

O-060-05

TRADE MARKS ACT 1994

**IN THE MATTER OF AN INTERLOCUTORY HEARING HELD IN RELATION TO
REVOCATION Nos: 81825 & 81826 BY HI-TEC SPORTS PLC TO REGISTRATION
Nos. 2169137 & 2144726 IN THE NAME OF ALTITUDE PROPERTIES**

TRADE MARKS ACT 1994

**IN THE MATTER OF an interlocutory hearing
held in relation to Revocation Nos: 81825 & 81826
by Hi-Tec Sports Plc to registration Nos. 2169137
& 2144726 in the name of Altitude Properties**

BACKGROUND

1. Trade Mark Nos. 2144726 and 2169137 both for the word ALTITUDE are registered in Class 25 for specifications of goods reading: “Fashion clothing” and “Sports and leisure clothing not specifically to be worn at altitude” respectively.

The marks were applied for on 12 September 1997 and 11 June 1998 respectively, and the registration procedure was completed on 22 May 1998 and 11 December 1998. The registrations stand in the name of Altitude Properties of Great Witley, Worcestershire (hereafter Altitude).

2. By applications dated 28 July 2004, Grant Spencer Caisley and Porteous (hereafter GSCP) acting as agents for Hi-Tec Sports Plc (hereafter Hi-Tec) applied for these registrations to be revoked. They did so in identical terms and on the following basis:

“2. Enquiries have been carried out which have revealed that there has been no use of the subject trade mark in the United Kingdom since the completion of the registration procedure.

3. Enquiries have shown that within the period of five years following the date of completion of the registration procedure of the subject registration the trade mark has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods for which the mark is registered, and there are no proper reasons for non use. The Applicant for Revocation hereby requests revocation of United Kingdom Trade Mark Registration number [] in accordance with Section 46(1)(a) of the Trade Marks Act 1994.

4. Enquiries have shown that the subject trade mark has not been used in the United Kingdom for an interrupted period of five years prior to 1 March 2004 and that there are no proper reasons for non-use. The Applicant for Revocation hereby requests revocation of United Kingdom Trade Mark Registration number [] in accordance with Section 46(1)(b) of the Trade Marks Act 1994.

5. The Applicant for Revocation requests that the subject registration is revoked as of 1 March 2004.

6. The Applicant for Revocation requests an award of costs in its favour”.

3. On 2 August 2004, the Trade Marks Registry served the Forms TM26(N) on the Registered Proprietor who was allowed until 2 November 2004 to file Forms TM8 and counterstatements together with either evidence of use made of the marks, or proper reasons for non-use.

4. On 12 October 2004, Industrial and Commercial Consultancy Limited of Redditch (hereafter Industrial) acting as agents for the Registered Proprietor filed Forms TM8 and counterstatements. The counterstatements provided details under the following headings: History, Use of the Mark, and Evidence of Use. Under the heading Evidence of Use, Industrial referred to material that had been provided at the same time as the counterstatements. This consisted of: (i) examples of invoices, (ii) a garment insert and an associated invoice (iii) examples of garment labels/badges and associated invoices (iv) a sample garment, (v) a catalogue and (vi) photographs showing exhibition stands and an associated invoice.

5. The Trade Marks Registry considered the totality of these documents/material and in an official letter dated 14 October 2004, responded to Industrial in, inter alia, the following terms:

“The registrar has considered the above documents and unfortunately, it is her preliminary view that the evidence of use provided does not show actual and real use of the trade mark as registered on the goods for which it is registered, or use in a form which does not alter the distinctive character of the mark in the form in which it was registered, or show proper reasons for non use. Also the evidence has not been sent in proper format i.e. a Witness Statement, Affidavit or Statutory Declaration with Exhibits.”

The parties were allowed until 28 October 2004 to request an interlocutory hearing. On 25 October 2004, Marks & Clerk filed Form TM33 to appoint themselves as agents for the Registered Proprietor and requested a hearing.

THE INTERLOCUTORY HEARING

6. On 16 December 2004, an interlocutory hearing took place before me to consider the preliminary view expressed in the official letter of 14 October 2004. At the Hearing, Ms Michelle Tew of Marks & Clerk represented the Registered Proprietor; the Applicant for Revocation was not represented at the hearing, but in reaching my decision I took into account the written submissions contained in GSCP’s letters of 14 December 2004.

