

Trade Marks Ordinance (Cap 43)

IN THE MATTER of an application by ITT  
Trademark & Trade GmbH to remove from  
the register the trade mark 1983B2476 'ITT'  
in class 9 in the name of ITT Manufacturing  
Enterprises Inc

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DECISION

of

Teresa Grant acting for the Registrar of Trade Marks after a hearing on 26 October 2004

Appearing : Philips B F Wong, Counsel, instructed by Sit, Fung, Kwong & Shum for the  
applicant for removal

John M Y Yan, SC, instructed by Rebecca Lo & Co for the registered  
proprietor

1. This is an application under the Trade Marks Ordinance (Cap 43) section 37(1)(b) to remove a trade mark from the register of trade marks on the ground of non-use. The application is made by ITT Trademark & Trade GmbH ('the applicant') to remove a trade mark registered in the name of ITT Manufacturing Enterprises Inc ('the registered proprietor').

2. The application to the registrar of trade marks proceeded to a hearing on 26 October 2004 at which both the applicant and the registered proprietor were represented.

### **Registered proprietor's trade mark**

3. The applicant applies to remove the registered proprietor's trade mark 'ITT' (registration 1983B2476) which is registered for 'television receivers and parts and fittings included in class 9 for the aforesaid goods'. The trade mark was entered on the register on 14 November 1983.

4. The applicant applies to remove the mark for all the goods of the registration.

### **Ground for removing trade mark**

5. The applicant makes its application to remove the registered proprietor's mark under section 37(1)(b) on the ground that 'up to the date one month before the date of the application a continuous period of five years or longer elapsed during which the trade mark was a registered trade mark and during which there was no bona fide use thereof in

relation to those goods by any proprietor thereof for the time being’.

### **Five-year period of non-use**

6. Under section 37(1)(b) the minimum period of non-use is a continuous period of five years, ending one month before the filing of the application to remove the mark. The applicant filed the application to remove on 28 November 2000 claiming that the registered proprietor had not used the mark in the five years from 28 October 1995 to 28 October 2000 (‘the five-year period’) during which the mark was a registered trade mark.

### **Onus**

7. An applicant applying to remove a mark from the register has the burden of establishing his case. An applicant must establish that he is a ‘person aggrieved’ to have the necessary standing to apply to remove a mark under section 37(1). Having established that he is a person aggrieved, an applicant must make out a prima facie case that the registered proprietor has not used the mark during the five-year period. It is only if an applicant establishes his case that the burden shifts to the registered proprietor to show he has used the mark.

### **Person aggrieved**

8. Under section 37 (1) any person aggrieved can make an application to remove a mark on the ground of non-use.

9. The applicant contends it is a person aggrieved because its application for registration is blocked under section 20 by the registered proprietor’s mark, which is

already on the register. The applicant made its application (application 199910037) to register the trade mark ITT in class 9 for ‘apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, data processing equipment and computers, television sets, VCRs and DVDs, printers, telephones and telephone accessories, cordless and mobile phones, walkie talkies, video phones, modems, ISDN devices, ATM devices, computer software, telefax machines and parts thereof, pagers, satellite dishes, antennae, global positioning systems, satellite receivers; parts and fittings thereof; all included in class 9’. In examining the application for registration, the registrar raised as an objection against it, the registered proprietor’s trade mark ITT (registration 1983B2476) registered for ‘television receivers and parts and fittings included in class 9 for the aforesaid goods’. The objection which is made under section 20, is that the applicant’s mark should not be registered because it is identical with or nearly resembles the registered proprietor’s mark and is for the same goods or goods of the same description. As the registered proprietor’s trade mark prevents the applicant’s application from being registered, the applicant contends it is a person aggrieved for the purpose of this application to remove the registered proprietor’s mark from the register.

10. The registered proprietor says the mere fact that the applicant’s application for registration is blocked by the registered proprietor’s registration does not make the applicant a person aggrieved. The registered proprietor cites case law establishing that the applicant must show that it has used or has a fixed intention to use the mark for goods of the type in the registered proprietor’s registration, or for goods of the same description, to qualify as a person aggrieved.

