BL O/0259/25

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. This is an appeal by Blue Moon Group Limited ("**Appellant**") from 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)). That that led to an Order dated 29 October 2018 stating the following "IT IS DECLARED THAT the [Respondent] is the sole owner of UK registered trade mark no. 25377778 in equity";

3. The IPEC issued a further Order on 20 December 2018 stating that the Respondent's solicitor may "execute an assignment of legal title to the [Mark]" from the Appellant to the Respondent. An assignment document was duly drafted and signed on 21 December 2018, by the Respondent's representative. On 24 December 2018 the Respondent filed a Form TM16 (together with a copy of the assignment) to record the transfer of the Mark into its name.

4. An application by the Appellant for leave to appeal the decision of the IPEC to the Court of Appeal was refused on 2 May 2019 by Order made by the Rt. Hon. Lord Justice Floyd where it was stated "[t]here is no conceivable basis on which the court could have given permission to appeal let alone re-open an appeal for which permission has already been refused".

5. In accordance with the IPEC Order of 20 December 2018, the recordal of the assignment of the Mark to the Respondent was actioned with effect from 21 December 2018.

6. Thereafter, there was a series of letters between Mr Gerard Dugdill (on behalf of the Appellant and the IPO, sporadically from July 2019, where he demanded that the IPO suspend the assignment of the Mark to the Respondent despite the Orders of the IPEC to transfer ownership to the Respondent. This was rebutted by the IPO's Deputy CEO at the time (David Holdsworth) in his letter of 28 August 2019 and again by the current Deputy CEO, Andy Bartlett (when the issue was raised again by Mr Dugdill) on 25 August 2023 where it was pointed out that the IPO would require a valid Order of the Court of Appeal overturning the Order of the IPEC of 21 December. Mr Dugdill was informed that the IPO would not correspond further until or unless the IPEC Order was overturned

7. 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.

8. 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*".

9. 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.

10. 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 ("**1994 Act**").

The progress of the appeal

11. The appeal was allocated to me, 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*".

12. 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*".

13. 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's reference to the Registry's "submissions" in its letter of 15 January 2025 is a reference 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.

14. 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*".

15. 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 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.

16. 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 misunderstanding 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.

17. On 5 February 2025, the Secretariat wrote to the parties on my behalf to explain that pursuant to s. 76 of the 1994 Act, transfer to the High Court following a request by a party to extant 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 4 pm on 13 February 2025.

18. 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*".

19. 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.

20. In my interim decision BL O/0137/25 ("**Interim Decision**"), I dismissed the Appellant's applications to transfer the appeal to the High Court and for the Respondent (and its solicitor) to provide security for costs. I declined to order the Appellant to provide security for the Respondent's costs, on the basis that the evidence the Respondent had filed related to the wrong company, but gave permission for the Respondent to renew its application for security for costs if it wished to do so. The Respondent has not renewed that application, and I say nothing more about it.

21. At the end of the Interim Decision, I directed the Appellant to select a date for the hearing from those already offered and which the Respondent had confirmed were convenient. I further ordered that if it did not do so within 7 days of the Interim Decision, a hearing date would be allocated without reference to the Appellant's availability.

22. The Appellant responded on 14 February 2025 to say:

"We are pressing with the registry to ascertain who the best person is we can engage with to take legal action against it, as per previous, continuing now in the issuance of these *ultra vires* rejected *in extremis* submissions of earlier today. We shall seek costs and damages against it, the more so as it seeks to continue to damage our case.

The substantive case is transferred to an alternative jurisdiction, as per previous, subject to our being satisfied such jurisdiction is equipped to handle the matter.

We should be grateful if the registry can also provide a statement as to its own solvency".

23. Later that same day it emailed the secretariat to say "The registry's involvement in this case is over".

24. On 18 February 2025 it sent a further email saying "Was this received, please? With reference to the below point: *We should be grateful if the registry can also provide a statement as to its own solvency*" (Appellant's italics), and on 20 February said "Further, can you please confirm of the contact point between this department and the distribution point for the "appointed person"?".

25. On 21 February 2025, having heard nothing further, I directed that the hearing would be listed on 17 March 2025. The Appellant responded on the same day to say:

"We refer to previous.

Our sole interest in relation to the registry in this matter is to ascertain the information requested in the attached email prior to us taking action against it.

