

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2159240 BY
ANDREAS KYRRIS TO REGISTER A TRADE MARK
IN CLASS 42**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO 50152 BY JOINT OPPONENTS, NAMELY
UNILEVER PLC AND BIRDS EYE WALLS LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2159240 by
Andreas Kyrris to Register a Trade Mark
in Class 42**

And

**IN THE MATTER OF Opposition Thereto
Under No 50152 by Joint Opponents, Namely
Unilever Plc and Birds Eye Walls Limited**

BACKGROUND

1. On 25th February 1998, Andrews Kyrris of Nottingham, England (“the applicant”) applied to register the following trade mark in class 42.



2. The trade mark was applied for in a number of colours, but nothing hangs on that.
3. The application was accepted and published for the following specification of goods:

“Catering services for the provision of food and drink”

4. On the 9th September 1999, Unilever Plc and Birds Eye Walls Limited (“the opponents”) filed notice of opposition. The grounds were based on Sections 3(4), 5(2)(b), 5(3) and 5(4)(a) of the Act, but later a ground under Section 3(6) of the Act was added.

5. On the 23rd December 1999, the applicant filed a counterstatement, which in essence denied each of the grounds of opposition. He objected to the late inclusion of the Section 3(6) ground, but the Trade Marks Registry took the view that it should be included; the applicant did not seek a hearing on the issue and did not file an amended statement of grounds.

6. Subsequently, after the evidence rounds the opponents asked to withdraw the Section 3(6) ground. The applicant strongly opposed this request, but after consideration, the Trade Marks Registry agreed to the withdrawal. However, the opponents were informed that the fact that this ground had first of all been admitted late into the proceedings and had then been subsequently withdrawn by them after the evidence rounds, would be brought to the attention of the Hearing Officer when the case came to be decided. I duly note these facts and will deal with them later in my decision.

7. Both sides sought an award of costs in their favour.

8. In accordance with the Trade Mark Registry's practice, I reviewed the case and informed the parties that I did not consider it necessary for an oral hearing to be held in order that the matter could be decided. Both parties agreed with this approach, directly in the case of the opponents, who through their Agents, Castles, supplied written submissions and tacitly in the case of the applicant, who did not respond to my letter informing him that it was my view that this case could be decided on the basis of the pleadings and evidence filed. In the case of no response, I had stated that I would proceed as I had suggested.

9. In the written submissions referred to above, the opponents relinquished their pleading under Section 3(4) of the Act. In essence then, the remaining grounds they wish to pursue are under Section 5(2)(b), 5(3) and 5(4)(a) of the Act.

10. In the statement of grounds, Unilever Plc say they are the proprietors of trade mark registration Nos 1321108, 2030194, 2030236, 1176859, 1206600, 2127986 and 2183662, details of which are annexed to this decision. They add that these registrations are similar to the application in suit and cover goods which are similar to the services of the application, such that there exists a likelihood of confusion between the marks, including a likelihood of association. That is the Section 5(2)(b) ground.

11. The remaining grounds under Section 5(3) and 5(4)(a) are dealt with in the statement of grounds is no more detail than can be found in the wording of the relevant provisions of the statute.

12. The applicant did no more than deny all the grounds in his counterstatement.

THE EVIDENCE

Opponents' Evidence

13. The opponents filed a statutory declaration by Christopher Charles Pomfret, the Business Director for Frozen Foods of Birds Eye Walls Limited (BEW) dated 13 June 2000. BEW is said to be a wholly-owned subsidiary of Unilever Plc which is its ultimate parent and registered proprietor of all the United Kingdom trade mark registrations cited in the statement of grounds. BEW and Unilever are the joint opponents in these proceedings.

