

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**APPLICATION No. 82302**

**IN THE NAME OF BSA COMPANY LTD**

**FOR REVOCATION OF**

**TRADE MARK REGISTRATION No. 2152708**

**IN THE NAME OF BRANDS HOLDINGS LTD**

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**D E C I S I O N**

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Trade Mark No. 2152708

1. The designation **BSA by R2** was registered under number 2152708 in the name of R2 Company Ltd on 28 July 2000 (with effect from 4 December 1997) as a trade mark for use in relation to '*Articles of clothing, excluding ties, caps and hats*' in Class 25.
2. A Form TM16 requesting transfer of the registration into the name of UCCL International Ltd was filed in July 2001. That company subsequently changed its name to Pan World Brands Ltd. In October 2005 the trade mark registration was assigned to Brands Holdings Ltd (*'the Proprietor'*).

Revocation Application No. 82302

3. On 27 October 2005 BSA Company Ltd (*'the Applicant'*) filed an application under Section 46 of the Trade Marks Act 1994 and Rule 31 of the Trade Marks Rules 2000 (as amended) for revocation of the registration of trade mark 2152708 on the ground of non-use. In the relevant Form TM26(N) the Applicant asked for revocation with effect from **'28 July 2000'**. In response to the question **'Are you basing your application on Section 46(1)(a), 46(1)(b) or both?'** the Applicant answered **'Both'**. In response to the question **'If you are basing your application on Section 46(1)(b), within which 5 year period do you say the mark was not used?'** the Applicant answered **'24 October 2000 to date'**. The Form TM26(N) was dated **'26 October 2005'**.

4. In the Statement of Grounds accompanying the Form TM26(N) the Applicant pleaded as follows (with emphasis added):

1. The Applicant submits that within the five years preceding the date of this application, and the period of five years after the date of completion of the registration procedure for the Registration, there has been no genuine use of the mark in the form in which it is registered in the United Kingdom, by the Proprietor or with his consent, and there are no proper reasons for non-use.

2. The Applicant's investigations have revealed that the previous registered proprietor might have used the mark BSA in relation to the goods for which the Mark is registered, but, as the elements "by R2" possess distinctive character, and as the addition of these elements significantly alters the identity of the mark, use of the mark BSA is not "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". Thus, such use does not fall within the scope of Section 46(2) of the Trade Marks Act 1994. No use of the mark BSA by R2 was discovered.

3. The Applicant therefore requests that the registration is revoked under Sections 46(1)(a) and (b) of the Trade Marks Act 1994, and that the revocation takes effect from the date of completion of the registration procedure, i.e. 28 July 2000. Alternatively if this is not possible, the Applicant requests that the revocation takes effect from the date five years after the completion of the registration procedure, i.e. 28 July 2005.

4. The Applicant hereby requests an award of costs in its favour.

5. At this juncture it is necessary to observe that the Registrar had no power under Section 46 of the Act to revoke the registration of the trade mark in suit with effect from any date earlier than 29 July 2005. I return to this point below.

#### Ex officio requirement for amendment

6. On a date in October 2005 which has not been identified, the Applicant's agents of record were telephoned by a Registry official and informed that the Form TM26(N) required amendment in order to specify dates and periods which the Registrar could properly take into consideration under Sections 46(1)(a) and 46(1)(b). With the consent of the Applicant's agents, the Form TM26(N) was then amended in manuscript within the Registry so as to change two of the answers I have quoted in paragraph 3 above to read as follows:

24 October 2000 to ~~date~~ **24 October 2005**  
(in relation to the 5-year period under Section 46(1)(b) of the Act)

~~28 July 2000~~ **2005 46(1)(a)**  
**24 October 2005 46(1)(b)**

(in relation to the date with effect from which revocation was requested).

The manuscript amendments were not dated or initialled. No written confirmation of the requirement for amendment or the Applicant's consent to amendment was sought or provided. After amendment the Form TM26(N) and Statement of Grounds continued to request revocation with effect from a date earlier than 29 July 2005.

### The Rule 31 procedure

7. Rule 31 provides as follows:

31. - (1) An application to the registrar for revocation of a trade mark under section 46, on the grounds set out in section 46(1)(a) or (b), shall be made on Form TM26(N) and be accompanied by a statement of the grounds on which the application is made.

(2) The registrar shall send a copy of Form TM26(N) and the statement of the grounds on which the application is made to the proprietor.

(3) The proprietor shall, within three months of the date on which he was sent a copy of Form TM26(N) and the statement by the registrar, file a Form TM8, which shall include a counter-statement, and be accompanied by –

- (a) two copies of evidence of use of the mark; or
- (b) reasons for non-use of the mark,

otherwise the registrar may treat him as not opposing the application.

(4) The evidence of use of the mark shall –

- (a) cover the period of non-use alleged by the applicant on Form TM26(N), or
- (b) where the proprietor intends to rely on section 46(3), show that use of the mark commenced or resumed after the end of that period but before the application for revocation was made.

(5) The reasons for non-use of the mark shall cover the period of non-use alleged by the applicant on Form TM26(N).

(6) The registrar shall send a copy of Form TM8 and any evidence of use, or reasons for non-use, filed by the proprietor to the applicant and the date upon which this is sent shall, for the purposes of rule 31A, be the “initiation date”.

8. The amended Form TM26(N) and the unamended Statement of Grounds were sent to the Proprietor under Rule 31(2) on 4 November 2005. Under Rule 31(3) the Proprietor was required to file a Form TM8 and Counterstatement accompanied by evidence of use (or reasons for non-use) within a period of 3 months expiring on 4 February 2006.

9. Within the relevant 3 month period the Proprietor filed a Form TM8 and Counterstatement accompanied by a Witness Statement of Paul Kelly with one Exhibit dated 1 February 2006. In the Counterstatement the Proprietor pleaded as follows:

1. It is denied by the registered proprietor that within the five years preceding the date of the Application for Revocation and the period of five years after the date of completion of the registration procedure for the registration, there has been no genuine use of the mark registered under number 2152708 in the United Kingdom by the proprietor or with his consent and there are no proper reasons for non-use as alleged by the applicant in paragraph 1 of their Statement of Grounds.

2. It is also denied by the registered proprietor that use of the Trade Mark BSA in relation to the goods for which the mark is registered is use in a form differing in elements which alter the distinctive character of the mark in the form in which it is registered and, therefore, it is denied that such use does not fall within the scope of Section 46(2) of the Trade Marks Act 1994. There is attached hereto a Witness Statement made by Paul John Kelly of Barlin Associates on behalf of the registered proprietor together with Exhibit “PJK/1” by way of evidence of use of the Trade Mark.

3. The registered proprietor hereby requests that the application for revocation under Section 46(1)(a) and (b) of

the Trade Marks Act 1994 be denied and also requests an award of costs in its favour.