11. The registered proprietor cites *Wells Fargo Trade Mark [1977] RPC 503* which conveniently extracts passages from *Powell’s Trade Mark (the Yorkshire Relish case) (1894) 11 RPC 4, HL*; *Appolinaris (1891) 8 RPC 137, CA*; and *Daiquiri Rum Trade Mark [1969] RPC 600, HL*. These are the authorities for the principle that the applicant must show that it is in the same trade as the registered proprietor and could use the mark, or at the very least, that the applicant intends to use the mark for the goods and is in some position to do so. Briefly, the relevant extracts are as follows:

‘Wherever it can be shown, as here, that the applicant is in the same trade as the person who has registered the trade mark, and wherever the trade mark, if remaining on the register, would, or might, limit the legal rights of the applicant, so that by reason of the existence of the entry on the register he could not lawfully do that which, but for the existence of the mark upon the register, he could lawfully do, it appears to me that he has a locus standi to be heard as a person aggrieved’ (*Powell’s Trade Mark (the Yorkshire Relish case) (1894) 11 RPC 4, Lord Herschell at 7, HL*).

‘It is implied, of course, that the person aggrieved must manufacture or deal in the same class of goods to which the registered mark applies and that there shall be a reasonable possibility of his finding occasion to use it. But the fact that the trader deals in the same class of goods, and could use it, is, prima facie, sufficient evidence of his being aggrieved’ (*Powell’s Trade Mark (the Yorkshire Relish case) (1894) 11 RPC 4, Lord Watson at 8, HL*).

‘A man in the same trade as the one who has wrongfully registered a trade mark and who desires to deal in the articles in question is prima facie an aggrieved person’ (*Wright Crossley & Co’s Trade Mark (1898) 15 RPC 131, Romer J at 132, citing Appolinaris (1891) 8 RPC 137, CA*).

‘The words were intended by the Act to cover all trade rivals over whom an advantage was gained by a trader who was getting the benefit of a registered trade mark to which he was not entitled’ (*Daiquiri Rum Trade Mark [1969] RPC 600, Lord Pearce at 615, HL*).

12. In addition, the registered proprietor cites a number of cases in which the principles are applied and I summarise the cases in the following paragraphs.

13. In *Wells Fargo*, the sole fact that the applicants had made an application to register did not make them ‘aggrieved’. The UK Assistant Registrar said:

‘if it had been established that the applicants were using the trade mark WELLS FARGO in the relevant field concerned prior to their application for rectification then their application to register the mark .....might have been regarded as a natural step to secure protection of the mark themselves’([1977] RPC 503 at 507). ‘In their statement of case, the applicants say that the objects of their company are investment and management of moveable and immovable property, financial and commercial transactions and trusteeships and that since their formation in November 1967 they have acquired a reputation in the words “Wells Fargo” which reputation is international on account of the international nature of their business. Apart from that statement no evidence has been furnished as to the trade or business carried on by the applicants in the United Kingdom and in respect of which the alleged international reputation exists’ (at 506). ‘Mr Young argued that the applicants did have a real business interest: that they were not common informers but were trade rivals, in the sense referred to by Lord Pearce in the Daiquiri Rum case. This, he said, was evident from the litigation between the parties taking place in countries abroad. But whether the parties are “trade rivals” must be judged in my opinion in the context of the business carried on in this country by the applicants compared with the trade of manufacturing or dealing in the goods comprised in the class 16 specification of the registered proprietors’ mark. As regards the applicants’ activity there is little to go on apart from the general statement of the objects of the company in their statement of case which, to my mind, is too vague to indicate prima facie that the applicants trade here in the paper, printed articles etc included in class 16 of the registered proprietors’ mark and that there is a reasonable possibility of them finding occasion to use it in respect of any of those goods. Applying the construction placed on the phrase ‘persons aggrieved’ in the decided cases which I have referred to I have come to the conclusion that the applicants do not have the locus standi to make their application’ (at 507, 508).

14. In *Consort Trade Mark* [1980] RPC 160 at 164 the UK Registrar’s hearing officer said:

‘Mr Prescott submitted that the mere expedient of applying for registration was not enough to establish that an applicant for rectification is a person aggrieved, by which I took him to mean aggrieved in respect of all goods within a registered

specification that might under section 12(1), be a bar to the progress of an application for registration. I think there is some force in this, but I do not consider that it is necessary for an applicant to show that he has actually used his mark before he can be a person aggrieved.’