14. Inter alia, the following relevant claims and facts emerge from Mr Pomfret's statutory declaration and exhibits:

- (a) BEW has an annual turnover of £640m, approximately two thirds of which (in 1999) were attributable to frozen food sales.
- (b) The CAPTAIN BIRDS EYE and CAPTAIN trade marks are some of BEW's leading brands in its fish range, which is a substantial sector of its business.
- (c) The CAPTAIN BIRDS EYE character was invented by BEW in 1967 and is also known as "THE CAPTAIN" or "CAP'N". The CAPTAIN and CAPTAIN BIRDS EYE brands have been used throughout England, Scotland, Wales, Northern Ireland and the Isle of Man in relation to fish products since that date, except for a period between June 1971 to July 1974. It has been in continuous use since then.
- (d) The popularity of the CAPTAIN BIRDS EYE figure initially used on "fish fingers" is claimed to be responsible for expanding and developing the frozen fish market in the United Kingdom. BEW's CAPTAIN BIRDS EYE share of the United Kingdom premium frozen fish finger market alone in terms of value are given as (eg) 74.4% in 1991, 78.3% in 1992, 76.2% in 1996 and 67.9% in 1998.
- (e) The Captain Birds Eye character was reintroduced in July 1974, sometimes accompanied by the title "THE CAP'N" or "CAP'N BIRDS EYE". Exhibits show some of this packaging (1974-1984). I note that whilst the image of "an archetypal seafaring captain" can be seen in abundance on this packaging, none of these images is in the form shown in trade mark Nos 2030194 or 2030236, although arguably recognisable as the same.
- (f) In 1984, BEW extended use of the character to a wider range of fish products than just 'fish fingers'. THE CAPTAIN'S TABLE range of packaging is exhibited along with that showing CAPTAINS BIRDS EYE fish product packaging from 1994 onwards. Again the images do not correspond identically with the registered forms of the image, but are in my view recognisable as such.

- (g) THE CAPTAIN brand in a number of versions has been put to use on a range of specific individual fish products from 1967 to date. The image of THE CAPTAIN has been long-running in terms of advertising, and examples are exhibited of unprompted comment and publicity about the character and advertising campaigns surrounding it, from 1978-1995.
- (h) THE CAPTAIN brand has been advertised on television since 1967. Advertising also took the form of national press coverage in newspapers such as The Daily Mail, The Sun, The Daily Express and Today and examples of such from 1970 - 1992 are provided. Spend on media advertising in support of BIRDS EYE fish fingers sold by reference to THE CAPTAIN in the United Kingdom since 1968 is given as (eg) £263,200 in 1968, £645,200 in 1978, £1,514,000 in 1988, to £2,918,000 in 1996. Total spend in the period 1968-1998 is £32,085,500.
- (i) Examples of estimated volumes (in litons) of products sold by reference to THE CAPTAIN or CAPTAIN BIRDS EYE are given as 12,871 in 1987, 15,726 in 1989, 13,099 in 1992 and 14,161 in 1998.

15. The rest of Mr Pomfret's statutory declaration consists of his opinions.

16. The opponents also filed a statutory declaration by Stephen Michael Reese, a solicitor with the firm of Eversheds dated 21 June 2000. The statutory declaration describes in some detail a survey conducted by two trainee solicitors at the firm in order to establish whether the word CAPTAIN (solus) "is recognised as indicting fish, fish fingers or Birds Eye". I will refer to it as necessary later in my decision, but the survey was carried out on Thursday 30th May 2000 in the Charing Cross and Covent Garden areas of London, amongst 50 or so people selected at random by the interviewers as being "a reasonable cross section of the public including a cross section of ages". The interviewees were shown a series of "prompt cards" containing five different military ranks including that of Captain. The cards are exhibited along with the questionnaire used. The procedure for questioning is described in the statutory declaration as is the deponents interpretation of the results of the survey. Exhibited too are the completed questionnaires and tabulated results.

17. The third statutory declaration by the opponents is by David William Lake, a Director of Farncombe International Limited, who I take to be a firm of Private Investigators employed by the opponents to investigate the business of the applicants in these proceedings. In my view, the intention of this evidence was to address only the Section 3(6) pleading, which was subsequently withdrawn. I pay it no further heed. The same applies to the statutory declaration of Mark John Hickey, a Trade Mark Attorney in the firm of Castles.

The Applicant's Evidence

18. This consists of a statutory declaration filed by Andreas Kyrris, the applicant himself, dated 13 October 2000. He describes himself as a Director of Captain K Foods Limited and at all material times, he says he has been responsible for the UK trade mark application in suit.