10. The Witness Statement of Paul Kelly stated as follows (with emphasis added):

1. I am a Trade Mark Attorney in the employ of Barlin Associates Trade Mark Agents of Crown House, 208 Gloucester Road, Redhill, Surrey RH1 1FH and I make this Witness Statement in these proceedings on behalf of Brands Holdings Limited the registered proprietors herein. I confirm that I have been authorised by Brands Holdings Limited to make this Witness Statement on its behalf and the facts to which I depose have been provided to me by the aforesaid company's predecessors which I will hereinafter refer to as "the company".

2. The dominant essential and distinctive part of the mark as registered under number 2152708 constitutes the letters BSA. The company's predecessors have used the trade mark BSA in the United Kingdom in relation to a range of articles of clothing during the relevant periods. In particular I have received and file herewith as Exhibit "PJK/1" a selection of material showing use of the mark BSA in relation to a range of clothing falling within the specification of goods of the said registration. All this material relates to sales of product during the period as claimed in the Application for Revocation. Contrary to what is stated in the statement of grounds of the Application for Revocation, the element "by R2" does not add distinctive character to the mark and it is submitted that the use made of the mark comprising the letters BSA constitutes use of the mark as registered and does not constitute a form differing in elements which alter the distinctive character of the mark as registered. It is claimed that the designation 'by R2' is totally non-distinctive matter such as not to alter the identity of the mark BSA. Its presence is no more than an identification of the name of the original Registered Proprietor. In particular, the addition of the designation 'by R2' does not add any distinctiveness to the registered Trade Mark. Accordingly, the use relied upon does fall within the scope of Section 46(2) of the Trade Marks Act 1994.

11. No objection was raised in respect of the Applicant's claim for revocation from a date earlier than 29 July 2005. The dates and periods specified in the amended Form TM26(N) appear to have caused the Proprietor no difficulty of any kind in relation to the preparation of its defence under Rule 31(3).

12. The Form TM8, Counterstatement, Witness Statement and Exhibit should have been sent to the Applicant under Rule 31(6) so as to establish the 'initiation date' for the purposes of the procedure laid down in Rules 31A and 31B for determination of the revocation application on its merits. That did not happen. Instead, the Registry raised an ex officio objection to the adequacy of the Proprietor's defence to the proceedings.

Ex officio objection under Section 100 and Rule 31(3)

13. Section 100 of the 1994 Act establishes that:

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.

In reliance on that Section of the Act, the Registry wrote to the Proprietor's agents of record on 6 February 2006 in the following terms:

The Registrar has considered the evidence filed and it is his preliminary view that it does not overcome the burden placed on the registered proprietor under the provisions of Section 100 of the Trade Marks Act 1994.

The evidence you have provided does not show evidence of use for the trade mark as registered on the goods for which it is registered, nor have you provided any dates of actual use within the periods of contention. The assertion within the

Witness Statement, that the mark has been used within the periods stated is insufficient.

The Trade Marks Registry is minded to deem your clients opposition to the application for revocation as having been withdrawn on the basis that no defence has been filed. This is in accordance with Rule 31(3). If either party disagrees with the above view, written arguments together with a request to be heard should be submitted on or before **20 February 2006**.

If no hearing is requested within this term or written submissions filed, the Registrar will proceed to issue a short decision on the issue of failure to comply with the Rules governing the filing of a defence.

14. This, in substance, amounted to notification of: (1) an objection by the Registrar to the adequacy of the defence filed by the Proprietor under Rule 31(3); (2) a preliminary indication that the official objection was considered to be well-founded; and (3) an intention to strike out the Proprietor's defence and treat the application for revocation as undefended if the Proprietor failed to persuade the Registrar that the official objection should be withdrawn. Rule 31(3) was identified as the source of the Registrar's power to act in that manner.

15. The Proprietor requested a hearing at which to argue against the official objection. This took place on 17 August 2006 before Mrs Ann Corbett acting on behalf of the Registrar. The Applicant was not represented at the hearing. It filed written submissions in support of the objection and attended by way of an observer.

Request for amendment of trade mark



16. In the meantime, on 28 March 2006, the Proprietor filed a Form TM25 requesting alteration of the trade mark under Section 44 of the Act. That Section provides as follows:

**44.—(1)** A registered trade mark shall not be altered in the register, during the period of registration or on renewal.

(2) Nevertheless, the registrar may, at the request of the proprietor, allow the alteration of a registered trade mark where the mark includes the proprietor's name or address and the alteration is limited to alteration of that name or address and does not substantially affect the identity of the mark.

(3) Provision shall be made by rules for the publication of any such alteration and the making of objections by any person claiming to be affected by it.

The amendment requested was deletion of the elements '**by R2**' so as to reduce the mark as registered to **BSA**. This echoed the position which the Proprietor had adopted in the pending revocation proceedings, where use of **BSA** was said to have constituted use of **BSA by R2** in a form differing in elements which did not alter the distinctive character of the mark in the form in which it was registered (Section 46(2) of the Act).

17. The Registry wrote to the Proprietor on 3 April 2006 declining to proceed with the request for amendment on the ground that the proposed amendment did not satisfy the requirements of Section 44(2). The Proprietor responded in a letter of 13 April 2006 setting out the basis on which it maintained that the request for amendment should be accepted. The last sentence of the letter said: '*In the event that the refusal to alter the Trade Mark is maintained, we request the appointment of a Hearing*'. The Registry replied on 19 April 2006 in a letter refusing to proceed with the request for amendment and stating '*therefore the next course of action is for you to request a hearing*'. The

request for a hearing in the Proprietor's letter of 13 April 2006 was overlooked. So far as I am aware, nothing was subsequently done by the Registry or the Proprietor to appoint a hearing. Mr Kelly confirmed in a second Witness Statement dated 14 November 2006 that the Proprietor's agents of record had not received the Registry letter of 19 April 2006.

#### The hearing on 17 August 2006

18. At the hearing on 17 August 2006, the Proprietor argued against the Registrar's objection under Rule 31(3) on several different grounds. It was contended that:

- (1) the Form TM26(N) and Statement of Case were '*fatally defective and ought to be dismissed as such*' in the absence of further amendments sufficient to identify dates and periods which the Registrar could properly take into consideration under Sections 46(1)(a) and 46(1)(b);
- (2) the application for revocation should be stayed pending the outcome of the Proprietor's application for amendment of the trade mark in suit under Section 44 so that '*the correct form of the mark ... may be determined and a proper, valid analysis of genuine use performed*';
- (3) the evidence filed under Rule 31(3) was '*sufficient to overcome the preliminary evidential hurdle that accompanies the filing of the TM8 and Counterstatement*' on the basis that use of **BSA** constituted use of '*an acceptable variant*' of **BSA by R2**.