Any further attempt by the registry to meddle in our case will result in an increased claims for costs and damages against it".

26. The Appellant did not attend the hearing on 17 March 2025, having emailed the Secretariat on 13 March 2025 (in response to the filing of the Respondent's skeleton argument) to say "This matter is transferred to the court. We would appreciate acknowledgement. Please "advise" the "Appointed Person" accordingly". On the same day, it also sent the Secretariat a copy of a sealed Appellant's Notice dated 11 March 2025, purporting to commence an appeal of the Decision and Supplementary Decision in the High Court.

The Hearing Officer's decision

27. The Hearing Officer held that the preliminary views were correct, and confirmed as follows:

i) In the IPEC judgment, Hacon J specifically considered the impact of goodwill in circumstances where it was assumed that the current rectification applicant owned the goodwill identified by the mark CREDIT TODAY. Nevertheless, at [17] of his judgement, Hacon J stated "...I cannot see how the position in relation to the goodwill makes any difference" to whether there was an implied term in the oral agreement between the parties that the rectification applicant would "take all necessary steps to give effect to the assignment". It appears that Hacon J had goodwill firmly in mind when giving his judgment and the IPEC Order must have been made in this context. Therefore issue estoppel applies.

ii) In the absence of a valid Order from the Court of Appeal to set aside the IPEC Order, the Registry has no authority to (a) ignore or reverse the Order or (b) the implementation of that Order by way of an assignment document that complies with that Order. The IPEC

Order did not make specific reference to goodwill and, therefore, the assignment document could not be in breach of that Order by not making reference to it either. In such circumstances, it would not be a requirement of the Registry that goodwill was mentioned in the assignment document.

iii) The Trade Mark Act 1994, section 24(1) states:

"24 Assignment, &c. of registered trade mark

(1) A registered trade mark is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal or moveable property.

It is so transmissible either in connection with the goodwill of a business or independently. [Hearing Officer's emphasis]"

It is clear from the language used in this section of the Act that there is no legal requirement for goodwill to be assigned with a trade mark.

Mr Dugdill asserts that "the registry is not in the habit of accepting assignments that do not simultaneously assign the goodwill along with the application or registration mark per se". This statement is wrong and such a practice would be incompatible with section 24(1). The letter provided to support this claim, dated 23 November 2005, is in respect of a party attempting to record an assignment of trade mark 2337786A. It appears, from the content of that letter, that there were issues regarding understanding the scope of the assignment agreement because its scope was qualified by the term "only in so far as defined in the original Sale and Purchase Agreement relating the purchase of certain of the business assets..." but that agreement was not in evidence. Any reference to goodwill in that case must be considered in the context of the Registry attempting to ascertain the scope of the agreement.

Even if the Registry considered that the transfer of the goodwill was a relevant consideration in that case, it is not evidence that this must be so in recording all assignments. In the current case, taking into account the content of section 24(1) and the requirements of the IPEC Order (that made no specific mention of goodwill), the Registry was not in error when recording the assignment to the current proprietor.

iv) An application to file an appeal to the IPEC judgment was refused by the Order of the Court of Appeal. Floyd LJ provided 17 reasons for refusing leave to appeal including at [14] that "[t]he position in relation to goodwill does not, as the judge explained at [17] make any difference." This Order brought the proceedings commenced in the IPEC to an end and, therefore, it is an endorsement of the IPEC Order.

v) [I]t is the preliminary view of the Registry that the application is an abuse of process. Despite the detailed history provided, the primary facts that (i) an Order was issued by IPEC, (ii) the subsequent assignment document complied with that Order. (iii) the attempt to appeal the judgment of the IPEC failed, all points to the Registry NOT being in error when it recorded the current proprietor as owner of the mark.

You [the rectification applicant] refer to the IPEC judgment as "entirely erroneous" and such a perceived error is not a matter for the Registry. An attempt to re-open the issues before IPEC amounts to an abuse of process.

28. Accordingly, the Hearing Officer held that the registration stands in the correct name and the application for rectification fails.