Additionally (*at 166*):

‘an applicant for rectification does not have the necessary status of a person aggrieved in respect of goods within the registered proprietor’s registration that are not the same or at least of the same description as those in which he is either already engaged in trade or has that fixed intention which is a necessary prerequisite to his own application for registration. It is to this extent that I accept Mr Prescott’s submission that the mere fact of making an application to register a trade mark will not suffice to confer a locus on the applicant for rectification and that it is necessary to look into the relevant business activities of an applicant and his intentions. Both in this aspect of the matter and in the question of showing which of the registered goods come within the ambit of the expression “goods of the same description” as the ones in which the applicant is interested, the onus is on the applicant to rectify.’

15. The registered proprietor cites two Australian cases: *Kraft Foods Inc v Gaines Pet Foods Corporation (1996) 34 IPR 189* and *Coors Brewing Company v Carlton and United Breweries Ltd (1997) 38 IPR 477*.

16. *Kraft Foods* sets out the history of the requirement that a person applying to remove a mark from the register in Australia must be ‘aggrieved’ (*at 206*):

‘The Australian authorities have accepted as a starting point, observations made in the speeches of Lords Watson and Herschell in *Powell v Birmingham Vinegar Brewery Co Ltd [1894] AC 8 (1894); 11 RPC 4, HL*.

17. *Kraft Foods* was decided on facts that:

‘fell well short of establishing that Kraft had used or intended to use the mark and which precluded Kraft from establishing that it was a person aggrieved by the registration of Gaines’ mark on the ground that it had used or intended to use an identical or similar mark’ (at 210). ‘The fact of filing the application, of itself, does not establish that the applicant is a person aggrieved’ (at 211).

18. The Australian decision *Coors Brewing Company v Carlton and United Breweries Ltd* (1997) 38 IPR 47 at 485 to 487 reaffirmed this view, although on the facts, Carlton and United Breweries who had filed an application to register, accompanied by a clear statement of intention to use the trade mark, was a ‘person aggrieved’ in proceedings to remove Coors Brewing’s blocking registration.

19. The applicant cites a number of cases that I consider, below. However, they do not disturb the view that simply making an application to register does not make the applicant a ‘person aggrieved’.

20. The applicant cites *Ernest Marshall* (1943) 60 RPC 147 but in that case at 151 it was assumed that Marshall, who applied to remove the mark, was a trader.

21. In *Kodiak Trade Mark* [1987] RPC 269, CA the issue was rather different. The argument was whether the words ‘any person aggrieved’ should be qualified by limiting the grievance to particular goods, covered by the registered mark, in which the applicant trades or wished to trade (at 273). The court held there was ‘no justification for qualifying the phrase in this way’:

‘The appellants were persons aggrieved by reason of the fact that they found their application to register the trade mark KODIAK in respect of boots, shoes and slippers was blocked by the presence of the allegedly unused mark KODAK on the register for all items of clothing in old class 38. This gave them the necessary locus standi to prosecute their application, and the fact that they may have chosen to ask for relief wider than that to which they might establish they were entitled – whether because they could only show an interest in a limited range of the class of goods covered by the registration, or because they could not prove non-user over the whole class – is nihil ad rem’. Kerly’s Law of Trade Marks and Trade Names (12 edn) First Supplement paragraph 11-08 says ‘The fact that the applicant might claim relief wider than that to which he was ultimately found to be entitled was held to be irrelevant, since locus standi was conferred if an application was blocked by the presence on the register of an allegedly unused mark. “Person aggrieved” was not to be unduly limited.’

22. *Kodiak* is not authority for the proposition that the mere fact that an application for registration is blocked by a registration is enough to give the applicant the status of a person aggrieved in proceedings to remove the registration. On the facts, the appellants’ trading interest was clear: they were a company manufacturing boots and shoes (*at 270*) and their own evidence showed they were concerned with boots, shoes and slippers (*at 271*).

23. The applicant includes in its list of authorities, *Ritz Hotel v Charles of the Ritz* (1988) 15 NSWLR 158; 12 IPR 417, in which the Ritz Hotel was judged a person aggrieved for the purposes of removing the trade marks CHARLES OF THE RITZ and RITZ from the register on the ground of non-use. (*At NSWLR 196; IPR 457*) McLelland J said:

‘from the time of commencement of these proceedings the plaintiff has been an applicant for registration of the trade mark RITZ in respect of all goods in class 3. Each of the four subject marks registered in respect of goods in class 3 is a serious

obstacle to the success of the plaintiff's application for registration of that mark. Those circumstances alone are in my opinion sufficient to constitute the plaintiff a 'person aggrieved' in respect of each of those four marks'.

