

TRADE MARKS ACT 1994

IN THE MATTER OF OPPOSITION No. 408557

IN THE NAME OF ITV STUDIOS LIMITED, ITV BROADCASTING LIMITED, ITV GLOBAL ENTERTAINMENT LIMITED, ITV VENTURES LIMITED & CARLTON FILM DISTRIBUTORS LIMITED

TO TRADE MARK APPLICATION No. 3195835 FOR CARRY ON

IN CLASSES 3, 6, 9, 16, 21, 25, 28, 30, 38, 41, 42, 45

IN THE NAME OF CARRY ON FILMS LIMITED

DECISION

1. This is an appeal against the decision of Mr George Salthouse (“the Hearing Officer”) dated 25 January 2019 (“the Decision”) in which he allowed an opposition to the mark CARRY ON sought to be registered in classes 3, 6, 9, 16, 21, 25, 28, 30, 38, 41, 42, 45 by Carry On Films Limited (“the Applicant/Appellant”) on the grounds of bad faith under s.3(6) of the Trade Marks Act 1994.

PRELIMINARY OBSERVATIONS

2. The circumstances of the present case are somewhat unusual for two main reasons.
3. First, the Hearing Officer did not feel it necessary to determine the other grounds of opposition relied on by the Opponents/Respondents¹ under ss. 5(1), 5(2)(a), 5(3) and 5(4)(a) of the Act.
4. From what I understand from the parties at the hearing before me, he did not give any prior notice of this case management decision. Indeed, I was told that although the Opponents contended that bad faith was their strongest objection, they also submitted that it was not appropriate for the Hearing Officer to ignore the other grounds. But that is exactly what he did.
5. The Hearing Officer accordingly decided only the s.3(6) ground for reasons of procedural economy. See in this regard the decisions of Prof Ruth Annand in *airblue*

¹ ITV Studios Ltd, ITV Broadcasting Ltd, ITV Global Entertainment Ltd, ITV Ventures Ltd & Carlton Film Distributors Ltd

TM (BL O/600/18) at §65 and Geoffrey Hobbs QC in MUSLIM MATCH TM (BL O/014/19) at §12. In the former decision Prof Annand cited §23 of Arnold J's decision in *Generics (UK) Ltd v. Warner Lambert Company LLC* [2015] EWHC 3370 (Pat) [2016] RPC 16 where he explained the English notion of "procedural economy" as follows:

"...the EPC Contracting States differ not merely in their procedural rules, but also in their procedural philosophies. Thus there are different conceptions of procedural economy. The traditional English conception is that it requires the first instance court to adjudicate upon all essential points in dispute, certainly all points that require findings of fact or evaluation. In that way, if there is an appeal, the Court of Appeal is in a position to deal with any issues of law that may then arise and dispose of the case without either a re-hearing or remitting it to the first instance court. By contrast, there are many civil law jurisdictions where the view is taken that the correct approach to procedural economy is for the first instance court only to decide the issues which are sufficient to enable that court to dispose of the case, and to leave other issues undecided."

6. This paragraph was cited with approval by Lord Briggs SC in the Supreme Court in *Generics (UK) Ltd v. Warner Lambert Company LLC* [2018] UKSC 56 [2019] 3 All E.R. 95 at §§116 & 118.
7. In the light of this, whilst I do not consider that it is compulsory for a Hearing Officer always to determine all grounds arising at a hearing before him or her, under the English approach to procedural economy it is customary to do so. Moreover, if a short-cut is being considered, it would normally be appropriate to raise this with the parties in advance so that submissions can be made in relation to it.
8. I acknowledge that this may place an unwelcome burden on hard-pressed adjudicators to write longer judgments than they might otherwise consider necessary on the basis of their perception of the case before them. However, subsidiary points can normally be dealt with more briefly, especially if the reasoning relies on findings already made in relation to earlier issues. Moreover, I consider that the burden on the parties and the tribunal/court system if cases ping-pong back and forth between first instance and appellate level would normally be greater than if the first instance judge determined all issues at large in one go. I return to this topic below in the context of the present case.
9. The second unusual feature in the present case arises from the fact that at the time of the original hearing the opposition was based amongst other things on the registrations in the name of ITV Studios Ltd for the following marks:

Mark	Number	Dates of filing and registration	Classes
CARRY ON	2162140	25.03.98 19.03.99	3, 9, 16, 25, 30, 41 & 42
CARRY ON	2146670	30.09.97 16.10.98	9, 25 & 41
CARRY ON	2475818	21.12.07 15.08.08	6, 16, 21 & 41

10. However, by the time the matter came before me the majority of these registrations had been revoked for non-use at first instance, so ITV Studios Ltd's portfolio looked like this (subject to the existence of a pending appeal in respect of a limited portion of the goods and services).

