

O-110-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN INTERLOCUTORY HEARING  
HELD IN RELATION TO REVOCATION NO. 81905  
BY PANRICO S.A.  
TO REGISTRATION NO. 2114720  
IN THE NAME OF KEVIN THOMAS ROGERS**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF an interlocutory hearing  
held in relation to revocation No. 81905  
by Panrico S.A. to registration  
No. 2114720 in the name of Kevin  
Thomas Rogers**

### **Background**

1. Trade Mark No. 2114720 is for a series of two marks DONETTE and DONETTES and stands in the name of Kevin Thomas Rogers. It is registered in respect of goods and services in classes 30 and 42.
2. The registration procedure was completed on 16 July 1999.
3. By an application filed 27 October 2004, f J Cleveland, acting for Panrico S.A. made an application for the registration to be revoked. For completeness I should explain that an application to invalidate the same registration was filed contemporaneously by the same party, although the invalidation action, No. 81906, was not before me.
4. The application to revoke the registration was based on the grounds of Sections 46(1)(a) and (b) and 46(6)(b) of the Trade Marks Act 1994.
5. On 1 November 2004 the registrar served a copy of the application on the registered proprietor through their then recorded address for service, Gill Jennings & Every. The letter allowed until 1 February 2005 for the registered proprietor to file a Form TM8, counterstatement and evidence of use (or reasons for non-use) to defend against the attack.
6. On 22 December 2004 Marks & Clerk filed a Form TM33 notifying the registrar that they had been appointed as address for service for Mr Rogers. The form was typewritten and indicated that the appointment was in respect of registration No. 2114720 but, written by hand underneath the trade mark number were the words "including invalidity No 81906". As a result of the receipt of this form, the registry updated its records to show Marks & Clerk as the address for service in respect of registration No. 2114720.
7. No form TM8, counterstatement and evidence of use, or reasons for non-use, were received from or on behalf of the registered proprietor by the given date. The registrar therefore wrote to Marks & Clerk on 10 February 2005 advising that it was minded to deem the opposition to the application as withdrawn under the provisions of rule 31(3). The letter allowed until 24 February 2005 for either party to request to be heard.
8. By way of a letter dated 14 February 2005, Marks & Clerk responded in the following terms:

“Our client’s registration is in use and we request permission to file form TM8 and a counterstatement. We cannot yet do this as we do not have a copy of the TM7 (sic) and Statement of Revocation, and so we are at present unable to do so. We therefore request a period within which to do so and we also request a copy of the TM7 and statement of Revocation , so that we may do this. An action before OHIM is being held in suspension awaiting the outcome of proceedings under Invalidity 81906 which we are handling. In the event that the Registrar decides not to accede to this request we would like to be heard in this matter. A TM33 is attached.”

9. The registry responded by way of a letter dated 21 February 2005. It stated:

“Your comments have been noted, however the Form TM26(N) and statement of grounds was correctly served by the Registry to the address for service at that time. Gill Jennings & Every were the recorded address for service and the Post Office (sic) have confirmed that the Form was delivered to their address on 3 November 2004. Therefore the documents were considered to have been correctly served.

A Form TM33 was received from yourselves for this registration but not until 22 December 2004, a date after the Form TM26(N) was served.”

10. Marks & Clerk responded by way of a letter dated 2 March 2005. The letter stated:

“We do not dispute that the papers were correctly served on the address for service then current in the Register. Our letter was merely to advise you that the documents did not reach us and we are now following the document trail to see where the documents arrived.”

The letter repeated the statement that the registered proprietor wanted the opportunity to file a counterstatement.

11. A further letter was received from Marks & Clerk dated 8 March 2005. It stated:

“I have been in touch with Messrs Gill Jennings & Every who have very kindly assisted me in tracing the documentation which was sent to them by the Registrar at a time when they were the registered address for service.

I am advised that the documents for the revocation 81905 and also the invalidity action 81906 were sent together to Messrs Callaghans Solicitors who were instructing Gill Jennings & Every at that time with a covering letter on 10 November 2004. Messrs Callaghans were, at that time, not instructed by Mr Rogers but they have advised Gill Jennings & Every that they forwarded the documents to Mr Kevin Thomas Rogers at his company address.”

## **The Hearing**

12. A hearing was arranged as requested and took place before me on 23 March 2005.

Mr Hillier of Marks & Clerk represented the registered proprietor. Ms Larkey of f J Cleveland represented the applicant.

