

O-433-11

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2527523

FOR THE TRADE MARKS (A SERIES OF TWO):

LAKES TV

Lakes.TV

IN THE NAME OF MURRAY LEWIS

IN CLASSES 35, 38, 39 AND 41

AND

THE OPPOSITION THERETO

UNDER NO 100094

BY

LAKES TV LTD

1) On 1 October 2009 Murray Lewis filed an application for the registration of a series of two trade marks: LAKES TV and Lakes.TV. The application was published for opposition purposes on 30 October 2009 with the following specification:

production of television commercials; Television advertising; Television commercials; Advertising services by means of television screen based text; Advertising services provided by television; Business services relating to the provision of sponsorship for television commercials; Business services relating to the provision of sponsorship for television programmes; Advertising services provided over the internet; Compilation of advertisements for use as web pages on the internet; Compilation of directories for publishing on the Internet; Production of television and radio advertisements; Provision of business information;

Internet portal services; Internet services providers (ISPs); Providing access to MP3 web sites on the internet; Providing access to digital music web sites on the internet; Video transmission services; Transmission of video films; Assisting others in providing cable television communications services; Broadcast of information by means of television; Broadcast of television programmes; Broadcasting (Cable television-); Broadcasting (Television-); Broadcasting of cable television programmes; Broadcasting of motion pictures by television; Broadcasting of programmes by television; Cable television broadcasting; Cable television service; Communication of information by television; Diffusion of television programmes; Dissemination of television programmes relayed by cable link to television receivers; Dissemination of television programmes relayed by extra-terrestrial satellite; Dissemination of television programmes relayed by microwave link to television receivers; Interactive services for facilitating the recordal of television programmes; Interactive services for television viewers facilitating the pre-selection of programmes; Operation of cable television systems; Operation of earth-to-satellite television transmitters; Operation of television cable networks; Reception of television programmes for onward transmission to subscribers; Relaying of television programmes by extra-terrestrial satellite; Subscription television broadcasting; Television broadcast transmissions; Television broadcasting; Television screen based text transmission services; Transmission of computerised data by means of television; Transmission of television programmes;

arranging travel and information therefor, all provided on-line from a computer database or the Internet; Provision of information on matters relating to tourism; Sightseeing;

game services provided on-line [from a computer network]; Publication of directories relating to tourism; Providing on-line electronic publication [not downloadable]; Provision of news on-line; Publication of electronic books and journals on-line; Production of videos; Distribution [other than transportation] of

videos; Library services provided by means of a computerised database containing information extracted from newspapers; Information relating to entertainment or education, provided on-line from a computer database or the Internet; News programme services for radio or television; News reporters services; Preparation of news programmes for broadcasting; Preparation of news programmes for the cinema; Provision of news on-line; Provision of news.

The above services are in classes 35, 38, 39 and 41 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 1 February 2010 a notice of opposition was received from Lakes TV Ltd (LTV).

3) LTV claims that the trade marks describe the Lake District with the “word” TV “which is a description of the services under the mark. Consumers would not associate the mark with owner”. Consequently, LTV claims that registration of the trade marks would be contrary to sections 3(1)(b) and (c) of the Trade Marks Act 1994 (the Act).

4) LTV claims that the application was made in bad faith and so its registration would be contrary to section 3(6) of the Act. It states:

“We believe that this is an application of bad faith as we feel that the applicant has no intention of using the trademark other than to stop us using the name Lakes TV. He has registered this trademark almost as a form of an aggressive act against our business perhaps with the intention of forcing us to buy it and/or his associated web domain name from him. He has bought up a lot of domain names and is using this application as a bargaining tool to get money rather than true commercial interest in the brand.

We are a daily TV channel that has been recording and broadcasting events, features, sports, entertainment and community based programmes focused on the Lakes region for some time. We first started filming events as far back as 2005 with the view to producing quality TV documentaries and coverage of Lakes events. Now a thriving business Lakes TV is both broadband based following and also set for full roll out on Sky TV Ch 203 on March 25, 2010 as well as Freeview and Virgin Media.”

5) LTV claims that registration of the trade marks would be contrary to section 5(4)(a) of the Act. It states that it began trading in December 2008 and started broadcasting via its broadband television channel lakestv.net on 29 July 2010. LTV states that it operates from its office/studio in Barrow-in-Furness and Ulverston in Cumbria but broadcasts to a global audience. It states that its

programmes are made almost exclusively in the Lake District region. LTV claims that it has been trading as Lakes TV since December 2008. It claims that if Mr Lewis' application were accepted it would cause confusion and damage its business.