Registration No. 21262140: "production, distribution of films" (Class 41)

Registration No. 2475818: "production of films; production, distribution of films" (Class 41)

11. It should be noted that the marks applied for by the Applicant in the dispute before me expressly exclude "the production, distribution and marketing of films" from the services applied for in class 41.
12. As I understand it, the Hearing Officer was told of the pending attempt to revoke the Opponents' marks but was not asked by either party to wait for that decision before reaching his own. He therefore cannot be criticised for not referring to it. I also acknowledge that even if he could have foreseen it, the resulting revocation may well have had no impact on him given that his decision was based on s.3(6). However, the fact is that the landscape before me is different to that before him, and I need to consider whether this change could have had any impact on a notional first instance decision based on the facts as they now are. Again, I will return to this below.

STANDARD OF APPEAL

13. There was no dispute as to this and I refer to the principles set out in the decision of Daniel Alexander QC, sitting as the Appointed Person, in *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17 at [52]-[55].

THE FINDINGS OF THE HEARING OFFICER

14. The Hearing Officer summarised the parties' respective position under s.3(6) as follows.
15. The Opponents'/Respondents' position as set out in their pleadings was set out in §13:
 5. "The Applicant did not conceive the trade mark CARRY ON independently and in good faith. Indeed, it is beyond reasonable doubt that The Applicant was fully aware of The Opponents' rights and activities when the application was filed. The Applicant would have been aware of the international reputation and goodwill owned by the Opponents through their promotion of the mark, including their marketing and advertising activities. ... Brian Baker is recorded as a licensee in relation to UK trade mark registration number 2162140 and UK trade mark registration number 2146670. ... It is therefore not possible that The Applicant coincidentally chose to register The Opponents' own mark, for goods and services identical or similar to those of interest to The Opponents, in a key territory of The Opponents' current and future business.
 6. Consequently it is beyond reasonable doubt that The Applicant filed an application to register CARRY ON in bad faith and The Application falls foul of Section 3(6) of the Act.
16. The Applicant's/Appellant's position was as follows. It contended that the rights to the mark CARRY ON originally belonged to a Mr Peter Rogers, who was the producer of the original series of Carry On films. It was alleged that on 19 November 2004 Mr Rogers assigned the rights in the mark to Brian Baker, who is a director of the Applicant. See §5 of the Decision.
17. The beginnings of the present dispute arose shortly before this, in 2003, when it became apparent to Mr Rogers that Carlton, ITV Studios Ltd's predecessor in title, had registered the CARRY ON marks. The Hearing Officer recorded in §9 of his decision that "*The applicant's evidence on this issue was mostly assertion.*" Nevertheless he summarised the Applicant's evidence as follows:
 9. ... In a witness statement, dated 16 March 2018, Mr Nigel Gordon-Stewart, a former Director of Carry On London Limited (predecessor to the applicant), states that on 10 December 2003 Peter Rogers (a co-director) wrote to the opponents expressing his dismay and disapproval that the opponents had registered Carry On as a trade mark without his (Mr Rogers) approval. At a meeting with a director of one of the opponent companies Mr Gordon-Stewart states that he asked a director of one opponent company, Mr Rupert Dilnott-Cooper, why and under what authority the

trade mark applications had been made. It is claimed that Mr Dilnott-Cooper responded that he had “land grabbed it”, explaining that the Carry On merchandising was worth a lot of money to his company and so they had decided to protect the revenue source by way of a trade mark. At the same meeting it was agreed that the opponents would grant Carry On London Limited a licence to use the mark to make a Carry On film.