In support of contention (3) the Proprietor sought to rely on a letter from Pan World Brands Ltd testifying to sales between 2001 and 2004. However, it emerged in the course of oral submissions at the hearing that the letter had (unwittingly, it seems) been omitted from the Exhibit to Mr Kelly's Witness Statement of 1 February 2006.

19. The Proprietor also made a conditional application to amend its Counterstatement to introduce a new paragraph to the following effect:

*2A. In the alternative, there is a proper reason for not using genuinely the Mark as registered, namely that it would have been inappropriate for the first, and each subsequent, assignee to use a mark that contained the company name of the original application for the Mark.*

The application to amend was put forward for consideration '*if the registry is still minded to hold that an acceptable variant has not been put to genuine use*'.

20. Under Rule 31(3) the Registrar may, if the requirements of that Rule are not satisfied within the relevant three month period, treat an application for revocation as unopposed or allow it to proceed to a determination in accordance with the provisions of Rules 31A and 31B: ARGENTUM Trade Mark [2006] RPC 19, p.509; MOVIESTAR Trade Mark [2005] RPC 26, p.623; see also Music Choice Ltd's Trade Mark [2006] RPC 13, p.358. So far as I can ascertain, the Proprietor did not ask the Registrar to exercise the power conferred by Rule 31(3) in favour of allowing the application for revocation to proceed under Rules 31A and 31B.

The Hearing Officer's Decision

21. In a written decision issued under reference BL O-294-06 on 18 October 2006 the Hearing Officer upheld the Registrar's objection to the adequacy of the Proprietor's defence and deemed its opposition to the application for revocation to have been withdrawn (paragraph 34). In other words, the Proprietor's defence was struck out. No date of revocation was specified in the decision.

22. The Proprietor's first contention was rejected on the basis that the Form TM26(N) as amended within the Registry specified dates and periods which the Registrar could properly take into consideration under Sections 46(1)(a) and 46(1)(b): paragraphs 22 to 25.

23. The Proprietor's second contention was rejected on the basis that its request for amendment of the trade mark in suit under Section 44 was '*resolved and closed*' (paragraphs 10 to 12).

24. The Proprietor's third contention was rejected on the basis stated in paragraphs 31 to 33 of the Hearing Officer's decision:

31. Mr. Kelly says that he has been given the information in his witness statement by the registered proprietor's predecessors and says the mark has been used by them but he gives no details of who those predecessors are or may have been. He is the registered proprietor's trade mark attorney but gives no indication of what, if any, connection he might have with those predecessors. He does not indicate that he has access to any of the current or previous companies' books or records. There is no indication that he was or is in any way responsible for the use of the mark either in the relevant period or subsequently.

32. Whilst photocopies of certain labels are exhibited with the presumed intention to show the mark has been used,

they fail to do so. There is no evidence which shows whether any use made was internal or external use. There is nothing to show when the mark might have been used and whether any such use was made on a single occasion, on an intermittent basis or throughout the relevant period. There is no evidence as to where, how or by whom the mark may have been used. There is no indication of any level of use. There is no corroborative evidence from third parties.

33. Taken as a whole, I was not satisfied that the registered proprietor had discharged the onus on it to show that it had an arguable defence to the allegation of non-use of the mark. Neither is there anything in the evidence that would provide the applicant for revocation with any information to enable him to investigate the use of the mark upon which the proprietor proposes to rely.

This conclusion was reached explicitly without deciding whether **BSA** could be regarded as an ‘*acceptable variant*’ of **BSA by R2** under Section 46(2) of the Act (paragraph 28).

25. The Hearing Officer declined to consider the Proprietor’s application to amend its Counterstatement on the basis that the application had not been properly made: ‘*There is a clear and published practice on requests for such amendments and a bare sentence in a skeleton argument prepared for a hearing on a separate issue did not comply with that practice*’ (paragraph 16).

### The Appeal

26. The Proprietor appealed to an Appointed Person under Section 76 of the Act. It repeated the contentions noted in paragraph 18 above and renewed its application to amend its Counterstatement, this time unconditionally. In addition, it raised a request for the discretion available to the Registrar under Rule 31(3) (see paragraph 20 above) to be exercised in favour of allowing the proceedings to continue.

27. These matters were explored in argument at the hearing before me. Close attention was paid to the Proprietor's contention that the Applicant's Form TM26(N) and Statement of Case were '*fatally defective*' for lack of acceptable particularisation as to the dates and periods relied upon in support of the application for revocation. The Applicant's representative acknowledged that there were deficiencies on dates which ought to be corrected by amendment so as to bring its pleadings into line with the Registrar's guidance on 'Applications for revocation on the grounds of non-use: calculation of the date of revocation' set out in Tribunal Practice Note (TPN 1/2007). However, she was not in a position to make submissions as to what the consequences of amendment should be in the light of case law on the point. I therefore allowed time for the filing of further written submissions directed to that aspect of the appeal.

28. The Applicant subsequently filed written submissions settled by Counsel in which it withdrew its acceptance of the need for amendment and challenged the correctness of the Registrar's Tribunal Practice Note (TPN 1/2007). It maintained that the Registrar had the power under Section 46 of the Act to revoke the registration of the trade mark in suit with effect from 28 July 2005 (the fifth anniversary of the date of completion of the registration procedure). In the alternative it maintained that amendment for the purpose of claiming revocation with effect from 29 July 2005 (the day following the fifth anniversary of the date of completion of the registration) should not, even if it was necessary, lead to re-commencement of the Rule 31 procedure or otherwise open the door to fresh pleadings or evidence by way of defence on behalf of the Proprietor under Rule 31(3).

29. The Proprietor filed written submissions adhering to its previously stated position that the Applicant had no alternative but to amend its Form TM26(N) and Statement of Grounds, thereby re-setting the time for compliance by the Proprietor with the requirements of Rule 31(3).

30. The Registrar filed written submissions maintaining that the guidance provided in Tribunal Practice Note (TPN 1/2007) was correct, that the earliest possible date for revocation in the present case was 29 July 2005, that the Form TM26(N) as amended within the Registry erroneously claimed revocation with effect from 28 July 2005 and that this involved an irregularity in procedure which could be corrected on such terms as the Registrar might see fit to specify under Rule 66. It was further submitted that the correction of an obvious administrative error such as that which had occurred in the present case should not lead to re-commencement of the Rule 31 procedure. A simple correction with a simple consequential amendment to the Proprietor's Form TM8 would be sufficient to meet the justice of the case.

