

## O-144-04

IN THE MATTER OF INTERNATIONAL TRADE MARK REGISTRATIONS NOS.  
732788 AND 739779 IN THE NAME OF HENKEL KGAA AND REQUEST FOR  
PROTECTION THEREOF IN THE UNITED KINGDOM

AND IN THE MATTER OF OPPOSITION NOS. 70459 AND 70534 THERETO BY  
ROBERT McBRIDE LIMITED

---

### DECISION

---

1. On 23 March 2000 and 10 August 2000 respectively Henkel KGaA (“the applicant”) requested that International Trade Mark Registrations Nos. 732788 and 739779 each consisting of the shape of a washing/dishwashing tablet in Classes 1, 3 and 21 be protected in the United Kingdom. These requests were opposed by Robert McBride Ltd (“the opponent”). These two oppositions were consolidated with nine others and heard together with a further two separately consolidated oppositions. On 11 August 2003 Mr Reynolds acting for the Registrar issued two decisions upholding all thirteen oppositions. On 8 September 2003 the applicant filed appeals in respect of these two oppositions. The appeals were subsequently fixed for a hearing on 1 April 2004, but unfortunately had to be adjourned due to problems with my availability on that date. The appeals were then re-fixed for hearing on 14 May 2004. On 10 May 2004 the applicant withdrew the appeals. Subsequently the opponent applied for an award of costs. This is my decision in respect of that application.
2. The hearing officer awarded the opponent the sum of £5,500 in respect of the costs of the eleven consolidated oppositions of which these were two, that is to say, a figure of £550 per opposition. In arriving at that decision the hearing officer took into account the factors that the similarity of issues between the cases was such that all thirteen oppositions were dealt with by a single set of

submissions at the hearing but nevertheless the opponent had had to go to the expense of filing separate oppositions and evidence in all the cases, albeit that the evidence was very similar and economies of scale had been achieved.

3. The opponent seeks the sum of £750 to cover both appeals. In support of this request the opponent's attorneys state that they have incurred costs in respect of (i) reviewing the notices of appeal, (ii) advising the applicant on the merits of the appeal, (iii) advising the opponent on the question of whether there should be a reference to the High Court, (iv) instructing counsel, (v) making arrangements for attendance at the hearing and adjourned hearing and (vi) considering the impact on the appeals of decisions of the European Court of Justice issued in May 2004. I have no doubt that such costs were incurred, and in my judgment they were reasonably incurred. Having regard to the lateness of the withdrawal of the appeal, I consider that the figure of £750 requested is reasonable and proportionate.
  
4. I therefore direct that the applicant pay the opponent the sum of £750 as a contribution to the opponent's costs of the two appeals within seven days.

21 May 2004

RICHARD ARNOLD QC

W.P. Thompson & Co acted for the applicant.

Marks & Clerk acted for the opponent.