BL O/0620/24

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 425937

IN THE NAME OF XACTWARE SOLUTIONS INC

TO TRADE MARK APPLICATION No. 3602773

IN THE NAME OF BUILDXACT SOFTWARE LTD

DECISION

1. On 1 March 2021, Buildxact Software Ltd ('**the Applicant**') applied under number 3602773 for registration of the word **BUILDXACT** as a trade mark for use in relation to various goods and services listed in Classes 9, 36, 37 and 42.

2. Xactware Solutions Inc ('**the Opponent**') opposed the application for registration in its entirety in a Form TM7 Notice and Grounds of Opposition filed on 3 August 2021. It did so under ss. 5(2), 5(3) and 5(4)(a) of the Trade Marks Act 1994 on the basis of prior rights claimed by virtue of registration and use of three '**XACT** – formative' marks identified in the Grounds of Opposition as: **XACTWARE**, **XACTANALYSIS** and **XACTIMATE**.

3. The Opposition was determined by Mr Mark Bryant acting on behalf of the Registrar of Trade Marks. He rejected it in its entirety for the reasons he gave in a Decision issued under reference BL O/0298/23 on 23 March 2023. The Opponent was ordered to pay £2,350. to the Applicant in respect of its costs of the Registry proceedings.

4. The Opponent appealed to an Appointed Person under s.76 of the 1994 Act contending that the Hearing Officer's reasoning was deficient hence defective in a number of respects and that his Decision should accordingly be set aside.

5. The Appeal was, as all such appeals are, an appeal against the outcome of the Opposition as expressed in the Hearing Officer's ultimate determination rather than an appeal against the underlying reasons he gave for making the determination he did: see

Thomas v Luv One Luv A ll Promotions Ltd [2022] 4 WLR 9; [2021] EWCA Civ 732 at para. [20] (per Lewison LJ with whom Newey and Lewis L.JJ agreed).

6. It came on for hearing before Mr Phillip Johnson sitting as the Appointed Person on 15 September 2023. By not contesting the rejection of its objection to registration under s.5(4)(a), the Opponent accepted the Hearing Officer's finding that the opposed application was unobjectionable under that section of the Act.

7. At para. [47] of its Skeleton Argument for the hearing, the Opponent had observed without further elaboration that if the Appointed Person were to find that the Decision under appeal was liable to be set aside for material and distinct errors of principle "*then that leaves the question as to whether it should be remitted back to a separate hearing officer*". There was a passing reference to that point in the Opponent's oral submissions as recorded at p.71, lines 22 to 25 of the Transcript of the hearing. The Applicant did not address the matter in its written or oral submissions. In the event, there was no real or substantial argument before the Appointed Person as to whether, if the Appeal succeeded, the Opposition should be remitted to the Registrar for determination by a different hearing officer.

8. The Appointed Person issued his Decision on the Appeal under reference BL O/0934/23 on 1 October 2023. Of the six Grounds of Appeal raised by the Opponent: Ground 1 succeeded; Grounds 2 to 5 were rejected; and one strand only of Ground 6 was upheld. In the result, the Appointed Person decided that the Opponent's objections to registration had not been fully addressed at first instance principally as a consequence of the Hearing Officer having mistakenly believed that the Opponent was relying on the formative mark **XACTIMATE** only in support of its objection under s.5(3) and not also in support of its objection to registration under s.5(2)(b).

9. Having considered the further implications of that for the Opponent's 'family of marks' argument on which both sides had addressed him at length at the hearing of the Appeal, he concluded as follows in paras. [50] to [52] of his Decision:

> 50. I therefore allow the appeal in part and remit this matter back to the registrar to determine the following issues only:
> (i) The merits of the opposition under section 5(2)(b) based on the mark XACTIMATE;

(ii) Whether the three marks XACTIMATE, XACTWARE and XACTANALYSIS are a family of marks. If so,

a. the merits of the opposition under section 5(2)(b) based on the shared characteristics of these marks.

b. Whether there is a link for the purposes of section 5(3) between XACTWARE and BUILDXACT taking into account the family of marks (and if a link is found, whether the injury required for section 5(3) is established.

