

O-138-10

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION No. 1501909
IN THE NAME OF ROBERT DENNIS BUSBRIDGE T/A COBRETTI
ENGINEERING
AND IN THE MATTER OF AN APPLICATION
FOR RECTIFICATION No. 83562
BY MARTIN ALAN BUSBRIDGE**

ALSO

**IN THE MATTER OF APPLICATION No. 81522
BY ROBERT DENNIS BUSBRIDGE
FOR A DECLARATION OF INVALIDITY
IN RESPECT OF TRADE MARK No. 2070139
STANDING IN THE NAME OF KENNETH COOK**

BACKGROUND

Rectification

1) On 18 May 1992, Cobretti Engineering (a partnership), subsequently amended (in 2007) to Robert Dennis Busbridge and Martin Alan Busbridge trading as Cobretti Engineering, applied for the trade mark **VIPER**.

2) The trade mark was registered on 12 November 2004 under number 1501909. It is registered in respect of the following goods:

“Sports Cars; all included in Class 12.”

3) In July 2009 the registration was amended to show the registered proprietor as Robert Dennis Busbridge trading as Cobretti Engineering.

4) On 18 August 2009, Martin Alan Busbridge filed a form TM26 (R) and accompanying Statement of Reasons seeking rectification of the register. This statement requested that the registered proprietor of registration number 1501909 be amended from Robert Dennis Busbridge trading as Cobretti Engineering to Robert Dennis Busbridge and Martin Alan Busbridge trading as Cobretti Engineering.

5) On 2 September 2009 the Registrar issued a letter informing Mr Robert Busbridge that an application for rectification of his registration had been received. The registered proprietor was provided with a period of two months in which to submit evidence.

Invalidity

6) The registered proprietor, Kenneth Cook has the following trade mark registered in the UK:

Mark	Number	Filing & registration dates	Class	Specification
VIPER	2070139	30.04.96 & 10.05.02	12	Motor vehicles and parts and fittings for motor vehicles; kits and components for assembly into motor vehicles.

7) The registered proprietor claimed honest concurrent use with Registration Nos. 1287718, 1410265 and others.

8) By an application dated 27 October 2003 Robert Dennis Busbridge, applied for a declaration of invalidity in respect of this registration. The grounds are, in summary:

- a) The applicant is the proprietor of the earlier registered trade mark No. 1501909 VIPER. The applicant and his predecessors in business have made substantial use of its mark in the UK since 1987 in relation to the manufacture, repair and servicing of sports cars and has acquired an extensive goodwill and reputation in the said trademark in relation to those goods and related services.

- b) The marks, goods of the two parties are identical. The registration of trade mark 2070139 was accordingly granted in violation of the provisions of Sections 5(1), 5(2) (a) and 5(4) (a) of the Act and should be declared invalid under Sections 47(2) (a) and (b) of the Act.

9) The registered proprietor filed a counterstatement denying the above grounds. The statement also contained a number of claims which I will include in my summary of evidence.

10) At a Case Management Conference held on 17 November 2009 it was agreed to hear both cases at the same time in order to reduce the parties' costs. All sides filed evidence in these two sets of proceedings. All sides ask for an award of costs. The matter came to be heard on 28 January 2010 when Mr Martin Busbridge and Mr Robert Busbridge represented themselves, whilst Mr Cook was represented by Mr Wallens of Messrs Lester Aldridge LLP.

EVIDENCE

Martin Busbridge

11) Mr Martin Busbridge filed three witness statements dated 12.08.09, 15.08.09 & 23 December 2009.

12) He states that in early 1988 he and his brother (Robert) began the partnership known as Cobretti Engineering, hereinafter referred to as Cobretti. Cobretti agreed with Mr Cook, acting on behalf of Brightwheel Replicas Ltd (BRL) to act as an agent selling a kit of parts for customers to build their own cars. In addition, Cobretti began building complete cars from the kits supplied by BRL in order to fulfil orders obtained by BRL for fully built cars. The kits and cars were sold under the name VIPER and were copies of the AC Cobra. He states that when BRL ceased operating its business in September 1989, Cobretti agreed to act in the same capacity for Mr Cook, now trading as Classic Replicas. Cobretti did this as they needed the supply of kits and parts in order to remain in business. A written agreement was entered into between Cobretti and Mr Cook dated 20 October 1989. This document is provided at page 1 of exhibit MAB1. It states that the name "Viper" is the property of Mr Cook and that "all efforts will be made to safeguard this name". He also states:

"It was intended that all and any goodwill generated in the Viper mark as a result of the Partnership's [Cobretti] activities would accrue to Mr Cook personally, acting through BRL, and then subsequently to Mr Cook trading as Classic Replicas. The Partnership [Cobretti] was acting as agent only for and on behalf of BRL and then for Mr Cook."

13) He states that Cobretti decided to begin making its own parts and cease purchasing from Mr Cook. He and his brother (Robert) persuaded the jig maker to copy Mr Cook's Jaguar V8 chassis jig and another company would copy the body moulds. After Mr Cook left for Switzerland Cobretti activated its plan, amending advertising so that the advertising stated "under new management". During the build up to this time Cobretti kept up the pretence of still being Mr Cook's agents. Mr Cook, he states, became aware of the true position late in 1991. He states that:

"At the relevant time in or around March or April 1992 my bank was threatening to enforce its security interest over my house and my wife and Mr [R] Busbridge were not

supporting me. So all this culminated in or around June 1992 in my splitting up and falling out with Mr [R] Busbridge and our agreement to terminate the Partnership [Cobretti] first orally and then in writing in accordance with the agreement exhibited at page 12.”

14) The agreement exhibited at page 12 states:

“After mutual discussion with Mr R Busbridge and Mr M Busbridge on the day dated Monday 29 June 1992. It was decided that the partnership between the two parties would be terminated.”

15) It would appear to be signed by both partners, but I note that the signature of Mr R Busbridge appears to be considerably different to that shown on the agreement between Cobretti and Mr Cook at page 1 of exhibit MAB1.

16) A number of points are repeated in the various witness statements. However, in his last statement he claims that Mr Colin Bruce was collaborating with Robert Busbridge, prior to the break-up of Cobretti and then became a director of Autotrak, along with Robert Busbridge and his wife. Mr M Busbridge states that contrary to the claims of his brother he did not leave the UK until October 1993. Mr Busbridge again questions the legality of copying Mr Cook’s jigs and body panels and states that if it were acceptable, why did they attempt to make sure that Mr Cook did not find out. When Mr Cook did find out he sent a letter threatening legal action which Martin Busbridge states “compounded” the pressure on him. At the same time the bank was requesting the repayment of the overdraft and his wife was not supporting him. He states “To make matters worse, Robert Busbridge was determined to carry on, with no thought of the consequences”. Shortly after this the partnership (Cobretti) was terminated. Regarding his relationship with Mr Cook he describes it as “frosty” as he states that he was part of a conspiracy to defraud Mr Cook. He continues:

“However, it now appears we have a common goal regarding Robert Busbridge’s actions and the fact that we have both been deceived.”