Grounds of Appeal

29. Attached to the TM55 is a document headed "Summary Response to IPO Submissions", running to 11 pages, and a "Detailed Response" of some 66 pages plus 94 pages of exhibits. The Detailed Response purports to be a line-by-line rebuttal of the Decision. Both documents are diffuse, rambling and difficult to follow. However, so far as I am able to gather, the Appellant contends that the Hearing Officer erred as follows (my numbering):

    a. **Ground 1**: The Registry failed to permit disclosure and proper evidence rounds when dealing with the application to rectify the Register.

    b. **Ground 2**: The provision of the preliminary view was *ultra vires*.

    c. **Ground 3**: Contrary to what the Hearing Officer states, the appeal process relating to the 2018 IPEC decision is still ongoing.

    d. **Ground 4**: There is also a pending appeal to the ECtHR which the Hearing Officer did not properly take into account.

    e. **Ground 5**: The Appellant had already begun to transfer matters to another jurisdiction, and the Decision is accordingly null and void.

    f. **Ground 6**: The Hearing Officer was wrong to say that a trade mark registration can be transferred independently of any goodwill in the mark.

30. The Appellant chose not to attend the hearing of its appeal, nor did it file any skeleton argument. The Respondent filed a skeleton argument and its representative, Mr Colledge attended the hearing and made further oral submissions.

Standard of review

31. The approach to be adopted in an appeal hearing has been laid down a number of times in case law. It was summarised in *Axogen v Aviv* [2022] EWHC 95 (Ch) at §24-25:

> **"Appellate Function**
>
> 24. Although I was referred to numerous cases on the subject (including *English v Emery Demibold & Struck Ltd* [2002] 1 WLR 2409, *REEF Trade Mark* [2003] RPC 5, *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5, *Shanks v Unilever Plc* [2014] RPC 29, *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17, *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch), *Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 and *NINEPLUS* O/039/21), the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:
>
>   i) The appeal is by way of a review, not a rehearing (see *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [52(i)]);
>
>   ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a

belief that he or she has reached the wrong decision suffices to justify interference (*NINEPLUS* O/039/21 at [14]);

iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible" (*Actavis Group* at [81]);

iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question (*REEF Trade Mark* [2003] RPC per at [26]). There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision" (*TT Education* at [52(ii)]), with decisions of primary fact at one end of the spectrum and multi-factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.

v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education* at [52(iv)], *REEF* at [28] and *Fine & Country* at [50]-[51]).

vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible (*Actavis Group* at [80]).

vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal" (*REEF* at [26], *Actavis Group* at [78]). Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts (*Shanks* at [28] citing the warning given by Baroness Hale in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49).

viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden" (see *REEF* at [29]). The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted (*English* at [17], *Fage* at [115]). The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained (*English* at [19]).

ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account (*TT Education* at [52(vi)]).

32. I shall bear all the above in mind when reviewing the Decision.

Discussion

33. As a preliminary point, as mentioned in §26 above, on 11 March 2025 the Appellant filed an Appellant's Notice in the High Court with reference number CH-2025-000067. That Appellant's Notice seeks for the Decision and Supplementary Decision "to be declared null and void". It is therefore duplicative of this appeal, of which the Appointed Person is already seised. It is accordingly liable to be struck out as an abuse of process. Furthermore, pursuant to CPR 52.12(b), the time limit for filing an Appellant's Notice is "21 days after the date of the decision of the lower court which the appellant wishes to appeal". CPR 63.16(1) states "Part 52 applies to appeals from decisions of the Comptroller and the registrar". The Supplementary Decision was issued on 12 November 2024, and the time limit for an appeal to the High Court was therefore 3 December 2024. The Appellant's new Appellant's Notice was accordingly filed over 3 months out of time[1]. For both the above reasons, therefore, I do not consider that the appeal set forth in the 11 March 2025 Appellant's Notice has any real prospect of success, and therefore is highly unlikely to impact on this appeal.

34. Given that the Appellant stated in correspondence to the Secretariat that "The registry's involvement in this case is over", and then failed to attend the appeal hearing, it is not necessary for me to consider each of the grounds of appeal in detail, as it can be inferred that it has voluntarily discontinued the appeal before the Appointed Person. However, I shall briefly address the main points raised, and address the second ground in detail as it raises an issue of more general importance.