51. I see no reason why the case needs to be assigned to a new hearing officer, but I will leave it to the registrar to assign it as the registrar sees fit. It is also for the registrar to make any further directions necessary.

52. In the light of my findings and the mixed success of the parties, I make no order as to costs.

10. The Opponent's Appeal against the Hearing Officer's rejection of its Opposition under ss.5(2)(b) and 5(3) was thus allowed and remitted to the Registrar for further processing in accordance with the provisions of the Trade Marks Act 1994 and the Trade Marks Rules 2008 on the limited basis specified in para. [50] of the Appointed Person's Decision.

11. The Appointed Person's Order to that effect matched the approach to orders made in proceedings for judicial review under s.31(5)(a) of the Senior Courts Act 1981, which provides: "*If, on an application for judicial review, the High Court makes a quashing order in respect of the decision to which the application relates, it may in addition — (a) remit the matter to the court, tribunal or authority which made the decision, with a direction to reconsider the matter and reach a decision in accordance with the findings of the High Court, …*".

12. The Order did not permit or require the parties or the Registrar to start the decision taking process all over again. It revived the jurisdiction of the Registrar in relation to the Opposition, but only to the limited extent necessary to enable him to determine the specifically remitted issues: Reliance Industries Ltd v The Union of India [2020] 1 Lloyd's Rep 489; [2020] EWHC 263 (Comm) (Robin Knowles J) at paragraph [8] and

the case law cited; Spencer Bower & Handley, Res Judicata, 5th Edition (2019) para. 5-14.

13. In para. [51] of his Decision the Appointed Person made it clear first, that he saw no reason to require the remitted Opposition to be determined by a different hearing officer and second, that all aspects of the further conduct of it in the Registry, including who the hearing officer should be, were for the Registrar to decide in the first instance.

14. After the Opposition returned to the Registry following the Appointed Person's Decision of 1 October 2023, it was allocated to the same Hearing Officer as before. The Registrar's representatives confirmed at the hearing before me that this was done in the usual way as part of the process by which the Registrar and the Registry assign cases to hearing officers taking account of their seniority, the complexity of the case, their diaries, their availability, their resourcing and so forth. It involved a conversation between senior managers and hearing officers in which para. [51] of the Appointed Person's Decision was seen and understood to have given the Registrar a free hand in the matter.

15. The Opponent contends in its Grounds of Appeal that: "*The decision as to whether or not to assign the case to Mr Bryant should have been made by the Registrar and not by Mr Bryant and he thus should have not allocated and assigned the case to himself.*" However, it appears from the information provided by the Registrar that the Hearing Officer did not simply proceed to allocate the remitted Opposition to himself and that the act of allocating it back to him was done in the exercise of the functions of the Comptroller-General of Patents, Designs and Trade Marks (who in s.62 of the 1994 Act is identified as the Registrar for the purposes of that Act) with the result that it is for all purposes to be treated as having been an officially authorised act done by him in his capacity as such in accordance with ss. 74(1), (2) and (4)(c) of the Deregulation and Contracting Out Act 1994.

16. This was to all appearances consistent and compatible with the approach to dealing with remitted proceedings adopted by the Court of Appeal in HCA International Ltd v Competition and Markets Authority [2015] EWCA Civ 492; [2015] 1 WLR 4341. In that case the CMA had accepted that two of its decisions affecting HCA should be quashed for having been based on material errors made in an investigation inquiry

report under Part IV of the Enterprise Act 2002, but refused to consent to HCA's request that the decisions be remade by a freshly constituted inquiry group. The Court of Appeal (Laws, Vos and Bean L.JJ) dismissed HCA's appeal against the ruling of the Competition Appeal Tribunal to the effect that it remained appropriate for the CMA to refer the matter back to the same inquiry group and the same case team as had undertaken the original investigation.