### **The Decision**

13. At the interlocutory hearing I upheld the preliminary view. No Form TM8, counterstatement and evidence of use had been filed within the period allowed. I declined to exercise the discretion under rule 31(3) to allow the registered proprietor to oppose the application. That being the case, I found the application for revocation to succeed.

14. On 11 April 2005, Marks & Clerk filed a Form TM5 requesting a written statement of the grounds of my decision. These I now give.

### **Skeleton Arguments**

15. Given that the skeleton arguments of both parties were brief, I reproduce them below in full.

#### **Registered proprietor's skeleton argument**

16. This reads:

“1. The Form TM26(N) filed by Panrico SA (PANRICO) was sent by the Registrar to the address for service at the time the documents were sent i.e. to Messrs Gill Jennings and Every (CJE). These were sent, together with documents relating to an Application for Declaration of Invalidity No. 81906, by CJE to the Solicitors from whom they received instructions, who no longer represented Kevin Thomas Rogers, the Registered Proprietor (RP), but who have advised CJE that they sent them on to the applicant.

2. The applicant contacted Peter Hillier at Marks & Clerk, who then sent a TM33 to the Registry on receipt of documents from RP relating to action 81906. That TM33 has in the handwriting of Peter Hillier a manuscript addition of the words “and Invalidity 81906”. The Hearings Clerk has confirmed that a copy of that TM33, because it relates to registration 2114770, is now in the Registry file relating to 81905. On receipt of the Registrars letter of the Registrar's letter (sic) of 10 February 2005 we filed a Form TM33 relating to Revocation 81905, which has been added to the file.

3. We did not receive the documents for 81905 so far as we are aware or Peter Hillier would have added a reference to 81905 to the TM No. 33 as well as the reference to 81906. We have searched our offices at Cheltenham and checked our computerised reminder system to see if any entry has been made for 81905 and none have been found nor have my papers relating to 81905 (save those copies recently received).

4. RP has used his mark DONETTE/DONETTES in relation to confectionery goods i.e. donuts/doughnuts in the United Kingdom and it would be unjust for him not to have the opportunity to defend his registration. As background RP

has filed an action to remove a CTM registration owned by PANRICO and has opposed a CTM application by PANRICO for the mark DONETTE based on his prior registration 2114720 in suit, which is why PANRICO have filed actions 81905 and 81906.

5. Documents have been supplied under 81906 to demonstrate to the Registrar RP's use of the mark DONETTES/DONETTES (sic) in the United Kingdom and this fact demonstrates to the Registrar that it is RP's intention to defend his registration.

6. Rule 31(B) states that on a failure by the Registered Proprietor to file Form TM8 and counterstatement the Registrar "may treat him as not opposing the application" [for revocation]. This is, we submit a provision to allow for the situation where a registered proprietor no longer trades, such that a response will not be forthcoming from that proprietor, and allows the Registrar to proceed in the absence of any meaningful reply. In the present circumstances the Registered Proprietor was not, in fact, aware of the action 81905, and we his present advisors were unaware until we received the Registrar's letter of 10 February 2005, as a result of having filed the TM33 after the receipt of papers relating only to action 81906.

7. In these circumstances we respectfully request the Register to allow the Registered Proprietor to file Form TM No. 8 and a Counterstatement and grant a period for doing so.

8. The Registered proprietor will be happy to accede to a request by the Opponent for similar consideration in the event that such is required."

17. Marks & Clerk submitted a letter on the day before the hearing which it intended to form an addition to the skeleton arguments. It reads:

"I wish to advise the Hearing Officer that we shall in addition to the skeleton arguments sent yesterday, base our argument for discretion on the precedent set by the FIRETRACE trade mark revocation (case summary 0/278/01 REV 12195/12196) in which the failure to file a counterstatement was due to reasons beyond the applicant's control and in which the proprietor requested to remain a party to the proceedings. We request that the proprietor be allowed to remain a party in these proceedings, and to file evidence in support of the registration, as has already been requested.

The wording of rules 32(2), (3) and (8) and 33(2) and (8) indicate that the Registrar has a discretion to allow a party to remain a party to the proceedings even if no form TM No. 8 and counterstatement has been filed. In that case the Hearing Officer Mr Knight directed that the registered proprietor would be allowed to file a letter response to the applications (under rule 57) and to file evidence in the proceedings. We respectfully request that the same provision be granted to our client the proprietor.

