

1 THE UK INTELLECTUAL PROPERTY OFFICE

2 The Rolls Building
3 7 Rolls Buildings
4 Fetter Lane
5 London EC4A 1NL

Friday 21st December 2018

6 Before:

7 MR JAMES MELLOR QC
(Sitting as the Appointed Person)

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9 In the Matter of the Trade Marks Act 1994

10 - and -

11 In the Matter of an Appeal to the Appointed Person under
12 Section 76

13 - and -

14 In the Matter of Trade Mark Application 3175876 by Mr Benjamin
15 George Walker for the Trade Mark: MEDIVAPOUR

16 - and -

17 In the Matter of Opposition No. 404702 by MediPen Ltd

18 - and -

19 In the Matter of the (now defunct) Consolidated Proceedings
20 concerning: An Application (No. 501425) by Mr Walker to
21 declare invalid the Trade Mark (No. 3170077) MEDIVAPOUR owned
22 by MediPen Ltd

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24 In the Matter of an Appeal to the Appointed Person from the
25 decision of Mr Oliver Morris, acting on behalf of the
Registrar, the Comptroller-General, dated 3rd July 2018.

(Transcript of the Stenograph Notes of Marten Walsh Cherer Ltd.,
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Chancery Lane, London WC2A 1HP.

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MR JAMIE MUIR WOOD, of Counsel, instructed by Trade Mark Wizards
Ltd, appeared for the Respondent

DECISION

1 THE APPOINTED PERSON: This is an appeal from the decision of the
2 Hearing Officer under reference 0397/18. It was a decision
3 issued on 3 July 2018. The Appellant, MediPen Ltd, filed its
4 form TM55P Notice of Appeal to the Appointed Person on 31 July
5 2018. This hearing date was fixed on 1 November after
6 communications with both parties in late October.

7 At 22.46 last night, the managing director of the
8 appellant MediPen Ltd, Mr Jordan Owen, sent an email in which
9 he indicated that he did not agree on the date of this appeal
10 and therefore will not be attending today. Further emails
11 followed last night, with the final email being sent at 00.08
12 this morning, in which Mr Owen indicated that he wanted to
13 take extra time to seek the correct legal advice on how to
14 proceed, as he put it. In those emails last night Mr Jordan
15 Owen of the Appellant sought an adjournment of the hearing of
16 the appeal today.

17 As usual in these sorts of situations, a little bit of
18 context is useful. First of all, as I have indicated, the
19 hearing date was fixed on 1 November. In the communications
20 which led to that, both sides had the opportunity to put
21 forward convenient dates, and, indeed, it was Mr Owen who
22 asked for the hearing to be after 20 December. In due course,
23 the Respondent agreed to a hearing today on 21 December, and
24 both parties were notified of the hearing date on 1 November
25 by my clerk.

1 Although in his email last night Mr Owen claimed to have
2 repeatedly attempted to make contact with my clerk via his
3 telephone number and left numerous voice mails, he claimed not
4 to have received a response. My clerk tells me that he has
5 been unable to trace any voice mails and does not believe that
6 Mr Owen has attempted to make contact via telephone. In any
7 event, bearing in mind all the communications were by email,
8 even if Mr Owen had not received a telephone response, he had
9 the opportunity at any time in the past seven weeks or so to
10 contact my clerk by email.

11 There is a little bit more to the history because when I
12 first received the papers in early October in this appeal, I
13 read the grounds of appeal and formed a preliminary view, and
14 I asked my clerk when fixing this appeal to communicate that
15 preliminary view to both parties. This message was sent
16 to both sides in an email sent by my clerk on 23 October 2018.
17 I will just read the message that I asked my clerk to include
18 in that email:

19 "I have read the TM55 and the Decision of the Hearing
20 Officer. By way of attachments to the TM55, I have one sheet
21 marked Appendix 2 and one sheet marked Appendix 3, but I do
22 not have any Appendix 1. Could the Appellant please send
23 through a copy of Appendix 1?

24 "Subject to receipt and consideration of Appendix 1, my
25 preliminary view is that, whilst the matters set out in the

1 TM55 in the section 'Reasons for appeal' are of obvious
2 concern to Mr Owen and his company MediPen Ltd, they do not
3 appear to disclose any grounds on which the appeal (which I
4 understand to be only against the order for costs made by the
5 Hearing Officer) could succeed. I emphasise that this is only
6 a preliminary and not a concluded view, and the Appellant is
7 not precluded from making any arguments to show there are
8 grounds for a successful appeal. However, in these unusual
9 circumstances, the Appellant might like to consider whether it
10 wishes to proceed to a hearing, bearing in mind that the
11 Respondent is likely to incur further costs in attending any
12 hearing with Counsel and can be expected to seek a further
13 award of costs if the appeal is unsuccessful.