6) Mr Lewis filed a counterstatement.

7) Mr Lewis states that he purchased the domain name Lakes.TV "several years ago" with the intention of creating a multimedia channel "based around that name". He states that on 24 January 2009 Gary Robinson, the current business partner of John McKeown at LTV, informed him that he was planning to create a television station of the same name. He took great exception to the idea and made his strong objections to it clear. Mr Lewis states that the idea and name for the channel had been originally proposed by him to Mr Robinson. Mr Lewis claims on the same day he published the beta website that he had created for his intended use of the site Lakes.TV. Mr Lewis claims that he thought by so doing it might give him some protection under the law of copyright. He states that at around the same time he discovered that he might be able to protect the name Lakes.TV and Lakes TV by applying for a trade mark. Mr Lewis states that, not having heard from Mr Robinson for a while or seen anything other than a holding page on the proposed website Lakestv.net, he did not make a trade mark application. He states that he was informed that Mr Robinson actually planned to create a television channel called Lamb TV. Mr Lewis states that in August 2009 he realised that Mr Robinson had gone ahead with using the name. He states that this was the second time that Mr Robinson had taken a business name that he had created and used for his own business use without his consent; the first being Northern Riviera. Mr Lewis states that to protect his right to use Lakes.TV he applied for a trade mark registration.

8) Mr Lewis states that he has every intention to develop Lakes.TV further. He denies that he applied for the trade marks to extract monies or as an aggressive act. Mr Lewis states that Lakes.TV has been active for several years and "for streaming video with a basic business directory since January 24th 2009". Mr Lewis states that any domain names that he has purchased have been purchased with the purpose of developing them.

9) Mr Lewis states that he believes that LTV was not incorporated until 17 March 2009, several weeks after he had launched the beta site at Lakes.TV. He states that, as far as he is aware, Mr McKeown was trading as Film North Limited (incorporated 15 September 2005) and Mr Robinson as Northern Riviera Productions.

10) Mr Lewis considers the combination of Lakes and TV to be distinctive. He was not aware of anyone else using it when he applied for the trade mark. Mr Lewis states that only he can use Lakes.TV "as it applies solely to the domain name www.Lakes.TV". Mr Lewis does not believe that Lakes and TV together

exclusively “describe origin or the goods and services”. Mr Lewis states that lakes does not solely stand for the Lake District and TV does not solely stand for television. Mr Lewis states the database of the Intellectual Property Office (IPO) is “full” of registered trade marks that use TV, .TV and television; such as Ocean TV, Apple TV, Last.TV and France Television. He states that the database also has many “registered examples based around the word Lakes such as Cambridge Lakes, University of the Lakes, Lakeland Plastics and The Lake District Cheese Co”. Mr Lewis sees no difference between the registered trade marks to which he refers and Lakes TV.

11) Both parties filed evidence. A hearing was not requested, neither were written submissions filed.

Evidence for LTV

12) This consists of a witness statement by John McKeown. Mr McKeown is the managing director of LTV.

13) Mr McKeown states that in 2005 he conceived of the idea of a Lake District television service, which he discussed with a journalist friend. It was considered achievable by means of the Internet. He had discussions in 2007 and 2008 with broadcast colleagues, a local Internet firm (Furness Internet) and a local enterprise company (Furness Enterprise) about his proposal. Exhibited at JMc1 and 2 are copies of e-mails correspondence. JMc1 is dated 23 October 2007 and is between Mr McKeown and Arthur Pickering. In his e-mail, Mr McKeown expresses an interest in promoting the Lakes. JMc2 consists of e-mails dated 23 and 24 January 2008. Mr McKeown is requesting funding from Furness Enterprise Ltd for “a possible website which would act as a ‘what’s on’ source of information for Cumbria. The site will be called The Lakes Today.”

14) In late 2008 Gary Robinson, “a local rival corporate film-maker”, approached Mr McKeown in relation to making programmes for a local Internet television channel. Mr Robinson’s proposal was for an Internet television station for the south Lake District, Furness and Morecambe Bay area called LAMB TV (an acronym for Lakeland and Morecambe Bay TV). Mr McKeown states that he agreed to join forces with Mr Robinson if they launched a Lakes web television channel and called it Lakes TV. He states that Mr Robinson agreed and, by the end of 2008, they had agreed to go into business together.