#### Calculating the relevant 5 year period(s)

31. The power to revoke the registration of a trade mark for non-use is prescribed by Article 12(1) of Council Directive 89/104/EEC of 21 December 1988 (*'the Directive'*) in the following terms:

1. A trade mark shall be liable to revocation if, within a continuous period of five years, it has not been put to genuine use in the Member State in connection with the goods or services in respect of which it is registered, and there are no proper reasons or non-use; however, no person may claim that the proprietor's rights in a trade mark should

be revoked where, during the interval between expiry of the five-year period and filing of the application for revocation, genuine use of the trade mark has been started or resumed; the commencement or resumption of use within a period of three months preceding the filing of the application for revocation which began at the earliest on expiry of the continuous period of five years of non-use, shall, however, be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application for revocation may be filed.

This must be read in conjunction with the following provisions of Article 10 of the Directive:

1. If, within a period of five years following the date of the completion of the registration procedure, the proprietor has not put the trade mark to genuine use in the Member State in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the trade mark shall be subject to the sanctions provided for in this Directive, unless there are proper reasons for non-use.
2. The following shall also constitute use within the meaning of paragraph 1:
  - (a) use of the trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered;
  - (b) affixing of the trade mark to goods or to the packaging thereof in the Member State concerned solely for export purposes.
3. Use of the trade mark with the consent of the proprietor or by any person who has authority to use a collective mark or a guarantee or certification mark shall be deemed to constitute use by the proprietor.

Articles 12(1) and 10(1) to (3) of the Directive are (with immaterial differences) repeated in Articles 50(1) and 15(1) to (3) of Council Regulation 40/94 of 20 December 1993 on the Community trade mark (*'the CTMR'*).



32. Sections 46(1)(a) and (b) and 46(2) of the 1994 Act repeat (with immaterial differences) Articles 10(1) and (2) of the Directive and Articles 15(1) and (2) of the CTMR. The relevant 5 year period(s) must, in principle, be calculated in the same way under these corresponding provisions of national and Community law.

33. The common thread is a requirement for expiry of a period of not less than 5 successive years throughout the whole of which the trade mark in question was registered, but not relevantly used either in the form in which it was registered or in the form of an acceptably similar variant. The date on which the registration procedure was completed and the date on (or with effect from) which revocation is requested must, on a straightforward reading of the legislation, lie outside the required period of not less than 5 successive years of non-use.

34. That accords with the approach laid down in Regulation (EEC, Euratom) No. 1182/71 of the Council of 3 June 1971 for determining the rules applicable to periods, dates and time limits:

#### Article 1

Save as otherwise provided, this regulation shall apply to acts of the Council or Commission which have been or will be passed pursuant to the Treaty establishing the European Economic Community ...

...

#### Article 3

1. Where a period expressed in hours is to be calculated from the moment at which an event occurs or an action takes place, the hour during which that event occurs or that action takes place shall not be considered as falling within the period in question.

Where a period expressed in days, weeks, months or years is to be calculated from the moment at which an event occurs or an action takes place, the day during which that event occurs or that action takes place shall not be considered as falling within the period in question.

2. Subject to the provisions of paragraphs 1 and 4:

(a) A period expressed in hours shall start at the beginning of the first hour and shall end with the expiry of the last hour of the period;

(b) A period expressed in days shall start at the beginning of the first hour of the first day and shall end with the expiry of the last hour of the last day of the period;

(c) A period expressed in weeks, months or years shall start at the beginning of the first hour of the first day of the period, and shall end with the expiry of the last hour of whichever day in the last week, month or year is the same day of the week, or falls on the same date, as the day from which the period runs. If, in a period expressed in months or in years, the day on which it should expire does not occur in the last month, the period shall end with the expiry of the last hour of the last day of that month;

(d) If a period includes parts of months, the month shall, for the purpose of calculating such parts, be considered as having thirty days.

3. The periods concerned shall include public holidays, Sundays and Saturdays, save where these are expressly excepted or where the periods are expressed in working days.

4. Where the last day of a period expressed otherwise than in hours is a public holiday, Sunday or Saturday, the period shall end with the expiry of the last hour of the following working day.

This provision shall not apply to periods calculated retroactively from a given date or event.

5. Any period of two days or more shall include at least two working days.

...

35. Commission Regulation (EC) No. 2868/95 of 13 December 1995 implementing the CTMR similarly provides:

*Rule 70*

**Calculation of time limits**

(1) Periods shall be laid down in terms of full years, months, weeks or day.

(2) Calculation shall start on the day following the day on which the relevant event occurred, the event being either a procedural step or the expiry of another period. Where that procedural step is a notification, the event considered shall be the receipt of the document notified, unless otherwise provided.

(3) Where a period is expressed as one year or a certain number of years, it shall expire in the relevant subsequent year in the month having the same name and on the day having the same number as the month and the day on which the said event occurred. Where the relevant month has no day with the same number the period shall expire on the last day of that month.

(4) Where a period is expressed as one month or a certain number of months, it shall expire in the relevant subsequent month on the day which has the same number as the day on which the said event occurred. Where the day on which the said event occurred was the last day of a month or where the relevant subsequent month has no day with the same number the period shall expire on the last day of that month.

(5) Where a period is expressed as one week or a certain number of weeks, it shall expire in the relevant subsequent week on the day having the same name as the day on which the said event occurred.

36. Finally in this connection I refer to the approach to computation summarised in Halsbury's Laws of England 4<sup>th</sup> Edn Vol.45(2) (1999 re-issue) at paragraph 235 in the following terms with footnotes omitted:

PERIOD WITHIN WHICH  
AN ACT MUST BE DONE

**235. Exclusion of first day.** The general rule in cases in which a period is fixed within which a person must act or take the consequences is that the day of the act or event from which the period runs should not be counted against him.

This general rule applies irrespective of whether the limitation of time is imposed by the act of a party or by statute. Thus, where a period is fixed within which a criminal prosecution or a civil action may be commenced, the day on which the offence is committed or the cause of action arises is excluded in the computation. So, also, where a statute provides that something may only be done within a certain period from the passing of the Act, the day on which the Act was passed is excluded, and many other instances may be cited. In particular, where an act is required by the Civil Procedure Rules, a practice direction or by any judgment or other of the court to be done within a specified period, the day on which the period begins is not included in computing the number of days. ...

37. These rules serve to confirm the correctness of the approach to computation which is now set out in Tribunal Practice Note (TPN 1/2007). Even without them I would adhere to the view that the required period of not less than 5 successive years of non-use must be calculated without counting against the trade mark proprietor either the date on which the registration procedure was completed or the date on (or with effect from) which revocation is requested. I therefore hold that the Registrar has no power to revoke the registration of the trade mark in issue in the present case: (1) with effect from any date earlier than 29 July 2005 if the application for revocation is upheld under Section

46(1)(a); or (2) with effect from any subsequent date preceded by less than 5 successive years of non-use if the application for revocation is upheld only under Section 46(1)(b).

