

O-340-04

1 THE PATENT OFFICE

2 Tribunal Room 1,  
3 Harmsworth House,  
4 13-15 Bouverie Street,  
5 London EC4Y 8DP.

6 Wednesday, 20th October 2004

7 Before:

8 MR. GEOFFREY HOBBS QC  
9 (Siting as the Appointed Person)

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11 In the Matter of the Trade Marks Act 1994  
12 -and-  
13 In the Matter of Trade Mark Registration No: 2044093  
14 in the name of MS. ALISON JUNE COGGINS  
15 -and-

16 In the Matter of Revocation Application No: 81434 by  
17 SKJELLAND GROUP AS

18 - - - - -

19 Appeal of the Registered Proprietor from the decision of  
20 Mr. Keven Bader dated 9th June 2004 on behalf of the  
21 Registrar.

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23 (Transcript of the Shorthand Notes of Marten Walsh Cherer Ltd.,  
24 Midway House, 27/29 Cursitor Street, London EC4A 1LT.  
25 Telephone No: 020 7405 5010. Fax No: 020 7405 5026.)

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27 MRS BARBARA COOKSON (of Messrs Nabarro Nathanson, London)  
28 appeared as Solicitor on behalf of the Registered Proprietor.

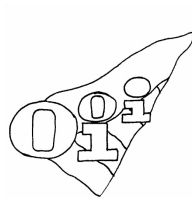
29 MR. MARK ENGELMAN (instructed by Messrs A.A. Thornton & Co,  
30 London) appeared as Counsel on behalf of the Applicant for  
31 Revocation.

32 MR. MICHAEL KNIGHT appeared on behalf of the Registrar for Trade  
33 Marks.

34 - - - - -  
35 APPROVED DECISION  
36 - - - - -



1 THE APPOINTED PERSON: Alison Coggins applied on 9th November  
2 1995 to register the following sign as a trade mark for use  
3 in relation to "casual Clothing; sports clothing" in class  
4 25.



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The application was filed on Form TM3 in accordance with the provisions of Section 66 of the 1994 Act and Rule 5 of the Trade Marks Rules 1994.

Box 8 of the form of application for registration required the applicant to identify an address for service in the United Kingdom in accordance with the provisions of Rule 10(1)(a).

The application proceeded to registration under number 2044093 on 16th May 1997. Under Rule 10(2), the address for service identified in the application became the applicant's address for service in her capacity as proprietor of the resulting registration.

On the basis of the information presently available to me, it appears that the nominated address was 43 Moreton Street, London SW1.

On 26th September 2003 Skjelland Group AS applied for revocation of registered trade mark number 2044093 under Section 46(1)(b) of the Trade Marks Act 1994. The application for revocation was filed on Form TM26(N) under

1 Rule 31(1) of the Trade Marks Rules 2000.

2 I understand that the statement of case in support of  
3 the application was revised several times at the request of  
4 the Registrar in order to clarify the basis on which  
5 revocation was being requested.

6 In its finally revised form, the statement of case  
7 contained averments in paragraphs 3 and 4 to the following  
8 effect:

9 "3. Use by the proprietor or with its consent in the  
10 United Kingdom of the trade mark the subject of  
11 the registration in suit in respect of the goods  
12 for which it is registered has been suspended  
13 for an uninterrupted period of five years ending  
14 on 4 June 2002 and there are no proper reasons  
15 for non-use.

16 4. Use by the proprietor or with its consent in the  
17 United Kingdom of the trade mark the subject of  
18 the registration in suit in respect of the goods  
19 for which it is registered has been suspended  
20 for an uninterrupted period of five years and  
21 there are no proper reasons for non-use."

22 In accordance with the provisions of Rule 31(1), the  
23 Registrar sent copies of the application for revocation and  
24 the revised statement to the registered proprietor of the  
25 trade mark in suit. The copies were sent to her by post at

1 her address for service. Initially, they were sent to her by  
2 recorded delivery post on 16th January 2004. However, the  
3 letter was returned by the Post Office as "undeliverable". A  
4 further letter containing copies of the relevant documents  
5 was sent to the same address by ordinary post on 23rd January  
6 2004.