17) Martin Busbridge states that his brother (Robert) has lied about not knowing of his (Martin’s) whereabouts, and states that his brother’s claims that he, Martin, had changed his name and also had problems with the UK authorities were also false. Martin Busbridge states that his Mother and his other brother, Andrew, knew where he was living and could have supplied the address and phone number to Robert Busbridge. He also states that Robert Busbridge has not been trading in cars and car parts but has in fact been making toy trains out of scrap metal and selling them at local markets. He states that his brother claimed that he was so good at dealing with the Registry that he could work for them. He also states that: “It would appear that Robert Busbridge has pre-planned his every move”.

18) I also found the following quotations from Martin Busbridge’s evidence of interest.

a) “I firstly would like to make comment about the reason for the termination of the partnership. This was done during a discussion between ourselves about the situation and future of Cobretti, which involved our financial position. It was decided to be financial suicide to continue and we should “close the doors” so to speak.”

b) “The decision was made to terminate the partnership only, hence the paper drawn up between us. I have never legally given up my rights for my brother to take over my share of the assets and trademark, even though this was discussed between us and also with my solicitor (Taylor Wilcox) who advised against it.”

c) “It is true that I played no active part in the business using the trademark 1501909 since 1992.”

d) “I have found out quite recently (May/June 2009) that I was disinherited by my mother and written out of her will – and my brothers bequeathed the proceeds of two properties, together with personal effects valued in the region of GB pounds 450,000. Out of which, I have received nothing. I am convinced by [sic] my brothers coerced my mother into that decision using her mental state at the time for their benefit and [sic] at present taking legal advice to rectify this situation.”

Mr COOK

19) Mr Cook filed two witness statements, dated 18 February 2009 and July 2009. Mr Cook claims that he is the owner of the mark VIPER. He states that Robert Busbridge only began use of the mark after being appointed as an agent by Brightwheel Replicas in 1988. He states that this company closed down in September 1989 and that Mr Cook formed a new business Classic Replicas and engaged Robert & Martin Busbridge as agents for this business. This continued until mid 1991 when Mr Cook found out that Robert Busbridge had copied his jigs and moulds. Mr Cook states that he instructed his agent to file a trade mark application for VIPER in 1992 under the name Classic Replicas. Mr Cook claims that the registration certificate submitted by Robert Busbridge in January 2005 which shows the mark registered to Robert Busbridge is a forgery or legally incorrect. However, his exhibits 3 & 4 prove this statement to be incorrect. Mr Cook is also selective in his views as to what the Registry found with regard to an earlier opposition involving Chrysler. The Hearing officer commented:

“The applicants, [Chrysler] however, did not respond to this evidence with evidence of their own user, or of other special circumstances which might entitle them to registration. Instead they provided evidence that Mr Cook’s claim to own the mark is not undisputed, and as I have already stated that is not a matter in which, in these proceedings, the Registrar has any part to play.”

20) He points out that in 1993 Robert Busbridge was declared bankrupt and so at that stage could not take part in any business until he was discharged. Much of the rest of his statement does not deal with specific facts but consists of invective against the Registry and Robert Busbridge. He also asks various questions in his statement; neither the invective nor the questions can be regarded as evidence. He provided a number of exhibits which I summarise below:

- Exhibit KC1: A copy of an agreement on “Classic Replicas” headed notepaper, with an address in the UK, between Robert Busbridge and Martin Busbridge trading as Cobretti Engineering and Mr Cook. This states that Cobretti will continue to work as agents “for the Viper range of Cobra replicas” manufactured by Mr Cook. It also states that the name VIPER belongs to Mr Cook and that Cobretti will not copy any chassis or parts. The only date is alongside Mr Cook’s signature and is 20 October

1989. At first sight it appears that it is signed by the three men, but I refer to my earlier comments at paragraph 15 above.

- Exhibit KC2: A series of magazine articles which suggest that Cobretti had jigs and moulds made up to continue in business finishing building cars for clients following the demise of Brightwheel Replicas Ltd. These articles do not have visible dates.
- Exhibits KC3 & 4; A copy of the registration certificate for the mark VIPER (number 1501909) in the name of Cobretti Engineering (a partnership) and a copy of an e-mail, dated 7 February 2005, from the IPO explaining that the original registration certificate in the name of Robert Busbridge was incorrect.
- Exhibits KC5, 6, 7, 8 & 9: A letter on “Classic Replicas” headed notepaper, dated 26 February 1992, with an address in Germany signed by Mr Cook asking his trade mark agent to search the name “VIPER” in England. A response, dated 8 April 1992, from Kings Patent Agency Ltd, suggesting filing the trade mark and then writing to Chrysler pointing out the prior rights. A reply by Mr Cook dated 15 April 1992, enclosing a cheque and instructions to file said application. A reply from the agent, dated 25 April 1992, pointing out that Chrysler’s mark had been advertised and so filing would not go ahead, instead a letter would be sent to Chrysler informing them of the prior use. A copy of a letter from the agent to the Registry, dated 24 June 1993, pointing out that Cobretti can only use the mark VIPER under the terms of the agreement Mr Cook dated 20 October 1989.
- Exhibit KC10: A magazine article, with a hand written date of May 1986, which refers to Brightwheel Ltd offering a Cobra replica, based on a Ford Granada. The article begins “By the end of May 1986, another manufacturer had joined the Cobra ranks.....”. It mentions the name VIPER.
- Exhibit KC11; A copy of the Christchurch Advertiser dated 29 September 1988 which refers to a local company selling replicas of the Cobra and Countach. The Cobra copy is known as a Brightwheel Viper. The article mentions that the cars are sold as kits only, due to issues with Type approval legislation.
- Exhibit KC12: This is an advertisement by Cobretti Engineering offering Viper cars and stating that they are “under new management”. Attached to it is the front cover of a kit car magazine the title of which has been blacked out. It is dated February 1991.
- Exhibit KC13: Consists of a copy of an advertisement by Cobretti Engineering for “The original Viper 4” based on a Ford Cortina. Hand dated June 1992.
- Exhibit KC14: This appears to be a copy of a magazine article, undated and source unknown, referring to Cobretti Engineering and the range of cars they offer. Mr Cook has annotated this claiming that the car used in the photo shoot is one he built in 1990. The article also states: “When Brightwheel finally went bust in autumn 1989, Cobretti’s copying of the Viper raised a few eyebrows but, after all, the car was already a copy- of the defunct Sheldonhurst Cobra”.
- Exhibit KC15: This appears to be an order for 5 cars from Wheels Abroad based in London. It is dated 14 April 1989. Of the five cars the order is annotated by hand to

show that two were allotted to Cobretti to build, the other three were made by Brightwheel Replicas Ltd. One of these Mr Cook claims is the vehicle in the article at exhibit KC14. I note that the order states that Wheels Abroad will supply engines and gearboxes and that all the cars are to have “Cobra” badges front and rear. Nowhere on the order is the mark Viper referred to.

