O/1138/23

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003423849

IN THE NAME OF BEN ARNOLD

FOR THE FOLLOWING TRADE MARK:

IN CLASSES 25 AND 26

AND

IN THE MATTER OF AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 504369

BY AIKON INTERNATIONAL LIMITED

BACKGROUND AND PLEADINGS

1. This case concerns an application for a declaration of invalidity by Aikon International Limited ("the applicant") against the trade mark shown on the cover page of this decision, which is owned by Ben Arnold ("the proprietor"). The contested mark was filed on 26 August 2019 and was registered on 19 February 2021. It stands registered for the following goods:

Class 25 Bathing caps; Bathing costumes; Bathing costumes for women; Bathing drawers; Bathing suit cover-ups; Bathing suits; Bathing suits for men; Bathing trunks; Beach clothes; Beach clothing; Beach cover-ups; Beach footwear; Beach hats; Beach robes; Beach shoes; Beach wraps; Beachwear; Bikinis; Caftans; Coverups; Cover-ups; Fitted swimming costumes with bra cups; Sarongs; Sun hats; Surf wear; Surfwear; Swim briefs; Swim caps; Swim shorts; Swim suits; Swim trunks; Swim wear for children; Swim wear for gentlemen and ladies; Swimming caps; Swimming costumes; Swimming suits; Swimming trunks.

Class 26 Bags [Zip fasteners for -]; Belt buckles for clothing; Belt clasp; Blouse fasteners; Buckles for clothing [clothing buckles]; Button badges; Buttons; Fasteners (Slide -) [zippers]; Zip fasteners; Zip fasteners for bags; Zipper fasteners; Zipper pulls; Zippers; Zippers for bags; Zips.

2. Aikon International Limited ("the applicant") filed its application for invalidity on 23 November 2021, relying on section 47 and sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Under section 5(2)(b) of the Act, the applicant relied on the following trade marks:

PALM
UKTM no. 723438
Filing date 4 November 1953; registration date 4 November 1953
("the First Earlier Mark")

PALM
UKTM no. 225552
Filing date 31 August 1899; registration date 31 August 1899
("the Second Earlier Mark")

3. In its Form TM26(I) the applicant claimed that the earlier marks were similar to the contested mark and registered for similar goods, resulting in a likelihood of confusion.

4. Under section 5(4)(a) of the Act, the applicant relies upon the sign PALM which it claims to have used throughout the UK since 2012 and the following sign which it claims to have used throughout the UK since 2016, both in relation to "clothing, tights, underwear, vests, long sleeved tops, camisoles, knitted clothing, thermal clothing, knitted underwear, thermal underwear, socks":

5. The proprietor filed a counterstatement denying the claims made and putting the applicant to proof of use.

6. The present invalidation action was consolidated with two revocation actions brought by the proprietor against the earlier marks relied upon by the applicant.

7. A decision was issued in this matter by Mr James Hopkins ("the original hearing officer"), acting on behalf of the Registrar, on 13 October 2022.[1] The decision of the original hearing officer dealt both with the present invalidation, and the two consolidated revocations. That decision revoked the First and Second Earlier Marks in their entirety, with effect from 29 April 1959 and 1 September 1904, respectively.

[1] BL O/889/22

The original hearing officer explained the impact of this upon the present application for invalidity as follows:

> "52. As [the proprietor's] applications for revocation against [the applicant's] registrations have been successful, [the applicant's] marks, having been revoked, were not valid registrations at the filing date of the [contested mark]. As a result, they may not be relied upon in support of [the applicant's] claim under section 5(2)(b) of the Act. Given that no other trade marks are relied upon, the application under this ground is dismissed."

8. In relation to the section 5(4)(a) ground, the original hearing officer found that the applicant did not have a protectable goodwill in relation to either sign relied upon. Consequently, the section 5(4)(a) ground failed at the first hurdle.

9. The original hearing officer's decision was subject to appeal. The grounds of appeal were as follows:

a) The Hearing Officer was wrong to find that the evidence of use filed by [the applicant] does not cover and show use of "Articles of knitted clothing and articles of clothing made from knitted piece goods, but not including bootees or slippers".

b) The Hearing Officer was wrong to find that "leggings and tights" do not fall into the category of "stockings and socks" or vice versa.

c) The Hearing Officer was wrong to state that the Wayback machine print outs at Exhibit AP7 of the [applicant's] witness statement are undated.

d) The Hearing Officer made material errors in the assessment of the evidence under section 5(4)(a).

10. The appeal decision was issued on 2 May 2023.[2] In relation to point a) the appeal was unsuccessful. In relation to point b) the appeal was successful. The result of this, is that the First Earlier Mark was revoked for non-use and the Second Earlier Mark remains registered for the following goods:

Class 25 Stockings.

The section 5(2)(b) ground of the present invalidation proceedings can, therefore, proceed on the basis of the Second Earlier Mark only in relation to the above goods.

11. In relation to point c) the appeal was successful and in relation to point d) the appeal was partially successful. The result of this was that the Appointed Person concluded that there was a protectable goodwill under the word only sign (PALM) but not the figurative sign.

