

O-283-19

TRADE MARKS ACT 1994

**IN THE MATTER OF A JOINT HEARING HELD IN RELATION TO
UK TRADE MARK REGISTRATION NO. 3223495
IN THE NAME OF WILTSGROVE LTD**

AND

**THE PRELIMINARY VIEW TO STRIKE OUT
AN APPLICATION FOR INVALIDATION
UNDER NO. 502368
BY WILLIAM IVOR CUTLAN**

Introduction

1. This decision follows a hearing to challenge to the preliminary view relayed by the registry that, in light of a previous cancellation decision on the subject registration and between the same parties, Cancellation Application No. 502368 should be struck out on the basis of: (i) issue estoppel; (ii) cause of action estoppel; and/or (iii) potential for abuse of process.

Factual Background

2. Wiltsgrove Ltd (“**the Proprietor**”) owns UK trade mark registration 3223495, filed on 6 April 2017 and entered in the register on 23 June 2017. The registration is for the word mark “BC ELECTRONICS” in respect of various remote controls specified in class 9.
3. William Ivor Cutlan (“**the Applicant**”) has applied for a declaration of invalidity against the registration, by filing a Form TM26(I), along with his own witness statement (dated 11 November 2018¹), and with submissions filed on his behalf dated 13 November 2018. The application for a declaration of invalidity is based on two grounds:
 - (i) **section 5(4)(a)** of the Trade Marks Act 1994 (“the Act”) – essentially a claim that at the date that the registered mark was applied for, its use was liable to have been prevented by the law of passing off, because the Applicant had traded under that sign since 1993 in connection with the registered goods; and
 - (ii) **section 3(6)** of the Act - an allegation that the trade mark was filed in bad faith. The Applicant claims that the Proprietor has been a competitor for around 10 years, that both parties trade on Amazon, the Proprietor trading as “cherrypickelectronics” under the company Akita (UK) Ltd., and that the Proprietor applied for the mark only to prevent the Applicant from using his own brand. Amazon emailed the Applicant on 1 July 2017 (a week after registration of the Proprietor’s mark) informing him that Amazon had removed a large quantity of his products from the Amazon website as they contravened trade mark rights.
4. The registry served the Applicant’s Form TM26(I) on the Proprietor on 18 December 2018. The Proprietor responded to the registry by email on 8 January 2019, with the following information and query:

¹ (with exhibits)

“Please note the same cancellation applicant previously tried to cancel this trade mark on 12 July 2017 and lost the case ... is it possible for this applicant to continuously file cancellations on this trade mark. Please can you look into this, as it seems much of this issue is the same as the first case and would be a waste of time to re-do all of this.”

5. The previous cancellation attempt referenced in the email query was Cancellation Application No. 501723, brought by the same Applicant, based (only) on section 5(4)(a) of the Act, which resulted in the decision published as BL O/570/18. In that decision the Hearing Officer dismissed the application because the evidence filed by the Applicant was insufficient to demonstrate sufficient goodwill to be protected by the law of passing off².
6. In response to the Proprietor’s email query, an official letter from the registry, dated 2 February 2019, asked the Proprietor whether this was a request for this Cancellation Action to be struck out. The Proprietor replied to that letter by e-mail on 13 February 2019, confirming that it requested that the present cancellation (No. 502368) be “struck out on the grounds that the argument for cancellation is the same in principle as the first denied cancellation request, CA000501723.” The Proprietor continued (verbatim):

“The evidence submitted again is sales figures, from ebay and Amazon, and assumes trade mark and considerable goodwill has been generated by opening a amazon store name to that of my registered brand BC ELECTRONICS UK00003223495. As explained in my initial case the evidence supplied by the Claimant did not make any sense nor did prove any goodwill was generated. Storefront names can be added/changed at any time irrespective of when the ebay/amazon account was open. I personally think this repetition of work is a waste of both yours and my time and money when the argument is essentially the same.”