- Exhibit KC16: This consists of pictures of a Cobra replica. Mr Cook states that it has a V12 engine and was built by him.
- Exhibit KC17: A witness statement which does not have any case details upon it. Mr Cook states that it was used in his defence against a charge of perjury. This is dated 13 March 2000 and is signed by Donald Savage of Wheels Abroad. He does not state his position in the company or whether he is trading as a sole proprietor. He states that he gave an order for five fully built cars to Mr Cook in 1988. In 1989 four were still to be built and he agreed for two to be completed by Cobretti, who he believed were Mr Cook’s agents.
- Exhibits KC18, 19 & 20: A magazine article, undated, about an accident between a Cobretti Viper and a Land Rover. A letter from the owner to Cobretti, dated 7 August 1990, describing the damage done to his vehicle, referring to “their vehicle”. A photograph of the damaged vehicle in the Cobretti workshop taken by Mr Cook, hand dated August/September 1990. Mr Cook states that the car was built by Cobretti from one of his kits as Cobretti did not have their own jigs until 1991/92.
- Exhibit KC21: A further article which refers to the accident and mentions the Cobretti Sierra based Viper, which Mr Cook claims he developed and was copied by Cobretti. The copy is from the Internet and has a search date of 20 April 2004.
- Exhibit KC23: This appears to be a quote by Cobretti to Dr Bechtolsheimer who has an address in Gloucester, although hand written notes suggest the car will be exported. This is undated.
- Exhibit KC24: This is a witness statement, dated March 2000, again not documented for any particular case. It is very similar to that filed by Mr Savage at exhibit 17 above, and may have been for Mr Cook’s trial for perjury. The wording was clearly typed for Dr Bechtolsheimer as he has altered much of it by hand, crossing out bits and writing in additional parts. It states that he met Mr Cook in 1991 and was interested in purchasing a Cobra replica. Mr Cook informed him he could not build one at that time. Dr Bechtolsheimer had already been to see Cobretti Engineering, and asked Mr Cook about them. Mr Cook informed him that Cobretti were his agents. He states that he does not know if this car was from a kit that Cobretti had in stock or if it was supplied by Mr Cook. Mr Cook believes that this shows that Cobretti were passing off cars they built from his kits as their own. It is not clear quite how he comes to this conclusion given that as Cobretti did build the car they were surely correct in stating that they built it from a kit that they sold to the owner.
- Exhibit KC25: A copy of an undated advertisement for a Viper placed by Cobretti.
- Exhibit KC26: Four order forms from “Cobretti”, also “Cob” and “Cob-Eng” to “K.C” dated February and March 1991 for parts relating to a “Swiss” V8.

- Exhibits KC27-29: Magazine articles showing pictures of Cobretti cars. The only dates are the search date in 2009. Again Mr Cook claims that he supplied the kits to Cobretti that they then built into the cars pictured.
- Exhibit KC30: A print out of a page of the Cobretti website. This is headed “The Original “Cobretti Viper” and Ex “Brightwheel” Parts Suppliers, Re-Builds and a Shoulder to Cry On”. It would seem that this dates from 2009.
- Exhibit KC31: A copy of an advertisement from Classic and Sportscar magazine dated May 1991. The advertisement shows a picture of a Cobra car. There is no indication of who placed the advertisement as no company or individual is named, nor does the word Viper appear. There are telephone and fax numbers for further information but these are said to be “Swiss & Germany”.
- Exhibit KC32: A sheet of photographs of Cobra type cars including one which is said to have been used in the advertisement in exhibit 31 above.
- Exhibit KC33: A copy of a page said to be from The Complete Guide to Kit Cars dated December 1994/95 which shows a Cobretti Viper which Mr Cook states is the car supplied to Dr Bechtolsheimer.
- Exhibit KC34: Orders for car parts and chassis from Cobretti dated late 1990 and early 1991. These mostly have “K.C” in the “to” part of the order form. There are also sales invoices which do not show any name to denote who they are from. The only time the mark VIPER is mentioned is on one sales invoice which has no originating name, but is addressed to Cobretti. It shows two commission kits “Viper Blk” and “Viper Blue” at £100 each.
- Exhibit KC35: An invoice dated 4 June 1990 to Brightwheel Replicas Ltd for printing brochures. This has a hand written note that it should have been addressed to Classic Replicas. Also attached is another printing invoice dated 19 February 1992 to Classic Replicas. Neither invoice mentions the mark in suit.
- Exhibits KC36 & 37: Copies of German car magazines which mention Mr Cook, Classic Replicas and also Viper. The articles are in German and have not been translated. Only one has a date which is March 1992.
- Exhibit KC38: Letters from Mr Cook to Cobretti regarding ordering and payment requirements. These letters are on “Classic Replicas” paper and dated April and May 1991.
- Exhibit KC39 & 40: A copy of a letter dated 3 September 1991 to Mick Frost seeking the return of jigs which Mr Cook states he supplied the patterns for. He also states that these should not be copied. A copy of a letter from Mick Frost stating that Mr Cook has paid for jigs to make a Cobra replica chassis which is Jaguar based. It states that these jigs will be given back to Mr Cook if Mr Frost ever ceases to work for him.

- Exhibits KC41 & 42. Letters from Mr Cook and his Trade Mark Agent to Cobretti Engineering dated 31 May and 3 July 1992 respectively, informing them that the mark VIPER belonged to Mr Cook.
- Exhibit KC43: This is a “To whom it may concern” witness statement by Trevor Sangster Jones, which is undated. He was employed by Cobretti Engineering to make a chassis jig for their Cortina based car. He makes numerous comments regarding the partners of Cobretti Engineering and others which I shall not summarise here as much of it appears to be conjecture.
- Exhibit KC44: This is an agreement between Mr Cook and a Mr Barrass regarding making a chassis jig and selling kits of parts including a chassis as an agent for Mr Cook. This is dated 3 March 1993.
- Exhibit KC44A: This is a witness statement, dated July 2008, by Tony Barrass. It was sworn with regard to the invalidity case against registration 2070139 but does not carry the invalidity number. He states that he was approached by Mr Cook in November 1992 shortly after Mr Barrass became the owner of a kit car company called DMS. In addition to the Cortina based Cobra replica which the previous owner had copied from Mr Cook, a Jaguar based Cobra called VIPER would be added. The Cortina based kit had its name changed from Venom to Viper 4 during 1993 and the business name changed from DMS to Classic Replicas although Mr Cook never became a partner as the business was not profitable. However, he does state that he was licensed by Mr Cook and that Mr Cook would receive a commission on any kit sold. In 1995 Mr Barrass sold the business to Mr Cook.
- Exhibit KC45: Various magazine articles and advertisements relating to the use of the Viper mark by DMS in October 1993 and by Classic Replicas in May 1994, April 1997, July 2000 and April 2001.
- Exhibit KC46: Selected pages from what is said to be Mr Cook’s trial at Dorchester County Court in 2000. It shows Robert Busbridge being cross examined. Mr Cook states that this shows that Robert Busbridge was an agent for him from September 1989, that Robert Busbridge did purchase Viper kits from Mr Cook to sell on and to make up into complete cars.
- Exhibit KC47: This is a copy of a letter from Mr Cook to Robert Busbridge dated 15 May 2009 which threatens further legal action if Mr Busbridge does not agree to Mr Cook’s terms.