19. A significant part of Mr Kyrris', statutory declaration (6 pages out of the 9 making up the full statutory declaration) refers to and deals with the withdrawn allegations of bad faith made by the opponents under the Section 3(6) ground and I need not therefore consider that part of the declaration. The same is true of a statutory declaration filed by Mario Royle, a Director of Captain K Foods Limited dated 13 October 2000.

20. The points which I do draw from the remainder of Mr Kyrris' statutory declaration are:

- (a) he considers the survey statistically unrepresentative - only 50 people were involved (he suggests 1000 would be a sounder base from which to draw any conclusions) and was conducted in a geographically limited area.
- (b) the survey was not independently carried out by a firm of professional market researchers.
- (c) the report is selective and misleading in the conclusion drawn from the statistics provided.

21. Mr Kyrris also comments on the statutory declaration of Mr Pomfret. He says in summary that:

- (a) Mr Pomfret himself describes at paragraph 5 of his statutory declaration the figure of the Captain Birds Eye character as being the "image of an archetypal seafaring captain". He says a dictionary describes the word "archetypal" as a "typical specimen", and concludes that it is therefore "the image perhaps a majority of people would perceive a seafaring captain to look like".
- (b) There would be no confusion, as the opponents suggest, because consumers can clearly distinguish between the frozen fish products and the fresh fish sold through a fish and chip restaurant and take-out outlet.
- (c) The opponents and he are not competing in the same market place.
- (d) No dilution or damage would be caused to the opponents because of the greatly differing financial resources available to each party and because of the quality of the products sold via the applicant's services.
- (e) There is no evidence of actual confusion from the opponents.

22. That concludes my summary of the evidence. The opponents did furnish me with written submissions in a letter dated 5 September 2001 and I bear those in mind in reaching my decision below.

THE DECISION

23. The first ground of opposition is based upon Section 5(2)(b), it and its reference to "an earlier trade mark" as defined by Section 6(1)(a) is reproduced below:

"5.-(2) A trade mark shall not be registered if because -

- (a)
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

“6.-(1) In this Act an ‘earlier trade mark’ means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

24. The caselaw I take into account is that provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

25. The starting point in Section 5(2)(b) consideration is usually a comparison of the goods or services involved. In this case, of course, we have a comparison of goods versus services. Thus the respective specifications are not identical. But are they similar? In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 at page 297 (the “Treat” case), Mr Justice Jacob said:

“I do not see any reason in principle why, in some cases, goods should not be similar to services (a service of repair might well be similar to the goods repaired, for instance).”

26. In the “Treat” case referred to above, Mr Justice Jacob, also set out some useful guidance on the relevant factors to consider when assessing the matter of the similarity of goods and services. These were:

- a) the respective **uses** of the respective goods or services
- b) the respective **users** of the respective goods or services;
- c) the physical **nature** of the goods or acts of service;
- d) the respective **channels of trade** through which the goods or services reach the market.
- e) in the case of self-serve consumer items whether they are, or are likely to be, found on the same or different shelves;
- f) the extent to which the respective goods or services are **competitive** (and whether in the same or different trade sectors).

27. Using the above guidance to assess food (in general) against catering services, I find as follows:-

- (a) Uses - are only similar, one is the food the other is the service of providing the food.
- (b) Users - are the same - the public at large for both the goods and the services.
- (c) Nature - different.
- (d) Channels of Trade - usually different, although there may be some cross-over. Food is retailed via shops, supermarkets etc, but also via catering services, restaurants and take-away outlets.
- (e) Is not relevant here.
- (f) Competitive - No competition.