17. The approach adopted by the Court of Appeal is sufficiently for present purposes summarised in the headnote to the Weekly Law Report of the case at p.4341E to p.4342B:

> *Held*, dismissing the appeal, that remission was to be made to the same decision-maker unless that would cause reasonably perceived unfairness to the affected parties or would damage public confidence in the decision-making process; that the presence of actual bias, apparent bias or confirmation bias would make remission to the original decision-maker undesirable, because any such bias would give rise to both reasonably perceived unfairness to an affected party and potentially serious damage to public confidence in the decision-making process; that the kind of unfairness concerned was such as contravened the public law duty of fairness; that although what fairness required would vary with the factual circumstances, it was a matter of law, rather than a matter of discretion for the decision-maker; that, although the authority had behaved inappropriately and unfairly in one respect in the conduct of the investigation, the inappropriate and unfair conduct concerned was not such as would lead a fair-minded and informed observer to conclude that there was a real possibility that the authority's inquiry group was or was likely to be biased and did not lead to the conclusion that remission to the same inquiry group would cause reasonably perceived unfairness to the applicant or damage public confidence in the authority's decision-making process; and that, accordingly, the Competition Appeal Tribunal had been right to rule that the two quashed decisions ought to be remitted to the original inquiry group.

18. The Registrar was free to proceed in the present case on the principle affirmed in HCA International Ltd to the effect that remission was to be made to the same decision taker unless doing so would cause reasonably perceived unfairness to the affected parties or would damage public confidence in the decision taking process.

19. It is well-established that the further involvement of a decision taker in future decision taking in the same or related proceedings is not objectionable in the absence of conduct

or circumstances in the light of which a fair minded and informed observer, having considered the facts, would conclude that there was a real possibility that the objecting party would not receive a fair trial.

20. I have expressed the point in that way in line with para. [71] of the Judgment of Lewison LJ in In re H (A Child) (Recusal) [2023] EWCA Civ 860; [2023] 4 WLR 64 and the substantial body of antecedent case law at appellate and senior court level comprehensively examined by Fraser J in Bates v Post Office Ltd (No. 4) (Recusal Application) [2019] EWHC 871(QB) at paras. [27] to [77].

21. There had been no suggestion in the Opponent's Grounds of Appeal to the Appointed Person or in its subsequent submissions in support of the Appeal or in the ensuing Decision of the Appointed Person issued on 1 October 2023 that the Decision issued at first instance on 23 March 2023 was liable to be set aside for unfairness in the Hearing Officer's conduct of the case. The Registrar quite simply had no reason to suppose (just as the Appointed Person indicated in para. [51] of his Decision that he had no reason to suppose) that there was any ground for concern with regard to the remitted Opposition being allocated back to the same Hearing Officer.

22. I do not accept that the act of allocating the remitted Opposition back to the same Hearing Officer involved or amounted to "*taking any decision*" within the scope of r.63 of the Trade Marks Rules 2008:

> "63. — (1) 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."

23. The expression "*any decision on any matter under the Act or these Rules which is or may be adverse to any party to any proceedings*" refers to the end step in the nature of a ruling or determination preceded by a decision taking process which the Registrar has been required or requested to undertake with a view to disposing of an issue that has arisen for decision on a particular matter affecting the position of a particular party or parties to particular proceedings under the Act or the Rules. It does not create or imply anything in the nature of a front end procedural requirement for anyone or everyone to

be given advance notice and provided with an opportunity to make pre-emptive representations as to who the Registrar should or should not nominate to act as hearing officer on his behalf in any Registry proceedings to which they are or may become a party.

