

O-104-05

TRADE MARKS ACT 1994

**IN THE MATTER OF AN INTERLOCUTORY HEARING
HELD IN RELATION TO REVOCATION NO. 81842
BY MIDDLESEX SILVER CO. LTD
TO REGISTRATION NO. 1434266
IN THE NAME OF ARGENTUM LTD**

TRADE MARKS ACT 1994

**IN THE MATTER OF an
interlocutory hearing held in
relation to revocation No. 81842
by Middlesex Silver Co. Ltd
to registration No. 1434266
in the name of Argentum Ltd**

Background

1. Trade Mark No. 1434266 is registered for the following as a series of 3 marks:

ARGENTUM

ARGENTUM

A·R·G·E·N·T·U·M

2. The registration stands in the name of Argentum Ltd and is registered in respect of: Cutlery, forks and spoons; pen knives and pocket knives; all the aforesaid goods being of sterling silver or being wholly or partially silver plated; all included in Class 8.

3. The registration procedure was completed on 24 January 1992.

4. By an application filed 23 August 2004, Lucas & Co acting as agent for Middlesex Silver Co Ltd, applied for the registration to be revoked. The applicant based this request on Section 46(1)(b) of the Trade Marks Act 1994 claiming that the mark had not been used in relation to the goods for which it is registered by the proprietor or with his consent during a continuous period beginning 1 July 1999 and ending 30 June 2004.

5. On 16 September 2004, the registrar served a copy of the application on the registered proprietor allowing until 16 December 2004 for filing a Form TM8, counterstatement and evidence of use to defend against the attack.

6. On 13 December 2004, Hulse & Co, acting as agent for the registered proprietor, filed a Form TM8 and counterstatement. The counterstatement referred to material that had been filed with the Form TM8 and counterstatement. This material consisted of four exhibits: (i) and (ii) copy invoices (iii) a catalogue and (iv) a care instruction leaflet.

7. The Trade Marks Registry considered all the documentation and wrote to the registered proprietor's agent by way of a letter dated 23 December 2004. This letter included the following:

“Where an application to revoke a registration is based on the grounds of non-use, the Registered Proprietor is required to file evidence of the use of the mark. This must be submitted within the period allowed to file the form TM8

and counterstatement. This is in accordance with Rule 31(3) of the Trade Mark Rules 2000 (as amended).

In the counterstatement the registered proprietor has filed exhibits showing examples of the mark as used. However, the evidence filed does not comply with Rule 55 of the Trade Marks Rules 2000 which states: “Where under these Rules evidence may be admitted by the Registrar in any proceedings before him, it shall be by the filing of a statutory declaration, affidavit or witness statement.”

Therefore, as no evidence of use have (sic) been filed within the time period set, Rule 31(3) applies. Rule 31(3) states that: “...otherwise the registrar may treat him as not opposing the application.””

8. The parties were allowed until 6 January 2005 to request an interlocutory hearing. Hulse & Co requested such a hearing by way of a letter dated 31 December 2004.

The hearing

9. An interlocutory hearing took place before me on 17 February 2005. Mr Wyand QC represented the registered proprietor, Ms Rogers of Counsel represented the applicant.

The decision

10. At the interlocutory hearing I concluded that the documentation provided by the registered proprietor was not in the correct evidential format and the period for filing the Form TM8, counterstatement and evidence of use was not extendable. I declined to exercise discretion under rule 31(3) and determined that the application for revocation should succeed with the registration being revoked with effect from 1 July 2004.

11. On 2 March 2005, Hulse & Co filed a Form TM5 requesting a written statement of the grounds of my decision. These I now give.

Skeleton Arguments

12. After setting out the background to the issue to be determined, Mr Wyand’s skeleton argument stated:

“4. Rule 31(3) provides that where a Counterstatement and evidence of use are not filed within the prescribed period the Registrar “may treat his opposition to the application as having been withdrawn.” In the present case the Counterstatement was filed in time. The Rule clearly gives the Registrar a discretion to treat the opposition as having been withdrawn or not. The discretion must be exercised judicially. To determine the circumstances in which the Registrar may exercise this discretion in favour of the proprietor of the mark attacked it is necessary to look at the purpose of the Rule.