- 10 In a witness statement, dated 14 March 2018, Mr Brian Baker, a director of the applicant company contends that the Carry On film franchise was created by Peter Rogers, who subsequently assigned all rights in the franchise to him [Mr Baker]. He states that the opponents have been involved in the distribution of the Carry On films but owned no rights beyond those connected with the distribution of the films. The films were produced by two companies, neither of which is involved in the instant case.”
18. The Hearing Officer went on to record the Applicant’s position as being that although Carlton had registered the CARRY ON marks, there was nevertheless an understanding that this was limited to the licensing and merchandising of the original 18 films owned by Carlton, and not new productions. As such, the Applicant asserted that Carlton did not make any demands from the producers of a then proposed new film in the franchise, Carry On London (which included Peter Rogers), since it would not be keeping with the spirit of an earlier agreement between Rank, the original distributors, and Peter Rogers.
19. Nevertheless, as a result of Carlton’s registration of the marks, those involved in the making of Carry On London sought confirmation that they could proceed with its production. The Hearing Officer recorded Mr Barker’s evidence on this point in §11 as follows:

“...Peter Rogers and I were being pressured continually to enter into a formal agreement with Carlton/Granada. By 2006, around half a million pounds had been raised to finance CARRY ON LONDON. Since Peter Rogers and I feared losing this and any future funding, I decided somewhat reluctantly to enter into an agreement with Carlton by means of which Carlton would be obliged on written request from me to grant me a licence to use the registered trade marks in respect of the production of feature films. This was not because I doubted my own entitlement to ownership of the CARRY ON name, but solely because I did not want to lose the funding for the film being promised. See "Exhibit BFB15" and clause 2.2 of that Agreement in particular.”

And:

“On 13 September 2016, following a written request from me, ITV Studios Limited did provide me with a licence to produce, distribute and market a film including the name CARRY ON (“Exhibit BFB16”).”

20. The Hearing Officer then proceeded to summarise a number of exhibits to the Applicant’s evidence in his §12, the most relevant to his decision being:

“BFB3: This consists of three letters:

- a) 14.09.2000 Letter from Gary G. Goldberger, VP of Carlton America to in which Goldberger recognises that Carlton does "not control the remake rights" to CARRY ON.
- b) 18.09.2000 Letter from Dilnott-Cooper to Peter Rogers attaching a copy of Goldberger's 14.09.2000 letter.
- c) 28.07.2003 Letter from Rupert Dilnott-Cooper, Director of Carlton Communications Limited to the Telegraph observing that "Carlton has never owned remake or sequel rights in CARRY ON Such rights were retained by Peter Rogers". I note that the letter also refers to the trade marks registered and the fact that Carlton has licensing and merchandising rights.

...

BFB6: A copy of a letter from Carlton to The Telegraph newspaper, following an article in the paper. Mr Dilnott-Cooper, the author of the letter, states:

“Following our relaunch of these films internationally, Carlton has the registered trademark [sic] in "CARRY ON" and we handle the licensing and merchandising in the UK.

However, Carlton has never owned the remake or sequel rights, which were retained by Peter Rogers, the driving force behind the original classic series of "CARRY ON" films. While we could technically seek to safeguard the use of our trade mark, it wouldn't be in keeping with the spirit of our deal with Rank and accordingly Peter Rogers, or anyone authorised by him, does not need to seek our blessing as he sets about making Carry On London. We wish Peter nothing but the best with his new project.”

...

BFB9: A copy of the license, dated 19 November 2004, between Mr Rogers and Mr Baker. It states:

“1. You assign to Brian Baker with full title guarantee absolutely free from all encumbrances all goodwill and all other rights of a like or similar nature (whether now or in the future created) which you have in the “Carry On” mark and concept (including all vested, future and contingent rights thereto) together with all rights and

powers arising or acquired therefrom including the right to take legal action for damages”

...

BFB15: A copy of a license between Mr Baker and Carlton Communications Ltd, dated 6 April 2006 which grants Mr Baker the right to use the Carry On marks (2146670 & 2162140) in relation to the production of feature films.

BFB16: A copy of a license, dated 13 September 2016 between Mr Baker and ITV Studios Ltd which allows Mr Baker to use the trade marks in respect of “all aspects of production and distribution of the first of six proposed films and its marketing”. The agreement is in relation to all three of the opponents’ trade marks.

BFB17: A copy of a license which replaces BFB9. It substitutes Carry On Films Limited instead of Mr Baker in the agreement.