28. The answers to the questions above do not, in my view, provide a definitive answer to the question "are the goods of the opponents similar to the services of the applicant"? I acknowledge that the evidence shows that the opponents use their trade marks on fish and frozen fish products and that the applicants use their trade mark in relation to fish restaurants and take-way outlets; also that the opponents' specification in some of their earlier rights go beyond just fish products, but where this is the case, they are still limited essentially to frozen products. The application in suit is not limited in any way as to what sort of food or drink may be provided via the catering services, so in a fair and normal assessment, I must assume the possibility of the applicant, being able to provide food products as part of their catering service which the opponents sell in a frozen form. However, bearing the answers to the questions in mind and considering the matter through the eyes of the average consumer/user of both I reach the view that there is little similarity between the respective goods and services. There is no expectation on the part of the public that the foodstuffs they purchase in a supermarket will originate from the same source as the provider of catering services and vice versa, though there are always exceptions. I am personally aware that 'HARRY RAMSDENS' provide restaurant services and sell fish and potato products (takeaway meals) but that does not mean that there is an expectation that all or some of those engaged in those respective activities will do so similarly.

29. Thus I reach the view that food and catering services are not similar per se.

30. Because I have found in this case that the respective services and goods are not similar that essentially determines matters under Section 5(2)(b), but I go on to consider the matter further because of the reputation that accrues to the opponents trade marks.

31. The opponents have brought to my attention seven trade marks they consider constitute earlier rights as defined by Section 6 of the Act. They each contain at least the word CAPTAIN (as in 1321108 and 2183662) or the word CAPTAIN with other matter, as in

CAPTAIN BIRDS EYE (1206600) and CAPTAIN'S TABLE and CAPTAIN'S COINS (1176859) and 2127986 respectively) or the word CAPTAIN and other material plus the device of what I describe as a character looking like a seafarer, with white beard and nautical attire, in a head and shoulders depiction (as in 2030194 and 2030236).

32. The applicant's trade mark can be viewed at page one in this decision. It contains the words CAPTAIN K (the K being larger than the word CAPTAIN) a diamond device as background and a cartoon depiction of what looks like a seafarer, also with white beard and nautical type attire. He in addition, carries a fishing net, with a fish protruding from it. He is also depicted in essentially head and shoulders view.

33. The opponents through their evidence, seek to establish that their CAPTAIN BIRDSEYE figure is a well known and well-recognised character in relation to their goods. They provide impressive evidence in terms of historical background, turnover and advertising spend dating back some 30 years or so. The applicants do not dispute any of the facts within their evidence and nor do I. The opponents seek to further establish, that not only is their CAPTAIN BIRDSEYE character and trade mark well established and well-known, but he and it are *so* well-known that their use of the word CAPTAIN alone (as registered) or CAP'N (as used), would also be recognised as referring to the CAPTAIN BIRDSEYE character trade mark. This, I think, is not established from the evidence of Mr Pomfret. Though use of those forms of the trade mark are shown it is not possible to gauge from the evidence before me that they have their own separate reputation, not least because no break-down of turnover and advertising etc relating specifically to those trade marks is provided.

34. This leads me to the survey evidence, which I think seeks to fill that gap by showing recognition of the word "CAPTAIN" and its relationship to the opponents or their products. I have not detailed the methodology or results of the survey carried out by Eversheds. The survey was commented on and criticised by the applicant and I referred to these criticisms in my summary of his evidence. I echo those criticisms in that I too find it to be flawed in its intention of establishing recognition of the CAPTAIN marks *solus*, see the comments of Mr Justice in *Imperial Group PLC v Phillip Morris Ltd [1984] RPC 293*. The results are open to interpretation unrepresentative and are not of evidential worth. I do not intend to comment any further in detail on that survey.

35. The survey evidence is in stark contrast to the statutory declaration of Mr Pomfret, which is meticulously put together and wholly relevant to the case the opponents are attempting to establish. Whilst I do not consider that that establishes without doubt recognition of the trade mark CAPTAIN, I am prepared to accept that in the context of frozen fish products, the CAPTAIN trade mark is likely to be linked to the CAPTAIN BIRDS EYE character (and trade marks) because of the substantial reputation the opponents have acquired in those *indicia*.

36. Does this mean the opponents marks are similar to that of the applicant? The guidance states that a side by side comparison of marks is not often possible. I would suggest that that is even less likely in a case such as this when it is a clash between a trade mark for goods and a trade mark for services.