5. The Rule is intended to give effect to Section 100 of the Trade Marks Act 1994 which provides that where “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.” To achieve this it is not strictly necessary that the proprietor should provide evidence at such an early stage of the proceedings but it was deemed appropriate for him to do so since this would avoid unnecessary time and effort being expended by the applicant for revocation where the proprietor was unable to establish any use.

6. It is clearly established that the proprietor is not required to provide full and complete evidence of the use that has been made of the registered trade mark at this early stage. It is enough to provide evidence that shows that the proprietor will be able to provide evidence to that effect.

7. In the present case the Proprietor clearly identified the use that it alleges has been made of the mark in the relevant time period. All that is missing is the formality of a witness statement or other formal document producing the documentary evidence which was annexed to and referred to in the Counterstatement. Those documents provide *prima facie* evidence of use of the trade mark within the relevant period. Exhibit 1 is a dated sales invoice within the relevant time period on the face of which the trade mark ARGENTUM is used. Exhibit 3, although undated, shows on page 3 the “Dubarry” range which is the subject of the invoice and is prominently marked with the trade mark ARGENTUM.

8. The applicant for revocation can see clearly from these documents the case that it has to meet and the documents that will be produced in support of the Proprietor’s case. In the circumstances, the Registrar’s discretion ought to be exercised to allow that Proprietor to oppose the application for revocation.

9. It is further submitted that the Proprietor’s opposition ought not to be dismissed on a technicality. Having produced the documentary evidence supporting its case relating to the use of the registered trade mark the Proprietor ought to be allowed to oppose the application for revocation on the grounds of non-use.

10. If the Registrar does not accept the above arguments the Proprietor seeks to file evidence of use confirming the facts recited in the Counterstatement and requests an extension of time under Rule 68(1). It is submitted that this is an appropriate case in which to grant such an extension because it has always been apparent to the Applicant for revocation what the Proprietor’s case would be and the evidence does no more than establish the facts set out in the Counterstatement. Rule 68(3) precludes the granting of an extension of the period for filing the counterstatement but does not preclude an extension of time for the filing of the evidence in support. Further, there is express power to give leave for the filing of evidence under Rule 31(8).

11. The Proprietor respectfully requests that either the discretion be exercised to allow the Proprietor to proceed with its opposition to the application for

revocation or that leave be given to admit the evidence confirming the facts set out in the Counterstatement.”

13. In her skeleton argument Ms Rogers submitted that the three month period allowed for the registered proprietor to file a Form TM8, counterstatement and evidence of use expired on 16 December 2004. She went on:

“4. Contrary to Rule 55 of the Rules, the evidence filed by Argentum was not sworn: That is to say, it was not filed by way of a statutory declaration, affidavit or witness statement:

5. The three month period prescribed by Rule 31(2) of the Rules is non-extendable by the express provisions of Rule 68(3) of the Rules.

6. Accordingly, Argentum should be treated as having filed no evidence in accordance with Rule 31(2) of the Rules and as having no further opportunity to do so.”

14. After setting out the provisions of rule 31(3) Ms Rogers continues:

“8. Middlesex supports the preliminary view of the Registrar, which results from the straightforward application of a clear reading of the Rules.

9. Middlesex further submits that this is not a suitable case for the exercise of the Registrar’s discretion to allow proceedings to continue.”

15. Ms Rogers then goes on to provide comments on the content of the material filed which, in view of my decision, I do not intend to summarise here. The skeleton argument concluded:

“10. Argentum bears the onus of proof as to the use to which the mark has been put (pursuant to section 100 of the Trade Marks Act 1994). The available evidence would clearly be inadequate to discharge this burden. In the circumstances, to allow Argentum to continue to defend these proceedings would serve only to delay and to increase the costs of both parties.

11. Middlesex asks to be compensated in full for its costs of the hearing, the need for which has arisen entirely through the default of Argentum or its agents.”

Grounds of decision

16. Rule 31 applies to actions for revocation of a registration on the grounds of non-use. It states:

“**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 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)

(5)

(6).....”

17. In relation to the burden of proving use, section 100 is relevant and states:

“**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.”

18. The combined effect of section 100 and rule 31 is that it is a matter for the proprietor to file evidence of use of his mark (or proper reasons for non use) with a Form TM8 and counter-statement within the period allowed, if he wishes to defend his registration which has become subject to an application for revocation on the grounds of non-use.

19. The filing of evidence is itself subject to requirements set out under section 69 of the Act and rule 55.

20. Section 69 states:

“**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)”

21. Rule 55 states:

“**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)...”