21. Having summarised the evidence and arguments in this way, all of the Hearing Officer’s reasoning can be found in his §16, which I set out in full below:

16) In his usual eloquent manner Mr Moody-Stuart reminded me at the hearing that the license obtained by his client related only to the production of feature films and that the services covered by the license were deliberately left out of the application as the applicant already had a right to use the mark upon these services. He also reminded me that the license was only obtained at the instance of various financial backers who wished to have every “i” dotted and “t” crossed so as to ensure that no legal issues could hold up the project. I accept these points and also accept that the applicant was clearly of the view that the opponents had obtained the trade mark rights through underhand means, the so called “land-grab”. Whilst I accept that Mr Rogers believed that he owned all the rights to the mark “Carry On” it is not clear quite why he believed this. It is claimed, and not disputed, that he was one of the producers of the earliest films and was involved in all the Carry On films. He probably became almost synonymous with the mark as he was ever present. However, this does not mean that the rights to the mark rested with him. The rights to films usually resides with the production company or the studio. To my mind, it is not clear that Mr Rogers had any rights to license or bequeath. I note particularly that Mr Baker describes Mr Rogers as being as a businessman who was “extremely commercial and open in his thinking with respect to how the brand could be exploited to achieve this and to broaden its appeal and aware ness”. Yet despite this and his obvious annoyance at the marks being registered by the opponents, Mr Rogers, and later Mr Baker, never once launched the obvious legal challenge to have the trade mark registrations deemed invalid. Even in the current action no attempt has been made to challenge the validity of the opponents registrations despite the applicant clearly being aware of the possibility of an invalidity action through the Registry. Instead of

challenging the opponents rights, the applicant sought a license, thereby legitimising the registrations. If a business truly believed that they had the law on their side they would not go cap in hand to the opponent and seek permission to use what was rightfully theirs, or so they believed, in the first instance. The applicant has made no secret of the fact that it was fully aware of the trade mark registrations of the opponents, but because it felt these were falsely obtained it believed it perfectly acceptable to submit its own applications which to a large extent duplicate those of the opponents. To do this, yet negate to directly challenge the validity of the opponents' marks (which would require the applicant to prove its claim to the rights in the mark), is, to my mind, the absolute antithesis of reasonable behaviour. As such the ground of opposition based upon section 3(6) is wholly successful.

22. He concluded in §17 that his determination under section 3(6) was “*so clear cut there is no need to consider the remaining grounds as they do not materially improve the opponents' position, being far weaker relying as they do upon proof of use and goodwill and reputation which has been only sketchily covered in evidence.*”

THE APPEAL

23. The Applicant made no criticism of the Hearing Officer's summary of the law. He relied on the eight principles set out by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch), which can be summarised as follows (with citations omitted):
- (a) the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date;
 - (b) later evidence is relevant if it casts light backwards on the position as at the application date;
 - (c) a person is presumed to have acted in good faith unless the contrary is proven and so it is not enough to prove facts which are also consistent with good faith;
 - (d) bad faith includes not only dishonesty, but also ‘some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined’;
 - (e) the provisions against bad faith are intended to prevent abuse of the trade mark system. There are two main classes of abuse - abuse vis-à-vis the relevant office and abuse vis-à-vis third parties;
 - (f) the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case;

- (g) the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry;
- (h) consideration must be given to the applicant's intention at the time of filing, including whether an applicant is intending to prevent a third party from entering the market.
24. The Court of Justice has recently handed down judgment in case C-104/18P *Koton*. In this decision the Court emphasised a number of the principles relevant to the law of bad faith. In particular, it stated as follows (emphasis added):
47. The intention of an applicant for a trade mark is a subjective factor which must, however, be determined objectively by the competent administrative or judicial authorities. Consequently, any claim of bad faith must be the subject of an overall assessment, taking into account all the factual circumstances relevant to the particular case (see, to that effect, judgment of 11 June 2009, *Chocoladefabriken Lindt & Sprüngli*, C-529/07, EU:C:2009:361, paragraphs 37 and 42). It is only in that manner that a claim of bad faith can be assessed objectively.
25. Notwithstanding the Hearing Officer's correct citation of the relevant principles, the Applicant submitted that the Hearing Officer had wrongly applied factors (c), (f) and (g) above in particular. This was the first ground of appeal. The Applicant suggested that the Hearing Officer failed to apply the legal principles correctly because he did not take into account all relevant factors, his reasoning was flawed and he failed to apply the test of objective standards of honesty to the matters within the applicant's knowledge (ground (g) above).
26. In particular the Applicant submitted that it was relevant that it had applied (successfully) to revoke the earlier registered marks for non-use. Further it relied on its honest belief that it was entitled to the CARRY ON mark and that the Opponents had obtained it by way of land-grab, and suggested that the Hearing Officer had pre-judged that this was incorrect in law instead of asking whether the Applicant's belief would objectively justify the application.
27. I think there is something in both of these points. The Hearing Officer found that *"the applicant was clearly of the view that the opponents had obtained the trade mark rights through underhand means, the so called "land-grab"*. It was this state

of mind which needed to be judged objectively. If the Applicant was right about this (and I expressly make no findings either way on this point), then that might negate a finding of bad faith.