7 Rule 10(4) of the Trade Marks Rules 2000 provides as  
8 follows:

9 "Anything sent to any applicant, opponent, intervener  
10 or registered proprietor at his address for service  
11 shall be deemed to be properly sent; and the registrar  
12 may, where no address for service is filed, treat as  
13 the address for service of the person concerned his  
14 trade or business address in the United Kingdom, if  
15 any."

16 Section 7 of the Interpretation Act 1978 further provides  
17 that:

18 "Where an Act authorises or requires any document to be  
19 served by post (whether the expression 'serve' or the  
20 expression 'give' or 'send' or any other expression is  
21 used) then, unless the contrary intention appears, the  
22 service is deemed to be effected by properly  
23 addressing, pre-paying and posting a letter containing  
24 the document and, unless the contrary is proved, to  
25 have been effected at the time at which the letter

1           would be delivered in the ordinary course of the  
2           post."

3           By virtue of the combined effect of these provisions,  
4           service of the documents which the Registrar was required to  
5           send to the registered proprietor under Rule 31(1) is deemed  
6           to have been effected when they were sent, i.e. despatched,  
7           to her address for service by pre-paid post under cover of  
8           the unreturned letter of 23rd January 2004.

9           That being so, the registered proprietor had three  
10          months (expiring on 23rd April 2004) within which to file a  
11          counter-statement in conjunction with notice of the same on  
12          Form TM8 and either (a) two copies of evidence of use made of  
13          the trade mark in suit or (b) reasons for non-use of the  
14          mark.

15          These requirements were imposed upon her by the  
16          provisions of Rule 31(2) of the Trade Marks Rules 2000. Rule  
17          68(3) prevented extension of the three-month time limit in  
18          all circumstances other than those specified in Rule 68(7).  
19          The latter rule allows for the possibility of an extension of  
20          time to be granted on application to the Registrar if failure  
21          to comply with an otherwise unextendable time limit is  
22          attributable wholly or in part to an error, default or  
23          omission on the part of the Office or the Registrar and it  
24          appears to the Registrar that late compliance should be  
25          permitted.

1           At this point in the narrative it is necessary to  
2 consider the position of the registered proprietor relative  
3 to the application for revocation filed by Skjelland.

4           She maintains that she was unaware of the application  
5 for revocation and the deadline for complying with the  
6 requirements of Rule 31(2) because she did not receive the  
7 letter sent to her address for service on 23rd January 2004.

8           The reasons for non-receipt are essentially:

9           (1) at some unspecified time, prior to 23rd January 2004, she  
10 ceased to have any contact or connection with the premises at  
11 43 Moreton Street which she had identified as her address for  
12 service; (2) that there were no effective arrangements in  
13 place for collection or redirection of letters sent to her at  
14 that address in 2004; and (3) that she failed to notify the  
15 Registrar of an up-to-date address for service of documents  
16 pertaining to trade mark registration 2044093 until  
17 15th April 2004.

18           Notwithstanding the fact that she notified the  
19 Registrar of an up-to-date address for service on 15th April  
20 2004 the application for revocation proceeded to the point at  
21 which there was a default in compliance by her with the  
22 requirements of Rule 31(2).

23           The consequences of such default are specified in Rule  
24 31(3) of the Trade Marks Rules 2000 in the following terms:


25           "Where a counter-statement, in conjunction with a

1 notice of the same, on Form TM8, and evidence of use  
2 of the mark or reasons for non-use of the mark, are  
3 not filed by the proprietor within the period  
4 prescribed by paragraph (2), the registrar may treat  
5 his opposition to the application as having been  
6 withdrawn."

7 It is clear from the language of these provisions that  
8 the Registrar may, but need not, decide to treat an  
9 application for revocation as unopposed if the registered  
10 proprietor fails to comply with the requirements of Rule  
11 31(2) within the period prescribed for compliance c.f.  
12 FIRETRACE TRADE MARK [2002] RPC 15, p337 at paragraph 20.

13 In the present case, the Registrar evidently decided to  
14 treat the application for revocation as unopposed and give  
15 judgment for Skjelland on that basis.

