

1 THE PATENT OFFICE

Tribunal Room 2
Harmsworth House
13-15 Bouverie Street
London EC4Y 3DP

4 Friday, 30th April 2004

5 Before:

6 MR. GEOFFREY HOBBS QC
(Sitting as the Appointed Person)

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8 In the Matter of the Trade Marks Act 1994

9 -and-

10 In the Matter of Trade Mark Registration No: 1516333 in the
11 name of TRADELINK (LONDON) LTD

12 -and-

13 In the Matter of Revocation No: 80806 by
14 EAST END FOODS PLC

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16 Appeal from the decision of Mr. M. Foley, acting on behalf of
the Registrar, dated 10th February 2004.

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18 (Transcript of the Shorthand Notes of Marten Walsh Cherer Ltd.,
19 Midway House, 27-29 Cursitor Street, London EC4A 1LT.
Telephone No: 020 7405 5010. Fax No: 020 7405 5026.)

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21 MR. S. KINSEY (of Messrs Wildbore Gibbons) appeared as Agent on
22 behalf of the Registered Proprietor/Appellant.

23 MR. M. SHAW (of Messrs Forrester Ketley & Co.) appeared as Agent
on behalf of the Opponent/Respondent.

24 D E C I S I O N
(Approved by the Appointed Person)

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1 THE APPOINTED PERSON: In view of the conclusion I am about to
2 come to, I think the less said about the substantive merits
3 of the issues between the parties the better.

4 I am clear in my own mind that the hearing officer's
5 decision is correct within the parameters in which it was
6 written. Indeed, I do not understand that to be disputed
7 by the appellant on this appeal.

8 Unfortunately, what appears to have happened
9 around and about the exchange of correspondence, consisting of
10 the letter of 27th August 2002 from the Trade Marks Registry and
11 the reply of 24th September 2002 on behalf of the registered
12 proprietor (with, I believe, a telephone conversation between
13 the registered proprietor and the Registry, in between times) is
14 that there developed a misunderstanding on the part of the
15 registered proprietor as to what he had proved and what was
16 sufficient to prove it for the purpose of defending his
17 registration from attack on the ground of non-use.

18 The misunderstanding relates to some sample products
19 which were admittedly filed with the Registry by the registered
20 proprietor. These were examples of products in commercial
21 circulation and distribution at the time of the correspondence.

22 On the basis of the materials I have seen, they

1 are likely to have carried indications as to when they were
2 produced in terms of batch numbers and will almost certainly
3 have carried use-before-dates indicative of the period in which
4 they were likely to have been released for distribution and sale
5 to consumers. However, the samples were withdrawn by the
6 registered proprietor and replaced with documents which lacked
7 the information as to batch numbers and use-before-dates that
8 would, I believe, have been discernible from the products
9 originally submitted for consideration. The products were
10 withdrawn by the registered proprietor in the mistaken belief
11 that they were not permitted or not required for the defence of
12 his registration.

13 It appears to me that if the physical samples had been
14 before the hearing officer when he came to take his decision,
15 there is a chance, I call it a real chance, but I do not put it
16 any higher than that, that he would have assimilated them with
17 the statements in narrative form in the witness statement of Mr.
18 Rajesh Doshi and reached a different or modified view of the
19 registered proprietor's trading activities compared with the
20 view which he took in the decision under appeal.

21 I see no reason to blame the Registry for the
22 misunderstanding that I have referred to. Equally, I see no
23 reason to blame the registered proprietor.

24 The net effect of this, it seems to me, is that there
25 has been a procedural irregularity of material significance in
26 relation to the determination of the inter partes proceedings.
27 I think that is sufficient to warrant the conclusion that the
28 hearing officer's decision should be set aside in all respects
29 including costs and that the inter partes proceedings should be
30 remitted to the Registry for further consideration. My intention
31 is that the matter should be restored for directions and at

1 that point it will be appropriate for the registered proprietor
2 to apply to the Registrar for leave to adduce further evidence.

3 I recognise that there is a need to know what the
4 samples that were misguidedly withdrawn from the Registry might
5 have demonstrated and confirmed in terms of their packaging and
6 presentation. It does not necessarily follow that any evidence
7 which is allowed in should extend to broader issues concerning
8 the commercialisation of the relevant mark during the relevant
9 period. However, I do not intend to pre-empt the Registrar's
10 decision on any application that may be made for the filing of
11 further evidence.

12 The upshot of this morning's proceedings is that the
13 appeal will be allowed and the revocation application will be
14 remitted to the Registry for further processing in
15 accordance with directions to be given by the Registrar
16 hereafter.

17 Based on what I have heard this morning, I think this is a
18 case where the parties would be well advised to try and resolve
19 their differences by agreement and if they cannot reach
20 agreement, it is a case where a mediator may assist them to
21 achieve what they cannot achieve by discussion between
22 themselves.

1 I would now like to hear the parties in relation to the
2 costs of this hearing.

3 MR. SHAW: I think, sir, most of the points have already been
4 made. You yourself have commented several times and you put
5 it succinctly towards the end in relation to Tradelink.

6 "Your side could have done so much more, so much sooner."

7 That is exactly what we have submitted in the written
8 correspondence and also orally today.

9 THE APPOINTED PERSON: What sort of costs can you tell me you may
10 have incurred, just in round numbers?

11 MR. SHAW: If you could give me a couple of minutes to look
12 through the files I could give you a rough idea. Off the top
13 of my head I do not know. Do you want to know that now?

14 THE APPOINTED PERSON: We go by scales. Generally speaking the
15 scales in this tribunal are much the same as the scales
16 below.

17 MR. SHAW: I may not have the relevant papers here. I do not see
18 that the actual costs that have been incurred by the
19 respondents are necessarily any higher than one would
20 normally have expected in respect of an appeal, but that is
21 not quite the point. The point is they should not have
22 incurred any costs in an appeal at all and for that reason we
23 think that an award of costs beyond the scale to make the

1 point, if you like, would be appropriate. I think we have
2 little else to add to that.

3 MR. KINSEY: As to an award of costs beyond the scale, I say that
4 is appropriate in circumstances where there has been
5 unreasonable behaviour on the part of the registered
6 proprietor/appellant. In this case we have not been
7 unreasonable. We have simply not understood the procedures.
8 We have not broken rules or created delaying tactics so we do
9 not think an award outside the scale would be right and an
10 award within the scale appears to be the appropriate course
11 here.

12 THE APPOINTED PERSON: As I indicated during the course of the
13 exchanges this morning, I consider that the respondent to
14 this appeal is completely blameless in relation to the
15 situation which has developed.

16 I think that the justice of the case requires that it
17 should, within reasonable limits, be protected from the
18 burden of costs in respect of this aspect of these
19 proceedings. Costs are not meant to be punitive. Even when
20 they are awarded off the scale, they are intended to be
21 compensatory.

22 Looking at the situation in the round, I think that the
23 appropriate order would be to require the registered proprietor
24 to pay the respondent £1400 in respect of its costs of this
25 appeal within 14 days of today.

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If it is not already clear from what I have said, the costs of the Registry proceedings to date and any proceedings in the Registry that may take place hereafter, will be entirely at the discretion of the Registrar.

That concludes this morning's business.

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