7. The Proprietor also filed its Form TM8 on 13 February 2019, in which the counterstatement denied the grounds, making some of the points above, denying goodwill and requesting proof of sales figures. On 18 February 2019, the registry wrote to the parties to acknowledge the filed Form TM8³ and the request to strike out the cancellation action, and gave the Applicant an opportunity to comment on the matter before the registry

² Paragraph 22 of BL O/570/18.

³ (The Form TM8 has not been formally served in these proceedings.)

decided how to proceed. The Applicant's legal representatives duly emailed its comment in reply on 25 February 2019, which essentially indicated a position of resistance to the proceedings being struck out. The registry then wrote to the parties on 19 March 2019, stating the following:

"It is the registry's view that an estoppel arises from the earlier invalidation proceedings. The relevant law was discussed by Peter Smith J in *Evans and another (t/a Firecraft) v Focal Point Fires Plc* [2009] EWHC 2784 (Ch).

The section 5(4)(a) ground would give rise to issue estoppel, as this claim concerns the same issue as has already been determined by the Tribunal. In the case of the section 3(6) ground, cause of action estoppel would, in our view, be applicable, as the cause of action (invalidity under section 47) is the same for both the new claim and the already determined claim. There is also the potential for abuse of process.

It is in the public interest that a party should bring forward its best case and that there should be finality in litigation."

8. The Applicant's legal representatives responded by email on 1 April 2019, including the following points:

The Applicant understands that it is in the public's interest that there should be finality to litigation. However, as previously noted, the Applicant's inexperience with such proceedings meant that he did not fully evidence his case. The Applicant respectfully submits that the Proprietor filed the application in bad faith and is an attempt to pass off on the applicant's goodwill and reputation held within the mark. There is no other feasible justification for the Proprietor to file an application for "BC ELECTRONICS" which as previously noted is the Applicant's initials (Bill Cutlan) other than to prevent his use. This is further evidenced by the Proprietor's immediate action in filing a trade mark complaint through Amazon seeking to have the Applicant's goods and services under his BC ELECTRONICS brand removed, as soon as registration was achieved.

In view of the above, the Applicant wishes to request a hearing in this matter. The Applicant further considers that it cannot be in the public interest to strike out actions that are founded in law, simply because the Applicant initially erred by misjudging the complexity of the issue and thus the evidence it filed in support of its case.

The Hearing

9. The took place before me by telephone conference on **Friday, 26 April 2019**. Two days before the hearing, Jeevan Singh, who had been due to attend on behalf of the Proprietor, notified the registry that he was unable to attend on that date, owing to a doctor appointment. As part of her response to that notification, the caseworker reiterated that the hearing was to consider only the challenge to the preliminary view on strike out given

in the registry letter of 19 March 2019, and that in the circumstances described by Mr Singh, and particularly given the short notice and that the other side had arranged a barrister to attend, the hearing would proceed as scheduled. Nonetheless, Mr Singh filed written submissions on behalf of the Proprietor⁴. Nick Zweck of Counsel attended the hearing on behalf of the Applicant at the instruction of Murgitroyd & Company. Mr Zweck filed a skeleton argument in advance and spoke to those points at the hearing. The points made by Mr Zweck heavily inform this decision, although I take account of points on both sides and refer to them to the extent that I find them relevant to my decision. I also note that Mr Zweck, in honour of his professional responsibility where the other party is without legal representation, unilaterally and proportionately raised points⁵ that might be considered against the interests of his client.

The relevant principles

Cause of action estoppel, issue estoppel and *Henderson* abuse of process

10. The only guidance provided in the UKIPO Trade Marks Manual as to the process appears to be at paragraph 4.19 of the Tribunal Section, which states: “A party may seek summary judgment on a case, i.e. have the entire case thrown out, because the other party is estopped from its action or, because its action is an abuse of process. In cases of estoppel and abuse of process it is for one party to raise the issue, the hearing officer will not raise the matter of his/her own motion. [Emphasis added]
11. *Evans v Focal Point Fires* referenced in the registry’s letter of 19 March 2019 is good authority for the proposition that, where a cancellation applicant has brought invalidity proceedings in the UKIPO, subsequent invalidity proceedings *may* be liable to be struck out on the basis of cause of action estoppel, issue estoppel and/or abuse of process⁶. However, care must be taken to determine whether and to what extent those principles apply on the facts of each particular case. Moreover, much of what is said in *Evans v Focal Point Fires* is now bad law in the light of the Supreme Court’s decision in *Virgin Atlantic*⁷, discussed further below. Accordingly, the statements of principle in *Evans v*

