

TRADE MARKS ACT 1994

IN THE MATTER OF
APPLICATION NO. 2171448 BY THE AMERICAN COLLEGE IN LONDON
LIMITED TO REGISTER A TRADE MARK IN CLASS 41

AND IN THE MATTER OF
OPPOSITION THERETO UNDER NO. 49919 BY RICHMOND COLLEGE, THE
AMERICAN INTERNATIONAL UNIVERSITY IN LONDON INC.

DECISION

1. In a written decision dated the 12th December 2000 Mr Allan James, the Hearing Officer for the Registrar, decided that application no. 2171448 by The American College in London Limited (“the Applicant”) should proceed to registration and that an opposition to it by Richmond College, The American International University in London (“the Opponent”), failed.
2. Mr James reached his decision on the basis of the pleadings and the supporting evidence because neither side requested an oral hearing. He ordered the Opponent to pay to the Applicant the sum of £500 as a contribution towards its costs.
3. In January 2001 the Opponent gave notice of intention to appeal against the decision to an Appointed Person and prepared and filed Grounds of Appeal.

4. The appeal was fixed to be heard on the 8th September 2001 and notice of that date was communicated to the parties by letter dated the 13th July 2001.
5. On the 8th August 2001 the Opponent abandoned the appeal. In the circumstances the Applicant seeks an award of costs. The parties have been invited to make their submissions on costs and have done so by correspondence. They have also agreed that the matter be disposed of on the basis of those submissions and without an oral hearing.
6. I believe that where an appeal is abandoned an appropriate award of costs should normally be made in favour of the respondent to the appeal. This approach has been adopted in a number of cases before the Appointed Person (see, for example, *VFM's Application*, a decision of Mr Hobbs Q.C., dated the 12th June 2002).
7. The Applicant has submitted in support of its application for costs that by the date the appeal was abandoned it had commenced preparations for the case, including making enquiries as to the availability of counsel and preparing draft instructions.
8. The Opponent resists an award of costs on the basis that following the filing of the Grounds of Appeal the parties entered into discussions with a view to resolving the dispute and that the appeal was abandoned in good time before the hearing date. It therefore submits that the Applicant cannot have incurred significant expense.
9. I consider that the Applicant acted reasonably in preparing to instruct counsel after the notification of the date set for the hearing. The settlement discussions had not resulted in an agreement between the parties and there must have been a real risk that they would not do so. In those circumstances the Applicant was entitled to proceed with reasonable preparations for the hearing and that

included preparing to instruct counsel. Costs have thereby been incurred by the Applicant in resisting the appeal and I consider it is entitled to some compensation. I have not, however, been provided with details of what those costs actually were.

10. I also have in mind the practice on appeal before the Appointed Person to have regard to the practice in the Registry of using published scale figures as a norm, to be adopted or departed from as the case may require. In the present case I also have regard to the fact that Mr James considered that £500 was a reasonable sum to award in respect of the proceedings before him, conducted as they were without an oral hearing.
11. In all these circumstances I have come to the conclusion that a proportionate sum to award to the Applicant in respect of the costs of the appeal is £200 and I therefore direct that the Opponent pay that sum to the Applicant on a like basis to that ordered by Mr James.

David Kitchin QC

17th January 2003.