15) Mr McKeown states that they needed a domain name that suited the proposed channel, “based around the name lakestv”. He states that lakestv.com and lakestv.co.uk were not available but that lakestv.net was available. Mr McKeown states that lakestv.com was “a holding, directory type page” and lakestv.co.uk is a chain of television and electrical goods stores in the Thames Valley. They bought several domain names, including lakedistricttv.com and

cumbriatv.org but preferred lakestv.net; which Mr McKeown states he bought on 17 December 2008.

16) Mr McKeown states that on 24 January 2009 Mr Robinson told his friend, Mr Lewis, that he had decided to launch a web television with Mr McKeown called Lakes TV. Mr McKeown states that Mr Lewis took objection to this, to Mr Robinson's surprise. Mr Lewis alleged that he had told Mr Robinson some time earlier that he owned the domain name lakes.tv and that he intended to use it as a directory for the Lake District region of Cumbria. Mr McKeown states that Mr Robinson says that he did not remember any such conversation with Mr Lewis. Mr McKeown states that at no point had Mr Robinson made any mention to him of Mr Lewis's plans. Mr McKeown states that Eric Robson, a broadcaster and chairperson of Cumbria Tourism, announced in spring 2009 that he intended to launch EnglishLakes TV. He states that Cumbria News Group looked into launching a television service at the same time, with Lakes TV being one of the names upon the table.

17) Mr McKeown states that it was his idea to call the channel Lakes TV and a website was created that played professionally shot and edited films about the Lake District. He states that it was launched on 27 July 2009 and that LTV was registered on 17 March 2009. Mr McKeown states that "[o]ur 1st anniversary of broadcasting on Sky is in March this year". (The wording indicates that the event will happen in the future. However, the statement was written on 21 June 2011, after March but in the same year. So it is not clear when broadcasting with Sky first took place. However, whenever it was, it was after the date of application for registration.)

18) Mr McKeown states that, having discovered the trade mark application, he met Mr Lewis to discuss the matter. The main concern of Mr Lewis, he states, seemed to be that Mr Robinson had stolen his idea and that he had decided to apply for the trade marks when LTV opened premises in Ulverston town centre.

19) Mr McKeown states that it was only after having the conversation with Mr Robinson about the plans of LTV, that Mr Lewis used the domain name to post a website. He "feels" that this is a way of recouping money from a domain name that he believed to be valuable; such as the domain names Mr Lewis had previously owned: Beatles.tv and StanLaurel.com.

20) Mr McKeown exhibits various correspondence. All the references, bar one, are to LAMB TV. The one exception is an e-mail from Mr McKeown, with an e-mail address at filmnorth.co.uk, to Mr Robinson dated 2 December 2008. In this e-mail the following appears:

"As for keeping our own productions going – I'm chilled out about it. I'm not bothered by the fact that you could be doing something big locally. My

focus will move rapidly towards the Lakes TV while hopefully keeping earnings topped up picking up scraps locally.....

Any corporate work will hopefully be a secondary thought in the future as this will be small time in comparison to Lakes TV.”

Evidence for Murray Lewis

21) This consists of a witness statement by Mr Lewis.

22) Mr Lewis states that in 2002 he purchased the domain name Lakes.TV with the intention of developing a multimedia broadcasting platform that included audio and video. He left the Lakes.TV idea for future development for when he was “more financially stable” and for when broadband was more available, affordable and accessible.

23) Mr Lewis states that in late 2006, with the “rise of the YouTube phenomenon” he decided to pursue the development of the Lakes.TV idea. He states that he developed “an initial concept and prototype that included a business directory which was to link to a page to display a promotional video for each business”. Exhibited at ML1 is a page from lakes.tv website. It was downloaded on 8 July 2011 and so well after the date of application. Mr Lewis states that he also created a template page for the video page. He refers to exhibit ML3. This consists of an undated screen print of a web page headed “Lakes.TV The Lake District Channel”. Although the page is undated there is reference to a walk to take place on 27 August 2011, consequently, the print will have been taken well after the date of application.

24) Mr Lewis states that he was contacted by Mr Robinson. He states that Mr Robinson was owner of Northern Riviera, a name that Mr Lewis states that he devised. Mr Lewis states that during the telephone conversation he mentioned that he owned the domain name lakes.tv and that he planned to create a multimedia/TV channel based around the name; initially containing a business directory which would stream promotional videos. Mr Lewis told Mr Robinson that he was looking for assistance with sales and marketing. This was not offered by Mr Robinson. However, Mr Robinson did offer to produce promotional videos for any orders that were obtained.

