

TRADE MARKS ACT 1994

IN THE MATTER OF Trade Mark Registration N^o: 2237730 in the name of Pals4Pets Limited

and

An Application under N^o: 12448 for a Declaration of Invalidity By Mr. James Rousou.

BACKGROUND

1. The registered mark PALS4PET was applied for on 30th June 2000 by Pals4Pets Limited, PO Box 25502, London, NW7 4WR, Great Britain, for:

Class 42: “Pet sitting services; provision of pet homes; pet care services; pet grooming services.”

2. On 3rd April 2001, Mr. James Rousou applied for invalidation of this mark on the basis of s. 5(2)(b), in that he was the proprietor of an earlier mark PETPALS. In a Counterstatement the Registered Proprietor denied the grounds on the basis of an earlier right. Both parties asked for their costs.
3. The matters were heard on 21st October 2002, where the Registered Proprietor (P4P) were represented by Ms. Lane of Counsel, advised by Davenport Lyons, and the applicant (Mr. Rousou) by Mr. Hicks of Counsel, advised by Gouldens.
4. Some description of the background to this case is required, as there is also a related ‘cross-invalidation’ action initiated by the proprietors here. The chronology of these actions is as follows:

13th June 2000 PETPALS applied for by Mr. James Rousou;
30th June 2000 PALS4PETS applied for by P4P.

(Both marks were subsequently registered, it appears, without citation).

3rd April 2001 Mr. Rousou seeks invalidation of P4P’s mark (No. 12448) and
26th July 2001 P4P seek invalidation of Mr. Rousou’s mark (No. 80008).

The proceedings were to be heard on the same day: the first in the morning, the second in the afternoon. It was agreed, however, they be conducted together. Though invalidity No. 12448 was initiated before No. 80008, it seemed most logical to hear the latter first. On consideration of the possible outcomes, were the order reversed, it appeared that the ‘earlier right’ claimed by P4P was always likely to be the critical issue; further, hearing action No. 80008 before No. 12448 was least likely to avoid unnecessary multiplication of proceedings.

5. My decision in invalidity No. 80008 resulted in the invalidation of mark No. 2235947. Of course, that decision is subject to appeal, and I am thus presented with one of two courses in the matter here. I can postpone a decision until after the appeal period and any subsequent appeal or complete this decision on the basis of my findings in invalidity No. 80008. I have chosen to

follow the latter course, as the matters were heard together and are closely connected. I have no doubt that any appeal from the decision in No. 80008 will also include an appeal here.

6. Following invalidation of the Applicant for Invalidity's mark, he is no longer the owner of an earlier mark according to s. 6(1) of the Act, and his case under s. 5(2)(b) cannot be sustained.
7. The Registered Proprietor has been successful in this case and deserve's some contribution to their costs. I order Mr. Rousou to pay them £700. This sum reflects the award already made in the other matter – much of the evidence being here reproduced – and is to 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 27th Day of November 2002.

**Dr W J Trott
Principal Hearing Officer
For the Registrar, the Comptroller General**