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TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2410745A
BY THE ENGLAND TEAM LIMITED LTD TO REGISTER A
TRADE MARK IN CLASSES 14, 16, 18, 25 & 28**

AND

**IN THE MATTER OF OPPOSITION
THERE TO UNDER NO. 94455A BY GROTTO SPA**

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**IN THE MATTER OF Application No. 2410745A
by The England Team Limited to register a
trade mark in Classes 14, 16, 18, 25 & 28**

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**IN THE MATTER OF Opposition thereto
under No. 94455A by Grotto SPA**

BACKGROUND

1. On 11 January 2006, The England Team Limited (which I will refer to as England) applied to register the following as a series of four trade marks:



Following examination, the application (No. 2410745) was accepted and published in Trade Marks Journal No. 6631 on 5 May 2006 for a range of goods in Classes 14, 16, 18, 21, 24, 25, 26, 28 & 30.

2. On 30 June 2006, Grotto S.p.A (which I will refer to as Grotto) filed a notice of opposition. There is only one ground of opposition which is based on Section 5(2)(b) of the Act and which is directed only at the following goods in England's application for registration:

Class 14: Jewellery and watches.

Class 16: Paper; cardboard and goods made from these materials, not included in other classes, printed matter; books; comics and comic magazines, stories in illustrated form; books, children's books, activity books, colouring books, sticker books; stickers; bumper stickers; posters; trading cards; collector cards; collector albums; playing cards; art supplies, namely crayons, markers, magazines and newsletter, stickers and transfers; photographs; stationery; greetings cards; calendars; writing materials and writing materials and writing instruments; pens, pencils, pen holders, pencil cases, pencil sharpeners and erasers; artists' materials; instructional and teaching materials, pre-printed sheets or posters for colouring or painting; slates; chalk and chalkboards; decals and heat transfers; school supplies, namely pens, pencils, erasers, pencil cases, pencil sharpeners, scissors, rulers, staplers, paperweights, notebooks, folders, ring binders, spiral

notepads, envelopes, note cards, book covers and bookmarks; door knob hangers; stationery, writing paper, envelopes, note cards, postcards, notepads, memo pads; appointment books; printed patterns for costumes; paper party goods namely gift wrapping paper, paper doilies, crepe paper, paper invitations, paper cake decorations, paper napkins, paper placemats, paper party hats, paper centrepieces and paper tablecloths.

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; umbrellas and parasols, handbags, rucksacks, purses and wallets, wallets, key cases, gym bags, school bags, book bags, tote bags, backpacks, knapsacks, shoe bags, sports bags, duffel bags, laundry bags; luggage and carry-alls, bath bags; beach bags; belt bags; boot bags; shoulder bags; shopping bags; towelling bags; toilet bags; toiletry bags; suit carriers being travelling bags; waist bags; wash bags; weekend bags; work bags.

Class 25: Clothing, footwear and headgear, T-shirts, sweatshirts, shirts, pyjamas, tank tops, sweaters, jerseys, turtlenecks, golf shirts, shorts, sweatpants, warm-up suits, snow suits, slacks, sleepwear, robes, underwear, boxer shorts, hats, wool hats, visors, scarves, headbands, ear muffs, wristbands, cloth bibs, ties, socks, overalls, vests, jackets, coats, parkas, ponchos, swimwear, rainwear, hosiery, shoes, boots, sneakers, beach shoes, sandals, slippers, gloves, suspenders, belts, Halloween and masquerade costumes.

Class 28: Games and playthings and sporting articles; toys; playing cards; toy guns; boomerangs, flying discs or rings, decorations for Christmas, electronic hand-held games and hand-held computer games equipment which is self contained (not adapted for use with external display screens or monitors), non-working novelty watches and other novelty products, bendable figurines, toy action figures and accessories, toy vehicles, role playing games and action play sets (sold as a unit for creative play activities), toy environments for use with action figures; plush dolls, soft sculpture dolls, bendable figurines, puppets; balloons, water play toys, inflatable toys; target games; chess games, board games, puzzles, kites, rack toys, toy weapons, toy calculators, model kits, craft and activity sets, gymnastic and sporting articles namely balls, sports balls, inflatable swimming pools for recreational use; roller skates, in-line skates, skateboards elbow pads, knee pads; jump ropes; snow sleds for recreational use; surf fins; swim fins; surfboards; swim boards for recreational use; mats for playing a trading card collectable game; fake tattoos; radio control cars; bean bags and bean bags in shapes, Christmas tree ornament, children's toy bikes.