24. The Applicant took the initiative in relation to the further conduct of the remitted Opposition by writing to the Registrar on 4 October 2023 proposing as follows: "*This is a case in which each side has expended significant resources on specialist attorneys and experienced counsel. The remitted issues cover a narrow compass. It is important therefore that the determination of those issues be conducted in a proportionate manner. Because of the circumscribed nature of the remitted issues, with the balance of the appeal grounds being dismissed, we consider that it is both appropriate and most cost-effective for Mr Bryant to determine them and for him to do so on the papers without a further hearing.*"

25. The Opponent responded on 5 October 2023 briefly stating that it objected to both aspects of the Applicant's proposal: *"… this is to inform the Registry that the Opponent / Appellant seeks to have the matter determined by a different Hearing Officer and with a hearing rather than on the papers. We will be submitting written submissions on these points as soon as possible, for the Registry to consider."*

26. These communications raised two issues for decision by the Registrar in accordance with the procedural requirements of r.63: (i) whether Mr Bryant should (as the Opponent contended) be recused from acting as the Hearing Officer on the remitted Opposition; and (ii) whether the remitted Opposition should (as the Applicant contended) be determined without recourse to a hearing. However, the Registry omitted to follow its standard practice under r.63 of issuing a 'preliminary view' on the issues which had been raised and offering the parties the opportunity of a hearing at which to contest the 'preliminary view' if and to the extent that they disagreed with it.

27. The Tribunal Hearings Section of the Registry simply wrote to the parties on 10 October 2023 informing them as follows:

> "The hearing officer, Mr Bryant, thanks both parties for their comments. He confirms that, as permitted within the scope of the Appointed Person's comments at [51] of his decision, he will retain the remitted case.

> The hearing officer has considered the parties comments regarding how to proceed but notes that the remittal is in respect of issues that were live at the time of the original hearing and that this provided an adequate opportunity for submissions on the issue.
>
> Insofar as the remittal 'drills down' on the issue of any potential impact on the family of marks as set out at [50(ii)] of the Appointed Person's decision, the parties are permitted a concurrent period of 21 days (i.e. until 30 October) to file written submissions that should not exceed 10 pages."

28. The failure to give effect to the requirements of r. 63 was a procedural irregularity. It was open to the Opponent to apply to the Registrar for the irregularity to be rectified under r.74 of the 2008 Rules by appointing a hearing at which to consider its objections afresh: AVON GRIPSTER Trade Mark [2009] RPC 17; PARIS BREAKFAST TEA Trade Mark BLO/396/15 (19 August 2015) at [17] to [22]. Doing so would have enabled the question of recusal to be determined before the Hearing Officer proceeded to issue a decision on the remitted Opposition. Regrettably, that did not happen. With the result that the Opponent was never substantively called upon to 'show cause' for the Hearing Officer to be recused and the Registrar was never substantively called upon to issue any decision on recusal supported by a statement of reasons under r.69 of the 2008 Rules.

29. On 30 October 2023, both parties filed their written submissions in line with the directions the Registry had given on 10 October 2023 for the further conduct of the remitted Opposition proceedings. In parallel, on the same day the Opponent filed a Form TM55P Notice and Grounds of Appeal to an Appointed Person under s.76 of the 1994 Act ('**the First Appeal**') maintaining that the Hearing Officer's decision not to recuse himself was legally and procedurally wrong and should be set aside. In para. 2 of its written submissions it stated: "*These written submissions are filed without prejudice to the Opponent's contention that in exercising its discretion, the Registrar should have assigned the case on remittance to be decided by another Hearing Officer, consonant with principles of natural justice. The Opponent will appeal that procedural decision.*" The Opponent raised no objection or complaint either in its written submissions to the Hearing Officer or in its Grounds of Appeal about the remitted Opposition being determined without recourse to a hearing.