⁴ In the interests of transparency, the short set of bullet points filed by the Proprietor is reproduced in **Annex 1** to this decision.

⁵ In particular dealing with passages in *Hormel Foods* (cited below) and *Focal Point Fires* (cited above).

⁶ This is in contrast to the position for opposition proceedings – see for example paragraphs 89 – 90 of *Hormel Foods* (cited below).

⁷ *Virgin Atlantic Airways Ltd v Zodiac Seats UK Ltd* [2013] UKSC 46

Focal Point Fires should not to be relied upon unless they are consistent with the law as stated in *Virgin Atlantic*.

12. The principles in this area of the law were restated by the Supreme Court in *Virgin Atlantic* at [17] to [26], including the following summary by Lord Sumption JSC⁸:

[17] Res judicata is a portmanteau term which is used to describe a number of different legal principles with different juridical origins. As with other such expressions, the label tends to distract attention from the contents of the bottle. The first principle is that once a cause of action has been held to exist or not to exist, that outcome may not be challenged by either party in subsequent proceedings. This is “cause of action estoppel”. It is properly described as a form of estoppel precluding a party from challenging the same cause of action in subsequent proceedings.

....

Fourth, there is the principle that even where the cause of action is not the same in the later action as it was in the earlier one, some issue which is necessarily common to both was decided on the earlier occasion and is binding on the parties: *Duchess of Kingston's Case* (1776) 20 State Tr 355. “Issue estoppel” was the expression devised to describe this principle by Higgins J in *Hoysted v Federal Commissioner of Taxation* (1921) 29 CLR 537, 561 and adopted by Diplock LJ in *Thoday v Thoday* [1964] P 181, 197–198. Fifth, there is the principle first formulated by Wigram V-C in *Henderson v Henderson* (1843) 3 Hare 100, 115, which precludes a party from raising in subsequent proceedings matters which were not, but could and should have been raised in the earlier ones. Finally, there is the more general procedural rule against abusive proceedings, which may be regarded as the policy underlying all of the above principles....” [Emphasis added]

13. Also in *Virgin Atlantic*, Lord Sumption JSC cited with approval the following passage from the judgment of Lord Keith in *Arnold v National Westminster Bank plc* [1991]⁹:

“Cause of action estoppel arises where the cause of action in the later proceedings is identical to that in the earlier proceedings, the latter having been between the same parties or their privies and having involved the same subject matter. In such a case

⁸ (with whom Baroness Hale of Richmond DPSC, Lord Clarke of Stone-Cum-Ebony and Lord Carnwath JJSC agreed)

⁹ 2 AC 93 at pages 104D-E and 105D-E

the bar is absolute in relation to all points decided unless fraud or collusion is alleged, such as to justify setting aside the earlier judgment. The discovery of new factual matter which could not have been found out by reasonable diligence for use in the earlier proceedings does not, according to the law of England, permit the latter to be reopened ...

Issue estoppel may arise where a particular issue forming a necessary ingredient in a cause of action has been litigated and decided and in subsequent proceedings between the same parties involving a different cause of action to which the same issue is relevant one of the parties seeks to reopen that issue” [Emphasis added]

14. Lord Sumption JSC drew the following conclusions from that case:

“[22] *Arnold v National Westminster Bank plc* [1991] 2 AC 93 is accordingly authority for the following propositions. (1) Cause of action estoppel is absolute in relation to all points which had to be and were decided in order to establish the existence or non-existence of a cause of action. (2) Cause of action estoppel also bars the raising in subsequent proceedings of points essential to the existence or non-existence of a cause of action which were not decided because they were not raised in the earlier proceedings, if they could with reasonable diligence and should in all the circumstances have been raised. (3) Except in special circumstances where this would cause injustice, issue estoppel bars the raising in subsequent proceedings of points which (i) were not raised in the earlier proceedings or (ii) were raised but unsuccessfully. If the relevant point was not raised, the bar will usually be absolute if it could with reasonable diligence and should in all the circumstances have been raised.”