16 On 9th June 2004, Mr. Keven Bader issued a formal  
17 decision on behalf of the Registrar in the following terms.

18 "The trade mark  has been registered since  
19 16 May 1997 under number 2044093, in respect of:  
20 casual clothing, sports clothing and stands in the  
21 name of Alison June Coggins.

22 By an application filed on 26 September 2003,  
23 Skjelland Group AS applied for revocation of this  
24 registration under the provisions of section 46(1)(b)  
25 of the Trade Marks Act 1994.



1           A copy of this application was sent by recorded  
2           delivery to the registered proprietor at her address  
3           for service on 16 January 2004. This was returned by  
4           the Post Office as undeliverable. A further copy was  
5           sent by normal post on 23 January 2004.  
6           The registered proprietor did not file a  
7           counterstatement within the three months specified by  
8           Rule 31(2) of the Trade Marks Rules 2000 and therefore  
9           no reasons have been advanced why revocation should  
10          not follow.  
11          Accordingly, the mark is revoked with effect from  
12          26 September 2003 and I direct that it be removed from  
13          the register."  
14          Neither party was satisfied with this decision. They  
15          both appealed to an Appointed Person under  
16          Section 76 of the 1994 Act. The registered proprietor  
17          contended that the decision should be set aside on the ground  
18          of serious procedural irregularity. The applicant for  
19          revocation contended that the decision should be altered so  
20          as to provide for revocation of the registration in suit with  
21          effect from 4th June 2002 on the basis that paragraph 3 of  
22          its revised statement of case left the Registrar with no  
23          alternative, in the absence of any pleading or evidence to  
24          the contrary, but to conclude for the purposes of  
25          Section 46(6)(b) of the Act that the grounds for revocation

1 under Section 46(1)(b) existed at that date.

2 The appeal on behalf of the registered proprietor was  
3 put upon the footing that she had not been duly served with  
4 copies of the relevant Form TM26(N) and statement of case  
5 under Rule 31(1). It was submitted that the Registrar was  
6 under a duty in the circumstances of the present case to  
7 verify the currency of the address for service at  
8 43 Moreton Street.

9 In my view these submissions are misconceived. The  
10 policy considerations underlying provisions such as those  
11 found in Rule 10(4) and Section 7 of the Interpretation Act  
12 1978 negate the existence of any such duty and entitle the  
13 Registrar to accept the address for service at face value,  
14 see the judgments of the Court of Appeal in the case of  
15 C A Webber (Transport) Ltd v. Railtrack Plc [2003]  
16 EWCA Civ 1167 15th July 2003.

17 The reasons for the failure on the part of the  
18 registered proprietor to comply with the requirements of Rule  
19 31(2) within the period of three months prescribed for that  
20 purpose do not singly or in combination permit me to hold  
21 that there was a failure on the part of the Registrar to  
22 comply with the requirements of Rule 31(1). And there is no  
23 request for relief against the consequences of Rule 31(3)  
24 under Rule 68(7).

25 However, that does not mean that I am satisfied that

1 the decision issued on 9th June 2004 is free of procedural  
2 irregularity. It appears to me that a decision on the part  
3 of the Registrar under Rule 31(3) as to how matters should  
4 thereafter proceed in a case covered by that rule is a  
5 decision to which the provisions of Rule 54 apply.

6 Rule 54 provides as follows:

7 "(1) Without prejudice to any provisions of the Act  
8 or these Rules requiring the registrar to hear  
9 any party to proceedings under the Act or these  
10 Rules, or to give such party an opportunity to  
11 be heard, the registrar shall, before taking any  
12 decision on any matter under the Act or these  
13 Rules which is or may be adverse to any party to  
14 any proceedings before her, give that party an  
15 opportunity to be heard.

16 (2) The registrar shall give that party at least  
17 fourteen days' notice of the time when he may be  
18 heard unless that party consents to shorter  
19 notice."

20 The requirements of this rule were clearly not  
21 satisfied in the present case and I think it is readily  
22 apparent that the failure to apply the rule had adverse  
23 consequences for the registered proprietor sufficient to  
24 warrant the conclusion that the decision issued on 9th June  
25 2004 involved a serious procedural irregularity.