25) Mr Lewis states that on 19 December 2007 he registered the channel LAKESTV at YouTube.com. Exhibited at ML2 is a page from youtube.com downloaded on 7 July 2011. The page shows that lakestv joined YouTube on 19 December 2007.

26) Mr Lewis states that on 24 January 2009 Mr Robinson telephoned him. He states that Mr Robinson told him that he was planning to launch a television station called Lakes TV. Mr Lewis states that this came as a shock to him as it

was the same concept with the same name that he had proposed to him. Mr Lewis states that after the conversation he received several text messages in which Mr Robinson wrote that the project was called Lakes TV and not based on the name Lakes.TV and that “he was perfectly entitled the do so and that ‘that was the end of the matter’”.

27) Mr Lewis states that he immediately set about publishing the prototype streaming video based website on Lakes.TV. He states that he did this to “establish a point in time of publishing my concept based on the name and to try and deter Mr Robinson from continuing with his plan to launch a very similar product with the same name”. Mr Lewis states that on the same day he checked Mr McKeown’s domain name lakestv.net and saw that it was just a holding page by the domain name registrar. He states that in August 2009 it became clear that Mr Robinson had gone ahead with using the name Lakes TV. Mr Lewis states that he decided to protect his right to develop Lakes.TV by applying for a trade mark.

28) Mr Lewis states that LTV was not incorporated until 17 March 2009 and that Lakestv.net was not launched until a few months later.

29) Mr Lewis states:

“I do not object to Mr McKeown having an idea to create a product, but I do object to him developing a similar product with the same name. If they had decided to continue using LAMB TV, this would not have been a problem as I would have been able to continue to develop Lakes.TV as I saw fit without a conflict of name.”

Section 3(1)(b) and (c) of the Act

30) Section 3(1)(b) and (c) of the Act states:

“3. - (1) The following shall not be registered –

(a).....

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d)

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

31) It is the claim of LTV that Lakes describes the Lake District. Consequently, the trade marks would simply describe a television service for the Lake District. LTV has put in no evidence to substantiate the claim that Lakes is used as a means of describing the Lake District. It has filed no evidence in relation to the section 3(1) objection at all. **In the absence of any evidence to substantiate its claim, the grounds of opposition under section 3(1)(b) and (c) of the Act are dismissed.**

Section 5(4)(a) of the Act – passing-off

32) Section 5(4)(a) of the Act states:

“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”.

33) The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

“The law of passing off can be summarised in one short, general proposition: no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

A similar provision to section 5(4)(a) of the Act is to be found in Article 8(4) of Council Regulation 40/94 of December 20, 1993. This was the subject of consideration by the General Court (GC) in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07*, in which the General Court (GC) stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.”

The reasoning of the GC, *mutatis mutandis*, is followed in relation to the Act. Consequently, LTV has to establish that it had a protectable goodwill at the date of application, 1 October 2009.

34) The evidence of Mr McKeown does not establish any goodwill in any business of LTV, let alone goodwill associated with the sign Lakes TV at the date of application. Mr McKeown seems to be under the misapprehension that there are rights in a name *per se*. A name does not enjoy goodwill, it does not engender rights other than in relation to goodwill. Parker J in *Burberrys v J C Cording & Co Ltd* [1909] 26 RPC 693 said:

“The principles of law applicable to a case of this sort are well known. On the one hand, apart from the law as to trade marks, no one can claim monopoly rights in the use of a word or name. On the other hand, no one is entitled by the use of any word or name, or indeed in any other way, to represent his goods as being the goods of another to that other’s injury. If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property, to protect which it is granted, is not property in the word or name, but the property in the trade or good-will which will be injured by its use. If the use of a word or a name be restrained, it can only be on the ground that such use involves a

* All of the judgments of the General Court (previously the Court of First Instance) and the Court of Justice of the European Union can be found at the url:

<http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=en>

misrepresentation, and that such misrepresentation has injured, or is calculated to injure another in his trade or business.”

Millet LJ in *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697 stated:

“It is well settled that (unless registered as a trade mark) no one has a monopoly in his brand name or get up, however familiar these may be. Passing off is a wrongful invasion of a right of property vested in the plaintiff; but the property which is protected by an action for passing off is not the plaintiff’s proprietary right in the name or get up which the defendant has misappropriated but the goodwill and reputation of his business which is likely to be harmed by the defendant’s misrepresentation: see *Reddaway v. Banham* [1896] A.C. 199 per Lord Herschell; *Spalding v. Gamage* (1915) 32 R.P.C. 273 at page 284 per Lord Parker; *H.P. Bulmer Ltd. and Showerings Ltd. v. J. Bollinger SA and Champagne Lanson Pere et Fils* (the Bollinger case) [1978] R.P.C. 79 at page 93-4 per Buckley L.J.”

