

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN INTERLOCUTORY HEARING IN  
RELATION TO APPLICATION No. 81684 BY JIMMY OSMAN TO  
REVOKE REGISTERED TRADE MARK No. 1494192 IN THE NAME  
OF MOTOWN RECORD COMPANY LP**

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**DECISION**

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**Introduction**

1. This is an appeal against an interlocutory decision of Ann Corbett, the Hearing Officer acting for the Registrar, dated the 2 March 2005, whereby she allowed proceedings for revocation for non use to proceed despite an absence of evidence from the applicant for revocation. It was common ground between the parties that the matter fell to be determined under the Trade Mark Rules 2000 (the “2000 Rules”).
2. On 25 March 2004 Jimmy Osman (“the Applicant”) filed an application under section 46(1)(a) and (b) of the Act for partial revocation of the registered trade mark MOTOWN on the grounds of non use. Revocation was sought in respect of discotheque

services, presentation of live performances and/or orchestra services.

3. On 1 July 2004 Motown Record Company LP (“the Proprietor”) filed form TM8 and counterstatement together with evidence of use. These documents were served on the Applicant and, by letter dated 16 July 2004, the Applicant was allowed until 16 October 2004 to file evidence in support of the application. He was also notified that failure to file evidence by the due date might result in the application being abandoned under rule 31(5) of the 2000 Rules.
4. On the 6 October 2004 the Applicant wrote in the following terms:

“Please note that we will not be filing any evidence and the Applicant seeks to rely on the grounds cited in the Statement of Grounds dated 26<sup>th</sup> March 2004. We would however be prepared to file further written submissions or attend a hearing if necessary in support of the Application.”
5. The Registrar sought comments from the Proprietor. It indicated that it did not agree with the position taken by the Applicant. On the 28 October the Registry issued a letter which said:

“as no reasons have been furnished to allow the Registrar to direct that the proceedings continue absent evidence from the Applicant, the application should be deemed abandoned under Rule 31(5) of the Trade Mark Rules 2000.”
6. Following further correspondence the Applicant requested an extension of time within which to file evidence, which was refused. He also requested an opportunity to be heard.
7. A hearing was duly appointed and took place before the Hearing Officer on 13 December 2004. She exercised her discretion to

allow the application to proceed. That being so she did not go on to consider the alternative request by the Applicant for an extension of time in which to serve evidence. She was subsequently asked to provide her reasons in writing and did so on 2 March 2005.

8. On 30 March 2005 the Proprietor filed a notice of appeal to an Appointed Person. The hearing took place before me on 14 September 2005.

### **The appeal**

9. On the appeal the Proprietor contended that the Hearing Officer fell into error because she had no material before her upon which to exercise her discretion in favour of the Applicant. In particular, it was said, the Applicant had failed to provide any reasons why the application should be allowed to proceed.

10. The relevant paragraphs of rule 31 of the 2000 Rules read:

“(4) Within three months of the date upon which a copy of the Form TM8 and counter-statement is sent by the registrar to the applicant, the applicant may file such evidence as he may consider necessary to adduce in support of the grounds stated in his application and shall send a copy thereof to the proprietor.

(5) If the applicant files no evidence under paragraph (4) above in support of his application, he shall, unless the Registrar otherwise directs, be deemed to have withdrawn his application.”

11. I must also refer to section 100 of the Act:

“100.If in any civil proceedings under this Act a question arises as to the use which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

12. It is to be noted that the position under the current rules is different. Rule 31A now expressly provides that if the applicant does not file evidence the application proceeds to the next stage and the proprietor has an opportunity to file further evidence in addition to that filed at the outset under rule 31.
13. It is clear that the 2000 Rules contemplate the situation in which an applicant chooses to file no evidence. In such a case, however, the application will be deemed to have been withdrawn unless the Registrar otherwise directs. In short, the Registrar has a discretion to allow the application to proceed.
14. It was accepted by the Proprietor that the Registrar has such a discretion but, it was submitted, the Registrar must have proper grounds to exercise that discretion in favour of an applicant who has chosen to file no evidence. It was argued that it is not appropriate for the discretion to be exercised automatically and it should not be exercised in favour of an applicant who has provided no evidence or reasons to explain why the application should be allowed to proceed.
15. I agree that under the 2000 Rules a failure to by the applicant to serve evidence must result in the application being deemed to be withdrawn unless the discretion of the Registrar is exercised to allow it to continue. I also agree that the discretion must be exercised judicially and not automatically. All the relevant circumstances must be taken into account. These may be apparent from submissions advanced by the applicant or they may be apparent to the Registrar upon an examination of the facts of the particular case in issue.
16. In the present case it seems to me the following points are material. First, it is apparent from the Applicant's letter of 6 October 2004 that he had no intention of abandoning the application and wished

it to proceed. He maintained his objection that the mark had not been used in relation to the specified services.

17. Secondly, it is also apparent from that same letter that the Applicant considered that there was no evidence he could usefully file in support of the application. This was a perfectly reasonable approach to adopt. Section 100 places the onus of proving use upon the proprietor and there are many cases where an applicant for revocation of a mark for non use is not in a position to advance any relevant evidence on the issue. As the Hearing Officer noted, the purpose of evidence is to prove or disprove facts and not to provide a vehicle for submissions.
18. Thirdly, it was implicit in the letter that the Applicant maintained that the evidence of use filed by the Proprietor was inadequate. Indeed, he offered to file further submissions or attend a hearing, if necessary.
19. All these matters were taken into account by the Hearing Officer. In paragraphs 22 to 24 of her decision she said:

“22. The exercise of the discretion requires a threshold to be crossed but it seems to me that the threshold is not a particularly high one. The applicant has made it clear that it does not wish to abandon its application; that it seeks to rely on its statement of grounds; that the filing of evidence from the applicant is not mandatory; that in revocation actions the onus to show use is on the registered proprietor; that although it considers the registered proprietor’s evidence insufficient it has no fact to prove and intends to deal with it by way of written and/or oral submissions.

23. In the applicant’s opinion the evidence of use is insufficient to discharge the onus on it. Whilst it may be useful to the registered proprietor to know why the applicant holds this opinion, there is no legal requirement for the applicant to divulge its reasons at this stage.

24. Whether or not any evidence filed is challenged by the applicant, the onus remains with the registered proprietor to show what use has been made of the trade mark. It is a matter for the registered proprietor to ensure it files its best evidence. It is a matter for the applicant to decide if and if so how, it wishes to challenge that evidence. It is matter for the registrar to assess the relevance and weight of all the evidence filed, at the appropriate time.”

20. The Hearing Officer accordingly exercised her discretion to allow the proceedings to continue. But she made her decision conditional upon the applicant providing written or oral submissions in due course.

21. In my judgment no criticism can be made of the approach of the Hearing Officer or the decision she arrived at. She exercised her discretion taking into account all relevant matters. Indeed, I agree with the conclusion she reached.

### **Conclusion**

22. In the circumstances the appeal must be dismissed. Both sides requested an order for costs. This was not a particularly complex appeal. In the circumstances I direct that that the Proprietor pay to the Applicant the sum of £750 as a contribution to his costs, such sum to be paid within 21 days.

David Kitchin QC  
15 September 2005

Mr Ashmead of Kilburn & Strode appeared on behalf of the Proprietor  
Miss Mensah instructed by Lloyd Wise appeared on behalf of the Applicant