(1) The Registry failed to permit disclosure and proper evidence rounds when dealing with the application to rectify the Register

35. The Appellant is correct to contend that in normal circumstances the determination of an application to rectify would involve the filing of evidence by the parties, and (if appropriate) the disclosure of documents. It is also correct to contend that no such disclosure or evidence was permitted in this instance. However, that is for the very good reason that the application was dismissed as an abuse of process. Accordingly, none of the usual procedural steps were necessary or required – indeed they would have been a waste of time and costs, given that the application would inevitably have failed at any final hearing on grounds of abuse of process. Subject to the other grounds, therefore, the Hearing Officer was correct to proceed to dismiss the application without permitting disclosure or evidence.

36. I dismiss the first ground of appeal.

(2) The provision of the preliminary view was *ultra vires*

37. The Appellant contends that the issuance of a preliminary view by the Registry was *ultra vires*. As this raises an issue of general importance, I shall address it in detail.

[1] The time limit for an appeal to the Appointed Person is 28 days after the decision being appealed. I understand that the Appellant was granted an extension to 13 January 2025 to file its appeal to the Appointed Person in this instance.

38. A practice has emerged in the Registry in relation to disputes over procedural issues. This practice is summarised as follows in the Trade Marks Manual ("**Manual**"):

> "6.2 Preliminary view
>
> If a dispute arises during the course of the proceedings over a procedural issue, which may either be between the parties or the Tribunal and party/parties, the Tribunal will issue a preliminary view on the matter. Parties should note that, in relation to procedural issues that come before it, the Tribunal will not usually ask the other side for comments before it issues its preliminary view in writing. The Tribunal's preliminary view will become final unless a party objects to it and provides written reasons for doing so (copied to the other side). If that happens, a CMC or Procedural Hearing will usually be appointed".

39. The Manual does not have force of law, and no express provision for the above practice is made either in the 1994 Act or in the Trade Marks Rules 2008 ("**2008 Rules**"). However, Rule 62(1) of the 2008 Rules provides:

> "Except where the Act or these Rules otherwise provide, the registrar may give such directions as to the management of any proceedings as the registrar thinks fit …".

40. The discretion in Rule 62(1) is very wide, and is certainly capable of encompassing the practice described in section 6.2 of the Manual. That practice would be *ultra vires*, therefore, only if it is contrary to some other rule or provision (including the provisions of the Civil Procedure Rules), or otherwise offends against the rules of natural justice.

41. The Appellant does not identify any rule elsewhere in the 1994 Act or 2008 Rules which prohibits the practice described in section 6.2 of the Manual. Rule 63(1) states:

> "Without prejudice to any provisions of the Act or these Rules requiring the registrar to hear any party to proceedings under the Act or these Rules, or to give such party an opportunity to be heard, the registrar shall, before taking any decision on any matter under the Act or these Rules which is or may be adverse to any party to any proceedings, give that party an opportunity to be heard."

42. In my view it is clear that the practice of permitting reconsideration of a contested preliminary view at a hearing before it becomes final is compliant with Rule 63(1). As it happens, in this particular case the Appellant did not request a hearing, and it therefore cannot complain that the Decision was made on the papers following written submissions by the parties.

43. Nor in my view can it be said that the practice in section 6.2 of the Manual is contrary to the CPR or any of the rules of natural justice. Indeed, it is a "litigant-friendly" practice, particularly when litigants in person are involved. The practice gives a party who may have breached a procedural rule an early warning, and the opportunity to seek to remedy any breach that may have occurred. The alternative in this case would have been for the Registry to remain silent and only to have raised the issues addressed in the preliminary view at the final hearing, at which point it would have been too late for the Appellant to seek to do anything about it.

44. The Appellant further objects that:

> "The major problem with such "views" is, we say, that the registry then sees its job largely as confirming a view already issued, in practice with the same hearing officer in charge confirming their earlier decision. Why would they say they got it wrong? See also the

> structure of the registry's "submissions", geared to this practice. This process can therefore intrinsically prejudice any actual "decision" against a thorough examination of the truth, once all relevant evidential material and submissions have been made. We say this is in effect the case here".

45. The Appellant is certainly correct to contend in terms that there is a possibility of "cognitive bias" on the part of a hearing officer, if appropriate safeguards are not observed. I addressed this issue in my decision in *MY E.* O/1161/24. In that decision, I stressed that a hearing following a preliminary view is *ab initio* – it is not a review of the preliminary view. If any further written materials are filed before the hearing, they will be taken into account together with the contents of the application as filed, and the hearing officer will make a decision from scratch.