Robert Busbridge

21) Mr Robert Busbridge filed witness statements dated 20 January 2005, 22 October 2009 & 3 January 2010. He states that none of his family have been in contact with his brother Martin, other than e-mails accusing Robert Busbridge of coercing their mother to disinheriting Martin. Robert Busbridge states in his statement of 22 October 2009:

“10. I admit no document was ever signed regarding an indemnity, but this was offered through my solicitor Taylor Willcox to his solicitor, showing my intent, also confirming that I intended to continue the business of Cobretti.”

22) He also states that in fact he did take care of all the customers, and carried on the business. There are numerous references to family issues which Robert states explains why his brother has an agenda. He includes e-mails from Martin which show that Martin is very angry with Robert and his other brother. One contains the phrase "I am now a very bitter individual". The e-mails from Martin Busbridge also make it clear that Martin lost his house and his marriage; that he blames his brother for interfering in his marriage and siding with his ex-partner, and he contrasts this with Robert Busbridge keeping his home. At the hearing it was made clear that Robert Busbridge also had his house seized and went into bankruptcy, albeit approximately one year after the partnership had dissolved. That both brothers had actually lost their properties is alluded to by Martin Busbridge in the Statement of Grounds for the rectification.

23) Robert Busbridge contends that the agreement between himself, his brother and Mr Cook as exhibited by Martin Busbridge is a forgery. He attaches various letters from Mr Cook which he contends show that the letter heading, logo and typescript on the agency agreement were not produced until as late as 10 September 1990. He states that the Classic Replicas letter heading only started to appear from August 1990 and stated "For all your 427 Parts". The typescript then changes on 10 September 1990 where the letter heading shows "427 turnkey cars & parts". He contends that the agreement dated 20 October 1989 is therefore a forgery, and that an agreement regarding a single Cortina based car was used to lift his signature and create the false agreement filed by his brother. He provides the original agreement regarding this car at exhibit 13 of his witness statement dated 5 January 2010.

24) Attached to his statement dated August 2009, he provides the following exhibits:

- Exhibit RB1: A copy of an advertisement said to date from 1987 which shows Bob Busbridge as the London Agent for Brightwheel Replicas Ltd for Viper V8 cars.
- Exhibit RB2: A copy of a Statutory Declaration by Mr Cook, dated 10 December 1996, sent to the UK Trade Marks Registry to back his claim for honest concurrent use. The declaration provides sales figures for the years 1986-1995. They show sales of cars and or kits in every one of the years. The average price of a car is said to be between £15,000-20,000 with kits costing £2,000. He provides advertising figures for the UK for the years 1985-1990 and 1993 -1995. Mr Cook states that in 1991 and 1992 he concentrated on the German market.
- Exhibit RB3: A copy of a deposition by Mr Cook at the Bournemouth Combined Court Centre, dated 28 June 1995. In his deposition Mr Cook states that he returned from Germany in September 1992 and registered for employment in November 1992 and that "I have not been in paid employment since that time". He states that the company Classic Replicas is owned by Mr Barrass and that although he (Mr Cook) has assisted by handling mail and taking telephone calls for Mr Barrass he has never received any payment and that he is not a partner with Mr Barrass in the company.
- Exhibit RB7: This is a copy of a letter, dated 6 October 1989, from Mr Cook and is addressed "Dear Sir". It is annotated by hand "For your records". Mr Busbridge states that this was a public letter from Mr Cook sent to the Kitcar Magazine for publication. The letter informs anyone who had ordered a kit from Brightwheel Replicas Ltd that

the company had ceased trading and that they would not get any money back. It contains the following paragraph:

“Those of you who are under the illusion that I owned BRL should know that I sold my interest in BRL to the backers in March 1987 and since then have worked as any other employee on a wage which was lower than many of the other employees. You should know that I am like the other staff of BRL, out of a job. You should also know that my original investment into Brightwheel Ltd then BRL pre March 1987, of £30,000 has been lost.

If you feel you wish to take action against BRL, I would advise you to see a solicitor. However, BRL as I have said has no assets and I am not legally liable for BRL’s debts.”

25) That concludes my review of the evidence. I now turn to the decision.

DECISION

RECTIFICATION

26) The application for rectification is made under the provisions of section 64(1) of the Act. Section 64 of the Act reads:

“64. - (1) Any person having a sufficient interest may apply for the rectification of an error or omission in the register:

Provided that an application for rectification may not be made in respect of a matter affecting the validity of the registration of a trade mark.

(2) An application for rectification may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(3) Except where the registrar or the court directs otherwise, the effect of rectification of the register is that the error or omission in question shall be deemed never to have been made.

(4) The registrar may, on request made in the prescribed manner by the proprietor of a registered trade mark, or a licensee, enter any change in his name or address as recorded in the register.

(5) The registrar may remove from the register matter appearing to him to have ceased to have effect.”

27) Mr Martin Busbridge seeks to rectify the register effectively to reverse the previous rectification already granted whereby the registration was adjusted to remove Martin Busbridge's name and leave the registration solely in the name of Robert Busbridge. The mark was originally applied for on 18 May 1992, however on 29 June 1992 Martin Busbridge states that the partnership ended with him providing his brother with written notice that he wanted nothing else to do with the partnership. The date of this letter and its effect of ending the partnership are not challenged by Robert Busbridge. What Robert Busbridge claims is that he continued to trade as Cobretti Engineering from this date and that he took on the assets and liabilities of the business in return for providing an indemnity to his brother. However, although an indemnity was offered by Robert Busbridge to Martin Busbridge it was never formalised.

28) Further, it is common ground between the Busbridges that there was never a formal agreement regarding their partnership, instead there was a verbal agreement. This position and its effects were considered in an earlier decision (BL O-239-05) where the Hearing Officer said:

“20) The official letter of 8 March 2005 appears to confuse a partnership at will with a partnership by parol ie there is no written agreement between the partners. Partnerships by parol are not uncommon (see “Lindley & Banks on Partnership (eighteenth edition)” 7-23: “It has already been seen that partnerships can be, and frequently are, created by parol.”) Mr R Busbridge in his reply to the official letter advises that the partnership was by verbal agreement ie a partnership by parol. A partnership at will exists where no fixed term has been agreed upon for the duration of the partnership. Section 26(1) of the Partnership Act 1890 relates to partnerships at will:

(1) Where no fixed term has been agreed upon for the duration of the partnership, any partner may determine the partnership at any time on giving notice of his intention so to do to all the other partners.”

It is necessary to show that a partnership was not at will, not vice versa as per “Lindley & Banks” at 9.05:

“In order to negative the implication of a partnership at will, there must be some express or implied agreement that is inconsistent with the right which a partner would otherwise have to determine the partnership by notice. Thus, an express term that “This agreement shall be terminated by mutual arrangement only” will clearly amount to such an agreement and will constitute a partnership for joint lives, unless all the partners agree to dissolve the partnership at some earlier date.”