30. On 5 December 2023, the Registry's Deputy Director of Tribunal Services wrote to the Opponent's professional representatives maintaining that the Form TM55P initiating the First Appeal on 30 October 2023 was neither appropriate nor admissible because the Registrar's allocation of the remitted Opposition back to the original Hearing Officer was not an appealable decision in its own right. The letter concluded by saying that arrangements had been made to refund the fee for the filing of the Form TM55P and that the case would remain with Mr Bryant who would issue his remittal decision in due course.

31. The position adopted by the Registrar in this letter was open to objection on the following basis:

(i) the First Appeal was in substance directed at the Registrar's failure to accede to the request made by the Opponent in its letter of 5 October 2023 for Mr Bryant to be recused from acting as the Hearing Officer on the remitted Opposition;

(ii) the Opponent's Form TM55P Notice and Grounds of Appeal could not be treated as void and of no effect for the purposes of s.76 of the 1994 Act and r.71 of the 2008 Rules without making a substantive determination to that effect;

(iii) it was necessary for any decision to strike out the First Appeal for abuse of process or lack of justiciable subject matter to be taken in accordance with the procedural requirements of r.63; and

(iv) in that connection it would have been necessary to determine whether the Registrar actually had the power under the Act and the Rules to strike out a Form TM55P Notice and Grounds of Appeal initiating an appeal to the Appointed Person under s.76.

32. On 14 December 2023, Mr Bryant acting on behalf of the Registrar issued a Decision under reference BL O/1182/23 rejecting the remitted Opposition in its entirety. He ordered the Opponent to pay £350. to the Applicant in respect of its costs of the Registry proceedings.

33. The Opponent then proceeded to file a Form TM55P Notice and Grounds of Appeal to an Appointed Person under s.76 of the 1994 Act on 30 December 2023 ('**the Second**

Appeal'). This was directed at the Decision recorded in the Registrar's letter of 5 December 2023 to treat the First Appeal filed on 30 October 2023 as a nullity. Both Appeals are now before me. Taken together, they serve as a platform for what is in sum and substance a contention that the failure to accede to the Opponent's request for Mr Bryant to be recused from acting as Hearing Officer on the remitted Opposition involved or amounted to a serious procedural irregularity by reason of which the Decision he issued on 14 December 2023 should be treated as tainted by unfairness and the appearance of bias so as to result in it being set aside without regard to the correctness or otherwise of what he decided.

34. The Opponent filed a third Form TM55P Notice and Grounds of Appeal to an Appointed Person on 11 January 2024 ('**the Third Appeal**'). This challenged the correctness of the Decision issued by the Hearing Officer on the remitted Opposition on 14 December 2024. Since it would not be required if the Opponent succeeded with its claim for that Decision to be set aside for unfairness and the appearance of bias in the decision taking process, the Third Appeal was adjourned to await and abide by the outcome of the two Appeals that I am dealing with in this Decision.

35. At the hearing before me, the Opponent applied for permission to amend its Grounds of Appeal in the First Appeal with a view to raising an additional procedural complaint to the effect that: "*The Appellant had requested a hearing on the remitted issues. The failure to have granted that was a breach of r.63, Trade Marks Rules 2008.*" Shortly stated, the factors which led me to refuse permission to amend were: (i) waiver — the Opponent had participated without reservation or exception in the implementation of the direction given by the Registry on 10 October 2023 for the remitted Opposition to be determined without recourse to a hearing (see paras [27] and [29] above); (ii) belated attempt to change position — the Opponent was evidently content to proceed without raising any such procedural complaint after the date of the Registry's letter of 10 October 2023 and for more than 6 months following the filing of the First Appeal on 30 October 2023; and (iii) inutility — if the substantive complaint relating to recusal succeeded on appeal, the procedure adopted by the Registrar would be set aside and the additional procedural complaint would in that event be redundant; if the substantive complaint relating to recusal failed on appeal, the procedure adopted by the Registrar

would remain in place and there would in that event be no unwaived basis on which the additional procedural complaint could still succeed.