12. The decision was remitted for the application for a declaration of invalidity to be considered by a different hearing officer in light of the Appointed Person's findings. It now falls to me to determine the case anew.

13. The proprietor is represented by Dynham Limited and the applicant is represented by Wilson Gunn.

14. Only the applicant filed evidence. Neither party requested a hearing, and only the applicant filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

15. The applicant filed evidence in chief in the form of the witness statement of Eddrish Adam Patel dated 22 November 2021, which is accompanied by 7 exhibits. Mr Patel is the director of a company called Ozzicozi Limited ("OZ"). OZ is owned by the

[2] BL O/0408/23

applicant and is responsible for the trading and distribution of the applicant's PALM products.

16. The applicant filed undated written submissions during the original consolidated proceedings on 29 April 2022.

17. The applicant filed written submissions in lieu, which appear to be identical to those referred to in the preceding paragraph, save for an addendum, which I have considered in full.

RELEVANCE OF EU LAW

18. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

19. Sections 5(2)(b) and 5(4)(a) of the Act have application in invalidation proceedings pursuant to section 47 of the Act. Section 47 reads as follows:

> "47. (1) […]
>
> (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-
>
> > (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
> >
> > (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a)the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered –

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five yar period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

Section 5(2)(b)

20. Section 5(2)(b) of the Act reads as follows:

"5(2) A trade mark shall not be registered if because –

(a)…

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

21. By virtue of its earlier filing date, the Second Earlier Mark qualifies as an earlier trade mark, pursuant to section 6 of the Act. As the Second Earlier Mark had completed its registration process more than 5 years before the application for a declaration of invalidity, it is subject to the use provisions in section 47(2B).

Proof of use

22. As explained in the above legislation, there are two relevant periods for assessing proof of use. The first is the period of 5 years ending with the date of the application for invalidity i.e. 24 November 2016 to 23 November 2021 ("the first relevant period"), and the second is the period of 5 years ending with the filing date of the contested mark i.e. 27 August 2014 to 26 August 2019 ("the second relevant period"). Whilst I bear in mind that the Appointed Person considered the issue of genuine use and made a finding in that regard on appeal, that assessment related to different relevant periods (being the non-use periods pleaded in the revocation actions). Consequently, I must consider the issue of proof of use anew in the context of the application for invalidity. However, in reaching my decision, I must bear in mind the Appointed Person's finding that use in relation to "tights" should also be taken as use in relation to "stockings".

23. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

> "105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

24. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" is, therefore, not genuine use.

25. I note the following from the opponent's evidence:

a) Ozzicozzi (being owned by the applicant and having responsibility for trading and distribution of PALM products) has been trading in the UK since 2016.

b) Sales of PALM branded products were over £117,000 in 2017, over £94,000 in 2018 and over £125,000 in 2019.

c) An invoice dated 29 January 2021 shows sales of 1,000 units of tights.[3]

d) A purchase order dated 26 January 2021 shows an order placed for 1,000 units of tights. I note that this relates to the same transaction as the above referenced invoice, as both display the same purchase order number.[4]

e) Photographs of various packs of tights have been provided, but these are undated.[5]

f) Brochures have been provided which show tights offered for sale.[6]

g) Products that may either be tights or stockings are visible in a photograph taken from the applicant's stand at the AIS Intimate Apparel show in February 2019.[7]

h) Tights were promoted on the applicant's website between 2016 and 2019.[8]

26. There are plainly issues with the applicant's evidence. Whilst I note sales figures have been provided, no breakdown by product type has been given by the applicant. Consequently, I have no way of knowing what proportion of those sales relate to the goods in issue; this is particularly important given that the applicant clearly sells a range of different product types. I have evidence of sales of 1,000 units of tights in January 2021. Taking into account the Appointed Person's finding regarding use in

[3] Exhibit AP1
[4] Exhibit AP2
[5] Exhibit AP3
[6] Exhibit AP4
[7] Exhibit AP5
[8] Exhibit AP7

relation to tights being acceptable to demonstrate use of “stockings”, I am satisfied that that is sufficient to show genuine use during the first relevant period.

27. However, in order to rely upon the Second Earlier Mark for the purposes of its application, the applicant must demonstrate genuine use in both the first and second relevant periods. I note that photographs of tights have been provided, but as these are undated I have no way of attributing them to either relevant period. Even if I could, they do not help in identifying the extent of the use that has been made of the Second Earlier Mark. I accept that the Second Earlier Mark (or a variant thereof) has appeared on the applicant’s website and in brochures during the second relevant period. However, again, I am unable to assess from this the extent of the use that has been made of the Second Earlier Mark. Further, the fact that a pair of tights/stocking appeared at the applicant’s stand at a trade show during the second relevant period presents the same difficulty regarding assessing the extent of the use. Taking the evidence as a whole into account, I am not satisfied that the applicant has demonstrated genuine use during both relevant periods. Consequently, it is not entitled to rely upon the Second Earlier Mark for the purposes of its application.