Pleading the relevant 5 year period(s)

38. The fifth recital in the preamble to the Directive confirms that the Member States remain free to fix the provisions of procedure concerning (inter alia) the revocation of trade mark rights acquired by registration. In the United Kingdom, Section 66 of the Act and Rule 3 combine to require the use of prescribed forms for the purpose of taking procedural steps in the Registry. It is not open to the Registrar to exempt anyone from the obligation to use an acceptable form as and when required by the substantive provisions of the Act and the Rules: KML Invest AB's Trade Mark Application [2004] RPC 47, p.972.

39. Form TM26(N) is the form prescribed by Rule 31(1) for commencement of proceedings for revocation on the basis of non-use under Sections 46(1)(a) or 46(1)(b). The version of the form which is relevant for present purposes was, I believe, introduced in early 2005. It requires the applicant to state whether revocation is requested under Section 46(1)(a) or Section 46(1)(b) or both. In Section 46(1)(a) of the Act the relevant 5 year period is, in terms, identified as '*the period of five years following the date of completion of the registration procedure*'. There is, accordingly, no need for the applicant to particularise that period in his Form TM26(N). However, Section 46(1)(b) of the Act refers only to '*an uninterrupted period of five years*'. This allows the applicant to apply for revocation on the basis of a period of not less than 5 years expiring at a later point in time than the period of 5 years identified in Section 46(1)(a). The prescribed Form

TM26(N) therefore requires the applicant to identify a period of not less than 5 years upon which he relies for the purposes of Section 46(1)(b) and, in doing so, to specify the end date of that period.

40. The prescribed Form TM26(N) goes on to require the applicant to specify the date with effect from which revocation is requested. The applicant necessarily alleges by reference to the date he specifies that there was no relevant use of the trade mark or any acceptable variant of it either: (1) during the period of 5 years ending on the day before the date specified; or (2) during the period commencing on the date specified and ending on the day before the date of the application for revocation. The latter allegation is necessary in order to discount the operation of Section 46(3), which provides that:

(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.

41. In paragraph 1.3 of Tribunal Practice Note (TPN 1/2005) it was indicated that the Registrar would allow up to three dates of revocation to be claimed in a single Form TM26(N) and Statement of Grounds: (1) the earliest possible date under Section 46(1)(a); (2) the date of the application for revocation, under Section 46(1)(b); and (3) a specified date somewhere in between those two dates, under Section 46(1)(b). It was further

indicated that '*Any other alleged period of non-use must be the subject of a separate application*'. I understand that the Registrar adopted this approach in order to prevent applicants from claiming revocation in formulaic terms designed to cover each and every successive date from the date of the application for revocation back to the earliest possible date under Section 46(1)(a).

#### Dealing with errors on dates

42. When it comes to questions of amendment, there is a curious omission from the powers expressly conferred upon the Registrar by the Rules made under the 1994 Act as compared with those expressly conferred upon the Registrar by the Rules made under the trade mark statutes previously in force in the United Kingdom.

43. For more than a hundred years prior to the commencement of the 1994 Act, the Registrar was expressly empowered to permit amendments and correct procedural irregularities. As can be seen from In re Moet's Trade Mark (1890) 7 RPC 226 at 230, the Trade Marks Rules 1890 provided:

54. Any document ... may be amended, and any irregularity in procedure which in the opinion of the comptroller may be obviated without detriment to the interests of any person may be corrected, if the comptroller thinks fit, and on such terms as he may direct.

Rules to the same substantive effect were promulgated under successive Acts.

44. Immediately prior to the introduction of the 1994 Act, the Trade Marks and Service Marks Rules 1986 provided as follows:

### **Amendments and irregularities**

**121.** Any document filed in any proceedings before the Registrar...may, if the Registrar thinks fit, be amended, and any irregularity in procedure in or before the Office may be rectified, on such terms as the Registrar may direct.

45. Section 78 of the 1994 Act enabled the Secretary of State to make rules for the purpose of regulating practice and procedure. Section 78(2)(d) enabled rules to be made in particular for the purpose of '*authorising the rectification of irregularities of procedure*'. A general power to permit amendment of filed documents could have been expressly conferred along with an express power to correct procedural irregularities. However, the Rules now contain no general power to permit amendment of filed documents. Rule 66 of the Trade Marks Rules 2000 (originally Rule 60 of the Trade Marks Rules 1994) simply provides:

### **Correction of irregularities of procedure**

**66.** Subject to rule 68 below, any irregularity in procedure in or before the Office or the registrar, may be rectified on such terms as the registrar may direct.

It appears to follow that amendments for the purpose of rectifying irregularities in procedure are within the scope of the express power conferred by Rule 66, whereas those which serve other purposes must be dealt with under other rules or within the limits of such inherent power as the Registrar possesses.

46. The power conferred by Rule 66 is interstitial. It cannot be used to thwart the intended effect of other provisions of the Act and the Rules: E's Application [1983] RPC 231 (HL). So non-compliance with the mandatory requirements of a rule such as Rule



31(1) cannot be rectified under Rule 66. However, inadequate compliance can, in my view, be treated as an irregularity capable of rectification in cases where the shortcomings are not so serious as to render the prescribed procedure inoperative. In saying that, I am extrapolating from the approach adopted for the purpose of differentiating between formal deficiencies which did and formal deficiencies which did not have a nullifying effect in the context of High Court proceedings under the (now superseded) Rules of the Supreme Court.

47. Rule 31(1) makes it obligatory for an applicant to file a Form TM26(N) and Statement of Grounds which, when read together, put forward an intelligible claim for revocation in accordance with Section 46(1)(a) or Section 46(1)(b) as the case may be. Experience has shown that applications under this Rule quite often contain errors with regard to identification of the relevant 5 year period(s). When the Form TM26(N) and Statement of Grounds identify dates indicative of errors in the reckoning or in the inscription of the non-use period(s) that the applicant was attempting to identify, the question for consideration is whether the shortcomings are so serious as to render the proceedings inoperative. If not, I think they can be treated as irregularities in procedure which may, in principle, be rectified by amendment under Rule 66.

48. Relief under Rule 66 is discretionary and may be conditional. The power to grant relief is exercisable in the first instance by the Registrar. It may be exercised on the basis that the Form TM26(N) and Statement of Grounds will be amended as necessary to correct the relevant error(s), with re-commencement of the Rule 31 procedure to follow.

That, in effect, was the outcome envisaged in LOWDEN Trade Mark [2005] RPC 18 at paragraphs 27 to 31.

49. I think it is important to emphasise that in LOWDEN both sides were, in differing degrees, seeking to unravel the antecedent proceedings in the Registry. Revocation had been ordered by the Registrar under Rule 31(3) with effect from the fourth anniversary of the date of registration of the trade mark in suit. That was an order which the Registrar clearly had no power to make. On setting it aside, the parties would be returned to the position in which they were before the order was made. It would then be necessary for the Registrar to consider whether the revived application for revocation should be allowed to proceed or treated as unopposed under Rule 31(3) (see paragraph 20 above) and, if the latter, what the date of revocation should be.