22. The provisions of the Act and rules set out above make it clear that following the filing of an application for revocation, the registry will (having scrutinised the application) send a copy to the proprietor. As the wording of section 100 of the Act places the burden of proving use of the trade mark on the proprietor, then, under the provisions of rule 31(3), the proprietor 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 or, alternatively, proper reasons for non-use. If nothing is received from the proprietor the registrar may treat him as not opposing the application.

23. If the proprietor chooses to file evidence, the combined provisions of section 69 and rule 55 requires that evidence to be filed in the form of an affidavit, a statutory declaration or a witness statement. In this case, the proprietor, through his attorneys, has filed Form TM8 and counterstatement together with exhibits referred to in paragraph 6 above. However, no affidavit, statutory declaration or witness statement was filed and the exhibits and claims made in the counterstatement do not constitute “evidence” as required by rule 31.

24. As indicated above, I was asked to grant an extension of time to allow the proprietor to file evidence of use confirming the facts claimed in its counterstatement.

25. The alteration of time limits is provided for by rule 68. This states as follows:

“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 things fit and upon such terms as she may direct.

(2) Where a request for the extension of a time or periods prescribed by these Rules –

(a)

(b) is filed after the application has been published under rule 12 above the request shall be on Form TM9 and shall in any other case be on that form if the registrar so directs.

(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).”

26. No Form TM9 was filed in line with the requirements set out in rule 68(2)(b) and therefore there was no formal request for me to consider. However, even if such a request had been made, I would have been unable to grant it. This is because rule 68(3) has been amended by rule 19 (b) of the Trade Marks (Amendment) Rules 2004 which reads:

“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(3) (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)”

and therefore precludes an extension of time for filing evidence of use.

27. The use of the word “may” in rule 31(3)- “otherwise the registrar may treat him as not opposition the application” - indicates that the registrar has a discretion to exercise where no defence is filed by the registered proprietor within the statutory period allowed. In the present case, a Form TM8 and counterstatement were filed. What was not filed, was evidence of use in the format prescribed by Section 69 and rule 55 and as required by rule 31(3).

28. In the case of *George Lowden and The Lowden Guitar Company Limited* [2004] EWHC 2531, Patten J referred to the exercise of the registrar’s discretion. At paragraph 23 he said:

“..although the Registrar clearly has a wide discretion as to how to conduct any hearings in the Registry, that does not entitle him, in my judgement, to adopt procedures which are in direct contradiction to the express provisions of the [Trade Marks Rules].”

He went on to refer to comments made in *Pharmedica GMBH's Trade Mark Application*[2000] RPC 536, at page 541, where Pumfrey J said:

“Notwithstanding the fact that the registrar is, like the county court, a tribunal which is established by statute, I have no doubt that the registrar has the power to regulate the procedure before her in such a way that she neither creates a substantive jurisdiction where none existed, nor exercises that power in a manner inconsistent with the express provisions conferring jurisdiction upon her.”

29. Rule 31(3) requires that the proprietor who seeks to defend his registration against a revocation action shall file a Form TM8 including a counter-statement and two copies of evidence of use (or reasons for non-use). Section 69 and rule 55 prescribe the form such evidence should take. Rule 68(3) precludes an extension of time for filing this material. Each of these is an express provision within the Act and rules and it seems to me that to exercise the discretion which exists under the provisions of rule 31(3) in the circumstances of this case would result in circumvention of these express provisions. I therefore declined to exercise the discretion.

30. The consequence of this decision is that the application for revocation must succeed on the basis indicated above.

Costs

31. Mr Wyand submitted that his client could not resist an award of costs. But he went on to say that the applicant had not needed to attend the hearing. Although the applicant had succeeded, their argument had not formed part of the decision.

32. For her part, Ms Rogers argued that the hearing was an inter partes one and that it would not have been fair to exclude the applicant from the hearing. In response to Mr Wyand's comments that the registrar should not make an award of costs without knowing what costs were involved, Ms Rogers indicated that she had with her a bill of costs and Mr Wyand accepted this.

33. The applicant, having been successful, is entitled to an award of costs. I ordered the registered proprietor to pay the applicant the sum of £900 which included an amount in respect of the hearing.

Dated this 18th day of April

**ANN CORBETT
For the Registrar
The Comptroller-General**