28. The application based upon section 5(2)(b) of the Act is dismissed in its entirety.

Section 5(4)(a)

29. Section 5(4)(a) of the Act states as follows:

> “5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -
>
> a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
>
> aa)…
>
> b) …

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

30. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

31. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

The relevant date

32. The proprietor has not filed any evidence of use. Consequently, I have only the prima facie relevant date to consider i.e. 26 August 2019.

Goodwill

33. As noted above, the original hearing officer's findings with regard to goodwill were subject to appeal. The Appointed Person found as follows in relation to the word only sign PALM:

> "In my view, the Appellant has provided sufficient evidence to establish actionable goodwill in the word sign in relation to *'clothing, tights, underwear, vests, long sleeved tops, camisoles, knitted clothing, thermal clothing, knitted underwear, thermal underwear, socks'*. The use is small, and the goodwill will be correspondingly modest, but nevertheless passes the requisite threshold."

34. I will, therefore, proceed on the basis that there is a modest (but protectable) degree of goodwill in relation to the aforementioned goods and that the sign PALM is distinctive of that goodwill.

Misrepresentation

35. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

> "There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is
>
> > "is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]"
>
> The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd*. (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

And later in the same judgment:

> ".... for my part, I think that references, in this context, to "more than *de minimis*" and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

36. *Halsbury's Laws of England* Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309, it is noted (with footnotes omitted) that:

> "To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:
>
> (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
>
> (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.
>
> While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.
>
> In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

37. As noted above, I will proceed on the basis that the applicant has a modest (but protectable) goodwill in relation to "clothing, tights, underwear, vests, long sleeved tops, camisoles, knitted clothing, thermal clothing, knitted underwear, thermal underwear, socks".

38. I accept that the parties are trading in the same or similar fields of activity. Plainly, it is common for the same businesses to sell a range of different clothing goods. The fields of activity are not identical in relation to the proprietor's class 26 goods; they are parts of clothing or bags. However, the fields of activity are plainly not entirely unrelated. It is common for the same businesses to sell bags and clothing, and it seems likely that there will be some (even if limited) overlap between businesses that sell the finished articles and parts for those goods. For example, a clothing/bag retailer might offer a repair service in the event of clothing/bags being damaged, which would include selling goods such as replacement zips/buttons.

39. The mark and sign to be compared are as follows:

Applicant's sign	Proprietor's mark
PALM	PALM

40. The applicant's sign and the proprietor's mark are both the word PALM. Whilst I recognise that the proprietor's mark is presented in a slightly stylised font, the impact of this is minimal. They are visually highly similar (at the very least). They are aurally and conceptually identical.

41. The relevant public for the goods and services in issue will be members of the general public.

42. Taking all of the above factors into account, particularly the closeness of the parties' respective fields of activity and the similarity of the mark/sign, I am satisfied that a substantial number of members of the relevant public will be misled into thinking that the goods of the proprietor are the goods of the applicant.

Damage

43. Damage through diversion of sales is easily foreseeable.

44. The application for a declaration of invalidity based upon section 5(4)(a) of the Act succeeds in its entirety.

CONCLUSION

45. The application for a declaration of invalidity against UKTM no. 3423894 succeeds in its entirety.

46. Pursuant to section 47(6) of the Act, the registration shall be deemed never to have been made.

COSTS

47. In relation to costs, the Appointed Person stated as follows:

> "56. Clearly, [the applicant] has been largely successful in this appeal. However, the utility of the appeal will depend on the outcome of the proceedings as a whole, and accordingly I direct that the costs of the Appeal be treated as incurred in the registry proceedings and dealt with by the Registrar in the usual way at the conclusion of the [applicant's] claim for invalidity.
>
> 57. The Hearing Officer ordered that the [applicant] should pay the [proprietor] £1,000. It remains to be seen who is the successful party in the underlying cross-applications, and therefore I overturn the Hearing Officer's costs order, and leave it to the Registrar to make an appropriate costs order following the determination of the s.5(2)(b) and s.5(4) invalidity applications."

48. It falls to me to determine both the costs of this invalidation application and the costs of the revocations. As the Appointed Person noted, the applicant had been successful on most of its appeal grounds. Notwithstanding that, the original hearing officer's decision was upheld in relation to the First Earlier Mark which remained revoked for non-use. The original hearing officer's decision in relation to the Second Earlier Mark was also only <u>partially</u> overturned (in relation to 'stockings'). The invalidation was remitted for further consideration, although the Appointed Person decided in the applicant's favour on the goodwill point. Consequently, it seems to me that in terms of the applicant's success in relation to the appeal proceedings overall, it enjoyed (at best) an equal degree of success with the proprietor. Consequently, I decline to make any costs award in respect of the appeal.

49. Plainly, the applicant has been successful in relation to the application for a declaration of invalidity. However, the proprietor was successful in relation to one of the revocations, and the parties enjoyed an equal degree of success in the other. As both parties have enjoyed a roughly equal degree of success overall, I direct that each party bear their own costs.

Dated this 29th day of December 2023

S WILSON
For the Registrar