36. In relation to the central question for determination, the Opponent submitted in its Skeleton Argument that "if proper consideration had been given to whether or not to remit the matter to the same or a different tribunal, **it should and would have been remitted to a different tribunal** (para. 28) and "if a proper approach had been made by the Registrar (having heard submissions from both sides), and the parties were both allowed to make submissions on this point, then **it would inevitably have led to the matter being remitted to a different tribunal** " (para. 35). This was a realistic and appropriate approach to adopt given the interplay in the Appeal between the concepts of unfairness and apparent bias, as to which see Ilirjan Hima v Secretary of State for the Home Department [2024] EWCA Civ 680 at paras. [8] to [13] (per William Davis LJ, with whom Underhill and King L.JJ agreed).

37. The Opponent relied in its oral submissions before me (Transcript pp. 53 to 55) on the points summarised in paras. 35.1 to 35.7 of its Skeleton Argument:

> 35.1 Mr Bryant had made a fundamental error in his decision in not considering the XACTIMATE mark. As there had been use of the XACTIMATE mark, it meant that both under s.5(2) and s.5(3), the Opponent had made use of a family of three marks - all of which had XACT in them. Here, it is of note that the Appointed Person at [18] referred to jurisprudence of the General Court where it had been said in T-175/22 *Novartis v EUIPO* that it was necessary to have at least three marks to form a family. The Appointed Person said that he did not need to consider whether such was good law (it being merely persuasive as it was decided after the UK left the EU), because once XACTIMATE was taken into account (as he held that it should have been by the Hearing Officer), there were three marks.
>
> 35.2 The situation was *"more serious in the instant case where the failure was a clear mistake and not a considered decision"* ([16], AP Decision)
>
> 35.3 As said by the Appointed Person, it was important that the Hearing Officer *"considers the family of marks argument again". A new mark (XACTIMATE) is joining the putative family and this is a material change. It is also not clear that the Hearing Officer followed the established case law relating to family marks".*

35.4 A failure to consider the mark XACTIMATE is analogous to a failure to consider the availability of other evidence (see X*Petitioner).* In that case, the Court of Session held that by reason of the same, it should be remitted to a freshly constituted tribunal to avoid any risk of perceived unfairness or damage to public confidence.

35.5 Undoubtedly, if the matter was remitted back to Mr Bryant, the Appellant would have been up against "confirmation bias" - namely the difficulty of persuading a decision maker that has made up its mind to change its view. (see [6),[70], *HCA* discussed above). Given that, it was undesirable to remit back to Mr Bryant because such a bias would amount to reasonably perceived unfairness and pose a potentially serious damage to public confidence.

35.6 Neither side had asked Mr Bryant to ignore XACTIMATE and its relevance to the s.5(2) ground of opposition. It was a serious and material oversight by Mr Bryant to which he was not led by either party. It is a fair and reasonable perception that Mr Bryant may well have found that embarrassing and would be keen to show that in fact, notwithstanding the oversight, it made no difference to his decision.

35.7 Mr Bryant had also committed an error of principle in failing to consider under s.5(3) when determining whether there was a link that the mark on which it was claimed had a reputation was a member of a family of marks. This was notwithstanding that in its Skeleton Argument at the first 1st instance hearing, … at [107], on the matter of link, the Appellant had said that a significant relevant factor was that the Opponent had used a family of marks with XACT in them and thus the relevant public had become habituated and educated to see XACT as being the main distinguishing element of the marks.