15. In considering previous Court of Appeal authority on cause of action estoppel in the patent law context, Lord Sumption JSC held in *Virgin Atlantic* that the Court of Appeal decisions in *Poulton v Adjustable Cover and Boiler Block Co* [1908] 2 Ch 440, *Coflexip SA v Stolt Offshore MS Ltd* (No 2) [2004] FSR 34 and *Unilin Foods Copn v Berry Floor NV* [2007] Bus LR 1140 were wrongly decided. Lord Sumption JSC identified the key to the error fallen into by the Court of Appeal in *Coflexip* as an overstatement of the effect of the statement of principle by Lord Keith in *Arnold v National Westminster Bank* cited above at

paragraph 13, and referred with approval to the dissenting judgment of Lord Neuberger in *Coflexip*. Thus, Lord Sumption JSC said:

“[32] In my opinion the majority in *Coflexip* were mistaken on both of the points they made, for substantially the reasons given by Neuberger LJ in his dissenting judgment ... The essential fallacy in the majority’s reasoning in *Coflexip* lay in their view that Lord Keith in *Arnold* had held that cause of action estoppel was always absolute. He did not. He held that it was absolute only in relation to points actually decided on the earlier occasion. [Emphasis added]

16. In *Coflexip*, Neuberger LJ had explained this point about cause of action estoppel applying only to those points actually decided in the earlier case when he said at [51]:

[51] The reference to “strict cause of action estoppel” is to the type of case where a party seeks to raise in a second action the “identical” issue to that decided in the first action. A relevant example would be a second attempt to invalidate a patent, after a first action had failed, relying on the same prior art and on the same grounds (e.g. obviousness and anticipation) as had been raised in the first action. As I read Lord Keith's analysis of the law in *Arnold*, the type of abuse of process discussed in *Henderson* can apply in cases of cause of action estoppel and, although, in cases of strict cause of action estoppel, there is no escape other than through fraud or collusion, the somewhat more flexible approach in relation to issue estoppel applies to (indeed is to be derived from) Henderson abuse of process cases, even where those cases involve cause of action estoppel as *Henderson* itself did. That conclusion seems clear from the observations of Lord Keith which I have quoted at 107C–D.” [Emphasis added]

17. For the purposes of the present proceedings, the key point of the restatement in *Virgin Atlantic* is that cause of action estoppel only provides an absolute bar to estop a later cause of action where all of the points relied upon in the cause of action on the second action were decided in the first action (or where such points in relation to that cause of action were not decided because they were not raised, but they should have been raised)¹⁰. The result of this is that the older statements of the law in *Hormel Foods*¹¹ (the

¹⁰ see [22] of Lord Sumption’s judgment in *Virgin Atlantic* extracted above at paragraph 14.

SPAMBUSTERS case), where Mr Richard Arnold Q.C. sitting as a Deputy High Court judge drew on the *Poulton* and *Coflexip* line of authority at [88], [95] and *Evans v Focal Point Fires* at [91] (which followed *Hormel Foods*) to the effect that cause of action estoppel would apply absolutely to bar *any* second attack on the validity of a trade mark where that validity had been attacked in earlier proceedings are incorrect; what cause of action estoppel bars absolutely is an *identical* attack (i.e. invalidity + same grounds and basis of invalidity as run the first time around), such as that identified by Neuberger LJ in the passage above.