THE SKELETON ARGUMENT, WRITTEN SUBMISSIONS

7. Ordinarily, I would provide here a summary of the parties’ skeleton arguments and written submissions. However, in view of the decision I took at the hearing, it is not necessary to refer to those arguments which go, as it were, to the substance of the evidence filed. In this regard, I note that the totality of the Registered Proprietor’s skeleton argument fell into this category, as indeed did the majority of the Applicant’s written submissions. That said, I note the following extract which appeared in the Applicant’s submissions:

“2. The Applicant for revocation submits that the evidence filed by the registered proprietor was not filed in an appropriate format and therefore should not be admitted into the proceedings. Rule 55 of the Trade Marks Rules 2000 (as amended) reads as follows.....”

At the hearing, Ms Tew explained that she had telephoned the Trade Marks Registry’s Law Section and received advice regarding the material filed by Industrial, and in particular, she explained that she had been advised that this material could, if the other objections to the applications were overcome, be put into the correct evidential format in due course. Obviously I was not privy to that telephone conversation and can only make a determination in these proceedings on the basis of the Trade Marks Act and the associated Rules.

THE DECISION AT THE INTERLOCUTORY HEARING

8. At the interlocutory hearing, I concluded that as the documents provided by the Registered Proprietor were not in the correct evidential format, and as the period for filing the Forms TM8 counterstatements and evidence of use was not extendable, the consequence of this failure was that the applications for revocation should succeed and that the registrations would be revoked in their entirety from 1 March 2004; I also made an award of costs to the Applicant for Revocation. On 17 January 2005, Marks & Clerk filed a Form TM5 requesting a written statement of the grounds of my decision; I give this decision below.

GROUND OF DECISION

9. For the purpose of this decision, the applicable sections of the Trade Marks Act 1994 (as amended) and the portions of the relevant rules contained in the Trade Marks Rules 2000 (as amended) are reproduced below:

Rule 31 (in relation to a request for revocation of a trade mark), namely:

“**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.”

Section 100 of the Act (in relation to the burden of proving use), namely:

“**100.** 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.”

Rule 68 (in relation to alteration of time periods) and in particular rule 68(3), namely:

“**68.** - (1) The time or periods-

(a) prescribed by these Rules, other than the times or periods prescribed by the rules mentioned in paragraph (3) below, or

(b) specified by the registrar for doing any act or taking any proceedings,

subject to paragraph (2) below, may, at the written request of the person or party concerned, or on the initiative of the registrar, be extended by the registrar as she thinks fit and upon such terms as she may direct.

(2).....

(3) The rules excepted from paragraph (1) above are rule 10(6) (failure to file address for service), rule 11 (deficiencies in application), rule 13(1) (time for filing opposition), rules 13(3) and 13(5) (time for filing counter-statement), rule 13(4) (cooling off period) save as provided for in that rule, rule 23(4) (time for filing opposition), rule 25(3) (time for filing opposition), rule 29 (delayed renewal), rule 30 (restoration of registration), rule 31(2) (time for filing counter-statement), rule 32(2) (time for filing counter-statement), rule 33(2) (time for filing counter-statement), and rule 47 (time for filing opposition).”

Rule 19 of the Trade Marks (Amendment) Rules 2004 (which amends rule 68 of the Trade Marks Rules 2000) and in particular rule 68(3), namely:

“**19.** - (1) Rule 68 (alteration of time limits) shall be amended as follows.

(2)

(3) In paragraph (3) -

(a).....

(b) for the words "rule 31(2) (time for filing counter-statement)" there shall be substituted "rule 31(3) (time for filing counter-statement and evidence of use or reasons for non-use)";

(c).....

(d)..... “

Section 69 and Rule 55 (in relation to evidence before the registrar), namely:

“**69.** Provision may be made by rules-

(a) as to the giving of evidence in proceedings before the registrar under this Act by affidavit or statutory declaration:

(b)....

(c)....”

Rule 55

“(1) Where under these Rules evidence may be admitted by the registrar in any proceedings before her, it shall be by the filing of a statutory declaration or affidavit.

(2)

(3) Where these Rules provide for the use of an affidavit or statutory declaration, a witness statement verified by a statement of truth may be used as an alternative; the Registrar may give a direction as she thinks fit in any particular case that evidence must be given by affidavit or statutory declaration instead of or in addition to a witness statement verified by a statement of truth.

4) The practice and procedure of the High Court with regard to witness statements and statements of truth, their form and contents and the procedure governing their use are to apply as appropriate to all proceedings under these Rules.

(5).....”

