, within the relevant period, by including them in the same catalogues in which the Wellingtons appeared, which were already being sent out to 6000 actual and potential customers. Although I have not been provided with sales figures for the expanded range, I come to the view that what the proprietor has done counts as genuine use in relation to boots and shoes.

26. It is difficult to describe the styles of boots and shoes shown (apart from Wellingtons) without being pernickety and artificial. A fair specification is *boots and shoes*.

27. The use of the mark shown is both in word only form and in the form of the word Woodland over the base of the tree device shown on the photographs in this decision. The word only use qualifies as genuine use, and the composite logo use also qualifies as genuine use of the mark. In Case C-252/12, *Specsavers International Healthcare Ltd, Specsavers BV, Specsavers Optical Group Ltd, Specsavers Optical Superstores Ltd v Asda Stores Ltd*, the CJEU stated[4]:

> "22. For a trade mark to possess distinctive character for the purposes of Regulation No 207/2009, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (see, to that effect, Joined Cases C-468/01 P to C-472/01 P Procter & Gamble v OHIM [2004] ECR I-5141, paragraph 32; Case C-304/06 P Eurohypo v OHIM [2008] ECR I-3297, paragraph 66; and Case C-311/11 P Smart Technologies v OHIM [2012] ECR I-0000, paragraph 23).
>
> 23. That distinctive character of a registered trade mark may be the result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases, it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service at issue as originating from a given undertaking (see, by analogy, Case C-353/03 Nestlé [2005] ECR I-6135, paragraph 30)."

28. The registered mark itself is unaltered and would clearly signify to the relevant class of persons that it originates from the same undertaking as the registered mark. The word only use and the composite logo use qualify as genuine use of the trade mark.

Outcome

29. The mark may remain registered for boots and shoes. The registration is revoked for slippers and sandals from 11 December 1998.

Costs

30. In the revocation action, both sides have achieved an equal measure of success. Both have also made comments regarding costs. I set out their submissions below, together with my comments. The proprietor requests that any cost award reflects the Applicant's "persistent attempts to abuse the procedure, inconvenience the Opponent and cause the Opponent to incur unnecessary costs". It submits, in a letter dated 15 September 2015:

[4] See also the CJEU's ruling in *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12.

> "1. Following the Opponent filing its Witness Statements[5], providing proof of use, on 20 June 2014, the Applicant proceeded to file an application for Cancellation of the Opponent's mark, despite being in receipt of substantial evidence which shows that the mark in question has been used by the Opponent on identical and/or similar goods. The Applicant knew that by making such an application (even if it had no merit) the Opposition Proceedings would be delayed and such an application would cause inconvenience to the Opponent."

31. The applicant filed its revocation application two months after it had seen the proprietor's evidence in the opposition proceedings. It clearly thought it had grounds to do so, and it has been shown that the mark has not been used upon slippers and sandals, despite statements of use being made in the opposition notices that the mark had been used on all the registered goods. In *Gerry Weber International AG v Guccio Gucci SPA* O/424/14, Mr Daniel Alexander QC, observed (in paragraph 4):

> "There is, of course, no question of the applicant's entitlement to make such an application: anyone can do so whenever they wish after the relevant period of registration has elapsed, including without warning, and an applicant can then stand back and say, subject to a costs risk: "now you prove your use – or lose your mark."

The filing of the revocation action does not, of itself, reveal abuse of procedure or a tactic to put the proprietor to unnecessary costs.

32. The proprietor submits:

> "2. At the Interim Hearing on 8 December 2014, the Hearing Officer suspended the proceedings until 8 March 2015 to allow the parties to mediate. Despite us contacting the Applicant's representatives, the Applicant failed to propose any dates for mediation until 3 March 2015. The dates suggested were 13 and 28 March which fell outside of the suspension deadline. Following the unnecessary delay, the Opponent decided not to mediate and wished to proceed with the Consolidated Proceedings."

At the hearing, Mr Benson pointed out that the applicant is in India and this affected timings for mediation. It might affect the dates of actual meetings, but it does not explain why it took the applicant almost three months to propose mediation dates, which were, in any event, after the period I had allowed for mediation to be attempted. This does look like unnecessary delay.

33. The proprietor submits:

> "3. On 15 July 2015 the Applicant informed the Registry that it had not received the Opponent's witness evidence and requested an extension to the deadline for the Applicant to file evidence in reply. This request was made

[5] There were witness statements filed for each opposition at this time, hence the reference to witness statements in the plural.

> less than 2 weeks before the Applicant's deadline to file its evidence and nearly 7 weeks after the Registry's letter dated 29 May 2015, confirming that the Opponent's evidence had been filed. The Registry rejected its request following our letter dated 16 July 2015 which enclosed a copy of the fax receipt showing that the Opponent's evidence had been served in the Applicant on 26 May 2015. Then, despite the request for an extension, the Applicant did not file any evidence. Consequently, we believe that the Applicant had no intention of filing any evidence, but chose to request an extension in an attempt to further delay the proceedings."

34. From what Mr Benson told me at the hearing, there had been an internal mix-up in his firm, and that three files were open (the opposition files and the revocation file). It appears that the evidence had been received, but it was put on the wrong file. This does not seem to have been a deliberate attempt to delay matters.

35. Both sides have, at times, failed to copy correspondence to each other.

36. The applicant submits that it is the proprietor which has tried to use the proceedings to prevent it from registering its trade mark applications (now withdrawn). The applicant refers to the proprietor's request for security for costs. This request was the reason for the interim hearing, referred to by the proprietor at point 2 of its submissions (paragraph 32, above). I held the hearing and directed the parties to attempt mediation, suspending my decision on security for costs until that had been attempted. Since mediation did not take place, I issued my decision on the security for costs issue in a letter dated 26 March 2015, in which I refused the proprietor's application for security for costs:

> "The opponent has failed to satisfy me as to the expense of enforcing a cost order in India, which was the basis for the request. As I said at the CMC, India (in common with other Commonwealth countries) has reciprocal enforcement arrangements with the UK through the Foreign Judgments (Reciprocal Enforcement) Act 1933."

37. Mr Benson submitted that my refusal of the security for costs application for these reasons showed its futility. At the interim hearing/CMC, Mr Benson did not make any submissions along the lines of my reasons for refusal of the request. I do not think it was a spurious request, just misinformed. As I was able to find out about the reciprocal enforcement arrangements with the UK through the Foreign Judgments (Reciprocal Enforcement) Act 1933, the parties' representatives could also have done the same.

38. So far, this is a score draw. However, there is also the matter of the oppositions, in relation to which the applicant withdrew its trade mark applications at the eleventh hour. The withdrawal of the oppositions reflects success for the proprietor/opponent, for which an award of costs will be made. Since the evidence filed in the oppositions was filed in the revocation action, I will make no separate award for it. However, I will make an award for the opposition pleadings stages, the statutory opposition fees, and the part of the written submissions which relates to

section 5(2)(b)[6]. The costs award is based upon the published scale of costs in Tribunal Practice Notice 4/2007.

39. The costs breakdown is:

Statutory fee of £100 per opposition x 2	£200
Filing notices of opposition and considering the counterstatements x 2	£300
Written submissions	£100
Total	**£600**

40. I order M/s. Aero Club to pay UK Distributors (Footwear) Ltd the sum of £600 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 17th day of November 2015

Judi Pike
For the Registrar,
the Comptroller-General

[6] But not the proof of use part which is covered by the costs assessment for the revocation action.