28. Furthermore, having made this finding, the Hearing Officer sought to dilute it by first doubting the legitimacy of Mr Roger's belief ("*it is not clear quite why he believed this*"... "*it is not clear that Mr Rogers had any rights to license or bequeath*") and then focussing on the Applicant's failure to challenge the validity of the marks. But the former point appears to pre-judge the very dispute between the parties (again, upon which I make no findings) and the latter ignores the fact that the Applicant has subsequently successfully revoked the majority of the Opponents' marks, at least at first instance. In particular, it is no longer necessarily correct that the marks applied for "*to a large extent duplicate those of the opponents*", as the Hearing Officer found in §16 (depending on a proper assessment of the date of revocation and the date of application for the mark, again upon which I make no finding). Of course, the Hearing Officer could not have been aware of this latter point when he made his decision, but had he known about it he may not have reached the conclusion he did.
29. The Opponents submitted that I could ignore the middle of the Hearing Officer's §16 where he doubt's the basis for the Applicant's belief, but I do not think it is fair to start salami slicing the reasoning of the Hearing Officer in this way. Moreover, the fact that I was asked to ignore the middle part of the only paragraph containing his reasoning might suggest that he has gone wrong somewhere, and that in itself is reason to review his overall conclusion.
30. The Opponents further submitted that the Hearing Officer was correct to conclude that the application for the present marks by the licensee of the Opponents was not in accordance with acceptable commercial behaviour and sought to draw parallels with s.60 of the Act. The Opponents may ultimately be correct in this assertion, but I do not think it was safe for the Hearing Officer to rely on this point without making an overall assessment of the dispute including the other relative grounds relied upon.
31. The second ground of appeal was related to the first in that the Hearing Officer had over-emphasised the Applicant's failure to apply to invalidate the Opponent's marks, and also wrongly attributed the rights to films to the production company or studio. I have dealt with the first point already and also consider that the second point is a valid criticism. I do not consider that the Hearing Officer was entitled to consider the general practice in the field without such evidence before him. Further there was evidence before him, which he did not consider in detail, as to the precise

arrangements alleged to have been made in relation to the Carry On marks. He ought to have made findings on this evidence rather than basing his decision on “general practice” when there was no evidence of the latter.

32. The third ground of appeal was that the Hearing Officer should have determined the bad faith ground at the same time as considering the relative grounds. I have considered the general principle of procedural economy above. When applied to the facts of this case I do not think this is an opposition in which it was sensible to determine the s.3(6) ground divorced from the other relative grounds. Without deciding any of the points, I consider it highly possible that there may be an interaction between the various findings, especially in the different landscape following the revocation decision. Even if the relative ground findings were to reinforce the conclusion of bad faith, I consider that it is fairer on both parties and in the greater interests of justice overall for all the issues to be determined together.
33. The Opponents referred me to Joined Cases T-3/18 and T-4/18 *Holzer y Cia v EUIPO (ANN TAYLOR)* for the proposition that it is not necessary to determine the relative grounds when there is a bad faith objection. There the General Court held (Opponents’ emphasis):

55 Furthermore, it is important to note that contrary to Article 60 of Regulation 2017/1001, which lists the grounds for the relative invalidity of a European Union trade mark and thus seeks to protect the private interests of the holders of certain prior rights which conflict with the trade mark in question, Article 59(1) of that regulation, which provides, in particular, that the applicant’s bad faith when filing a trade mark application constitutes a ground for absolute invalidity, is intended to protect the general interest. Therefore, **the assessments which are relevant in order to establish whether one of the grounds of relative invalidity above existed are not necessarily applicable to a finding of the existence of bad faith** (see, to that effect and by analogy, judgment of 22 October 2015, *BGW*, C-20/14, EU:C:2015:714, paragraphs 23 to 34).

56 In particular, **the applicant for a declaration of invalidity invoking bad faith cannot be systematically required to establish the existence of a likelihood of confusion, within the meaning of Article 8(1)(b) of Regulation 2017/1001**, between the earlier trade mark of which he is the owner and of the contested mark. As EUIPO and the intervener noted at the hearing, **doing so would largely deprive the provisions of Article 59(1)(b) of Regulation 2017/1001 of their effectiveness**. Moreover, those provisions, which are intended to protect the public interest, may be relied on by any natural or legal person and not only by holders of prior rights.

...