Henderson v Henderson abuse of process

18. In respect of *Henderson v Henderson* abuse of process, Lord Sumption JSC in *Virgin Atlantic* quoted with approval the exposition of the law by Lord Bingham of Cornhill in *Johnson v Gore-Wood & Co* [2002] 2 A.C. 1 at page 31:

“*Henderson v Henderson* abuse of process, as now understood, although separate and distinct from cause of action estoppel and issue estoppel, has much in common with them. The underlying public interest is the same: that there should be finality in litigation and that a party should not be twice vexed in the same matter. This public interest is reinforced by the current emphasis on efficiency and economy in the conduct of litigation, in the interests of the parties and the public as a whole. The bringing of a claim or the raising of a defence in later proceedings may, without more, amount to abuse if the court is satisfied (the onus being on the party alleging abuse) that the claim or defence should have been raised in the earlier proceedings if it was to be raised at all. I would not accept that it is necessary, before abuse may be found, to identify any additional element such as a collateral attack on a previous decision or some dishonesty, but where those elements are present the later proceedings will be much more obviously abusive, and there will rarely be a finding of abuse unless the later proceeding involves what the court regards as unjust harassment of a party. It is, however, wrong to hold that because a matter could have been raised in earlier proceedings it should have been, so as to render the raising of it in later proceedings necessarily abusive. That is to adopt too dogmatic

¹¹ *Hormel Foods Corporation v Antilles Landscape Investments NV* [2005] R.P.C. 28 – see in particular paragraph 76 as to the cause of action absolute bar operating even against different grounds; see too paragraph 95 – 96 of that decision.

an approach to what should in my opinion be a broad, merits-based judgment which takes account of the public and private interests involved and also takes account of all the facts of the case, focusing attention on the crucial question whether, in all the circumstances, a party is misusing or abusing the process of the court by seeking to raise before it the issue which could have been raised before.” [Emphasis added]

Decision

19. I turn now to apply the above principles in the context of the facts of the present proceedings and of the preliminary view relayed in the letter of 19 March 2019 that:

- The section 5(4)(a) ground (passing off) gave rise to issue estoppel;
- The section 3(6) ground (bad faith) gave rise to cause of action estoppel;
- There is potential for abuse of process.

20. In some respects, “a cause of action” is an expression that lacks precision and its use may signify different things in different contexts. The preliminary view clearly implied that an application under section 47 of the Act to declare invalid a registered trade mark was a “cause of action” that gave rise to a cause of action estoppel. Indeed, that position was consistent with the rulings in earlier cases such as *Hormel*, *Focal Point Fires* and *Coflexip*. However, the use of the expression by Lord Keith in *Arnold v National Westminster Bank*, as quoted at paragraph 13 above, would seem to permit a tighter construction of the phrase, and to so construe also aligns with the position following the Supreme Court decision in *Virgin Atlantic* where an absolute bar arises from a cause of action estoppel only where the attack is identical. I find that in the circumstances of these proceedings, the “cause of action” may properly be considered to be the combination of a claim under section 47 of the Act together with each of the grounds claimed for invalidity – section 5(4)(a) and section 3(6) of the Act (severally).

First cause of action: invalidity based on section 5(4)(a) – earlier right (passing off)

21. The preliminary view of the Registrar was that the section 5(4)(a) ground of invalidity would give rise to issue estoppel. However, **I find that**, based on the principles set out in *Virgin Atlantic*, **issue estoppel is not apt for the present proceedings**. For example, in line with the characterisation of issue estoppel as referenced at paragraph 17 of Lord Sumption’s judgment in that case, that principle envisages circumstances where the

causes of action are not the same but there is nevertheless some issue which is common to the two actions and which was decided as between the parties on the earlier occasion¹². Instead, **I find that the present (second) invalidity claim relying on section 5(4)(a) is prevented on the basis of cause of action estoppel**, because in that regard the cause of action in these proceedings is identical to that raised and determined in the earlier proceedings – a claim that the contested mark is invalid based on a claim to an earlier right in the form of goodwill protecting against passing off.