24. Sackville J in *Kraft Foods at 212* states the judgment in *Ritz Hotel v Charles of the Ritz* 'must be read in the context of the findings of fact':

'The plaintiff had applied for registration of its mark, intending to exploit it commercially for merchandising purposes. I read his Honour's reference to the obstacle posed by the registration of the defendant's marks, as relating to the successful registration of the plaintiff's mark having regard to the plaintiff's intended use of its mark. I do not read his Honour's observations as suggesting that the plaintiff's application would have been sufficient to constitute it a 'person aggrieved', regardless of whether there was any proof of its intention to use the mark'.

25. In *Palm Trade Mark [1992] RPC 258* the applicant was Ladbroke Hotels Limited, part of the Ladbroke Group plc. The applicant's evidence described how Ladbroke Hotels Limited had adopted the name PALMS as the name of a restaurant and filed an application for registration of a service mark, PALMS, in respect of restaurants (*at 260*). In the circumstances, it is not surprising that Ladbroke Hotels Limited's status as a person aggrieved was accepted without challenge.

26. Similarly, in *Arlite Trade Mark [1995] RPC 504*, there appears to have been no issue as to whether the applicant was in the trade and was intending to make use of the mark. Although the hearing officer said:

'the first matter to be considered is whether the applicants have the qualifying status

demanded by the section, that they be persons aggrieved. I am satisfied that the applicants are persons aggrieved because the presence of the mark on the register constituted a bar to the registration of a trade mark which they were seeking to register' (*at 508*),

there was apparently no argument on the matter so the case cannot be regarded as authoritative on the point.

27. In *Batchelors Snackpot Trade Mark [1995] RPC 555*, Dalgety Spillers Foods Limited, the applicant applying to remove the mark, was the owner of a number of marks in class 29 and 30 containing the word 'pot' and it was simply assumed that the applicant was a person aggrieved. The hearing officer in applying Lord Hershell's test *from Powell v Birmingham Vinegar Brewery Company [1894] AC 8 (Batchelors Snackpot at 564)* noted:

'in applying the principles set down by Lord Herschell to the facts of this case it appears to me to be clear that the applicants to rectify are 'persons aggrieved'. The two companies are in the same field of business or at least potentially so, if the registered proprietors were to use their mark in respect of the goods for which it is registered' (*Batchelors Snackpot at 565*).

28. In summary, there is strong authority for the principle that the applicant must show that it has used or has a fixed intention to use the mark for goods of the type in the registered proprietor's registration or for goods of the same description. The applicant's reference to cases in which the issue either did not arise or was simply accepted without challenge, does not assist. The applicant says nothing about its business activities or its intention to use the mark ITT. The applicant has not shown that it is a person aggrieved for the purpose of these proceedings to remove the registered proprietor's trade mark.

## **Application to admit evidence**

29. The registered proprietor gives its evidence in a statutory declaration of 1 February 2002 made by Keith Johnson. Mr Johnson is Vice-President and Treasurer of ITT Manufacturing Enterprises Inc, the registered proprietor. In paragraph 4 of his declaration, Mr Johnson repeats and confirms to be true paragraphs 1-31 and 35 of his 'first declaration' also dated 1 February 2002. The registered proprietor filed the first declaration in opposition proceedings against the applicant's application 1999010036 to register the trade mark ITT in class 7.

30. At the hearing in these proceedings to remove the registered proprietor's trade mark, the registered proprietor sought to rely on paragraph 36 of the first declaration. Paragraph 36 alleges that the applicant's status as a newly formed company for the business object of 'licensing of national, foreign and international intellectual property rights as well as selling such rights', indicates that the applicant's intended activities are confined to licensing and selling intellectual property rights. The registered proprietor infers from paragraph 36 that the applicant does not have a bona fide intention to use the mark ITT for trade in goods.

31. The applicant says paragraph 36 is excluded by the terms of Mr Johnson's statutory declaration and an application by the registered proprietor to admit paragraph 36 into evidence should be refused as being unfair to the applicant who would not have an opportunity to file evidence to counter the allegation.