The case of LTV under the law of passing-off has not been substantiated and the ground of opposition under section 5(4)(a) of the Act must be dismissed.

Section 3(6) of the Act

35) Section 3(6) of the Act states:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

Bad faith includes dishonesty and “some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular field being examinedⁱⁱⁱ”. Certain behaviour might have become prevalent but this does not mean that it can be deemed to be acceptableⁱⁱ. It is necessary to apply what is referred to as the “combined test”. It is necessary to decide what Mr Lewis knew at the time of filing his application and then, in the light of that knowledge, whether his behaviour fell short of acceptable commercial behaviourⁱⁱⁱ.[†] Bad faith impugns the character of an individual or collective character of a business, as such it is a serious allegation^{iv}. The more serious the allegation the more cogent must be the evidence to support it^v. However, the matter still has to be decided upon the balance of probabilities. The material date for bad faith is the date of the filing of the application for registration^{vi}. Bad faith cannot be cured by some action after the date of the application^{vii}. Consequently, the issue of bad faith must be considered solely at the date of application, although action after the date of application may cast light upon the application for registration.

[†] Decisions with the prefix BL can be found on the website of the IPO.

36) The action of filing the application was, to some extent, the result of the behaviour of Mr Robinson. Mr McKeown gives pure hearsay evidence in relation to what Mr Robinson knew and said. Mr McKeown has no personal basis for the statements that he makes in relation to Mr Robinson. Mr Robinson could have given evidence but did not. On the basis of the non-hearsay evidence of Mr Lewis, his versions of events must be preferred.

37) In *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* Case C-529/07 the Court of Justice of the European Union (CJEU) stated:

“40 However, the fact that the applicant knows or must know that a third party has long been using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought is not sufficient, in itself, to permit the conclusion that the applicant was acting in bad faith.

46 Equally, the fact a third party has long used a sign for an identical or similar product capable of being confused with the mark applied for and that that sign enjoys some degree of legal protection is one of the factors relevant to the determination of whether the applicant was acting in bad faith.

47 In such a case, the applicant’s sole aim in taking advantage of the rights conferred by the Community trade mark might be to compete unfairly with a competitor who is using a sign which, because of characteristics of its own, has by that time obtained some degree of legal protection.

48 That said, it cannot however be excluded that even in such circumstances, and in particular when several producers were using, on the market, identical or similar signs for identical or similar products capable of being confused with the sign for which registration is sought, the applicant’s registration of the sign may be in pursuit of a legitimate objective.

49 That may in particular be the case, as stated by the Advocate General in point 67 of her Opinion, where the applicant knows, when filing the application for registration, that a third party, who is a newcomer in the market, is trying to take advantage of that sign by copying its presentation, and the applicant seeks to register the sign with a view to preventing use of that presentation.

50 Moreover, as the Advocate General states in point 66 of her Opinion, the nature of the mark applied for may also be relevant to determining whether the applicant is acting in bad faith. In a case where the sign for which registration is sought consists of the entire shape and presentation

of a product, the fact that the applicant is acting in bad faith might more readily be established where the competitors' freedom to choose the shape of a product and its presentation is restricted by technical or commercial factors, so that the trade mark proprietor is able to prevent his competitors not merely from using an identical or similar sign, but also from marketing comparable products.

51 Furthermore, in order to determine whether the applicant is acting in bad faith, consideration may be given to the extent of the reputation enjoyed by a sign at the time when the application for its registration as a Community trade mark is filed."

In *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others* [2008] EWHC 3032(Ch) Arnold J held:

"189. In my judgment it follows from the foregoing considerations that it does not constitute bad faith for a party to apply to register a Community trade mark merely because he knows that third parties are using the same mark in relation to identical goods or services, let alone where the third parties are using similar marks and/or are using them in relation to similar goods or services. The applicant may believe that he has a superior right to registration and use of the mark. For example, it is not uncommon for prospective claimants who intend to sue a prospective defendant for passing off first to file an application for registration to strengthen their position. Even if the applicant does not believe that he has a superior right to registration and use of the mark, he may still believe that he is entitled to registration. The applicant may not intend to seek to enforce the trade mark against the third parties and/or may know or believe that the third parties would have a defence to a claim for infringement on one of the bases discussed above. In particular, the applicant may wish to secure exclusivity in the bulk of the Community while knowing that third parties have local rights in certain areas. An applicant who proceeds on the basis explicitly provided for in Article 107 can hardly be said to be abusing the Community trade mark system."