At the hearing Mr R Busbridge confirmed that the partnership had been a partnership at will. The retirement from the partnership by M Busbridge will have caused dissolution of the partnership. “If a partner decides to retire from a partnership at will, his departure will cause a *general* dissolution of the firm, unless by the act of retiring he can be taken to have forfeited his right to force a sale of the partnership assets, etc., in exchange for a right to be paid out the market value of his share as at the date of his “retirement”” (Lindley & Banks 24-91). Section 32 of the Partnership Act states:

“Subject to any agreement between the partners, a partnership is dissolved-
(a) If entered into for a fixed term, by the expiration of that term:

(b) If entered into for a single adventure or undertaking, by the termination of that adventure or undertaking:

(c) If entered into for an undefined time, by any partner giving notice to the other or others of his intention to dissolve the partnership.

In the last-mentioned case the partnership is dissolved as from the date mentioned in the notice as the date of dissolution, or, if no date is so mentioned, as from the date of the communication of the notice.”

The result of Mr M Busbridge’s retirement brought about a general dissolution of the partnership. A general dissolution involves a full scale winding up of the partnership. The time of dissolution refers to the time when the partnership ceases to continue, however, the partners may continue to be associated together in order to wind up the affairs of the partnership. This is in contrast to the dissolution of a company, where the dissolution marks the conclusion of the winding up (see Lindsey & Banks at 24-01 to 24-04). Section 38 of the Partnership Act deals with the continuing authority of partners following dissolution of a partnership:

“After the dissolution of a partnership the authority of each partner to bind the firm, and the other rights and obligations of the partner, continue notwithstanding the dissolution so far as may be necessary to wind up the affairs of the partnership, and to complete transactions begun but unfinished at the time of the dissolution, but not otherwise. Provided that the firm is in no case bound by the acts of a partner who has become bankrupt; but this proviso does not affect the liability of any person who has after the bankruptcy represented himself or knowingly suffered himself to be represented as a partner of the bankrupt.”

So the partners would have the ability and the need to wind up the affairs of the partnership and dispose of the assets, which would include the trade mark application.

The official letter of 4 April 2005 indicates that an assignment could not take place after the dissolution of the partnership. This, in my view, confuses the different natures of a winding up of a company and a partnership; this in turn seems to be based upon the misconception that in England a partnership is a legal entity. In *Memec Plc v The Commissioners of Inland Revenue* [1998] EWCA 941 Gibson LJ listed the “relevant characteristics of an ordinary English Partnership” in these terms:

- “(1) the partnership is not a legal entity;
- (2) the partners carry on the business of the partnership in common with a view to profit (s.1(1) Partnership Act 1890);
- (3) each does so both as principal and (s.5 *ibid.*) as agent for each other, binding the firm and his partners in all matters within his authority;
- (4) every partner is liable jointly with the other partners for all debts and obligations of the firm (s.9 *ibid.*); and
- (5) the partners own the business, having a beneficial interest, in the form of an undivided share, in the partnership assets (*MacKinlay v Arthur Young & Co.* [1990] 2 A.C. 239 at p.249 per Lord Oliver), including any profits of the business.”

As per the fifth point, the assets of the R and B Busbridge partnership include the trade mark application/registration.”

29) However, in *BL O-130-09 VIPER* Professor Ruth Annand acting as the Appointed Person considered the issue of the indemnity, and commented:

“28. Mr. Cook’s other criticism was the lack of evidence of an express indemnity having been entered into. However such an indemnity can be implied on the part of a continuing or surviving partner (Lindley & Banks on Partnership, 18 Edition, paragraph 10-201 and the cases mentioned therein).”

30) The issue of unincorporated associations was recently considered by Mr Hobbs Q.C. acting as the Appointed Person in case *BL O-074-10 Club Sail* where he said:

“26. This opens up the appeal to the extent that I am now required to determine the competing claims of the parties to proprietorship of the goodwill of the business appertaining to the signs in issue. Before doing so, I make the general observation that goodwill can be and frequently is built up and acquired by means of economic activities carried out collectively. By using the word ‘collectively’ I am intending to refer to all of the various ways in which alliances may be formed between and among individuals or corporate bodies in pursuit of shared interests and objectives. It is appropriate in this connection to refer to the following observations in the judgment of the Court of Appeal delivered by Hughes LJ in *R v. L(R) and F(J)* [2008] EWCA Crim. 1970; [2009] 1 Cr. App. R 16:

Unincorporated associations

11. There are probably almost as many different types of unincorporated association as there are forms of human activity. This particular one was a club with 900-odd members, substantial land, buildings and other assets, and it had no doubt stood as an entity in every sense except the legal for many years. But the legal description “unincorporated association” applies equally to any collection of individuals linked by agreement into a group. Some may be solid and permanent; others may be fleeting, and/or without assets. A village football team, with no constitution and a casual fluctuating membership, meeting on a Saturday morning on a rented pitch, is an unincorporated association, but so are a number of learned societies with large fixed assets and detailed constitutional structures. So too is a fishing association and a trade union. And a partnership, of which there are hundreds of thousands, some very large indeed, is a particular type of unincorporated association, where the object of the association is the carrying on of business with a view to profit.

12. At common law, an unincorporated association is to be distinguished from a corporation, which has a legal personality separate from those who have formed it, or who manage it or belong to it. The most numerous species of corporation is the limited liability company, but there are of course other types, such as chartered professional associations, local government bodies and indeed bishops. At common law, as the judge succinctly held, an unincorporated association has no legal identity separate from its members. It is simply a group of individuals linked together by contract. By contrast, the corporation, of whatever type, is a legal person separate from the natural persons connected with it.

13. This is an apparently simple legal dichotomy duly learned by every law student in his first year. But its simplicity is deceptive. It conceals a significantly more complicated factual and legal position.

14. As to fact, many unincorporated associations have in reality a substantial existence which is treated by all who deal with them as distinct from the mere sum of those who are for the time being members. Those who have business dealing with an unincorporated partnership of accountants, with hundreds of partners world-wide, do not generally regard themselves as contracting with each partner personally; they look to the partnership as if it were an entity. The same is true of those who have dealings with a learned society, or a trade union, or for that matter with a large established golf club. Frequently, as Lord Phillips of Worth Matravers C.J. pointed out in *R. v. W. Stevenson & Sons (a partnership and others)* [2008] EWCA Crim. 273; [2008] 2 Cr. App. R. 14 (p.187) (at [23]) third parties will simply not know whether the organisation being dealt with is a company or some form of unincorporated association.