14 "If the appeal is to proceed, the issues appear to
15 be narrow and ought to be resolved this year. I pass this
16 message to the parties in an attempt to save costs on both
17 sides".

18 In his email last night, Mr Owen referred to that
19 message in the following terms:

20 "As we are still seeking further clarification
21 regarding your previous comments, we request that the appeal
22 brought by us be postponed to a date that is suitable to both
23 parties. We have spent a significant amount of time and funds
24 seeking further advice on how to resolve this hearing
25 following your correspondence stating that there is a chance

1 that our evidence will be dismissed outright. It has been
2 stated that it is a preliminary view that there are no grounds
3 for a successful appeal and that this appeal ought to be
4 resolved this year. This is not a view we hold and we do not
5 wish to be forced to rush into an appeal based on this
6 preliminary view. Please confirm a new date for an appeal in
7 the new year that works for both parties”.

8 In considering this application for an adjournment, I
9 have to balance three competing interests. The first is the
10 interests of justice that appeals in this Tribunal are
11 resolved within a reasonable period.

12 Secondly, I have to consider the interests of the
13 Respondent in having the appeal heard and disposed of. The
14 Respondent is present here before me by counsel, having served
15 its skeleton argument in accordance with my direction, and
16 they have an obvious interest in having the appeal disposed of
17 today.

18 Thirdly, I have to consider the interests of the
19 Appellant in having a fair opportunity to put its case on
20 appeal and, as Mr Owen indicated in his email last night, an
21 opportunity to prepare for the appeal and to take appropriate
22 advice.

23 I take into account that Mr Owen has been, since an early
24 stage in these proceedings, representing his company without
25 the benefit of legal representation. I take into account his

1 is a small company with limited resources, but, even taking
2 due account of those factors, it does not mean that a
3 different set of rules applies to this appellant.

4 Accordingly, I am going to dismiss his application for
5 an adjournment. I am quite satisfied he has had ample notice
6 of this hearing and ample time in which to prepare his case. I am
7 also quite satisfied that, in fact, delaying the final resolution
8 of this appeal is not in either of the party's interests. It will
9 simply mean that more costs are incurred and, bearing in mind Mr
10 Owen's complaints about having to bear the costs below, or at least
11 a proportion of them, it is not really in his interests, or his
12 company's interests, to have further costs incurred.

13 For all those reasons, I dismiss Mr Owen and MediPen
14 Ltd's application for an adjournment.

15 (Proceedings continued).

16 This is an appeal by MediPen Ltd against the Decision of
17 the Hearing Officer under reference O397/18 dated 3 July 2018.
18 As the title page of the Hearing Officer's decision indicates,
19 his decision concerned an application (No. 3175876) by Mr
20 Benjamin George Walker for the trademark MEDIVAPOUR. There
21 was an opposition to that application (No. 408197) filed by
22 MediPen Ltd. In addition, there were some consolidated
23 proceedings concerning an application by Mr Walker to declare
24 invalid an earlier trade mark (No. 3170077) also for
25 MEDIVAPOUR owned by MediPen Ltd. As the title page indicates,

1 the application to invalidate was now defunct by the time of
2 his decision, for reasons which will become apparent.

3 Again, a little chronology will help to set the scene.
4 On 7 April 2015, MediPen Ltd filed an application to register
5 a trade mark MEDIPEN for certain services in class 44.
6 Subsequently, MediPen filed on 17 June 2016 its application
7 for the word mark MEDIVAPOUR. On 21 July 2016 the applicant,
8 Mr Benjamin George Walker, also filed his application to
9 register MEDIVAPOUR in a variety of classes.

10 Subsequently, Mr Walker and his company brought their
11 respective applications to invalidate the earlier MEDIVAPOUR
12 mark owned by MediPen Ltd, and, in due course, one of the
13 invalidation actions proceeded without being defended and,
14 therefore, the MediPen MEDIVAPOUR mark was cancelled, with the
15 consequence that that registration was deemed never to have
16 been made. That meant that in the opposition to Mr Walker's
17 application to register MEDIVAPOUR, the only ground left was
18 based upon MediPen's mark for the word mark MEDIPEN.

19 What the Hearing Officer had to deal with was a single
20 ground of opposition under section 5(2)(b) of the Trade Mark
21 Act 1994 against the mark applied for MEDIVAPOUR for a variety of
22 goods, based on the earlier trade mark MEDIPEN registered for
23 certain services in class 44.

24 I have read the Hearing Officer's Decision, and he gave
25 a carefully nuanced decision, particularly on the comparison

1 of the goods and services, but also on the usual comparison of
2 marks. I could find no error in his Decision on the
3 substantive issues. In the result the Hearing Officer
4 dismissed the single ground of opposition and ordered that the
5 application could proceed to registration in respect of all of
6 the applied for goods and services.

