

TRADE MARKS ACT 1994

**In the matter of 32 registrations of trade marks
consisting of, or including, the letters MG
in the name of Nanjing Automobile (Group) Corporation**

And

**Applications by by MG Sports and Racing Europe Limited
for rectification of the register in respect of registration No.2296016
and revocation of the remaining marks**

1. In a decision dated 12 November 2008 (now published under No. BL O-309-08), I indicated that:

- i) Subject to the receipt of an undertaking on behalf of Nanjing Automobile (Group) Corporation (“NAC”), I would order that these proceedings be transferred to the court;
- ii) I would consider making an interim award of costs in favour of MG Sports and Racing Europe Limited (“the applicant”) if provided with copies of relevant bills for the applicant’s evidence in reply and preparation for dealing with the substantive issues at the hearing on 30 September.

2. I subsequently received a letter dated 21 November from Pinsent Mason LLP, NAC’s legal representatives, undertaking to pursue the High Court proceedings with such vigour and urgency as the circumstances permit.

3. I therefore order under sections 46(4)(b) and 64(2)(b) of the Trade Marks Act 1994, that the revocation and rectification proceedings specified in annex A be transferred to the court.

4. I have also received a letter dated 24 November from Decisis Intellectual Property, the applicant’s legal advisers, with copies of bills of costs in respect of work undertaken on behalf of the applicant in respect of the period from 1 July to 23 October.

5. The material provided is not entirely clear and there is no covering explanation of the parts that are said to be relevant to the matters that I have identified. As far as I can tell from my own analysis, the bills show that the applicant’s relevant costs are:

- i) £1200 for Decisis’s input to the applicant’s evidence in reply (6 hours)
- ii) £1600 for Decisis’ contribution to the skeleton argument and preparation for the hearing on 30 September (8 hours);
- iii) £5400 for counsel to draft the applicant’s evidence in reply dated 21 August (14.5 hours) ;

- iv) £6350 for counsel to draft the applicant's skeleton argument and prepare for the hearing (19.75 hours).

6. Accordingly, the applicant's total costs for the preparing for the hearing on 30 September seems to have been £7950. Judging from the skeleton, just over half of this was attributable to preparing for the hearing of the substantive issues. This is at least £4000.

7. I indicated in my previous decision that I would award the applicant's reasonable wasted costs in this respect on a compensation basis. I regard the length of time spent preparing for the hearing (nearly 26 hours in total) as being in excess of what was necessary and reasonable for what would probably have been a 4-5 hour hearing with no witnesses. I will therefore allow the applicant the cost of 5 hours of counsel's time (£1500) and 3 hours of Decisis' time (£600) for the time spent preparing (including the skeleton argument) for the hearing of the substantive issues. £2100 in total.

8. The applicant's costs of filing its evidence in reply dated 21 August appears to be £6600 covering 20.5 hours work. As I noted in my previous decision, the evidence in question was a 17 page critique of NAC's evidence. Again the amount of time attributed to this appears to me to be beyond what was necessary and reasonable. A reasonable allocation should be no more than 5 hours of counsel's time (£1500) and 2 hour of Decisis' time (£400), making £1900 in total.

9. NAC points out that the applicant's evidence in reply is not wasted because the proceedings will continue in court. That, of course, depends on the applicant making any necessary applications. Further, given that the substantive hearing before the court is likely to be some months away and that the parties may file further evidence in the court proceedings, it seems likely that the applicant's evidence in reply in the Registry proceedings, if not entirely wasted, will probably be overtaken and/or require updating before the hearing in court. It will probably not serve the purpose it was intended to – to bring the applicant's evidence in the rectification/revocation proceedings to a conclusion. I will therefore award the applicant half the maximum reasonable cost of the preparation of that evidence - £950.

10. I therefore order that:

- i) These proceedings are transferred to the court;
- ii) NAC pay the applicant £3050 within 28 days as compensation for the reasonable and wasted costs of the Registry proceedings from 25 July onwards.

Dated this 10 day of December 2008

**Allan James
For the Registrar**

Annex A

1. Trade Mark: **"MG X POWER"**
Registration No: 2296016
Rectification No: 83154

2. Trade Mark: **"MG"** (Badge)
Registration No: 1511445
Revocation No: 82963
3. Trade Mark: **"MG"** (Badge)
Registration No: 2154382
Revocation No: 82986
4. Trade Mark: **"MG"** (Badge) (series of two marks)
Registration No: 2009494
Revocation No: 82987
5. Trade Mark: **"MG"** (Badge) (series of three marks)
Registration No: 2311308
Revocation No: 82988
6. Trade Mark: **"MG"**
Registration No: 1284198
Revocation No: 82989
7. Trade Mark: **"MG"** (Badge)
Registration No: 1511446
Revocation No: 82990
8. Trade Mark: **"MG"** (Badge)
Registration No: 1511450
Revocation No: 82991
9. Trade Mark: **"MG EXPRESS"**
Registration No: 2320793
Revocation No: 82992
10. Trade Mark: **"MG LIFE'S TOO SHORT NOT TO"**
"MG LIFE IS TOO SHORT NOT TO"
Registration No: 2314255
Revocation No: 82993
11. Trade Mark: **"MG"**
Registration No: 2067055
Revocation No: 82995

12. Trade Mark: **"MG"** (Badge)
Registration No: 490090
Revocation No: 82996
13. Trade Mark: **"MG"** (Badge)
Registration No: 659592
Revocation No: 82997
14. Trade Mark: **"MG"** (Badge)
Registration No: 659591
Revocation No: 82998
15. Trade Mark: **"MG"** (Badge)
Registration No: 499386
Revocation No: 82999
16. Trade Mark: **"MG"** (Badge)
Registration No: 1283661
Revocation No: 83000
17. Trade Mark: **"MG CARS"**
"MG CAR"
"MG"
Registration No: 2154358
Revocation No: 83001
18. Trade Mark: **"MG"**
Registration No: 2311312
Revocation No: 83002
19. Trade Mark: **"MG"** (Badge) (series of two marks)
Registration No: 2067053
Revocation No: 83003
20. Trade Mark: **"MG"** (Badge)
Registration No: 1511448
Revocation No: 83004
21. Trade Mark: **"MG"** (Badge)
Registration No: 1511447
Revocation No: 83005
22. Trade Mark: **"MG"** (Badge) (series of two marks)
Registration No: 2104403
Revocation No: 83006
23. Trade Mark: **"MG"** (Badge)
Registration No: 1511449
Revocation No: 83007

24. Trade Mark: **"MG"** (Badge)
Registration No: 490091
Revocation No: 83008
25. Trade Mark: **"MG"** (Badge) (series of two marks)
Registration No: 1538064
Revocation No: 83009
26. Trade Mark: **"MG"** (Badge) (series of two marks)
Registration No: 2002422
Revocation No: 83010
27. Trade Mark: **"MG"**
Registration No: 2131546
Revocation No: 83011
28. Trade Mark: **"MG"** (Badge)
Registration No: 1254349
Revocation No: 83012
29. Trade Mark: **"MG"** (Badge)
Registration No: 1511444
Revocation No: 83013
30. Trade Mark: **"MG"** (Badge)
Registration No: 520176
Revocation No: 83014
31. Trade Mark: **"MG MAGNETTE"**
Registration No: 535521
Revocation No: 83015
32. Trade Mark: **"MG"**
Registration No: 1031424
Revocation No: 8301