38. I do not see in the Opponent's position as summarised in those paragraphs any sustainable basis for requiring Mr Bryant to be recused from acting as the Hearing Officer on the remitted Opposition. There was, as I have said, no suggestion — still less any finding — that the Decision he had issued at first instance on 23 March 2023 was liable to be set aside for unfairness in the conduct of the case. The Opponent's Grounds of Appeal were for the most part rejected by the Appointed Person in the Decision he issued on 1 October 2023. The Hearing Officer was found to have inadvertently made an 'error by omission.' The relatively discrete nature of the error was reflected in the relatively limited extent to which the Opposition remained open for determination in

the aftermath of the Appointed Person's Decision. The Hearing Officer's first instance Decision of 23 March 2023 was, in effect, ordered to stand as an interim decision in what by then had become a part-heard Opposition. All except the specifically remitted issues fell to be regarded as settled by the Hearing Officer's original Decision. It could not seriously be contended that continuing with the remitted Opposition on that basis — as the Appointed Person had directed — would involve or amount to doing so with anything properly describable as 'confirmation bias' relative to the remitted issues which remained to be determined. Seen from that perspective, the Hearing Officer's inadvertant 'error by omission' in the present case was no more liable to be regarded as a portent of 'confirmation bias' in the ongoing Opposition than the errors of assessment which the Court of Appeal held to be non-disqualifying of the decision taking team to whom the ongoing Enterprise Act investigation inquiry was remitted in the HCA International Ltd case. The making of that error was not without more — and there was nothing more — preclusive of future involvement and decision taking by the Hearing Officer in the ongoing Registry proceedings.

39. That is necessarily a fact sensitive and case specific assessment. I do not accept that the situation in the present case is analogous to that in the cited case of XPetitioner [2022] CSOH 15 (Lord Woolman) where it was found at paras. [38] to [41] that the determination made at first instance was vitiated by unfairness and should be set aside in its entirety because the tribunal below had proceeded in ignorance of the availability of evidence due to a mistake which must have played a material part in its reasoning. The Lord Ordinary went on to observe in para. [44]: "*Were it competent for me to decide these matters I would conclude that the case should be determined by a freshly constituted tribunal. That avoids any risk of perceived unfairness or damage to public confidence*" (citing HCA International Ltd). By contrast, the Appointed Person did not in the present case find that the Hearing Officer's Decision at first instance was vitiated by unfairness or that it should be set aside in its entirety and he made a point of saying that he saw no reason why the remitted Opposition would need to be assigned to a new hearing officer. And that continues to be the condition in which the Opposition has now reached me on appeal.

40. For the reasons I have given, I determine:

[1] that the Opponent's request made on 5 October 2023 for Mr Bryant to be recused from acting as Hearing Officer on the remitted Opposition should have been dealt with by the Registrar in accordance with the requirements of r. 63 of the Trade Marks Rules 2008;

[2] that the Registrar's failure to give effect to the requirements of that rule was a procedural irregularity which deprived the Opponent of the opportunity to make what in substance and reality would have been an application for recusal that was unsustainable in point of fact and point of law; and

[3] that the Opponent's First Appeal and Second Appeal were and are nugatory for lack of a sustainable basis for requesting recusal of the Hearing Officer allocated by the Registrar to the remitted Opposition.

41. I therefore dismiss the First Appeal and the Second Appeal and direct the Opponent to pay £3,750. to the Applicant in respect of its costs of the dismissed Appeals within 21 days of the date of this Decision. I regard that as a reasonable amount to award by way of contribution to the Applicant's costs having regard to what I consider to have been the amount of effort and expenditure that is likely to have been reasonably and productively incurred by it in resisting the Appeals, adopting the approach to quantification indicated in paras. [12] to [14] of my decision in AMARO GAYO COFFEE Trade Mark BL O/257/18 (25 April 2018).

Geoffrey Hobbs KC

1 July 2024

Mr Guy Tritton instructed by Noerr Alicante IP, SL appeared on behalf of the Opponent / Appellant

Mr Simon Malynicz KC instructed by HGF Ltd appeared on behalf of the Applicant / Respondent

Dr James Porter (Chief Hearing Officer) and Mr Nathan Abraham (Tribunal Deputy Director) represented the Registrar in line with the practice recognised and upheld in CORGI TM [1999] RPC 549 at pp. 555, 556 and 562.