50. As to that, Section 46(6) of the Act provides as follows:

- (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.

The Registrar could not have been satisfied that grounds for revocation existed at the earlier date originally pleaded by the applicant i.e. the fourth anniversary of the date of registration. But that would not have prevented the Registrar from making an order under Section 46(6)(a) with effect from the date of the application for revocation.

51. However, the trade mark proprietor wanted to be able to oppose the making of any order for revocation as fully and effectively as it could. For its part, the applicant wanted the Registrar to order revocation under Section 46(6)(b) from the earliest possible date under Section 46(1)(a). That was taken to require amendment of the pleadings filed under Rule 31(1) and, if amendment was permitted, re-commencement of the Rule 31 procedure. In that event the trade mark proprietor would succeed in obtaining the opportunity it was seeking to enter a fully effective defence to the application for revocation. And so the justice of the case would be met by returning the parties to the beginning of the procedure without treating the proceedings as *'fatally defective'* (a determination which might have led to loss of the filing date of the application for revocation).

52. I can see that the approach adopted in LOWDEN takes account of the basic rule that amendments to pleadings are effective as of the date when they are made: Rhone-Poulenc Rorer International Holdings Inc. v. Yeda Research and Development Co. Ltd [2006] RPC 24, p.605 at paragraphs 48 to 52 (the point is not separately addressed in the judgments of the Court of Appeal reported at [2007] RPC 9, p.167). That said, it does not appear to me that returning the parties to the beginning of the procedure is the only permissible approach to adopt when deciding how the discretionary power to rectify irregularities in the context of Rule 31(1) should be exercised under Rule 66. I think that Rule 66 is, in terms, broad enough to enable the Registrar to decide in appropriate circumstances that the justice of the case can be met by amendment of pleadings without re-commencement of the Rule 31 procedure.

As matters currently stand

53. In the present case the Applicant succeeded, with assistance from the Registry, in claiming revocation under Section 46(1)(a) with effect from 28 July 2005 instead of 29 July 2005 and under Section 46(1)(b) with effect from 24 October 2005 instead of 25 October 2005, in respect of a period with a specified end date of 24 October 2005. Paragraphs 1 and 3 of the Statement of Grounds did not fully coincide with the Form TM26(N) as amended in relation to dates. It nevertheless remained apparent on an objective reading of the Form TM26(N) and Statement of Grounds that the Applicant was, for the purposes of Section 46(6)(b) of the Act, trying to claim revocation firstly with effect from the earliest possible date under Section 46(1)(a) and secondly by reference to a 5 year period with an end date of 24 October 2005 under Section 46(1)(b).

54. I do not accept that the application for revocation was '*fatally defective*' by reason of the miscalculations on dates. I think they amounted to minor shortcomings in compliance with the requirements of Rule 31(1) and I would not, as presently advised, consider it necessary or desirable in the interests of justice to provide for rectification by amendment under Rule 66 with re-commencement of the Rule 31 procedure to follow. However, the power conferred by Rule 66 is, as I have already pointed out, exercisable in the first instance by the Registrar. And the Applicant has not, as yet, sought permission to amend its Form TM26(N) and Statement of Grounds by invoking that Rule (or such inherent power as the Registrar possesses to permit amendment independently of the Rule).

55. As matters currently stand, the proceedings for revocation have gone forward on the basis of pleadings itemising dates for consideration under Section 46(6)(b) which do not fully accord with the provisions of Sections 46(1)(a) and 46(1)(b). It nonetheless remains the task of the Registrar under Section 46(6)(b) to consider, at the appropriate juncture, whether he is satisfied on the basis of the evidence and materials then before him that grounds for revocation existed at a date earlier than the date of the application under Rule 31(1). The earlier date (if any) need not be a date which the Applicant has actually succeeded in specifying in its pleadings. If and when the Registrar decides to exercise the power of determination conferred upon him by Section 46(6)(b), he must deal with the matter as the justice of the case requires.

56. The judgment of Jacob J. in Omega SA v. Omega Engineering Inc. [2003] FSR 49, p.893 is instructive as to the way in which inadequacies in an applicant's pleadings may affect the justice of the case under Section 46(6)(b). It was decided, prior to the introduction of the present version of Form TM26(N), that the date of application for revocation should be taken to be the relevant date for revocation in the absence of any clearly formulated request for revocation from an earlier date under Section 46(6)(b). By failing to adopt that approach, the applicant for revocation had unfairly prejudiced the proprietor in its defence of the registration in issue. The Court accepted that the pleadings did not put in play use going back beyond the five-year period immediately before the application for revocation; because that was not fairly put in play, use before the period was not an issue in the case; and although the onus lies on the proprietor of the registration to prove his use, the proprietor did not have to prove use for a period which was not properly in issue. These were not purely technical pleading points: "*What*

*happened here is that the proprietors set about proving use within the last five years, that is to say the five year period before the date of application for revocation. They did not set about proving use for an earlier period”* (paragraph 9). In the result, the decision of the Registrar’s hearing officer to order revocation with effect from the date of the application for revocation was upheld.

### Role of the Registrar under Rules 31(1) and 31(3)

57. On receipt of an application under Rule 31(1) the Registrar can require clarification of the basis on which the claim for revocation is being put forward. This is an aspect of case management under Rule 57:

#### **Registrar’s power to require documents, information or evidence**

**57.** At any stage of any proceedings before the registrar, she may direct that such documents, information or evidence as she may reasonably require shall be filed within such period as she may specify.

The power conferred by Rule 57 is, on the face of it, wide enough to enable the Registrar to require such clarification to be provided by way of amendment to the Form TM26(N) or Statement of Grounds. The applicant may either correct the filed documentation himself or ask the Registrar to implement the correction he intends to make. If the Registry is willing to implement the correction, it should be made clear that the Registrar is implementing it in a non-advisory capacity. The request should at least be confirmed in writing so that there can be no misunderstanding as to what the applicant intends. The resulting correction will take effect by amendment when made: Rhone-Poulenc Rorer International Holdings Inc. v. Yeda Research and Development Co. Ltd (above). The date

of correction should therefore be formally recorded in case anything turns on it (for example, whether the initial filing date can be retained) at a later stage.

58. In the present case there was inadequate compliance by the Applicant with the requirements of Rule 31(1). The ex officio requirement for amendment was an attempt on the part of the Registrar to secure compliance within the latitude allowed by Rule 57. The Proprietor described it as a ‘partisan’ attempt to assist the Applicant in the conduct of its case. I reject that. It was a well-intentioned but deficient attempt to use Rule 57 for the legitimate purpose of ensuring effective case management of Registry proceedings, as to which see Tribunal Practice Note (TPN 1/2000) and Tribunal Practice Note (TPN 4/2000).

