

BL O/0137/25

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO. 2537778 IN THE NAME OF SHARD FINANCIAL MEDIA LIMITED IN RESPECT OF THE TRADE MARK

CREDIT TODAY

IN CLASSES 9, 16 & 41

AND IN THE MATTER OF AN APPLICATION TO RECTIFY THE REGISTER (UNDER NO. 84916) BY BLUE MOON GROUP LIMITED

AND IN THE MATTER OF AN APPEAL FROM THE DECISIONS OF M BRYANT DATED 7 & 12 NOVEMBER 2024.

DECISION

Introduction

1. I am dealing with an application by Blue Moon Group Limited ("**Appellant**") to transfer an appeal from the Appointed Person to the High Court, and a cross-application by the Respondent for security for costs. The underlying appeal is in respect of the decisions of Mark Bryant dated 7 November 2024 ("**Decision**") and 12 November 2024 ("**Supplementary Decision**") which dismissed the Appellant's application for rectification of the register. That application concerned registration no. 2537778 for the trade mark CREDIT TODAY for goods in classes 9 and 16 and services in class 41 ("**Mark**"). The Mark currently stands in the name of Shard Financial Media Limited ("**Respondent**").
2. There is a long history to this matter, which goes back to at least 2009. The dispute between the parties culminated in a judgment of the Intellectual Property Enterprise Court on 19 September 2018 (*Shard Financial Media Ltd v Blue Moon Group Ltd & Anor* [2018] EWHC 2859 (IPEC)). The Hearing Officer summarised the developments since that decision at §§2-4 of the Decision and I do not repeat that account here.
3. On 5 October 2023 the Appellant filed an application to rectify the Register, using Form TM26R. Following receipt of written submissions from both sides, the Registry issued its preliminary view on 27 June 2024 to refuse the application for rectification. Following further written submissions, the Registry issued a further preliminary view. The parties were then invited to file further submissions in lieu of a hearing, with a deadline of 30 July 2024. The Respondent filed written submissions on that date. The Appellant, rather than filing a single set of submissions, chose instead to continue to argue its case in a stream of emails and letters filed both before and after the deadline. As explained in the Decision, the Hearing Officer took into account all the Appellant's arguments received up to the official deadline of 30 July 2024, but not those filed later.
4. In the Decision, the Hearing Officer concluded at §61:

“All five reasons for the preliminary views have been found to be correct and the preliminary views are confirmed. Confirmation of any one of these would have been fatal to the application for rectification. The Registry was not in error when it amended the register to record the current proprietor as the owner of the contested mark. The registration stands in the correct name and the application for rectification fails”.

5. On 12 November 2024 the Hearing Officer issued the Supplementary Decision to correct an error in the Decision, namely that the Appellant had erroneously been stated to be the controlling mind of the Appellant and the individual who acted for it, Mr Gerard Dugdill, rather than the Appellant company itself.
6. On 13 January 2025 the Appellant filed a Notice to Appeal to the Appointed Person against the Decision and Supplementary Decision under Section 76 of the Trade Marks Act 1994.

The progress of the appeal

7. The appeal was allocated, and on 29 January 2025 I provided the parties (via the Appointed Persons Secretariat Manager) with a list of potential dates for the hearing of the appeal. The Respondent replied on the same day to provide its availability. The Appellant, however, responded to say *“The substantive issues need to be addressed, as per our previous emails, see below and our letter of 15 January 2025 attached, as well as the quality of the material forwarded on. We take these to be a priority to be addressed before any hearing is set”.*

8. In its letter of 15 January 2025, the Appellant had said:

“We made various stipulations as to what we wish to see happen next in our letter of 13 January (which I also reattach, with the addition of IPO references). These were in sum:

- *The registry’s above referenced submissions to be struck out as null and void. As stated, we also are continuing to pursue a number of other issues with the registry (eg over privileged status of its submissions etc).*

- *Our appeal, if not to be immediately granted, to be stayed pending a full resolution of the issues behind the case.*