15. As to the law, it no longer treats every unincorporated association as simply a collective expression for its members and has not done so for well over a hundred years. A great array of varying provisions has been made by statute to endow different unincorporated associations with many of the characteristics of legal personality. Examples selected at random include the following. The detailed special rules for partnerships contained in the Partnership Act 1890 scrupulously preserve the personal joint and several liability of the partners (see ss.5-12), and the Law Commission recommendation in November 2003 (Law Com. No. 283) that a firm should have legal personality has not been implemented, but the partnership can sue or be sued in its firm name: see CPR 7.2A and 7PD5A.3, repeating a rule which has existed for more than a century. A trade union is, by statute, not a corporation: s.10(1) of the Trade Union and Labour Relations (Consolidation) Act 1992. But by the same section it can make contracts, sue and be sued in its own name, and commit a criminal offence. In the case of learned societies and institutions, their property (if not vested in trustees) is by s.20 of the Literary and Scientific Institutions Act 1854 vested in their governing body, albeit that neither the institution nor the governing body is a corporation. Nor are these developments confined to the statutory. As long ago as 1901 the House of Lords held in *Taff Vale Railway v. Amalgamated Society of Railway Servants* [1901] A.C. 426 that a trade union (unincorporated) could be sued in its own name despite the absence of any statutory provision permitting it. Lord Lindley observed (at 442) that the problem of how to adapt legal proceedings to unincorporated societies consisting of many members was by no means new, and that the rules of common law had had to be altered to meet them. Those several examples relate largely to civil liability, but as will be seen, there is a similar variety of provision dealing with criminal liability in the case of unincorporated associations.

The judgment in that case related to the operation of the general rule that in any enactment passed after 1889 the word '*person*' includes '*a body of persons corporate or unincorporate*' unless the contrary intention appears: Section 5 and Sch. 1, Interpretation Act 1978.

27. I consider that the starting point for the purposes of analysis in the present case is the general proposition that the goodwill accrued and accruing to the members of an alliance such as I have described is collectively owned by the members for the time being, subject to the terms of any contractual arrangements between them: *Artistic Upholstery Ltd v. Art Forma (Furniture) Ltd* [2000] FSR 311 at paragraphs 31 to 40 (Mr. Lawrence Collins Q.C. sitting as a Deputy High Court Judge). When members cease to be members of an ongoing alliance they cease to have any interest in the collectively owned goodwill, again subject to the terms of any contractual arrangements between them; see, for example, *Byford v. Oliver (SAXON Trade Mark)* [2003] EWHC 295 (Ch); [2003] FSR 39 (Laddie J.); *Mary Wilson Enterprises Inc's Trade Mark Application (THE SUPREMES Trade Mark)* BL O-478-02 (20 November 2002); [2003] EMLR 14 (Appointed Person); *Dawnay Day & Co Ltd v. Cantor Fitzgerald International* [2000] RPC 669 (CA); and note also the observations of Lord Nicholls of Birkenhead in *Scandecor Development AB v. Scandecor Marketing AB* [2001] UKHL 21; [2002] FSR 7 (HL) at paragraphs [42] to [44]. This allows the collectively owned goodwill to devolve by succession upon continuing members of the alliance down to the point at which the membership falls below two, when 'the last man standing' becomes solely entitled to it in default of any other entitlement in remainder: see, for example, *VIPER Trade Mark* (BL O-130-09; 13 May 2009) (Appointed Person, Professor Ruth Annand).

28. These principles were fully analysed and explained in the context of a claim concerning the distribution of the assets of an unincorporated association in the judgment of Lewison J. in *Hanchett-Stamford v. Attorney General* [2008] EWHC 330 (Ch.); [2009] Ch. 173 at paragraphs [28] to [50]. At paragraph [47] he provided the following summary:

47. The thread that runs through all these cases is that the property of an unincorporated association is the property of its members, but that they are contractually precluded from severing their share except in accordance with the rules of the association; and that, on its dissolution, those who are members at the time are entitled to the assets free from any such contractual restrictions. It is true that this is not a joint tenancy according to the classical model; but since any collective ownership of property must be a species of joint tenancy or tenancy in common, this kind of collective ownership must, in my judgment, be a subspecies of joint tenancy, albeit taking effect subject to any contractual restrictions applicable as between members. In some cases (such as *Cunnack v. Edwards* [1895] 1 Ch. 1 489; [1896] 2 Ch. 679) those contractual restrictions may be such as to exclude any possibility of a future claim. In others they may not. The cases are united in saying that on a dissolution the members of a dissolved association have a beneficial interest in its assets, and Lord Denning MR goes as far as to say that it is a "beneficial equitable joint tenancy". I cannot see why the legal principle should be any different if the reason for the dissolution is the permanent cessation of the association's activities or the fall in its membership to below two. The same principle ought also to hold if the contractual restrictions are abrogated or varied by agreement of the members. ...

I believe that this reasoning helps to clarify some of the obscurities in the case law relating to the acquisition, retention and elimination of interests in collectively owned goodwill noted and discussed in *Wadlow The Law of Passing Off* (3rd Edn, 2004) paragraphs 3-104 to 3-185

29. It appears to be open to any of the existing members of an alliance to bring proceedings in passing off against a third party for the protection of their proprietary interest in the collectively owned goodwill. In *Scott v. Tuff-Kote (Australia) Pty Ltd* [1975] 1 NSWLR 537 it was held that an underwriter at Lloyds (that is to say a person who was a member of the Society of Lloyds incorporated by statute and who, with other members, joining in syndicates, underwrote insurance risks) was entitled to proceed in his own name for injunctive relief against misuse to his detriment of the name **LLOYD'S OF LONDON**, without joining the Society or all members, or any other member of the syndicate of which he was a member and which, as he did, suffered detriment from the misuse of the name. That case was mentioned with approval by Lord Fraser of Tullybelton in *Erven Warnink BV v. J Townend & Sons (Hull) Ltd* [1980] RPC 31 (HL) at p. 106. In *Dawnay Day & Co Ltd v. Cantor Fitzgerald International* (above) at p. 705 the Court of Appeal observed per Sir Richard Scott V-C:

It is not, in my judgment, necessary to analyse the ownership of the “Dawnay Day” name for the purpose of deciding whether the goodwill in the name belongs to the holding company, or is shared by all the members of the group or whether the goodwill is jointly or severally owned by the group members. Each of the group members that trades under a style which includes the name “Dawnay Day”, has, in my judgment, a legitimate interest, for passing-off purposes, in complaining of a deceptive use of the Dawnay Day style by CFI. The deceptive use by CFI of the “Dawnay Day Securities” trading style represents in respect of each Dawnay Day group member that the proprietor of Dawnay Day Securities is an associate with that member in the Dawnay Day group. Each is, in my judgment, entitled to complain of that misrepresentation. In my judgment, DDCL and DDI are entitled to sue CFI for passing-off and DDI is entitled to sue also on behalf of all other group members who trade under a style that includes “Dawnay Day”.

That was the approach applied in *Artistic Upholstery Ltd* (above). It does not enable a claim in passing off to be maintained by a person who has no proprietary interest of his own in the goodwill he seeks to protect: *Chocosuisse Union des Fabricants Suisse de Chocolat v. Cadbury Ltd* [1999] RPC 826 (CA) at pp. 843, 844 per Chadwick LJ. The net effect of these considerations is that an earlier right to prevent the use of a trade mark by virtue of the law of passing off can be asserted under Section 5(4)(a) of the 1994 Act by a person who is entitled, either alone or with others, to a proprietary interest in the goodwill to which the earlier right relates.

30. The general rule with regard to the position of former members is as stated by Plowman J. in *Pompadour Laboratories Ltd v. Stanley Frazer* [1966] RPC 7 at p.10:

As I understand the law it is clearly settled that a defendant who formerly had a connection with the plaintiffs business, but has ceased to do so, although entitled to inform the world that he formerly had that connection, is not entitled to state that he still has such a connection if that in fact is not the case.