7 Having dismissed the ground of opposition, the Hearing
8 Officer was then asked for an award of costs off the scale,
9 for various reasons which he set out in paragraph 28 of his
10 Decision. He declined to award costs off the scale and in the
11 end he awarded the Applicant a total sum of £2,500 as a
12 contribution towards the costs of the proceedings.

13 As I said in my earlier ruling, MediPen then filed a
14 TM55P, its application to appeal, to this Tribunal, on 31 July
15 2018, and in early October this appeal was allocated to me.

16 Since my message to the parties, which I referred to in my
17 earlier ruling, I did receive a full copy of Appendix 1 to the
18 grounds of appeal. I have considered all the material in Appendix
19 1. I understand that the Respondent objects to certain material
20 in there. There is some without prejudice correspondence,
21 which I will not take into account, but I will just summarise
22 the grounds of appeal in the TM55.

23 In section 6, under the heading, "Reasons for appeal" it
24 starts with this phrase, "We understand that the current
25 decision was founded on the basis of lack of additional

1 evidence submitted on our behalf following our initial
2 submissions. I would like to further clarify our reasoning
3 behind this".

4 There are then four numbered paragraphs which actually
5 set out the reasons as to why MediPen Ltd did not file any
6 evidence. The reasons are various. It is alleged that Mr
7 Walker's company launched on aggressive series of defamatory
8 attacks against MediPen's business. Although this is a matter
9 that is dealt with in some of the correspondence in Appendix
10 1, there is no material on which I can rule either way on
11 these allegations and, indeed, it is not my role, nor would it
12 have been the role of the Hearing Officer to rule on any of
13 these matters. They are completely outside the scope of these
14 proceedings.

15 Mr Owen in his TM55 also asserts that he has made every
16 effort to settle these issues amicably. Again, he refers to
17 some without prejudice correspondence but, again, those are
18 not matters that I can take into account.

19 Then he talks about the research that his establishment,
20 MediPen, undertakes into non-small-cell lung cancer, and he
21 indicates that he has diverted funds to that end rather than
22 to spend money on filing evidence for the purposes of these
23 proceedings. He concludes his TM55 by saying:

24 "Although we have no intention of using the name
25 MEDIVAPOUR in the future or defending this trade mark given

1 the situation, I believe it is incredibly unreasonable for us
2 to be expected to pay any costs towards the opposing party.
3 To date we have already been forced to pay upwards of £20,000
4 on legal fees as a result of this trade mark dispute and this,
5 combined with the serious financial harm and reputational
6 damage caused by the opposing party's libellous pursuit, has
7 left us with very limited funding to support our staff and our
8 research programme. As these defamatory attacks came as a
9 direct response to our submission to the IPO, these events and
10 the attributed financial trouble it has caused us should be
11 taken into consideration when determining the award of costs.
12 If we are forced to pay any more than we already have towards
13 these proceedings, it would severely impact our business and I
14 feel this would be very unfair considering the exceptional
15 circumstances behind this case. I would therefore like to
16 request an appeal hearing following the successful receipt of
17 our TM55P and discuss the matter of costs in greater detail.
18 Should you require any further information, I would be more
19 than happy to assist".

20 In accordance with the preliminary view that I asked my
21 clerk to transmit to both parties on 23 October, and following
22 my consideration of Appendix 1, which I did not have at the
23 time of expressing that view, I am clear that these grounds of
24 appeal do not exhibit any possible ground on which I can
25 interfere with the Hearing Officer's decision, either on the

1 merits of the substantive issues or on the question of costs.

2 For those reasons I will dismiss this appeal.

3 (There followed a discussion on costs, please see separate
4 transcript).

5 I now have to deal with the costs position. In his
6 decision, Mr Morris awarded, as I have said, the Applicant the
7 sum of £2,500 as a contribution towards the costs of the
8 proceedings. Mr Muir Wood for the Respondent has given me an
9 indication of the costs incurred by his client in relation to
10 his appeal and it does not surprise me at all that they are in
11 the low thousands. Having said that, this is supposed to be a
12 lower cost tribunal and I take into account the lack of any
13 real issue raised by the appeal.

14 What I will do is I will award the Respondent the sum of
15 £500 as a contribution to its costs in the appeal. The effect
16 will be, and I will take into account the Christmas period,
17 that the Appellant, MediPen Ltd, must pay to the Respondent
18 the total sum of £3,000 within 21 days of today, i.e. on or
19 before 11 January 2019.

20 MR MUIR WOOD: I am grateful.

21 THE APPOINTED PERSON: Thank you. I think that concludes
22 everything.

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