- *We also intend to pursue our complaints with the registry as necessary”.*

9. With regard to the first numbered point above, the Form TM55 states *“We require the registry’s submissions of 7 and 12 November to be declared null and void”.* Clearly, therefore, the Appellant is referring to the Decision and the Supplementary Decision. The Secretariat replied on my behalf to explain that no such action could be countenanced in relation to the Decision and Supplementary Decision before all issues had been fully considered at a hearing. The reference to *“quality of the material forwarded on”* is to a complaint of the Appellant that the appeal documents filed by him had not been faithfully reproduced. The Secretariat explained that the Appellant would have the opportunity to file, before any hearing, a bundle containing clean copies of all the documents it sought to rely upon.

10. On 31 January 2025 the Appellant sent a further letter stating:

“We maintain our position that we cannot yet agree to a hearing time until all the appropriate substantive evidence is gathered and submitted, including statements. Please also refer again to our requests in this matter, for example by email of 1 August 2024, over disclosure (notwithstanding a subsequent claim by the respondent, which we of

course reject, that there were no “proceedings” under way at the time). To be helpful, in relation to the substantive case, we relist these requirements at the end of the of this letter, annex 1. (We will pursue the other requirements in relation to the registry separately as necessary and possible.)

...

Our letter of 15 January 2025, to which you do not refer, reinforced these points while at the same time noted that there was provision for transferring the case to “the court”. We said: “We believe such a move may have the effect of allowing the proceedings to be transferred to a jurisdiction where facility is provided to allow the totality of evidence and argument to be submitted, with a final decision being made on the substance of the case (via existing or fresh proceedings) and therefore in turn any appeal, ie the overall case.” We remain unconvinced that a hearing in front of the “appointed person” will resolve issues 1 and 2 as listed above. However, we believe such a transfer may have the effect of resolving the whole case substantively, ie point 3, if our appeal is not to be immediately granted. This remains our position therefore we make such a request, allowing the facility as described just above”.

11. The Secretariat replied on my behalf on 3 February 2025 to explain that an appeal before the Appointed Person (and also before the High Court) is limited to a review of the Hearing Officer's decision. As it is not a re-hearing, the Appointed Person or Court will not, save in exceptional circumstances, consider any new evidence that was not placed before the Hearing Officer. The Appellant's reference to requiring further time "until all the appropriate substantive evidence is gathered and submitted, including statements" suggests that it is proposing to ask the Appointed Person to consider new evidence - this is highly unlikely to be permitted.
12. The Appellant replied on the same day to reiterate that it wishes to proceed in the High Court. I understood from the Appellant's reply that, in fact, proceedings were already underway before the High Court, and therefore proposed that the Appellant's appeal before the Appointed Person be treated as withdrawn, in order to avoid duplicate parallel proceedings. The Appellant corrected my understanding on 4 February 2025, explaining that separate proceedings had not been commenced in the High Court, but rather the Appellant sought transfer of this appeal to the High Court.
13. On 5 February 2025, the Secretariat wrote to the parties on my behalf to explain that, pursuant to s. 76 of the Trade Marks Act 1994, transfer to the High Court following a request by a party to proceedings is at the Appointed Person's discretion. The parties were invited to file any further information or arguments they wished the Appointed Person to take into account when deciding whether to transfer the appeal to the High Court, with a deadline of 4pm on 13 February 2025.
14. The Appellant replied on the same day to say:

“We disagree with any contention that such a transfer is at the “Appointed Person’s” discretion. There is no legal basis to deny. We have made the request pure and simple.

We have also stated that substantive evidence rounds (including witness statements from appropriate personnel) need to take place on the matter, pursuant to the registry's earlier mishandling of the case, this forming the basis of our two ongoing complaints against the registry, upon which we shall revert.

These evidence rounds will take in matters of initial disclosure, requests as detailed for example in our letter of 31 January 2025, reattached via the attached 3 February 2025 email attachment.

All of this will we believe the effect of expediting proceedings”.