The rights of a former member should therefore be distinguished from the rights of the existing members of an ongoing alliance with regard to proprietorship of the collectively owned goodwill. That was the approach adopted by the Court of Appeal in

Dawnay Day & Co. Ltd v. Cantor Fitzgerald International (above) at pp.703, 704. Former members may nonetheless have continuing rights in relation to the use of a trade mark based on apportionment or consent, within the ambit of what is achievable without practising a deception on the public: see, for example, Habib Bank Ltd v. Habib Bank AG [1982 RPC 1 (CA); Anderson & Lembke Ltd v. Anderson & Lembke Inc. [1989] RPC 124 (Hoffmann J.)

31) In the instant case Robert Busbridge offered, in writing, an indemnity to his brother Martin Busbridge, this is uncontested. Whilst this was not formalised, Robert Busbridge continued the business and dealt with creditors and customers as though nothing had changed. Indeed, it would appear that to the outside world nothing had changed. Cobretti Engineering was still advertising its products and supplying customers. At the hearing Martin Busbridge stated that he considered that he had paid off his half of the creditors when he lost his house. However, I note that the bank foreclosing on his house also coincided with the break-up of his marriage. It is not clear that the sale of his house was used solely to pay off creditors of the partnership. I also note that after the dissolution of the partnership Robert Busbridge continued trading and dealing with customers and creditors for approximately a year before he also had his house seized and went into bankruptcy. It seems to me that Robert Busbridge offered his brother a written indemnity and then effectively provided the same by continuing the business and dealing with creditors of the partnership. That he then went into bankruptcy does not affect this position.

32) This is the position considered by Professor Annand when acting as the Appointed Person in an earlier case involving the instant trade mark. In her decision *BL O-130-09 VIPER* she said:

“Section 64(5)

29. Section 64(5) of the Act is forward looking in that the Registrar is required to look at the circumstances which pertain at the time he determines whether to exercise his power to remove from the register matter appearing to him to have ceased to have effect. At the time of the application on 3rd January 2007, it was undisputed that Mr. Martin Busbridge had taken no active part in the business carried on using Trade Mark number 1501909 since around 1992, when there was corroborated evidence (letters Taylor Willcocks) that the partnership had been dissolved and indemnity arrangements in favour of Mr. Martin Busbridge discussed. Mr. Martin Busbridge had departed from the United Kingdom in 1992 and, as far as it is known, had not returned. In the meantime, the evidence indicated that Mr. Robert Busbridge had continued the business under the VIPER mark and assumed all liabilities. The Registrar had followed the correct procedure and served notice on Mr. Martin Busbridge under rule 45(1)(b) of the Rules. For that purpose Mr. Robert Busbridge had supplied at the Registrar’s request, Mr. Martin Busbridge’s last known address in a witness statement accompanied by a statement of truth. Mr. Martin Busbridge’s objections/observations were invited by the Registrar but no response was forthcoming. Given those circumstances, I believe that it was within the Registrar’s discretion to exercise his power to remove Mr. Martin Alan Busbridge’s name from the register as matter appearing to him to have ceased to have effect, and to show Trade Mark number 1501909 as henceforth standing in the name of Mr. Robert Dennis Busbridge trading as Cobretti Engineering, 22 Hillfield Avenue, Morden, Surrey SM4 6BA.”

33) There have been allegations in this case that Robert Busbridge deliberately misled the Registry as to the whereabouts of his brother. Given the acrimonious nature of the break-up of the business partnership and the accusations surrounding the demise of Martin Busbridge's marriage it would have been understandable had Robert Busbridge simply denied any knowledge of his brother's whereabouts. I am willing to accept that, had he put more effort into the search, he may have been able to provide an up to date address. However, given that Martin Busbridge had been content to simply walk away from the business and had made it clear by his actions that he wished to have nothing more to do with either the business or his brother I do not consider that Robert Busbridge was under any obligation to do anything to assist in locating his brother.

34) The effect of my findings above is that the request by Martin Busbridge to have the Register rectified fails and the trade mark remains registered in the name of Robert Dennis Busbridge t/a Cobretti Engineering.

35) If I am incorrect in my interpretation of the law regarding the dissolution of the partnership and the question of the implied indemnity the outcome would not have been significantly different with regard to the second case in this decision (invalidity application 81522). If I am found to be incorrect in my approach to the rectification then the only other result would be that the trade mark would remain upon the Register but be in the names of both the Busbridge brothers. I make this statement on the basis that under Section 64 of the Act (see paragraph 26 above) it states

“Provided that an application for rectification may not be made in respect of a matter affecting the validity of the registration of a trade mark.”

36) In the pleadings Martin Busbridge merely sought to have his name re-entered onto the Register. The issue of whether the trade mark should remain upon the Register was not pleaded and could not be considered under the guise of a rectification in any case. Given that the partners would be expected to protect the assets and business of a partnership or at least not deliberately act to its detriment it would have been surprising if he had requested that the trade mark be removed from the Register. The effect on the invalidity case I consider below would have been that the earlier mark would still be on the Register and either of the partners could have sought to protect the assets of the partnership by bringing such an action.

COSTS

37) Mr Robert Busbridge has been successful in his defence of the earlier rectification of the Register. As such he is entitled to a contribution towards his costs. He represented himself throughout the case including addressing me at the hearing. Although Mr Cook's solicitor was also allowed to speak regarding this case, it was an indulgence which I granted and Mr Cook was not formally recognised as an intervener. As such I must consider costs due to a private litigant. In *Adrenalin Trade Mark*, BL O/040/02, Simon Thorley Q.C. sitting as the Appointed Person, observed that:

“6. Under section 68 of the Trade Marks Act 1994, the Registrar is given a wide discretion to award costs. The principles upon which the Registrar will exercise that discretion are set out in a Tribunal Practice Note (TPN 2/2000 – see *Kerly's Law of Trade Marks* 13th edition page 1009). In general the Registrar proceeds by reference to a scale of costs and it is a long established practice that costs in proceedings before the

Registrar are not intended to compensate parties for the expense to which they may have been put. Mr. Knight expressed the policy behind the scale of costs in his decision in this case as follows:

‘That scale of costs is meant to be a reasonable scale based upon the policy that no-one should be deterred from seeking to register their intellectual property rights or indeed defend their intellectual property rights so that, for example, if a litigant in person loses an action before the trade mark registry, he or she would know fairly clearly in advance the sum of money they may have to pay to the other side.’

7. Plainly however a pre-requisite of making an award of costs on the scale of costs is that the award should not exceed the costs incurred.

8. It is correct to point out that the Registrar’s practice on costs does not specifically relate to litigants in person but in my judgment it could not be that a litigant in person before the Trade Mark Registry could be placed in any more favourable position than a litigant in person before the High Court as governed by the CPR. The correct approach to making an award of costs in the case of a litigant in person is considered in CPR Part 48.6.

...

10. As indicated above, the Registrar is given a wide discretion as to costs. The practice note is, and is intended to be, merely guidance as to how the Registrar will, in general, exercise that discretion. It does not and cannot impose a fetter upon the overriding discretion.