In addition, I have been trying to establish whether the papers relating to Revocation 81905 ever entered this office. At the time when the papers for

action 81906 arrived, I was somewhat distracted due to an excessive work load, coupled with concerns about the health of my elderly parents one of whom has dementia caused by a stroke. The papers would have been put initially in the new file opened for action 81906 (though I would have opened a new separate file thereafter), and a computerised reminder would have been entered in our system. I do recall that in the middle of February one of my part-time secretaries mentioned that we had a duplicate due-date entry on one of our files and an extra copy of the documents. There was at that time a file duplication on another matter. My secretary stated that we had already filed a response (which we had, on case 81906).

It is my belief after much enquiry and investigation, and I cannot substantiate it, that the papers for 81905 may have arrived, been entered in the reminder system, and subsequently the papers were mistakenly discarded as unnecessary duplicates and the “dual” reminder date removed. At present the secretary Ms Heidi Stuckey is on sick leave due to depressive illness and I am unable to ask her about this. I cannot substantiate the foregoing as there is nothing in this office to indicate that this is indeed what happened.

We apologise to the Hearing Officer for the lateness of this addition to our Skeleton arguments.”

### **The applicant’s skeleton argument**

18. This reads:

“The Applicant for Revocation is in agreement with the preliminary view of the Registrar issued on 10 February 2005, that is, that no defence has been filed by the Registered Proprietor within the prescribed period and that, as a consequence, the opposition to the application should be deemed withdrawn. We understand that the Registered Proprietor is asking for the Registrar to exercise discretion to file a counter-statement outside the period prescribed under Rule 31(3).

Our observations are as follows:

1. Our understanding is that the Registrar is prevented from granting an extension of time within which to submit the counter-statement and evidence of use, beyond the three month deadline, by Rule 68(3) of the Trade Mark Rules.
2. We do understand that the Registrar has discretionary powers with regard to treating the Proprietor’s opposition to the application as not opposing the application, under Rule 31(3).
3. However, we also understand that the Registrar’s discretion under Rule 31(3) is fairly narrow. We respectfully submit that the discretion afforded to the Registrar under Rule 31(3) cannot be exercised in the Registered Proprietor’s favour, having regard to the relevant points and having regard to the scope of discretion available to the Registrar according to current practice.

4. In their submissions of 8 March 2005, the agents for the Proprietor point out that details of usage of the subject trade mark by the Proprietor have been filed in relation to case no. 81906. These assertions have not been made in admissible format in these proceedings, within the prescribed period. Furthermore, they are unsupported assertions of use which the Applicant denies.
5. The Applicant submits that there is no procedure under the Trade Mark Rules to accept an opposition to a Revocation action by letter or by observation. Hence, the submissions filed by the Proprietor by way of their agents' letters of 2 March and 8 March 2005 should not be deemed to amount to the service of objections in these proceedings. Accordingly, we ask the Registrar to conclude that the Proprietor has not opposed the Revocation application. Further, in the absence of any defence being filed with the prescribed period, we ask that the Registrar issues a short decision on the issue of failure to comply with the Rules governing the filing of a defence.
6. The Applicant asks for a contribution towards its costs in respect of preparation for and telephone attendance at this Hearing.”

### **Grounds of decision**

19. 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 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) .....

(5) .....

(6).....”

20. 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.”

21. 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.

22. Rule 10 of the Trade Marks Rules 2000 (as amended) provides as follows:

“10. –(1) For the purposes of any proceedings before the registrar under these Rules or any appeal from a decision of the registrar under the Act or these Rules, an address for service in the United Kingdom shall be filed by-

- (a) every applicant for the registration of a trade mark;
- (b) every person opposing an application for registration of a trade mark;
- (c) every applicant applying to the registrar under section 46 for the revocation of the registration of a trade mark, under section 47 for the invalidation of the registration of a trade mark, or under section 64 for the rectification of the register;
- (d) every person granted leave to intervene under rule 35 (the intervener); and
- (e) every proprietor of a registered trade mark which is the subject of an application to the registrar for the revocation, invalidation or rectification of the registration of the mark.

(2) The address for service of an applicant for registration of a trade mark shall, upon registration of the mark, be deemed to be the address for service of the registered proprietor, subject to any filing to the contrary under paragraph (1) above or rule 44(2) below.

(3) In any case in which an address for service is filed at the same time as the filing of a form required by the registrar under rule 3 which requires the furnishing of an address for service, the address shall be filed on that form and in any other case it shall be filed on Form TM33.