15. On 6 February 2025, the Respondent filed a request for security for costs from the Appellant in the sum of £10,000. The Appellant responded on the same day to rebut the request for security for costs, and made its own request for security for costs from Blake Morgan in the sum of £20 million, and from the Respondent in the sum of £50,000.
16. At 4.41pm on 13 February 2025, the Respondent filed its response to the Appellant’s application to transfer to the High Court. The Appellant invites me to disregard the Respondent’s response, given that it was served out of time. However, in my view, to do so would be contrary to the approach to relief from sanctions mandated in *Denton v White*, pursuant to which relief in respect of trivial breaches (into which category a delay of a mere 41 minutes falls) can be granted without the need to consider the wider circumstances of the case. I accordingly overlook the short delay and will take the Respondent’s submissions into account. The Respondent submits that:
 - There is no point of general legal importance raised in this appeal;
 - Transferring to the High Court would entail substantial delays and increased costs; and
 - Even were the appeal to be transferred to the High Court, the Appellant would still not be entitled to seek the disclosure and submit the witness evidence he contends is required to determine this appeal.
17. The Registrar has said *“I can confirm that we have no particular or strong view as to whether the Appointed Person should exercise his discretion by transferring this case to the High Court. That notwithstanding, the Register also considers there to be no obvious or particular reason why referring to the Court is necessary for effective resolution of the case and the issues it raises”*.

Referral of an appeal from the Appointed Person to the High Court

18. Section 76 of the Trade Marks Act 1994 provides:
 - “(1) An appeal lies from any decision of the registrar under this Act, except as otherwise expressly provided by rules. For this purpose "decision" includes any act of the registrar in exercise of a discretion vested in him by or under this Act.
 - (2) Any such appeal may be brought either to an appointed person or to the court.
 - (3) Where an appeal is made to an appointed person, he may refer the appeal to the court if--
 - (a) it appears to him that a point of general legal importance is involved,
 - (b) the registrar requests that it be so referred, or
 - (c) such a request is made by any party to the proceedings before the registrar in which the decision appealed against was made.

Before doing so the appointed person shall give the appellant and any other party to the appeal an opportunity to make representations as to whether the appeal should be referred to the court.

(4) Where an appeal is made to an appointed person and he does not refer it to the court, he shall hear and determine the appeal and his decision shall be final."

19. The principles applicable to a decision to transfer have been considered a number of times by the Appointed Person. In *Parkair Trade Mark O/065/09*, Amanda Michaels acting as the Appointed Person reviewed the earlier decisions including *A.J. AND M.A. LEVY's trade mark (No. 2) [1999] R.P.C. 358*, *Academy trade mark [2000] R.P.C. 35*, *Royal Enfield trade mark O/273/01*, *EBC trade mark O/132/03*, and *Elizabeth Emanuel Trade Mark [2004] RPC 15*. Ms Michaels summarised the applicable principles as follows:

- The Appointed Person has an unfettered discretion under s. 76(3);
- Any consensus reached between the parties about referring the appeal to the court is not determinative;
- The power to refer appeals to the court should be used sparingly, otherwise the clear object of the legislation to provide a relatively inexpensive, quick and final resolution of appeals by a specialist tribunal would be defeated;
- It will be very rare to make a reference in circumstances where a point of general legal importance cannot be identified;
- The cost and expense to the party not seeking to refer should be taken into account; this is a matter which may be of particular significance in a case where the party in question is an individual or small company or partnership;
- Regard must be had to the public interest generally. There is a public interest in having any uncertainty as to the state of the register resolved as soon as possible. On the other hand there is a public interest in having important points of law decided by the higher courts;
- The attitude of the registrar is important but not decisive.

Security for costs

20. Rule 68 of the Trade Marks Rules 2008 states:

"(1) The registrar may require any person who is a party in any proceedings under the Act or these Rules to give security for costs in relation to those proceedings; and may also require security for the costs of any appeal from the registrar's decision.

(2) In default of such security being given, the registrar, in the case of the proceedings before the registrar, or in the case of an appeal, the person appointed under section 76 may treat the party in default as having withdrawn their application, opposition, objection or intervention, as the case may be."

