

SUPPLEMENTARY DECISION

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION No. 3281886 FOR THE TRADE MARK

EvacMAT

STANDING IN THE NAME OF

EMERGENCY EVACUATION EQUIPMENT AND TRAINING (3ET) LIMITED

AND

IN THE MATTER OF A REQUEST FOR A DECLARATION

OF INVALIDITY THERETO UNDER No.502110 BY PAINTCRAFT LIMITED

BACKGROUND

1) On 22 August 2019 I issued decision O-493-19. The invalidity action under Sections 3(6) and 5(4)(a) were successful. I gave both parties time to provide submissions on costs as both sought costs off the scale. Both parties provided their submissions within its allotted time.

2) Emergency Evacuation Equipment and Training (3ET) Limited (hereinafter 3ET) accepted in its submissions that Paintcraft Limited (hereinafter PL) was entitled to a contribution to its costs, but within the normal scale. 3ET first referred me to *Rizla's Application* [1993] RPC 365 which states:

“I believe a case such as the present can only be regarded as exceptional if it can be shown that the losing party has abused the process of the Comptroller by commencing or maintaining a case without a genuine belief that there is an issue to be tried. In my view, this is not shown to be such a case. There are of course a large number of other circumstances such as deliberate delay, unnecessary adjournments etc where the Comptroller will be entitled to award compensatory costs, but it is unnecessary to attempt to define what is clearly a wide discretion.”

2) 3ET then pointed out that the case quoted by PL O/409/18 *TRUMP TV* was not on all fours with the instant case as in that case the losing party had no bona fide belief that its defence was soundly based; the losing party had a well-evidenced pattern of abusive behaviour in previous proceedings

before the IPO; and there was no evidence that it had any intention of using the mark. I agree with the view that this earlier case had significant differences to the instant case.

3) For its part PL submitted, that Mr Wilson, the controlling mind behind 3ET, acted as a consultant for PL in the development of the EVACMAT product and brand in 2013. Also that Mr Wilson subsequently set up a rival business selling a similar product under the same name to the customers of PL, and having applied for the mark unbeknownst to PL, then proceeded to send a cease and desist letter within days of being granted the registration. However, to my mind, this does not rise to the level of unreasonable behaviour and I therefore decline to award costs off the scale.

4) PL are entitled to a contribution towards their costs as set out below:

Preparing a statement and considering the other side's statement	£200
Expenses	£200
Preparing evidence and considering the other side's evidence	£1000
Attendance at a hearing	£1200
TOTAL	£2,600

5) I order Emergency Evacuation Equipment and Training (3ET) Limited to pay Paintcraft Ltd the sum of £2,600. This sum to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of October 2019

George W Salthouse
For the Registrar,
the Comptroller-General