32. As it is, I do not admit paragraph 36 into the evidence. In these proceedings, both applicant and registered proprietor have long since filed their evidence under Trade Marks Rules 25 to 27. Although rule 28 states that 'in any proceedings before the Registrar he may at any time, if he thinks fit, give leave to either [party] to file any evidence upon

such terms ..... as the Registrar may think fit', the rule begins with the limiting words 'no further evidence shall be filed by either side .....'. These words reflect rules of court and, by analogy and practice, *Ladd v Marshall [1954] 1 WLR 1489 (CA)* principles apply. These principles are that further or fresh evidence should be admitted, only if the evidence could not with reasonable diligence have been obtained earlier, if the evidence would probably have an important influence on the result of the case and, if the evidence is apparently credible.

33. If a party applies to admit further evidence, it must justify the exercise of the registrar's discretion in its favour. The registered proprietor says that the applicant has long known of the contents of paragraph 36 because the first declaration, excepting exhibits, was attached to Mr Johnson's declaration, although Mr Johnson adopted only paragraphs 1-31 and 35 of the first declaration. Consequently, the registered proprietor argues, paragraph 36 does not take the applicant by surprise. Additionally, the registered proprietor says, the applicant's status and intentions, the subject of paragraph 36, are important to the proceedings.

34. However, it is not enough to show that paragraph 36 is relevant, or that it is credible. Rule 28 limits the filing of further evidence, except where justice requires it. Paragraph 36 may strengthen the registered proprietor's argument in the proceedings but rule 28 does not admit evidence merely for the purpose of bolstering a party's case; evidence that could and should have been filed at the proper time under the rules. The time for filing evidence under the rules has long since passed. There is no compelling reason to admit paragraph 36 and I decline to do so.

### **Prima facie evidence of non-use**

35. The applicant cites *Estex Clothing Manufacturing Pty v Ellis & Goldstein*

*Ltd (1967) 116 CLR 254; 1A IPR 491 at CLR 258; IPR 494:*

‘It is for an applicant who seeks to have a mark removed to prove his case. The onus is on him to show an absence of use in good faith during the period ...If persons who, by reason of their connection with the relevant trade, might be expected to have seen or heard of the mark if it were used as a trade mark upon goods for which it is registered, swear that they had not seen or heard of it in use as a trade mark at any time during the relevant period, that is prima facie evidence of the fact which the applicant must prove. Slight evidence may suffice at this stage, for the applicant has the task of proving a negative and the registered proprietor is probably in a better position to prove user than is the applicant to prove non-user ... but ... when all the evidence is complete, the question is still, has the applicant proved his case?’

36. The applicant also cites *Estex at 259, 260* as authority for allowing some latitude, as regards evidence, in complying with rules of court. In *Estex*, the fact that none of the affidavits in the applicant’s evidence complied fully with rules of court was not fatal to the establishment of the applicant’s case.

37. On both onus and evidence, I acknowledge *Estex* is good authority and on this basis I consider the applicant’s evidence.

38. The applicant’s evidence of the registered proprietor’s non-use is a statutory declaration by James Kennoway Allan, Managing Director of a firm of private enquiry agents instructed by the applicant’s solicitors. In his declaration, Mr Allan describes the results of a survey of electrical shops and department stores in Hong Kong and of persons working in the shops and stores. The survey was carried out between 27 to 29 October 2000. The persons interviewed were asked if they had heard of or had sold ITT products in the last five years. On the face of it, the survey covers the whole of the five-year period of

non-use and has the merit of having been conducted immediately after the expiry of the period. (It is obviously desirable that the inquiry should be made as soon as possible after the expiry of the period: *Estex Clothing Manufacturing Pty v Ellis & Goldstein Ltd* (1967) 116 CLR 254 at 257.)

39. Investigators from Mr Allan's firm 'conducted the market survey with 20 leading retail outlets selling audio/video equipment, telephones and computers ..... and conducted interviews with an employee in each of the outlets visited. The interviews followed the line of questioning as listed in a standard questionnaire' (Mr Allan's declaration, 1 August 2001, paragraph 5). The questionnaires exhibited to Mr Allan's declaration pose two questions: one, 'have you ever sold the above products (ITT audio/video product, telephone, computer) during the past five years?': and two, 'have you ever heard of this brand?'. 'Fifteen of the staff said that they had never heard of or sold products bearing the name ITT. Five of the subjects appeared to have heard of the brand ITT but stated that they had not seen such on sale in Hong Kong during the last five years' (Mr Allan's declaration paragraph 5).