46. In this particular instance, it is not credible for the Appellant to contend that the Hearing Officer has merely confirmed his earlier preliminary view. It is clear from the Decision that the Hearing Officer looked carefully at both parties' submissions, and set out a detailed analysis of the Appellant's responses to the preliminary view. Furthermore, the preliminary view was in any case clearly correct, as I explain elsewhere in this decision, so it is not surprising that the Hearing Officer reached the same outcome upon redetermination in light of the parties' submissions.

47. I dismiss this second ground of appeal.

(3) Contrary to what the Hearing Officer states, the appeal process relating to the 2018 IPEC decision is still ongoing

48. The Hearing Officer's account of this point is at §59:

> "Mr Dugdill has also submitted that the rectification applicant's appeal is not exhausted because the Court of Appeal Order that set out 17 reasons why leave to appeal was refused was responded to by Mr Dugdill. He states that "we provided 17 reasons back". This appears to reflect either a refusal to accept, or a misunderstanding of the status of the Court of Appeal Order. The Order ended the appeal process in the UK courts, regardless of whether Mr Dugdill considers it to be wrong. I need say no more."

49. The Hearing Officer is quite right. The Court of Appeal does not engage in correspondence with a disappointed applicant in relation to a refusal of leave to appeal. The Appellant may well regard the Court of Appeal's refusal of leave as "unfinished business", but the Court of Appeal's involvement ended on 2 May 2019 when Floyd LJ provided the reasons for refusal. Permission to appeal was refused and the 2018 IPEC decision still stands.

50. I dismiss this third ground of appeal.

(4) There is also a pending appeal to the ECtHR which the Hearing Officer did not properly take into account

51. The Hearing Officer said at §58:

> "The rectification applicant concedes that its application for rectification is "a bid to "potentially" expediate matters while [it] await[s] the conclusion of [its] appeal". I understand the reference to "appeal" to relate to an outstanding action before the European Court of Human Rights ("the ECtHR"). This is not an appeal court and in circumstances where Mr Dugdill's case was ultimately successful it would still not require the UK court to automatically set aside its Order that resulted in the assignment of the mark to the current proprietor. It is within the range of outcomes of a successful case

before the ECtHR that the UK court would review its judgment but deem that it still stands. Consequently, there is nothing in this argument that suggests that the Registry was in error when recording the current registered proprietor on the basis of the assignment document that flowed from the IPEC Order. Of course, if the ECtHR judgment ultimately resulted in a change of ownership of the mark, then Mr Dugdill would be able to file the appropriate change of ownership documents to the Registry who could then update the proprietor's name on the trade mark register".

52. There are two points arising from the above. First, the Hearing Officer was correct to recognise that the effect of an appeal to the ECtHR is not suspensory, and therefore it is entirely appropriate for the Registry to record the current ownership position in relation to the Mark. That position could be revisited in the event that an appeal to the ECtHR succeeds. Secondly and in any event, I note from the documents annexed to the TM55 that the Appellant states that on 27 October 2020 the ECtHR "wrote back to say we were late in filing our case, but we were not. I had to wait until the appeal later Nov. 2019. I have written back to ECHR and made the point, but not heard back".

53. Given that nothing has happened in relation to the Appellant's appeal to the ECtHR in over four years, I strongly suspect that (just as with the English Court of Appeal) the ECtHR has refused permission and the Appellant is simply not willing to accept that refusal. In any case, no evidence was provided to the Hearing Officer (or to me) in support of the contention that the appeal to the ECtHR remains live.

54. I dismiss this fourth ground of appeal.

(5) The Appellant had already begun to transfer matters to another jurisdiction, and the Decision is accordingly null and void

55. The Appellant contends:

> "We issued a second complaint against the registry in that it seemed to want to carry on with proceedings as if the case had not been mangled as described above. We had also already begun the process of transferring the case to another jurisdiction.
>
> The registry says in para 37 of its 7 November submissions:
>
> ....even if the rectification applicant had an arguable case, the appropriate recourse would be through the Court.
>
> This is exactly what we have been arguing, and what we have begun work on.
>
> We therefore seek a declaration that these submissions from the registry - which it dresses as "decision" - are null and void (similar to our request re "preliminary views")."