59. Under Rule 31(3) the Registrar ‘may’ decide to treat an application for revocation under Rule 31(1) as unopposed if the proprietor of the relevant trade mark fails to file a Form TM8 and Counterstatement accompanied by ‘*evidence of use of the mark*’ or ‘*reasons for non-use of the mark*’ within the non-extendable period of 3 months prescribed by the Rule. The discretionary power to treat an application as unopposed under Rule 31(3) obviously cannot be exercised unless and until the proprietor has failed to comply.

60. Under Rule 31(3) the proprietor is required to establish the existence of an arguable or viable defence, not the absence of an arguable or viable claim. If the proprietor can establish that the claim for revocation is, to a greater or lesser extent, doomed to failure it is highly desirable that he should do so. However, the scheme of the

legislation indicates that he does not need to go that far when filing his initial response to the Form TM26(N) and Statement of Grounds.

61. In MOO JUICE Trade Mark [2006] RPC 18, p.501 at paragraphs 16 and 17 Kitchin J. explained the position in the following terms:

16. ... Section 100 and rr.31 and 31A address the difficulty facing anyone who wishes to establish a trade mark has not been used. As explained in the *White Paper: Reform of Trade Marks Law*, (September 1990) at para. 4.30:

“It is however difficult and time consuming to have to prove a negative, whereas if a trade mark is in fact being used it is a straightforward matter for the proprietor to demonstrate this. The law will therefore provide for a person who is affected by the presence of a mark on the register...to call upon the proprietor to produce evidence of use; failure to produce such evidence will be treated as an admission of non-use.”

To my mind the requirements laid down by r.31(3) is not therefore satisfied by a proprietor who simply asserts, through a relevant witness, that the trade mark has been used. Such a bare assertion would provide no evidence as to the actual use made by the proprietor. The evidence must provide a sufficient explanation of how the mark has been used for the tribunal to conclude that the proprietor has an arguable defence to the application. I respectfully concur with Mr. Geoffrey Hobbs Q.C., sitting as the appointed person, in *YORK Trade Mark* [Decision O-191-05 of July 1, 2005] when he said, at para. 10:

“The purpose of rule 31(3) is to allow the Registrar to make an order for revocation if it does not appear from information provided in the manner prescribed by rule 31(2) that the



proprietor has a viable defence to the pleaded allegation(s) of non-use.”

Conversely, however, the evidence does not have to be so persuasive that, if unanswered, it would necessarily discharge the burden of proof lying upon the proprietor. The scheme which I have summarised clearly contemplates that the proprietor should have an opportunity to supplement its evidence even if the applicant for revocation chooses to file no evidence. The purpose of the evidence under r.31(3) is to establish that the proprietor has an arguable or viable defence to the attack mounted upon the registration and to provide the applicant for revocation with sufficient information to enable him to investigate the use of the mark upon which the proprietor proposes to rely.

17. In *CARTE BLEUE Trade Marks* [2002] R.P.C. 31 Mr. Knight, the principal hearing officer acting for the registrar, observed at [35]:

“Therefore it seems to me that the Act and the Rules indicate that at least initially the registered proprietor in seeking to defend himself against an allegation of non-use need only show use at the outset which indicates clearly to those concerned that a proper defence is, and can be, mounted in relation to the allegation that the trade mark has not been used.”

If, in using the expression “proper defence”, the hearing officer meant an arguable defence then I respectfully agree with him. After referring to another decision by one of the registrar’s hearing officers in *Adrenalin* [BLO/336/99] he continued, at [37]:

“From my point of view I would simply reinforce what has been said in these decisions and in the Manual, that the sort of evidence that one would normally hope to see is copies of brochures, catalogues, pamphlets, advertisements, etc all of which show use of the trade mark in question

together with some indication of the sale of goods, or the provision of services during the relevant periods. Clearly this cannot be an exhaustive list and is merely an example of documents which might be sent in.”

I agree with the hearing officer that evidence of this kind is highly desirable. If the proprietor files such evidence it will assist in clarifying the issues at an early stage and may even serve to shorten the proceedings. It is not, however, a requirement of r.31(3). If the proprietor is able to establish that it has an arguable defence to the application without filing such evidence then, in my judgment, it is not obliged to do so.

62. When considering of his own motion whether the proprietor of a trade mark has provided enough information in the prescribed manner to show that he has an arguable defence to the revocation application, the Registrar should be prepared to receive the information that is provided for what it may properly be thought to be worth. To subject it to sceptical analysis on the basis that there is an assumption of non-use which must be neutralised by definitive evidence of use of the relevant trade mark is to go too far. The Registrar is not a party to the proceedings. Consistently with his duty to act as an independent and impartial tribunal, he should approach the matter on the basis that the trade mark in question might or might not have been relevantly used in the form in which it was registered or in the form of an acceptably similar variant, with it being incumbent on the proprietor to show in the manner prescribed by Rule 31(3) that he has an arguable case for retention of his registration.

63. In Stephens v. Cannon [2005] EWCA Civ 222 (14 March 2005) the Court of Appeal emphasised that a decision taker should not resort to the burden of proof for the

purpose of determining issues in civil proceedings unless he or she cannot reasonably make a finding in relation to the disputed issue or issues on the basis of the available evidence, notwithstanding that he or she has striven to do so. That carries the corollary that the question whether the burden of proof has been discharged is a matter which falls to be decided when (and not before) the evidence in the case is complete. I see no reason why the latter proposition should not apply to the ‘burden of proving use of trade mark’ established by Section 100 of the 1994 Act. To apply the full rigour of Section 100 to a defence filed under Rule 31(3) would be to treat the defence as if it was the proprietor’s last word on the subject of use. However, that is not what the legislation requires it to be.

#### Striking out the defence

64. The defence of the Proprietor in the present case did not seek to show that there had been use of the mark **BSA by R2**. It sought to show that there had been use of the mark **BSA** with **BSA** simpliciter being, in its contention, an acceptably similar variant of **BSA by R2** for the purposes of Section 46(2).

65. The defence was put forward in the context of paragraph 2 of the Statement of Grounds, which confirmed that *‘The Applicant’s investigations have revealed that the previous registered proprietor might have used the mark BSA in relation to the goods for which the Mark is registered. ... No use of the mark BSA by R2 was discovered’*. Against that background, the first Witness Statement and Exhibit of Paul Kelly provided information which indicated that the position was indeed as suggested by the results of the Applicant’s investigations: the Proprietor’s predecessor in title had used the mark

**BSA** (and had not used the mark **BSA by R2**) in relation to *‘articles of clothing’* sold in the United Kingdom *‘during the relevant periods’*.