38) The evidence of Mr Lewis establishes that he had the idea of using the trade marks some time before he became aware of the intentions of LTV. His action in applying to register the trade marks was the prudent action of a person in the business who was trying to protect his position^{viii}. LTV has substantiated none of the claims that it has made against Mr Lewis. There is nothing in the action of making the application that can be categorised as being an act of bad faith. The ground of opposition under section 3(6) of the Act is dismissed.

Costs

39) Mr Lewis having been successful is entitled to a contribution towards his costs. Mr Lewis is a litigant in person. In BL O/160/08 Mr Richard Arnold QC, sitting as the appointed person, stated:

“32. Secondly, counsel for the opponent submitted that, if CPR r. 48.6 was applicable, the hearing officer had misapplied it. In support of this submission he pointed out that CPR r. 48.6(4) provides:

The amount of costs to be allowed to the litigant in person for any item of work claimed shall be-

(a) where the litigant can prove financial loss, the amount that he can prove he has lost for time reasonably spent on doing the work; or

(b) where the litigant cannot prove financial loss, an amount for the time reasonably spent on doing the work at the rate set out in the practice direction.

The Part 48 Practice Direction provides at paragraph 52.4 that the amount which may be allowed to a litigant in person under rule 46.8(4) is £9.25 per hour. Counsel submitted that the hearing officer appeared to have awarded the applicant two-thirds of the scale figure which he would have awarded a represented party, and that this could not be justified since the opponent had not proved any financial loss and was very unlikely to have spent over 160 hours on the matter.....

36. In my judgment the approach which should be adopted when the Registrar is asked to make an award of costs in favour of a litigant in person is as follows. The hearing officer should direct the litigant in person pursuant to r. 57 of the 2000 Rules to file a brief schedule or statement setting out (i) any disbursements which the litigant claimed he has incurred, (ii) any other financial losses claimed by the litigant and (iii) a statement of the time spent by the litigant in dealing with the proceedings. The hearing officer should then make an assessment of the costs to be awarded applying by analogy the principles applicable under r. 48.6, but with a fairly broad brush. The objective should be to ensure that litigants in person are neither disadvantaged nor overcompensated by comparison with professionally represented litigants.”

(Under the current practice direction the amount allowed to a litigant in person is £18 per hour.)

40) Mr Lewis should furnish, within two weeks of the date of issue of this decision, a brief schedule of costs as indicated above in the decision of Mr Arnold. A supplementary decision on costs will then be issued.

41) The period for any appeal against this decision will run concurrently with the appeal period for the decision on costs and so will not commence until the issuing of that decision.

Dated this 2nd day of December 2011

**David Landau
For the Registrar
the Comptroller-General**

ⁱ *Gromax Plastics Limited v Don and Low Nonwovens Ltd* [1999] RPC 367.

ⁱⁱ *Harrison v Teton Valley Trading Co* [2005] FSR 10. Full judgment to be found at the url:

<http://www.bailii.org/ew/cases/EWCA/Civ/2004/1028.html>

ⁱⁱⁱ (1) *Barlow Clowes International Ltd. (in liquidation)* (2) *Nigel James Hamilton and (3) Michael Anthony Jordan v (1) Eurotrust International Limited (2) Peter Stephen William Henwood and (3) Andrew George Sebastian* [2005] UKPC 37 to be found at the url:

<http://www.bailii.org/uk/cases/UKPC/2005/37.html>

and *Ajit Weekly Trade Mark* BL O/004/06.

^{iv} See *Royal Enfield Trade Marks* BL O/363/01.

^v *Re H (minors)* [1996] AC 563.

^{vi} *Hotpicks Trade Mark* [2004] RPC 42 and *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* Case C-529/07 paragraph 35.

^{vii} *Nonogram Trade Mark* BL O/367/00.

^{viii} See the judgment of Walton J in *Athlete's Foot Marketing Associates Inc v Cobra Sports Ltd* [1980] RPC 343:

“Of course, again, it may very well have been that the defendants advanced their own use of the name when they realised, as a result of Mr. Parkin's “cautious conversation” that someone else was about to use their chosen name first. This would be ordinary commercial prudence. All this means legally is that they got their foot in the door first.”