

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 46843

**IN THE NAME OF THE EDGE INTERACTIVE MEDIA INC. AND THE EDGE
INTERACTIVE MEDIA LTD**

TO APPLICATION No. 2051099

TO REGISTER A TRADE MARK IN CLASS 9

IN THE NAME OF ZYE TECHNOLOGY LTD

DECISION

This is an appeal from a decision issued by Mr. G.W. Salthouse acting as Hearing Officer for the Registrar of Trade Marks on 21st October 1999.

The sequence of events, so far as material for present purposes, is as follows:

1. On 13th January 1996 Zye Technology Ltd (“the Applicant”) applied to register the designation DIGITAL EDGE as a trade mark for use in relation to “keyboards, joysticks, mice” in Class 9.

2. On 19th May 1997 The Edge Interactive Media Inc and The Edge Interactive Media Ltd (“the Opponents”) filed notice of opposition to the Application.

3. The opposition proceeded to a hearing (at which the Opponents were not represented) on 29th September 1999.

4. In his decision issued on 21st October 1999, the Hearing Officer held that the inclusion of “joysticks” in the specification of the application for registration was objectionable under Section 5(2) of the Trade Marks Act 1994. He determined that:

“the application will be allowed to proceed to registration if, within one month of the end of the appeal period for this decision, the applicants file a TM21 amending the specification to ‘keyboards and mice’. If the applicants do not file a TM21 restricting the specification as set out above the application will be refused in its entirety”.

He made no order for costs.

5. The Applicant appealed against the Registrar’s refusal to allow registration of the designation DIGITAL EDGE for “joysticks” and the Opponents appealed against the Registrar’s decision to permit registration of it for “keyboards and mice”. Both appeals were lodged on 17th November 1999.

6. The appeals were listed to be heard before me on 27th March 2000. On 21st March 2000 the agents for the Applicant wrote to the Treasury Solicitor’s Department in the following terms:

“With reference to the hearing scheduled for Monday, 27th March, we have today been advised by Baker Tilly, the Joint Administrative Receivers acting for Zye Technology Limited, that the company is in Administrative Receivership and the business and assets have been sold to Ivell Trading Limited and that any interest in the trade mark has been passed to them. The solicitors representing Ivell Trading Limited have advised that their Client does not wish to pursue this matter further and accordingly, we have no further comments.

In response to my request via the Treasury Solicitor for clarification as to the status of the pending application, the agents for the Applicant indicated that they had no instructions to comply with the Hearing Officer's requirement for the filing of a Form TM21.

7. I heard the Opponents' appeal on the 27th March 2000. Mr. Ashton appeared as Counsel on their behalf. Mr. Knight appeared on behalf of the Registrar. The Applicant was not represented. At the conclusion of the hearing I requested the Registrar to write to the Applicant giving it 28 days from the date of the hearing within which to file a Form TM21 in accordance with the Hearing Officer's decision. I reserved my decision on the Opponents' appeal to await the outcome of that notification.

8. The Applicant was notified of the time for filing the required Form TM21 in an official letter from the Trade Marks Registry dated 31st March 2000. No Form TM21 was filed. The Applicant thus failed to comply with the Registrar's requirements for acceptance of its application for registration and the application was refused in accordance with the provisions of Section 37(4) of the Trade Marks Act 1994. The Registrar's decision to that effect was communicated to the Applicant in an official letter from the Trade Marks Registry dated 28th April 2000.

By abandoning its appeal and then failing to comply with the requirements for acceptance of its application for registration, the Applicant has brought about the result that the Opponents were seeking to achieve by means of their appeal. In so doing, the Applicant has moved from a position of resistance to a position of capitulation without attempting to defend the intermediate position adopted by the Hearing Officer. That

makes it unnecessary for me to rule on the merits of the Opponents' appeal. However, the question of costs remains to be considered in relation to the two appeals.

It seems to me that the Opponents' costs of the appeals were incurred in pursuit of an outcome (refusal of the application for registration in its entirety) which the Applicant can fairly be said to have conceded by means of its acts and omissions referred to in points 6, 7 and 8 above. I think that the costs of the appeals should follow the concession. In the circumstances I will: (1) dismiss the Applicant's appeal and order the Applicant to pay the Opponents £100 as a contribution towards their costs of that appeal; and (2) make no order on the Opponents' appeal other than an order requiring the Applicant to pay the Opponents £550 as a contribution towards their costs of that appeal.

I have considered whether the Hearing Officer's decision to make no order for costs should stand in the light of the subsequent failure on the part of the Applicant to comply with the requirements for acceptance of its application.

It is to be noted that the Hearing Officer's decision specifically provided for the application for registration to be refused if the required Form TM21 was not filed. The possibility that the Applicant might not file the required Form TM21 was, therefore, within his contemplation when he decided that the costs of the proceedings in the Trade Marks Registry should lie where they fell. His decision as to costs seem to have been made on the basis that the overall result of the proceedings before him was "a score draw" (my expression, not his). I can well see why he disposed of the question of costs in the way that he did: the Opponents were largely unsuccessful and the Applicant was largely successful in terms of his determination of the various different objections raised in the

notice of opposition. Even if I had issued a decision upholding the Opponents' appeal on the more limited basis upon which it was presented by Mr. Ashton at the hearing before me, I would not have felt able to say that the Hearing Officer's order as to costs was wrong in the context in which it was made. My position remains the same in the absence of any decision to that effect.

Geoffrey Hobbs Q.C.

31st May 2000

Arthur Ashton, instructed by Messrs. Marks & Clerk, appeared as Counsel on behalf of the Opponents.

Mike Knight, Principal Hearing Officer, appeared on behalf of the Registrar.