56. The text in §37 of the Decision relied upon above needs to be read in conjunction with §36:

> "36. Therefore, contrary to the rectification applicant's assertion, Hacon J's judgment is predicated upon an assumption that the goodwill was owned by the rectification applicant. It challenged this on a number of occasions. It is not necessary that I detail its submissions here but it is of the view that the summary judgment made by the IPEC "was totally wrong in all respects". It also asserts that the points in the Court of Appeal's Order "are clearly arguable. It is nonsense to suggest otherwise, a simple attempt to try to bury the matter rather than execute real justice". This position ignores the authority of the

> Courts and the status of the IPEC Orders and the Court of Appeal's Order rejecting the rectification applicant's request for leave to appeal the IPEC judgments. The IPEC's Order has not been set aside. In light of the request to record the assignment that flowed from these Orders, the Registry correctly updated the register. It was not in error to record a change of proprietor following a valid assignment flowing from a Court Order. It is plainly clear to me that to attempt to reopen these issues before the Registry is prohibited by the doctrine of issue estoppel.
>
> 37. I discuss this further later, but even if the rectification applicant had an arguable case, the appropriate recourse would be through the Court. The issue of ownership of the trade mark has been settled by the IPEC and its subsequent Orders. The rectification applicant cannot reopen the issues before the Registry, which is (i) a lower authority than IPEC, and (ii) has no powers to force a change in ownership. This combined with the motive of the rectification applicant to try and bring about a change of ownership of the contested mark contrary to the IPEC Order amounts to an abuse of process."

57. It is clear, therefore, that the Hearing Officer was not contending that the Appellant's application for rectification should proceed in the Courts rather than in the Registry. Rather, he was saying that the Courts have reached a binding decision, and that decision could only have been challenged in the Court. For the reasons set out in §§48-49 above, the Appellant's attempt to appeal the IPEC's decision failed, and the involvement of the Courts is therefore over.

58. In any case, the Appellant's contentions regarding transfer to the Court demonstrates that it was labouring under the same misapprehension as it was in relation to transfer of this appeal to the Court. An applicant for rectification has the choice of Registry or Court, just as an appellant from a Registry decision has the choice of Appointed Person or Court. However, once a choice has been made, the applicant/appellant cannot simply change its mind and demand transfer to its preferred venue. Once a venue is seised of an appeal, that venue must consent to any transfer. Even if, therefore, the Appellant had a case it could have run in the Court, it would have required the Registry's consent for the application for rectification to be transferred to the Court.

59. The Hearing Officer had all the above well in mind when he said at §§21-22:

> "21. The rectification applicant repeatedly requested that the case should be transferred to the court. This request was declined because the reasons set out in the Form TM26R were all issues that the Registry has competence to decide or had already been decided by the IPEC. The rectification applicant clearly holds strongly held beliefs that that Order issued by the IPEC and subsequent assignment document are wrong and the rectification applicant's arguments are founded upon a desire for that to be recognised and corrected. It argues that:
>
> (i) firstly, the written arguments attached to the Form TM26R are based upon a claim that the assignment ordered by the IPEC is faulty because it does not also include assignment of goodwill;
>
> (ii) secondly, there is still an outstanding appeal to the IPEC judgment
>
> 22. These are both issues that the Registry is able to dispose of and consequently I consider that there is no need to transfer the proceedings to the court."

60. The Hearing Officer was therefore not wrong to continue with determining the application, notwithstanding the Appellant's stated desire to transfer proceedings to the Court. I dismiss this fifth ground of appeal.

(6) The Hearing Officer was wrong to say that a trade mark registration can be transferred independently of any goodwill in the mark

61. The Appellant has contended throughout that a trade mark registration cannot be transferred independently of any goodwill in the mark. That is simply incorrect as a matter of law. The Hearing Officer explained why in the preliminary view, citing s. 24 of the 1994 Act (which is set out at §27(iii) above, complete with the Hearing Officer's own emphasis on the relevant text). That was challenged by the Appellant, and in the Decision the Hearing Officer responded to the Appellant's further submissions and provided further detail of the applicable law at §§45-54.