10. The scheme of the Act and Rules provided above, makes it clear that when an Application for Revocation is filed, the Trade Marks Registry will (having scrutinised the Application), send a copy to the Registered Proprietor. As the wording of section 100 of the Act places the burden of proving use of the trade mark on the Registered Proprietor, under the provisions of rule 31(3), the Registered Proprietor then has a period of three months from the date on which he was sent a copy of the application to file a Form TM8 and counterstatement and either two copies of evidence of use of the mark or alternatively proper reasons for non-use. If nothing is received from the Registered Proprietor, the Registrar:

“...may treat him as not opposing the application.”

11. If evidence is to be filed, the combined provisions of section 69 of the Act and rule 55 of the Rules, provides that evidence before the Registrar is by way of statutory declaration, affidavit or witness statement. In these sets of proceedings, Industrial, acting as agents for the Registered Proprietor, filed Forms TM8 and counterstatements together with a range of material mentioned in paragraph (4) above. It is clear that this material was intended to be read together with the comments contained in the counterstatement under the heading “Evidence of Use”. However, as

this material has not been provided in the format specified by section 69 of the Act and rule 55 of the Rules, it does not constitute “evidence” and as such is inadmissible.

12. Rule 68(3) of the Trade Marks Rules 2000 (as amended), lists those provisions for which no alteration of time limits is permitted. It includes the following wording:

“rule 31(3) (time for filing counter-statement and evidence of use or reasons for non-use).”

Consequently, as there is no possibility of extending the period under rule 31(3), it is not possible for the Registered Proprietor’s agents (now Marks & Clerk) to rectify the deficiency which occurred when Industrial filed the Registered Proprietor’s defence in these proceedings on 12 October 2004.

13. However that is not an end to the matter. The use of the word “may” appearing in the phrase “otherwise the registrar may treat him as not opposing the application” indicates that the Registrar still retains a discretion in such circumstances. The manner in which this discretion should be exercised has been recently considered (albeit in the context of the Trade Marks Rules 2000) by Patten J in *George Lowden and The Lowden Guitar Company Limited* [2004] EWHC 2531 (ch); at paragraph 25 of that decision, Patten J said:

“25.The discretion created under [rule 31\(3\)](#) has to be exercised on the basis that the proprietor is not entitled to defend the factual basis of the application. The Registrar must therefore consider whether the application is one which will not necessarily be granted, even if the alleged non-use is not challenged. For this purpose I think that the Registrar is entitled to look at the material filed out of time by the proprietor and to rely on it so far as it identifies reasons which could be pursued even in the light of non-use. In practice this is likely to limit any continued opposition in most cases to defects in the application which are apparent from the Statement of Grounds....”

14. Having considered the totality of the material provided by the Registered Proprietor there are no (in the words of Patten J): “..reasons which could be pursued even in the light of non-use”, and as a result the Applications for Revocation must succeed on the basis indicated above.

COSTS

15. I made the following comments in relation to costs in my letter to the parties following the interlocutory hearing:

“In so far as Costs were concerned, neither you or Grant Spencer Caisley & Porteous in their written submissions drew my attention to any special circumstances which may exist. That being the case, and having reviewed the guidance provided in Tribunal Practice Notice 2 of 2000, I order the Registered Proprietor to pay to the Applicant the sum of £1250. This sum reflects the fact that the Applicant was able to rely on substantially similar Statements of Case in both proceedings, was required to review substantially similar Statements of Case and evidence in reply and was able to file

substantially similar written submissions. It does however ensure that the Applicant is reimbursed for the statutory fee incurred on both applications and provides a contribution towards the costs incurred in the preparation of their written submissions.”

I have nothing to add to this statement.

CONCLUSIONS

16. In view of my findings above, I have concluded that:

- whilst Industrial acting on behalf of the Registered Proprietor filed Forms TM8 and counter-statements within the period prescribed by rule 31(3), they did not provide evidence of use of the marks or proper reasons for non-use (as required by rule 31(3)) in the format required by section 69 of the Act and rule 55 of the Rules;
- the period for filing evidence of use of the mark or proper reasons for non-use (under rule 31(3)) is not extendable – rule 68(3) refers;
- in the light of the guidance provided by Patten J in *Lowden* as to the scope of the Registrar’s discretion in revocation proceedings, there was no basis for me to exercise my discretion in the Registered Proprietor’s favour to allow the applications to continue as opposed;
- the consequence of my decisions is that the registrations will be revoked in their entirety from 1 March 2004;
- the Applicant is entitled to a contribution towards their costs incurred in the proceedings in the amount of £1250.

Dated this 8th Day of March 2005

C J BOWEN
For the Registrar
The Comptroller-General