66. I have looked at the fair copy of Exhibit PJK1. This contains undated depictions (in the form of design sketches and photographs) of articles of clothing carrying the designation **BSA** and the strapline **A NEW VISION**. The absence of dates severely weakens the evidential value of the exhibited materials. So does the total absence of any sales figures and the total absence of information as to any particular dealings or transactions in clothing of the kind depicted. However, the narrative statements of use in Mr. Kelly’s first Witness Statement are at least consistent with the position put forward by the Applicant in paragraph 2 of its Statement of Grounds. It would, for that reason, be wrong to disregard the Witness Statement and Exhibit filed on behalf of the Proprietor or (which would amount to the same thing) to ascribe no evidential value to them.

67. In the context of paragraph 2 of the Statement of Grounds, the evidence in the Witness Statement and Exhibit points only to the existence of an arguable basis for claiming use of the mark **BSA** to an unspecified extent in relation to generally unspecified articles of clothing within the period 29 July 2000 to 26 October 2005. Did that entitle the Registrar to strike out the defence and treat the application for registration as unopposed under Rule 31(3)? Only if it was properly determined, following due notice to the Proprietor under Rule 54, that the mark **BSA** was not an acceptably similar variant of the mark **BSA by R2** for the purposes of Section 46(2) of the Act. Short of that, the information provided on behalf of the Proprietor in the prescribed manner would stand in the way of a finding of non-compliance with the requirements of Rule 31(3).

68. The Registrar raised no objection to the Proprietor's reliance on Section 46(2). The Hearing Officer also declined to consider the Proprietor's contention that the evidence filed under Rule 31(3) was sufficient to overcome the preliminary hurdle that accompanies the filing of the Form TM8 and Counterstatement on the basis that use of **BSA** constituted use of an acceptable variant of **BSA by R2**. She assessed the evidence independently of that contention, by reference to the burden imposed by Section 100 of the Act and from the same perspective as the Registry letter of 6 February 2006 in which the ex officio objection had originally been raised (paragraph 13 above). On the day after the hearing of 17 August 2006, she wrote to the parties informing them of her decision in the following terms:

Having considered all the submissions made, my decision is to uphold the Registrar's preliminary view. I was not persuaded that the evidence, as filed, was sufficient to discharge the onus placed on the registered proprietor.

This (like the Registry letter of 6 February 2006) referred to the onus which the Proprietor would need to have discharged by the time the evidence in defence of its registration was complete.

69. It further appears from the paragraphs of the Hearing Officer's written decision which I have quoted in paragraph 24 above that she regarded Section 100 and Rule 31(3) as provisions which together enabled the Registrar to subject the evidence filed under Rule 31(3) to sceptical analysis rather than neutral evaluation in the manner I have attempted to describe in paragraph 62 above. In the result, the decision appears to me to be inconsistent with the basic proposition that an application for revocation cannot simply

be treated as unopposed if it has been met by a defence which cannot simply be treated as hollow and insubstantial.

70. For these reasons I consider that that Hearing Officer's decision to strike out the defence filed on behalf of the Proprietor was wrong and should be set aside. It is unnecessary for me to consider whether the application for revocation should have been allowed to proceed under Rules 31A and 31B in the exercise of the discretionary power conferred by Rule 31(3).

#### Amendment under Section 44

71. I do not accept that the Proprietor's application for amendment of its trade mark under Section 44 could be regarded as resolved and closed. The Hearing Officer was none the less entitled to treat that application as a matter of no direct relevance, because it could not retroactively affect the form of the trade mark as registered for the purposes of the revocation application filed on 27 October 2005. It is a separate question whether the Proprietor's reliance on the provisions of Section 46(2) is well-founded. The Registrar remains free to determine that question in whatever way he thinks most appropriate in the context of the pending application for revocation.

#### Amendment to the Counterstatement

72. The Hearing Officer was entitled to proceed upon the basis that the Proprietor had raised a request for permission to amend its Counterstatement without due regard for the requirements of fair notice to the Applicant and the tribunal. I consider that her refusal to

entertain the request at the hearing which took place before her on 17 August 2006 was a legitimate exercise of the Registrar's powers of case management.

### Costs

73. I understand that the parties wish me to deal with the costs consequences of my decision in accordance with the usual practice.

74. The argument relating to dates and amendment of the application for revocation was started by the Proprietor. It was continued by the Applicant. At the finish, the parties were deeply divided on the issues which had been raised. Neither side has gained very much from the position it adopted. Each side has been saddled with the burden of resisting points on which the other side was unsuccessful. The argument was, in accordance with my findings, peripheral to the question whether the Proprietor's defence was liable to be struck out. Looking at matters in the round, I think that the parties should be left to bear their own costs of this aspect of their dispute. I therefore intend to make no order for costs in that connection.

75. The argument relating to the adequacy of the defence filed by the Proprietor under Rule 31(3) was started by the Registrar. The Applicant then adopted it. In paragraph 1 of its written submissions for the hearing on 17 August 2006 it confirmed that:

The Applicant concurs with the Registrar's preliminary opinion that the evidence of use filed by the Proprietor with its Form TM8 and Counterstatement is not sufficient to constitute a proper defence to the application for revocation.

It proceeded upon that basis notwithstanding that it recognised in the Statement of Grounds it had filed under Rule 31(1) that the real issue in the proceedings was the extent (if any) to which the Proprietor could rely on use of the mark **BSA** as an acceptably similar variant of the mark **BSA by R2** under Section 46(2). It also adopted and supported the Hearing Officer's decision in response to the Proprietor's appeal.

76. In the circumstances, I think it is appropriate to make an award in favour of the Proprietor in relation to its costs of this aspect of the dispute. I therefore direct the Applicant to pay the sum of £600 as a contribution towards the Proprietor's costs of opposing the decision to strike out its defence. That sum is to be paid within 21 days after the date of this decision.

77. The Registrar was represented at the hearing of the appeal. His aim in that connection was to provide assistance to the tribunal so far as he could without intervening in favour of one side or the other on the substance of the dispute between the parties. I take the view that the Registrar should neither receive nor pay costs in relation to his involvement in the appeal.

**Geoffrey Hobbs Q.C.**

29 May 2007



Mr. Michael Edenborough instructed by Messrs Barlin Associates appeared as Counsel for the Proprietor and provided further written submissions on behalf of the Proprietor following the hearing.

Dr. Alison Lawson of Messrs Forrester Ketley & Co appeared on behalf of the Applicant.

Mr. Simon Malynicz instructed by Messrs Forrester Ketley & Co provided written submissions as Counsel on behalf of the Applicant following the hearing.

Mr. Raoul Colombo appeared on behalf of the Registrar and provided written submissions on behalf of the Registrar following the hearing.