40. Mr Yan for the registered proprietor launches a number of attacks on the survey evidence. He says that, of the 20 'leading retail outlets', only Fortress, Broadway, and Tai Lam Radio appear to be leading television sales outlets and of the others, nothing is said about the range or reach of their business. He discounts Bose, which is a company that sells only its own products. He accepts that the department stores, CRC, Mitsukoshi, Pricerite, Seiyu, Sincere and Sogo, would sell a range of products from various manufacturers but he discounts the evidence from their employees because the survey does not state that the employees work in a department selling audio/video, telephone or computer products. This may not be a telling point because Mr Allan's declaration states that 'the investigators interviewed those persons who have over five years' experience in the trade dealing with television receivers and parts and fittings' (Mr Allan's declaration, paragraph 4) and perhaps it can be assumed that the department store employees were putting their experience to use in the stores' electrical products department. However, the survey does not make it clear that 'working experience' is experience with the particular

outlet in which the employee was interviewed. The working experience of the salesmen and salesladies could as easily have come from employment with other employers, admittedly, dealing in electrical products but, possibly in ‘own brand products’, or in a narrow range of products. Mr Yan’s criticism is made equally against the evidence of the salesmen of the other retail outlets. The question, ‘have you ever sold the above products (ITT audio/video product, telephone, computer) during the past five years?’ is not the same as, ‘has this company or shop offered the products for sale during the past five years?’ and is not necessarily as relevant.

41. The persons interviewed were asked if they had heard of or had sold ITT products in the last five years, so on the face of it, the survey covers the whole of the five-year period of non-use. However, as Mr Yan points out, four of the persons interviewed have less than five years’ working experience, so their evidence does not cover the necessary period of non-use.

42. Mr Yan takes issue with the statement ‘five of the subjects appeared to have heard of the brand ITT but stated that they had not seen such on sale in Hong Kong during the last five years’ (Mr Allan’s declaration, paragraph 5). Mr Yan rightly says this is not what the persons interviewed were asked. They were asked ‘have you ever sold the above products (ITT audio/video product, telephone, computer) during the past five years?’ and ‘have you ever heard of this brand?’ On the facts, Mr Allan’s statement, that the persons interviewed had not seen ITT products on sale in Hong Kong, is inaccurate.

43. Five out of the 20 persons interviewed said that they had heard of ITT. Mr Yan says this is a significant number in a survey of 20 persons and tends to show that the mark ITT has been used. Mr Allan declares that out of the five, ‘three of the subjects indicated that they believed the name ITT had been used on TVs named ITT LAWRENCE (ITT 羅蘭士); one of the subjects believed such was used on TVs made in Europe whilst the last subject believed such was used on audio video equipment but was unsure of the exact products’. I think it is putting it too strongly to say that this is evidence of the registered proprietor’s use of the mark ITT in Hong Kong but similarly, it is not evidence of

non-use.

44. Mr Allan declares that ‘no goods bearing the ITT mark were seen on display in any of the 20 retail outlets and counters actually visited in person. In other words, at the time of such visits, no goods bearing the ITT mark were available’ (Mr Allan’s declaration, paragraph 6). In response, Mr Yan’s final salvo is that department stores and electrical retail outlets are not appropriate outlets for direct sales of the registered proprietor’s goods, that is, ‘television receivers and parts and fittings’. ‘Television receivers and parts and fittings’ are not ‘television sets’ and would not be sold as separate items in department stores or electrical retail outlets. Television receivers are integrated into television sets. They are not sold separately.

45. Mr Yan’s criticisms are undeniable and in the face of them the survey evidence cannot stand. The applicant’s evidence does not establish a prima facie case of non-use.

46. For these reasons, the applicant cannot succeed in its application to remove under section 37(1)(b). The application to remove the registered proprietor’s mark fails at the threshold and I need not go on to consider the registered proprietor’s evidence.

### **Discretion**

47. As it was noted in *Estex at 260*:

‘if the applicant fails to establish the matter which it must establish to have an order

for the removal of a mark, then the [registrar] cannot make an order for its removal'.

### **Costs**

48. The application to remove the registered proprietor's mark has failed and I award the registered proprietor costs. Subject to any representations, as to the amount of costs or calling for special treatment, which either party makes within one month from the date of this decision, costs will be calculated with reference to the usual scale in Part I of the First Schedule to Order 62 of the Rules of the High Court (Cap. 4) as applied to trade mark matters, unless otherwise agreed between the parties.

(Teresa Grant)  
for Registrar of Trade Marks  
22 December 2004