

**IN THE MATTER OF APPLICATION NO. 10604 BY CELTIC PLC AND THE  
RANGERS FOOTBALL CLUB PLC  
FOR A REVOCATION OF NON-USE  
IN RESPECT OF TRADE MARK REGISTRATION NO. 1524939  
IN THE NAME OF THE VINTAGE MALT WHISKY COMPANY LIMITED**

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**Decision**

Celtic Plc and The Rangers Football Club Plc applied, on the 24 February 1999, to revoke trade mark registration number 1524939 under the provisions of Section 46(1) (a) and/or(b) of the Trade Marks Act 1994. The trade mark is The Old Firm and stands in the name of the Vintage Malt Whisky Company Limited.

Under the provisions of Rule 31(3) of the Trade Mark Rules 1994, as amended, the proprietor filed a Form TM8 and counterstatement along with documentation which it was stated demonstrated evidence of use of the trade mark in question.

Fitzpatrick's, acting on behalf of the applicant for revocation, filed written submissions claiming that the proprietor had failed to discharge its burden of proof in accordance with Section 100 of the Trade Marks Act 1994. (which requires the proprietor of a registered trade mark to show what use has been made of it when challenged in proceedings,) Murgitroyd & Co, acting on behalf of the proprietor, filed comments in response. The Registrar's provisional decision determined that the proprietor had disposed of its burden of proof.

Fitzpatrick's, sought a hearing under Rule 48(1) and this was held before me on the 28 October 1999.

The hearing considered "*the request by the applicants for revocation that the registration be revoked in full because they alleged that the proprietor had failed to file evidence of use of the Trade Mark. Alternatively, they asked that the proprietor be required to file further and better particulars in relation to use claimed*". Mr Alasdair Hume, Fitzpatrick's, represented the applicants for revocation. The proprietor was not present and was not represented.

In the event I was satisfied that the proprietor had indicated at least an intention to defend the registration in suit and that it should not be summarily revoked. Under the provisions of Rule 51 of the Trade Marks Rules 1994, I considered it right that the proprietor should be ordered to file further evidence, in support of their statement that the Registered Trade Mark has been put to genuine use in the United Kingdom. In particular that evidence was to support their statement that they had put "*considerable energy into designing commercially viable products embodied in a carefully selected mark for which registration has already been sought, designing labels incorporating the marks for the brands, and offering the brands for sale under these marks*" insofar as the Trade Mark "The Old Firm" the subject of these proceedings, is concerned. The proprietor was allowed until 28 November 1999 to comply with this order. That period was extended at the request of Murgitroyd & Co until 2 January 2000 with the agreement of Fitzpatrick's. A subsequent request for a further extension of the period for filing the additional evidence was refused. No request for a hearing on that matter has been lodged.

On 24 February 2000 the Trade Marks Registry wrote to the parties stating that in the

circumstances it was intended to issue an Order revoking the registration.

Section 69 of the Act states:-

*Provision made by the rules:-*

- (a) *as to the giving of evidence in proceedings before the Registrar under the Act by affidavit or statutory declaration;*
- (b) *conferring on the registrar the powers of an official referee of the Supreme Court as regards the examination of witnesses on oath and the discovery and production of documents; and*
- (c) *applying in relation to the attendance of witnesses in proceedings before the registrar the rules applicable to the attendance of witnesses before such a referee*

Accordingly, as the Registrar assumes the power of an official referee of the Supreme Court in relation to matters of disclosure and the production of documents required, consideration must be taken of Part 40 Rule 8 of the Civil Procedure Rules which state:-

*Orders requiring an act to be done*

- 8.1 *An order which requires an act to be done (other than a judgment or order for the payment of an amount of money) must specify the time within which the act should be done.*
- 8.2 *The consequences of failure to do an act within the time specified may be set out in the order. In this case the wording of the following example suitably adapted must be used:*
  - (1) *Unless the [claimant] [defendant] serves his list of documents by 4.00pm on Friday, January 22, 1999 his [claim] [defence] will be struck out and judgement entered for the [defendant] [claimant], or*
  - (2) *Unless the [claimant] [defendant] serves his list of documents within 14 days or service of this order his [claim] [defence] will be struck out and judgement entered for the [defendant] [claimant].*

*Example (1) should be used wherever possible.*

The Registered Proprietor in this case was given until 28 November 1999, to comply with the order for disclosure; this was extended, with the agreement of the parties until 2 January 2000.

There has been no response to the refusal of a subsequent request for an extension either by way of an appeal of that decision or an explanation as to why the requested evidence sought in these proceedings has not been delivered.

In the circumstances I consider that the defence to the application for revocation should be struck out because of the failure on the part of the Registered Proprietor to comply with the Order for disclosure.

Trade Mark Registration Number 1524939 standing in the name of The Vintage Malt Whisky Company Limited is hereby revoked with effect from the date of the application for revocation, namely 24 February 1999, in accordance with Section 46(6).

**Dated this            1st            Day of    March    2000**

**M KNIGHT  
For the Registrar  
The Comptroller General**