(4) Anything sent to any applicant, opponent, intervener or registered proprietor at his address for service shall be deemed to be properly sent; and the registrar may, where no address for service is filed, treat as the address for service of the person concerned his trade or business address in the United Kingdom, if any.

(5) .....

(6) .....

23. Rule 44(2) states:

“(2) The registrar may at any time, on a request made on Form TM33 by any person who has furnished an address for service under rule 10 above, if the address is recorded in the register, change it.”

24. In accordance with rule 10(2), Gill Jennings & Every was deemed to be the address for service upon registration of the mark in suit. In accordance with rule 31(2) the registrar sent the copy Form TM26(N) and statement of grounds to this address for service by recorded delivery post on 1 November 2004. The registered proprietor accepts that the copy was properly served on him by the registrar sending it to this address and, as indicated in paragraph 9 above, the registry has confirmed that the copy was received by the address for service.

25. It is clear that at some unspecified date, the registered proprietor changed his address for service and Marks & Clerk took over the role. The registrar was not informed of this until some time after the copy of the application for revocation was served on the registered proprietor in accordance with rules 10(2) and 31(2).

26. What is less clear is what happened next. Marks & Clerk indicate that the registered proprietor was sent the copy direct from the original instructing solicitors (their letter of 8 March 2005 refers). They then suggest that the copy may have been forwarded to them by the former address for service but may have been destroyed after being mistakenly taken to be a duplicate of another action (their letter of 16 March 2005 refers). Whatever might have happened, it is not a matter for me to speculate upon. The fact remains that the copy notice was properly served and the registered proprietor failed to file a defence.

27. The registered proprietor, through Marks & Clerk, has asked the registrar to grant a further period to allow a defence to be filed. The alteration of time limits is a matter provided for under rule 68. This reads:

“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) Where a request for the extension of a time or periods prescribed by these Rules-

(a) is sought in respect of a time or periods prescribed by rules 13, 13C, 18, 23, 25, 31, 31A, 32, 32A, 33, 33A or 34, the party seeking the extension shall send a copy of the request to each person party to the proceedings;

(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), rule 13A(1) (time for filing counter-statement), 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(3) (time for filing counter-statement and evidence of use or reasons for non-use), rule 32(2) time for filing counter-statement, rule 33(2) (time for filing counter-statement), and rule 47 (time for filing opposition).”

28. The registered proprietor’s request for an extension of time to file his defence was not made on Form TM9 as is required by rule 68 (2)(b). Even if it had been, I would have been unable to grant such an extension as the period for filing a counter-statement and evidence of use (or reasons for non-use) is one of the periods specifically excepted under rule 68(3).

29. The consequences of failing to file a defence as set out in rule 31(3) are that the registrar “may treat [the registered proprietor] as not opposing the application.” Mr Hillier referred me to a previous decision of the registrar in the case of *Firetrace* [2002] RPC 15 and urged me to exercise discretion to allow the registered proprietor to remain a party to these proceedings.

30. The approach taken by the registrar in the *Firetrace* case has been criticised in the recent case of *George Lowden and The Lowden Guitar Company Limited* [2004] EWHC 2531. At paragraph 23 of that decision Patten J 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].”

31. 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.”

32. 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). 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.

33. The failure of the registered proprietor to file a defence was not due to reasons which were beyond his control. Marks & Clerk may or may not have received a copy of the application for revocation. As Mr Hobbs QC, sitting as the Appointed Person said in an appeal relating to revocation No. 81434, O-340-04, the registrar was entitled to accept Gill Jennings & Every as the address for service at face value. Whatever may have gone awry after the registrar served the copy of the application, the failure of the registered proprietor to file a defence stems from his failure to maintain and notify the registrar of an up-to-date address for service. I therefore declined to exercise the discretion.

34. The consequence of this decision is that the application for revocation must succeed. In the statement of grounds the applicant requests revocation of the registration in its entirety with effect from 16 July 2004. There is no evidence of use before me and I am therefore satisfied that the grounds for revocation existed at this date. The registration will be revoked in its entirety with effect from 16 July 2004.

### **Costs**

35. The applicant having been successful is entitled to an award of costs. The applicant's skeleton argument requested a contribution towards the costs involved in the preparation for and attendance at the hearing. Neither party made any submissions as to why costs should not follow the usual practice. I therefore order the registered proprietor to pay the applicant the sum of £600 as a contribution towards its costs. This sum includes an award of £100 in respect of the interlocutory hearing. This sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 26th day of April**

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