22. It is noted that when the Applicant brought his initial invalidity proceedings (CA501723 / BLO/570/18) based (only) on section 5(4)(a) of the Act, he did so without legal representation and might have failed to properly understand the nature of the evidence of use that was required in order to succeed in that invalidation action. It is recognised that cause of action estoppel has at least the potential to bring injustice in such circumstances; nonetheless, the law is clear as to the operation of the absolute bar on further proceedings under cause of action estoppel; a court or tribunal has no discretion in such instances.

Second cause of action: invalidity based on section 3(6) – bad faith

23. The preliminary view was not limited to addressing the Applicant's second attempt to cancel the Proprietor's mark on the basis of passing off; the preliminary view went further than that, stating that the section 3(6) ground of invalidity for bad faith (which ground had not previously been claimed by the Applicant) would give rise to cause of action estoppel because the cause of action (invalidity under section 47) is the same for both the new claim and the already determined claim.
24. *Threshold issue:* As set out earlier in this decision¹³, the Trade Marks Manual provides in relation to striking out on the grounds of estoppel or abuse of process that "*it is for one party to raise the issue, the hearing officer will not raise the matter of his/her own motion.*" In the present case, the Proprietor actively raised the matter of the earlier decision (BLO/570/18), stating in its email to the registry on 8 January 2019 that "*it seems much of this issue is the same as the first case*"; the official letter from the registry, dated 2 February 2019, asked the Proprietor for confirmation as to whether this was a request "*for*

¹² See too: Lord Keith in *Arnold* as quoted at paragraph 13 above and the passage from the dissenting judgment of Lord Neuberger in *Coflexip* at [51] as cited at paragraph 16 above.

¹³ paragraph 10 above

this Cancellation Action to be struck out”; that is broader language that does not limit itself precisely to that part of the issue (which the Proprietor’s 8 January email had referred to as “much”) that is the same as the decided case. The Proprietor did confirm (by e-mail on 13 February 2019) that it requested that the cancellation action be struck out, although it again expressly stated that the request was based on the grounds that “the argument for cancellation is the same in principle as the first denied cancellation request, CA000501723.”

25. Mr Zweck submitted that the Proprietor has not objected to the bad faith ground and that to strike out that ground would be tantamount to a Hearing Officer raising the matter at his/her own motion, and a Hearing Officer should therefore refrain from doing so. I accept that the Proprietor has not discretely or expressly objected to the bad faith ground – neither in its emails to the registry, nor in its filed Form TM8. All of its comments, including its filed Form TM8 and the points it raised in lieu of its attendance at the hearing (Annex 1) focus only on matters relating to the section 5(4)(a) ground. It appears that nothing is said directly in response to the bad faith claim. Nonetheless, the Proprietor did expressly confirm that it requested “the cancellation action” be struck out, and, when I allow for the fact that the Proprietor is a litigant in person, acting without legal representation, I am prepared to accept that its request for strike out was intended to cover both grounds claimed in the second (present) cancellation application. I therefore proceed to consider the substantive preliminary objections raised by the registry in relation to the section 3(6) bad faith ground.

26. **Cause of action estoppel:** Applying the points from case law¹⁴ in light of the Supreme Court ruling in *Virgin Atlantic* to the case here, the cause of action for invalidity here is not simply “invalidity under section 47”; it is “invalidity under section 47 on the ground that the trade mark is not registrable on account of the absolute ground of invalidity under section 3(6) for bad faith”. Accordingly, and in line with the reasoning discussed at paragraph 21 of this decision, **I find that cause of action estoppel does not apply to the section 3(6) ground**, as that cause of action was not raised or decided in the earlier proceedings. Cause of action estoppel operates as a strict bar, and this is so even where that may lead to harsh or unjust consequences; therefore there are good policy reasons for the

¹⁴ See paragraphs 12 to 17 above.

restriction of cause of action estoppel by reference to the points decided on the earlier occasion.