62. The Appellant continues to contend that s. 24 of the 1994 Act does not mean what it says. In its "Detailed Response" the Appellant states:

> "We believe this does not cover the case where the *goodwill actually exists*, as in this case here. The act does not say a mark can be transferred independently of goodwill in this circumstance." (Appellant's italics)

63. The Appellant is of course entitled to its own view as to what the law ought to be, but that does not trump the law as it actually is. The Appellant's argument makes no sense. Clearly s. 24 is drafted with the situation in which "*goodwill actually exists*" in mind, as the provision would be redundant in a scenario in which goodwill does not exist (such as, for example, transfer of a mark which has never been used).

64. I dismiss this sixth ground of appeal.

Conclusion

65. The appeal is dismissed.

Totally without merit?

66. The Respondent seeks an order recording that the appeal was totally without merit. For all the reasons discussed in §§33-63 above, the Appellant's appeal was hopelessly misconceived. Each of the grounds of appeal was predicated upon fundamental misunderstandings of the applicable law and procedure. Furthermore, the situation regarding ownership of the Mark was settled conclusively by the IPEC in 2018. Permission to appeal the IPEC's decision was refused by the Court of Appeal in May 2019. The Appellant's subsequent attempt to relitigate "by the back door" by way of its application to rectify the register was an abuse of process. This appeal, against an unimpeachable decision by a Hearing Officer, was a further abuse of process.

67. Additionally, it is clear from the Appellant's conduct that, in the event that the Appointed Person refused to agree to its upfront demands, the Appellant never had any intention of complying with the rules and timetable of the appeal. Those upfront demands – that the Decisions be summarily "*struck out as null and void*" were plainly unreasonable, given that no appeal tribunal would ever agree to such course of action without hearing from the Respondent. As such, even ignoring the (lack of) merits, I infer that this entire appeal was commenced only in an attempt to cause a nuisance to the Respondent, rather than as a *bona fide* appeal. That adds further weight to my finding that this appeal is an abuse of process.

68. Accordingly, it is abundantly clear that the appeal was totally without merit, and I so record.

69. I further add that the Appellant's conduct has fallen woefully short of what can reasonably be expected of a party involved in an appeal before the Appointed Person. It has behaved unreasonably both in its dealings with the Respondent and also with the Appointed Person. With regard to the Respondent, the Appellant has:

- Made repeated demands for extensive disclosure and witness evidence which are wholly unfounded under the rules. Even after I explained to the Appellant that such disclosure and witness evidence would not be ordered, either in appeal proceedings before the Appointed Person or the High Court, the Appellant continued to make its demands, backed by unilaterally imposed deadlines, all of which were copied to the Secretariat. I say in passing that the Respondent cannot be criticised for refusing to engage with the Appellant's demands for disclosure, given that there are no proceedings between the parties which could possibly give rise to any disclosure obligations on the part of the Respondent;

- Made an entirely misconceived application for security for costs against the Respondent's solicitors in the sum of £20 million;

- Made repeated threats to sue the Respondent's solicitors. Any claims the Appellant may have against the Respondent's solicitors are plainly not a matter for the Appointed Person, but even after this was pointed out to the Appellant, the threats continued to be made in correspondence copied to the Secretariat.

70. All the above is anathema to the efficient and cost-effective handling of an appeal.

71. With regard to the Appointed Person, the Appellant has:

- Consistently refused to agree to a date for the appeal hearing;

- Refused to accept the ruling in relation to transfer to the High Court, describing it as *ultra vires*, notwithstanding the fact that the Appointed Person was seised of the appeal by virtue of the Appellant's own choice of venue;

- Made repeated threats to sue the Registry and other (unspecified) persons involved in the administration of the Appointed Person; and

- Failed to attend the appeal hearing.

72. The cumulative effect of all the above is that the Respondent has been compelled to respond to an appeal that i) should never have been commenced in the first place, and ii) has been conducted in an abusive and unreasonable manner.

Costs

73. Although the Respondent states that its costs have exceeded the maximum set forth in TPN 1/2023, it does not seek an off-scale costs order. I accordingly order that the Appellant shall pay the Respondent the sum of £1,900, which is the maximum under the scale for preparing for and attending a one-day hearing.

74. The Hearing Officer's order that the Appellant should pay the Respondent £1,850 by way of costs of the proceedings below still stands. The net effect is that the Appellant shall pay the Respondent £3,750 within 21 days of this decision.

Dr. Brian Whitehead

19 March 2025

Representation

Gerard Dugdill, Director of the Appellant, who did not attend the hearing

Michael Colledge of Blake Morgan LLP for the Respondent