1           The decision will therefore be set aside and I will  
2           direct the Registrar to indicate to the parties within 21  
3           days of today's date how he would propose to proceed under  
4           Rule 31(3), the indication to be given in accordance with the  
5           requirements of Rule 54. In the circumstances it is  
6           unnecessary to deal with the appeal brought on behalf of  
7           Skjelland and I will not do so beyond saying that I see  
8           considerable force in the submissions advanced on its behalf  
9           as noted above. That is my determination in relation to  
10          these two appeals.

11                   Who would like to say what in relation to costs?

12          MR. ENGELMAN: Sir, if I may. In relation to costs, your  
13                   indication with regard to our appeal, whilst deferred, is  
14                   indicative of the fact that there is some merit in it.

15                   With regard to the cross-appeal which we have had to  
16                   defend, as we submitted earlier, we have had no amended  
17                   pleadings nor evidence to support any of the facts in dispute  
18                   and therefore I had great difficulty actually dealing with  
19                   the facts of this case as put to us. Much is within the  
20                   knowledge of my learned friend and Miss Coggins.

21                   In that regard, sir, we would say that this application  
22                   has not been procedurally, with regard to its progress to  
23                   yourself, sir, dealt with in a reasonable manner such that we  
24                   have only had today to address you on specific legal  
25                   arguments that were not in fact in the original grounds of

1           appeal.

2           THE APPOINTED PERSON: The facts have not changed. The legal  
3           argument did change in relation to Rule 54. The argument  
4           that was raised in relation to ineffective service and  
5           vigilance of the Registrar in relation to the accuracy of the  
6           address for service has failed.

7           MR. ENGELMAN: In relation to those issues and, of course, being  
8           an award on an issue-based basis under the CPR, we would say  
9           that roughly two-thirds of our costs in meeting that appeal  
10          should be awarded in our favour.

11          THE APPOINTED PERSON: What sort of figure might you put on that?

12          MR. ENGELMAN: Sir, we were in the process of actually providing  
13          to you a bill of costs because we feel it is appropriate in  
14          these circumstances in line with some authority in the High  
15          Court, sir, that bill of costs are appropriate in proceedings  
16          of this nature to ensure that no punitive award of damage  
17          over and above those actually incurred----

18          THE APPOINTED PERSON: Give me a general idea?

19          MR. ENGELMAN: A general idea in total, I would say about  
20          3000.

21          THE APPOINTED PERSON: All right. I hear you. Is there more you  
22          would like to say on the question of costs at this point?

23          MR. ENGELMAN: No, sir.

24          THE APPOINTED PERSON: Mrs Cookson, what about the question of  
25          costs?

1 MRS COOKSON: I accept what you say that we have not won on the  
2 specific points pleaded. Although, as I say in my skeleton  
3 argument, we think it would not be appropriate for any costs  
4 order to be made against our client. In fact, it might be  
5 appropriate for the Registrar to be ordered to pay some small  
6 contribution towards her costs because it is her omission of  
7 notice that you have decided caused all this trouble. On  
8 balance on think it may well be one of those cases where each  
9 party bears his own costs would be the fairest outcome.

10 THE APPOINTED PERSON: Mr. Knight, would you like to pay some  
11 costs?

12 MR. KNIGHT: No, because the registered proprietor did not keep  
13 the address for service up-to-date. I think the proceedings  
14 today stem from that error. I see no reason why the  
15 Registrar should meet either side's costs in this particular  
16 appeal.

17 THE APPOINTED PERSON: It seems to me to be right that I should  
18 deal with the costs of this appeal as a self-contained  
19 matter. There was a conspicuous failure on the part of the  
20 registered proprietor to keep her address for service  
21 up-to-date. I also see no reason at all why the applicant  
22 for revocation should be out of pocket in relation to the  
23 arguments that have been raised unsuccessfully as grounds of  
24 appeal in the statement of case, as originally presented  
25 under section 76.

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I think in those circumstances, given that the registered proprietor has received quite a considerable indulgence from this tribunal, that it is right there should be a contribution by the registered proprietor to the costs of the applicant for revocation.

I direct the registered proprietor to pay the applicant for revocation the sum of 850 as a contribution towards costs within 21 days of the date of this decision.

I think that concludes everything. Thank you for your submissions.

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