27. **Issue estoppel:** The preliminary view relayed in the letter of 19 March 2019 does not mention issue estoppel in relation to the section 3.6 ground, but I agree with Mr Zweck's submission that issue estoppel will not apply here either, since the issues relevant to the cause of action in the earlier proceedings (being goodwill, misrepresentation and likelihood of damage at the relevant date) are different from the issues relevant to the bad faith ground of invalidity in these proceedings.
28. **Henderson abuse of process:** the preliminary view relayed in the letter of 19 March 2019 also raised abuse of process as a possible objection. However, it was submitted on the part of Applicant that adopting the broad merits-based approach set out by Lord Bingham of Cornhill in *Johnson v Gore-Wood* at page 31 and approved by Lord Sumption in *Virgin Atlantic* at [24] leads to the conclusion that present action for invalidity on the 3(6) ground is not abusive. Mr Zweck made a number of submissions as to why there is in this case no abuse of process, which included the following:
- i. The onus would be with the Proprietor to prove an allegation that there has been an abuse of process. In this case, it is not clear that the Proprietor has raised abuse of process; indeed, it is far from clear that there has been any objection by the Proprietor to the bad faith ground of invalidity;
 - ii. At the time that the Applicant brought the previous invalidation proceedings he acted as a litigant in person, and cannot therefore have been expected to grasp fully the causes of action open to him or the potential consequences of advancing only one of those causes of action during the earlier proceedings;
 - iii. There is sworn evidence before the registry in the form of Mr Cutlan's witness statement that the Applicant has been trading under the contested mark and therefore has a genuine economic interest in these proceedings – this is not a case of harassment;
 - iv. The bad faith ground of invalidity is an entirely different ground to the passing off ground relied upon in the earlier proceedings. Accordingly, there would have been minimal time or costs savings made by having the bad faith ground of invalidity dealt with in the earlier proceedings, and it cannot therefore be said that the Proprietor has been

substantially inconvenienced by having the proceedings dealt with now rather than in the earlier proceedings.

29. While I acknowledge the observation in the letter of 19 March 2019 that it is in the public interest that a party should bring forward its best case and that there should be finality in litigation, I find that when I consider the facts of this case in the round, in line with the guidance of Lord Bingham cited at paragraph 18 above, I conclude that the Applicant in this case is not misusing or abusing the process of the tribunal by seeking to raise before it an issue which could have been raised before.

Conclusion

30. **I set aside the preliminary view as expressed. The Applicant's claim in relation to section 5(4)(a) is struck out on the basis of cause of action estoppel, but I allow the proceedings to continue in relation to the bad faith claim.**

31. The caseworker will shortly contact the parties to clarify and confirm the basis and extent of the application for invalidation in light of the previously served Form TM26(l) and this decision. The caseworker will also proceed to serve the Proprietor's defence accordingly and will set out the next steps in the process, in particular the dates for the evidence rounds. The communication from the caseworker will also refer to the opportunity for a case management conference (by telephone) in the event that either party should wish to clarify any procedural steps going forward.

Costs

32. No issues of costs arise.

Dated this 23rd day of May 2019

Matthew Williams

For the registrar

Annex 1 – points filed by the Proprietor in advance of the joint hearing

- Registering the domain bcelectronics.co.uk, there is no indication of trade
- https://www.amazon.co.uk/s/other?pickerToList=brandtextbin&qid=1556097587&me=A GPI6NRRHB0VN&ref=sr_sa_p_4 is a link to this storefront which belongs to the applicant demonstrates, various other registered brands other than 'BC ELECTRONICS' are being sold by the applicant via this amazon storefront.
- The ebay store name stated by the cancellation applicant 'b*c*electronics and Amazon storefront 'BC Electronics' are simply shop names or user ID's, which can easily be created and changed at any point.
- The applicant's Feedback scores from ebay and Amazon are speculative at best. They do not indicate the type of product being sold nor its volume of sales.
- The applicant has not provided any proof of the goods themselves nor provided invoices.
- The hearing officer has now twice rejected the applicant from cancelling the registered trademark. Nothing has changed since these decisions.