21. Rule 76(5) states:

“The provisions of sections 68 and 69 (costs and security for costs; evidence) apply in relation to proceedings before an appointed person as in relation to proceedings before the registrar.”

22. The rules do not state the test which is applicable in determining whether an order for security for costs should be made. I shall adopt as guidance the conditions set forth in Part 25 of the Civil Procedure Rules, which include circumstances where there is reason to believe a company will be unable to meet a costs order made against it. I bear in mind also that the court must be satisfied, having regard to all the circumstances in the case, that it is just to make such an order (CPR 25.13).
23. From the case law relating to CPR 25, “all the circumstances of the case” may require consideration of the amount of security for costs claimed, the prospects of success in the main proceedings, any delay in applying for security and access to justice considerations.

Discussion – application to transfer

24. Unusually in my experience, it is the Appellant, rather than the Respondent, who is seeking transfer in this instance. Martin Howe QC (as he then was), sitting as the Appointed Person in *Truscott O-391-18* said:

“Although it is unusual to say the least for an appellant who has elected to appeal to the Appointed Person to change its mind and ask for a transfer of the appeal to the High Court, I do not consider that that bars a transfer being made or indeed that it is a particularly strong factor against a transfer if there are good grounds for making it. The fact that the appellant has been somewhat tardy in realising that those good grounds exist may not really matter, particularly if those grounds are based on public interest considerations. If costs have been caused to the respondent by the appellant’s unnecessary detour into an Appointed Person appeal followed by a procedural application to transfer that would not have been necessary if the appeal had been brought to the High Court in the first place, then the respondent could be compensated with an appropriate order for payment of the wasted costs”.

25. Although the above was in the context of an appeal concerning designs, nothing turns on that, and I respectfully agree with all that Mr Howe QC said. I will therefore give little weight to the fact that it is the Appellant, not the Respondent, who seeks transfer, notwithstanding that it was the Appellant who chose to appeal to the Appointed Person in the first place.
26. It is clear from §19 above that the primary point to consider is whether or not a point of general legal importance can be identified in this appeal. Having reviewed the Appellant’s Form TM55, it is immediately apparent that it raises no point of general legal importance. The Form TM55 sets out a litany of complaints about the conduct both of the Respondent’s solicitors, Blake Morgan LLP, and the Registry. Any claims that the Appellant may have against Blake Morgan are clearly not relevant to this appeal, and I say no more about them. The complaints about the Registry include:
 - There has been no disclosure or proper evidence rounds;
 - The Registry’s handling of the Appellant’s application for rectification has been confusing and littered with errors;