11. Part 44.3 of the CPR sets out the circumstances which should be taken into account when a court exercises its discretion as to costs and in my judgment exactly the same principles apply to the Registrar.”

38) I also rely upon the comments of Richard Arnold QC, acting as the Appointed Person in *South Beck* BL O/160/08 where he commented:

“34. The Registrar is not bound by the CPR. On the other hand, the Registrar is entitled to, and does, have regard to the CPR in exercising his powers in circumstances where the Trade Marks Act 1994 and Trade Marks Rules 2000 do not make specific provision. Section 68 of the 1994 Act and rule 60 of the 2000 Rules give the registrar discretion to “award to any party such costs as she may consider reasonable”, but do not place any constraints upon the exercise of that discretion. I agree with Mr Thorley that (i) an award of costs should not exceed the costs incurred and (ii) a litigant in person should not be in any more favourable position in proceedings in the Registry than he would be in High Court proceedings under CRP r. 48.6. So far as the first point is concerned, I note that paragraph 8 of TPN 4/2007 now states:

“Depending on the circumstances the Comptroller may also award costs below the minimum indicated by the standard scale. For example, the Comptroller will not normally award costs which appear to him to exceed the reasonable costs incurred by a party.”

35. Turning to the second submission, I agree with counsel for the opponent that the hearing officer appears to have misapplied CPR r. 48.6 and to have awarded the

applicant two-thirds of the scale costs he would have awarded a professionally represented litigant without reference to the applicant's actual loss or any figure calculated in accordance with r. 48.6(4)(b).

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.

37. In the present case I directed the applicant to provide such a schedule. The applicant duly filed a schedule claiming in respect of the proceedings at first instance disbursements of £20 together with mileage of 310 miles. No specific mileage rate was claimed so I propose to apply a rate of 25p per mile, giving a figure of £77.50, making total disbursements of £97.50. The applicant also estimated that it had spent a total of 83 hours dealing with the first instance proceedings. While this seems quite a lot by professional standards, it is appropriate to allow a litigant in person more time for a particular task than a professional advisor would be allowed: *Mealing McLeod v Common Professional Examination Board* [2000] 2 Costs L.R. 223. At the rate of £9.25 an hour, 83 hours comes to £767.75. Accordingly, I shall set aside the hearing officer's costs order and substitute an order that the opponent pay the applicant the sum of £865.25 in respect of the first instance proceedings.

38. So far as the appeal is concerned, the applicant again claimed disbursements of £20 and mileage of 310 miles. It also estimated that it had spent 21 hours dealing with the appeal. Accordingly I shall order the opponent to pay the applicant the sum of £291.75 in respect of the appeal, making a total of £1157."

39) In accordance with these principles I direct Robert Busbridge to provide a brief schedule of costs setting out any disbursements incurred, any other financial losses claimed and a statement of the time spent in dealing with the proceedings. This should be submitted to the Registry, and copied to Martin Busbridge, within one month of the date of issue of this decision. Mr Martin Busbridge will then have two weeks to provide comments on these costs. I shall then issue a supplementary decision concerning the costs.

INVALIDITY

40) I now turn to consider the application for a declaration of invalidity which is made under Sections 5(1), 5(2)(a), and 5(4)(a) of the Act. I will first consider the ground under Sections 5(1) and 5(2)(a) which read:

"5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the earlier trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

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

(b)

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

41) An “earlier trade mark” is defined in Section 6, the relevant parts of which state:

“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,”

42) From my earlier finding Robert Busbridge is the registered proprietor of UK trade mark 1501909 which was applied for on 18 May 1992 and is plainly an “earlier trade mark”. The issue of proof of use is not applicable in the instant case.

43) Both parties marks consist of the word “VIPER” in simple capitals. That the marks are identical is not contested. I therefore move onto consider the goods of the two parties which for ease of reference are reproduced below:

Mr Cook 2070439	Mr Busbridge 1501909
Class 12: Motor vehicles and parts and fittings for motor vehicles; kits and components for assembly into motor vehicles.	Sports cars; all included in Class 12.

44) Clearly, Mr Busbridge’s specification is fully encompassed by that of Mr Cook’s mark. However, the later mark (2070439) also contains items not included in 1501909. The specifications are therefore only partially identical. I therefore have to consider whether the additional elements are similar. In carrying out the comparison I will take into account *British Sugar Plc v James Robertson & Sons Ltd* (TREAT) RPC 281. This identified the following as elements to be considered, uses, users, nature, trade channels, where the items are to be found and whether they are in competition. This test was confirmed *Canon* at paragraph 45.

45) I also take into account the views of Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I

see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

46) Mr Cook’s specification includes “kits and components for assembly into motor vehicles” which I regard as being no different to the initial part of his specification of “motor vehicles and parts and fittings for motor vehicles”. I fully accept that the term “motor vehicles” encompasses a wider range of products than “sports cars”, however sports cars can come in many guises. One only has to consider the cars on offer from major manufacturers to see that the term “sports” is applied to many vehicles. There are four door saloons from Maserati, Ferrari and Aston Martin all of which would be regarded as being sports cars. Equally there is the Range Rover Sport. To my mind the term “sports cars” and “motor vehicles” whilst obviously not identical must be regarded as being highly similar. Equally the parts and fittings for said vehicles would also be similar. Mr Cook’s representative at the hearing did not dispute that the goods were similar.

47) The average consumer or users for both parties’ goods would be that percentage of the general population of the UK who have driving licences. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). 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*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/ services in question; *Sabel BV v Puma AG*, 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.*,
- (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*,
- (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*,
- (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.*,
- (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*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(h) 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*,

(i) 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 and Adidas Benelux BV*,

(j) 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.*,

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

48) I take all of the above into account when considering the marks globally. To my mind, the identity of the marks means that when used on goods which are very similar I have no doubt that there is a likelihood of consumers being confused into believing that the goods provided by the registered proprietor (Mr Cook) are those of the applicant (Mr Busbridge) or provided by some undertaking linked to Mr Busbridge. The application for invalidation under Section 5(1) and 5(2)(a) therefore succeeds in relation to the whole of the registered proprietor's Class 12 specification. The consequence of this decision is that the mark (2070139) is deemed to have never been registered.

49) Given the above finding I do not need to consider the ground of invalidity under Section 5(4)(a).

COSTS

50) Mr Robert Busbridge having been successful in his invalidation request is entitled to a contribution towards his costs. I have set out in paragraphs 37-39 earlier in this decision how costs are arrived at for a private litigant. In accordance with these principles I direct Robert Busbridge to provide a brief schedule of costs setting out any disbursements incurred, any other financial losses claimed and a statement of the time spent in dealing with the proceedings. This should be submitted to the Registry, and copied to Messrs Lester Aldridge

LLP, within one month of the date of issue of this decision. Mr Cook's representatives will then have two weeks to provide comments on these costs. I shall then issue a supplementary decision concerning the costs.

Dated this 06 day of May 2010

**George W Salthouse
For the Registrar,
the Comptroller-General**