37. It appears to me that the opponents' best case under Section 5(2)(b) rests on the CAPTAIN BIRDS EYE trade marks, both in pictorial form and words; any reputation in CAPTAIN (or CAP'N) alone stems from and subsists in those marks only by reference back to the CAPTAIN BIRDS EYE trade marks and character.

38. Using the visual, aural and conceptual tests established under the Court of Justice guidance above, I consider that visually the only point of similarity is between the occurrence of the word CAPTAIN in all of the opponents' earlier rights and in the application, and the occurrence of the seafarer device in the opponents' registration Nos 2030194 and 2030236 and in the application. Given the nature of the goods of the opponents, the reason for the selection of a seafaring character to promote these goods is fairly obvious. Mr Pomfret states that it is an "archetypal image". Given the lack of inherent distinctiveness of the device of a seafarer in relation to fish products and fish and chips and the fact that one is a cartoon, the respective devices are not, in my view, very similar, the relevant public would be able to discern one from the other. Thus the shared characteristic of the trade marks is the word CAPTAIN. However, the guidance tells me that I should not dissect the trade mark into its constituent parts - *Sabel BV v Puma AG* page 224. Thus, the "CAPTAIN K" element viewed along with the other elements in the trade mark it is equally striking. Taken as a whole, I do not consider the applicants' trade mark to be visually similar to that of the opponents.

39. Aurally, there is obviously the shared CAPTAIN elements in all of the trade marks. The device elements are unlikely to be described in the normal course of events in asking for either the respective goods or the services, except perhaps by reference to the characters they portray in the respective marks, ie CAPTAIN BIRDS EYE and CAPTAIN K. In totality there is little or no aural similarity between those trade marks containing the device elements. Nor is there between the applicants trade mark and the opponents CAPTAIN BIRDS EYE trade mark, which is clearly distinguished by the distinctive second element. The high point in any aural assessment as far as the opponents are concerned must be the two "CAPTAIN" (solus) trade marks and those with descriptive elements following that word, ie CAPTAIN'S COINS and CAPTAIN'S TABLE and here I accept there is some aural similarity, because of the shared element.

40. Conceptually, the various trade marks need to be considered separately. The best case for the opponents is, in my view, the device trade marks where the seafaring character clearly shares a conceptual similarity with that element in the trade mark the subject of the application. In both of the opponents trade marks there are other words, namely CAPTAIN and BIRDSEYE or BIRDS EYE and that would I think be seen by the average consumer as the name of the character in the trade mark. For the CAPTAIN (solus) trade marks, I have accepted that through use, this has become a reference to the "CAPTAIN BIRDS EYE" trade mark and character. The same is likely in relation to the CAPTAINS TABLE and CAPTAIN'S COINS trade marks. The remaining trade mark CAPTAIN BIRDS EYE (solus) is a clear reference to the character. All of these then must be compared in totality to the CAPTAIN K plus device trade mark. Though there are some conceptual similarities between individual elements of the respective trade marks, viewed as wholes I do not see any conceptual similarity between the applicant's trade mark and any of the opponents' earlier rights. CAPTAIN K is a different character. While one may bring to mind the other. But one is Captain "K" as opposed to Captain "Birds Eye". Even allowing for imperfect

recollection and the reputation established by Birds Eye Walls Ltd in their CAPTAIN BIRDS EYE indicia, it seems to me that the average consumer will be able to distinguish between the opponents' "Captain" trade marks and that of the applicants. As Mr Geoffrey Hobbs sitting as the Appointed Person in Raleigh International [2001] RPC 202 said:

"Similarities between marks cannot eliminate differences between goods or services; and similarities between goods or services cannot eliminate differences between marks. So the purpose of the assessment under Section 5(2) must be to determine the net effect of the given similarities and differences."

41. With that in mind and having regard to the respective trade marks and the goods and services that are or could be provided under them I do not consider that the applicants' trade mark is similar to those of the opponents; there will be no likelihood of confusion on the part of the public if the applicants trade mark is registered. Thus the ground of opposition based upon Section 5(2)(b) fails.

Section 5(3)

42. This states:

"5.-(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark".