60 ...for reasons similar to those mentioned in paragraphs 55 and 56 above, **while the reputation of an earlier sign in the European Union may, depending on the circumstances of the case, constitute a relevant factor for the assessment of bad faith, the applicant for a declaration of invalidity who relies upon that ground cannot be required systematically to establish such a reputation, in line with what is required of the applicant for a declaration of invalidity relying on the conditions of Article 60(1)(a) and Article 8(5) of Regulation 2017/1001.** In particular, as recalled in paragraph 35 above, bad faith underpins the applicant's intention at the time of filing the trade mark at issue. However, as noted by the intervener at the hearing, the possible impacts of the use of that trade mark on the reputation of an earlier mark are not necessarily relevant.

34. This was further explained in the recent *Koton* decision where the Court held at §56:

56 For the reasons set out in paragraphs 52 to 55 of this judgment, it must be held that, in the absence of any likelihood of confusion between the sign used by a third party and the contested mark, or if there has been no use, by a third party, of a sign identical with, or similar to, the contested mark, other factual circumstances may, depending on the circumstances, constitute relevant and consistent indicia establishing the bad faith of the applicant.

35. I accept all of these propositions, but they go no further than demonstrating that the relative grounds objections may be of no assistance to the Hearing Officer who has to decide the bad faith grounds. That may be the case in the present dispute, but I am simply not in a position to decide that in the absence of any relative ground findings. The jurisprudence certainly does not suggest that the relative grounds objections are never of relevance to a plea of bad faith – indeed the General Court expressly accept that they may be relevant. If anything *Holzer y Cia v EUIPO (ANN TAYLOR)* supports the Applicant and not the Opponents in the appeal before me.

36. Finally the Applicant submitted that even if the Hearing Officer was entitled to consider bad faith on its own, he should have done so on the assumption that the other relative grounds had failed. I am not sure there is anything in this point given the Hearing Officers conclusions in his §17 quoted above, but that does not matter given my earlier conclusions.

37. The Opponents relied on two grounds by way of Respondents' Notice, each seeking to bolster the Hearing Officer's findings by reference to the weakness of the invalidity attacks on the Opponents' marks which were never brought. I do not see how these can assist the Opponents, as they appear to prejudge the basis of the dispute about who was entitled to the marks in the way that I consider is not possible without also

determining the relative grounds. Indeed, if anything the suggestion that an invalidity attack would be statute barred (the second Respondent's Notice point) could be said to be to be a point in favour of the Applicant, because it explains why no attack has been made (at least in recent years).

CONCLUSION

38. In conclusion, I consider that the Hearing Officer was wrong to come to a conclusion on the s.3(6) grounds without also considering the relative grounds. Further, the landscape has shifted since his decision, and this might have made a difference to his conclusion had he applied the correct principles in the context of the case as a whole.
39. I am conscious that I should be cautious to set aside the conclusion of an experienced Hearing Officer, reached in the light of a matrix of factual findings. However, in the present case I am satisfied that the Hearing Officer did not have in mind all the relevant material available to him when he reached his decision. Putting aside the procedural considerations I have referred to above, although it may not be necessary to have in mind the other objections to the validity of a particular trade mark when considering a bad faith objection, I consider that in the present case the Hearing Officer was wrong not to do so. It is therefore not safe to conclude that the Hearing Officer based his decision on "*all the factual circumstances relevant to the particular case*", per *Koton*.
40. I consider that the safest way to proceed is to remit the whole matter back to first instance, to be heard by a different Hearing Officer, who will determine all the grounds together, including bad faith, afresh. This should preferably take place after the determination of any appeal in the non-use application.
41. I should emphasise that I have not reached any conclusion as to whether the marks were or were not applied for in bad faith, because I am not in a position to do so and consider that it would be wrong for anyone to do so in the present case without accompanying findings across the scope of the grounds of opposition and in light of the revised specifications of the Opponents' marks. Indeed, I have deliberately sought to avoid commenting on the submissions before me which might have required me to take a position on the arguments which might arise on the restored hearing. Accordingly nothing in this decision should be read as binding the future decision of the Hearing Officer in any way.

42. I therefore keep an entirely open mind in relation to the overall result of the Opposition. As a result, the costs of this appeal should be reserved pending the outcome of the Opposition as a whole.

Thomas Mitcheson QC
The Appointed Person

The Applicant was represented by Tom Moody-Stuart QC instructed by Stevens Hewlett & Perkins LLP

The Opponents were represented by Guy Hollingworth instructed by Boulton Wade Tennant LLP

The Registrar took no part in the Appeal.