- The Registry failed to issue proceedings and/or clarify whether proceedings were underway following the filing of the application for rectification on 5 October 2023;
 - The Appellant’s submissions to the Registry have not been reproduced in full or with sufficient accuracy; and
 - The Registry’s preliminary views were *ultra vires*.
27. Taken at their highest, all the above concern the Registry’s conduct in this particular case, rather than substantive trade mark law, or even Registry practice and procedure more generally. Whereas all the above issues are no doubt of concern to the Appellant, they have no wider impact on the public more generally. Indeed, they could be said to be paradigm examples of issues which are of importance only to the individual parties in this appeal, rather than to the wider public.
28. Dealing with the other factors listed above, the Respondent rightly submits that transfer to the High Court would result in substantial increased legal costs. Prejudice resulting from that would fall almost entirely on the Respondent, given that the Appellant is self-representing via its director, Mr Dugdill. I am cognisant that the Respondent is a small company with limited assets. As the Respondent submits, it as *“a small entity would be unnecessarily prejudiced by the incurrence of substantial costs where a more appropriate statutory regime has been introduced for the very purpose of reducing cost”*.
29. Furthermore, as the dispute concerning the Mark has been ongoing since at least 2009, it is imperative that issues are finally resolved sooner rather than later. A hearing before the Appointed Person could take place as early as March this year, with a final decision (from which there is no appeal) to follow a few weeks later. Transferring to the High Court would be likely to push the matter into 2026 or even later, with the prospect of further appeals thereafter. The Registrar is neutral, although can see no obvious reason why transfer is necessary.
30. A further issue which arises from the Appellant’s communications is whether, by transferring the appeal to the High Court, the Appellant would be afforded the right to disclosure, exchange of evidence etc. The Appellant seeks *“the proceedings to be transferred to a jurisdiction where facility is provided to allow the totality of evidence and argument to be submitted, with a final decision being made on the substance of the case”*.
31. The Appellant is certainly correct to contend that disclosure and exchange of evidence will not be permitted if the appeal remains before the Appointed Person. However, his belief that such would be permitted in an appeal in the High Court is unfounded. As has been laid down many times, for example in *Axogen v Aviv* [2022] EWHC 95 (Ch) at §24-25, an appeal of a Registry decision, whether before the Appointed Person or the High Court, is by way of a review, not a rehearing. Of course, if the review concludes that a party was wrongly precluded by the original tribunal from obtaining disclosure and/or filing evidence, the matter is likely to be remitted to the original tribunal, where such new disclosure/evidence will be ordered and considered. The appeal court, however, will not consider such disclosure/evidence for itself. Consequently, this particular factor is neutral, as the position will be the same whether the appeal remains with the Appointed Person or is transferred to the High Court.
32. Taking all the above into account, it is abundantly clear that the appeal should remain before the Appointed Person. There is no good argument in favour of transfer to the High Court, and a number of good arguments in favour of it remaining before the Appointed Person.

Discussion – security for costs

33. The Respondent's application is made on the basis that:
- a. The Applicant is listed as a dormant company on Companies House;
 - b. The most recent micro-entity accounts filed for the Applicant on 31 December 2023 list the company assets at just £10 (see attached);
 - c. The Appellant has not paid the sum of £5,000 as ordered by IPEC on 21 December 2018; and
 - d. The Applicant/Appellant has not paid the sum of £1,850 awarded in the decision of the Registrar on 7 November 2024 (although for completeness this sum is only due within 21 days from the final determination of this case).
34. However, the Companies House documents, including accounts, relied upon by the Respondent relate to a different company - Blue Moon Limited – rather than the Appellant, Blue Moon Group Limited. There is no evidence before me that Blue Moon Group Limited will be unable to meet any costs order that may be made against it. I accordingly decline to order security against the Appellant. Should the Respondent wish to renew its application for security for costs against the Appellant, it should provide the relevant documentation pertaining to the correct company, and make appropriate submissions in relation to that company.
35. The Appellant's application for security for costs from Blake Morgan is misconceived, as Blake Morgan is not a party to these proceedings. The Appellant's application for security for costs from the Respondent is unsupported by any information as to i) the Appellant's likely costs in this appeal (given that Appellant's director is acting in person on its behalf, it is difficult to see why it will incur any substantial level of costs); or ii) why it believes that the Respondent will be unable to meet any costs order that may be made against it. I therefore dismiss the Appellant's applications for security for costs.

Conclusion

36. The Appellant's application to transfer the appeal to the High Court is dismissed. The Appellant should, forthwith, select a date for the hearing from those already offered and which the Respondent has confirmed are convenient. If it does not do so within 7 days of this Decision, a hearing date will be allocated without reference to the Appellant's availability.
37. For the reasons set out at paragraph 31 above, the Appellant's contention that it needs to prepare evidence for the appeal is misconceived. No such evidence is required or admissible. The parties should file skeleton arguments in the usual way, 2 days before the hearing, setting out any arguments they wish to make in relation to the appeal.
38. The Appellant's application for security for costs is dismissed. The Respondent's application for security for costs has not succeeded, but the Respondent may renew its application should it wish to do so.

Costs

39. The costs of these preliminary issues are reserved to the appeal.

Dr. Brian Whitehead

14 February 2025

Representation

Gerard Dugdill, Director of the Appellant, in person

Blake Morgan LLP for the Respondent