43. It can be seen that the first hurdle of the test under this section is that there must be identity or similarity between the trade marks in suit. In this case I have found there is not. This ground consequently also fails.

Section 5(4)(a)

44. This states:

"5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

45. The authority used by the Registrar’s Hearing Officer in respect of an opposition based upon Section 5(4)(a) is WILD CHILD [1998] RPC 455.

49. In the written submission of the opponents dated 5th September 2001, they offered detailed comments on the Section 5(2)(b) and 5(3) grounds and on the evidence filed by the opponents and applicants. In relation to the Section 5(4)(a) pleading, they had this to say:

“We do not intend to recite detailed arguments under this section but in the case at hand would refer the Hearing Officer to the arguments made in the context of Section 5(2)(b)”.

46. This suggests to me that the opponents accepted that if they did not succeed under their Section 5(2)(b) pleading, they had no stronger case under Section 5(4)(a). I agree with them. The evidence of Mr Pomfret shows some use of the unregistered trade marks ‘CAP’N and “CAP’N BIRDS EYE” marks for example, but this does not add to their case. The “classic trinity” set out in WILD CHILD are not satisfied here - principally because I do not consider that the public would be misled as to the origin of the respective goods and services.

47. The opposition based upon Section 5(4)(a) also fails.

COSTS

48. As the opposition has failed on all grounds, the applicants are entitled to a contribution towards their costs. Because of the introduction late and subsequent withdrawal of a ground of opposition based upon Section 3(6) there is a costs issue which goes beyond the usual considerations. It can be seen from my summary of the applicant’s evidence and account of the background to these proceedings, that the Section 3(6) ground was something with which the applicant had to, and did, deal with. Mr Kyrris spent much of his statutory declaration (6 of 9 pages) in denying the allegation of bad faith made against him and had filed a second statutory declaration from a fellow director of his company (Mr Royle) to further deal with the matter. There is correspondence from the applicant protesting at the admittance of the Section 3(6) ground who the proceedings. In a letter to the Trade Marks Registry dated 16 March 2000, he says:

“I vehemently oppose the opponents request

And in a letter dated 21 February 2001, he protests at its withdrawal by the opponents:

“I strongly oppose the opponents request for their objections under Section 3(6) of the Act being struck from their pleadings

And later in the same letter:

“The opponents subsequently filed a substantial amount of evidence in support of their very serious allegations of bad faith, to which I had to respond. Apart from the very considerable distress I suffered as a consequence of those allegations, I also had to expend both time and money in seeking professional advice in order to rebut the opponents allegations.

The Registrar now has before him very serious allegations made by the opponents, together with my response to those allegations, and I am firmly of the view that the Registrar, having admitted the opponents amended statement of grounds into these proceedings at their request, should now determine the issue of bad faith”.

49. In both instances the Trade Marks Registry held for the opponents, but in a letter dated the 11th May 2001, notified them clearly that the cost implications of their actions would be considered at a later date.

50. An allegation of “bad faith”, is of course a serious allegation and one which should not be lightly raised, see Mr Simon Thorley QC acting as the Appointed Person in the Royal Enfield Motor Units case (BL O-363-01).

51. In my view, the opponents' decision to seek to add late to the pleadings a bad faith allegation and then subsequently to seek to have it withdrawn was ill judged. Having convinced the Trade Marks Registry that they had a case for late admittance, filing substantial, if unconvincing, evidence in support of it, leading the applicant to respond to it, only subsequently to drop it, caused unnecessary effort on both sides.

52. Clearly the applicant expended energies attempting to refute these serious allegations against him. Whilst in the opponents' favour is the fact that realising they had no strong case to offer, they withdrew the ground, but this was too late. The applicant had already had to deal with it, and in effect so have I, at least in part, in dealing with the cost implications. In my view the applicants are entitled to a separate award of costs for the evidence they filed in relation to the bad faith allegation, on top of the normal award, as well as for having to peruse an amended statement of grounds and the opponents' evidence. Taking that into account I order the opponents to pay to the applicants the sum of £3000. This sum 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 15 day of March 2002

**M KNIGHT
For the Registrar
the Comptroller-General**

Annex available as order a copy