3. On 15 August 2006 England filed a Form TM12 to request the division of the application. This was actioned by the Trade Marks Registry (hereafter TMR) and the opposed classes were allocated to No. 2410745A (Opposition No. 94455A). The B element of the application which relates to classes 21, 24, 26 and 30 has proceeded to registration.

4. Grotto are the owners of the following trade marks:

CTM No: 2867463



Applied for: 23 September 2002

In respect of goods and services in Classes: 3, 9, 14, 16, 18, 25, 28, 32, 35, 41, 42, 43 and 45, but which is relied on only in relation to the following goods:

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; jewellery, goldware.

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; notebooks, pens, periodicals, magazines, books.

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class 25: Clothing, shoes, headgear; coats, overcoats, blousons, greatcoats, pants, jeans, jackets, shirts, skirts, hosiery, tailored jackets, tracks, sweatshirts, stockings, socks, neckties, hats, berets, headscarves, footwear, boots, slippers.

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

CTM No. 306050



Applied for: 8 July 1996 (International Priority claimed from 29 January 1996)

Registered: 10 August 2001

In respect of goods in Classes 3, 9, 14 and 25, but which is relied on only in relation to the following goods:

Class 14: Jewellery; gold ware; clocks and watches.

Class 25: Trousers, jackets, jeans, shirts, skirts, heavy jackets, sports jerseys, sweaters, tailored jackets, stockings, socks, footwear, boots, slippers.

CTM No. 654624



Applied for: 10 October 1997 (International Priority claimed from 9 September 1997).

Registered: 6 April 1999

In respect of goods in Classes 16, 18 and 32, but which is relied on only in relation to the following goods:

Class 16: Paper, writing or drawing books; instructional material; periodicals, magazines; paint brushes; pens; books.

Class 18: Bags, travelling bags; umbrellas.

5. In their statement of case, Grotto put their case in the following terms:

“5. ..that when used in connection with the [opposed goods], the word element of the marks of the application in suit is non-distinctive. Those goods are of the type which are regularly branded with a sport’s team’s name or logo and sold to supporters of that team as merchandise. There is nothing about the word element of the marks of the application in suit which would differentiate them in the mind of the consumer from the many different types of branded merchandise which have been sold to fans of England sporting teams for many years.

6. The dominant element of the marks of the application in suit is the tick device. A highly similar tick device has been used by the Opponent for many years and has become recognisable by the public as the Opponent’s trade mark.

7. As a result of this extensive use, the tick device, which is an integral and striking element in the marks of the Opponent's application and registrations, has attained a high degree of distinctiveness.

8. As the only distinctive element of the marks of the application in suit is highly similar to the mark of the Opponent's application and registrations, it is clear that when faced with [the opposed goods] which are branded (sic) the Applicant's marks, the consumer would assume that those goods originate from the Opponent. It can therefore be acknowledged that there is similarity between the marks of the application in suit and the marks of the Opponent's application and registrations such that there is a likelihood that the public will be confused into believing that the goods provided under the mark of the application in suit originate from the Opponent, this likelihood of confusion including a likelihood of association."

Having made a comparison between the goods contained in their trade marks and the opposed goods indicated above, and having concluded that the respective parties' goods are either identical or similar, Grotto say that:

"14....because of the similarity of the marks of the application in suit and the marks of the Opponent's application and registrations as detailed above and the identical nature or similarity of the goods of the application in suit and those of the Opponent's application and registrations, there exists a likelihood of confusion, including a likelihood of association such that the application in suit should be refused."

6. On 9 October 2006, England filed a counterstatement in which they comment as follows:

"We do not accept that there is a realistic chance of any confusion between our proposed mark and the mark of the opponent. We also believe that there is no realistic possibility of any potential confusion between the marks. Both we and the opponent currently have marks which co-exist in UK classes 09 and 41 and previous examiners must have believed that these marks were distinctively different in order that our mark in these two classes could proceed to registration. We also note that the opponent did not oppose our mark in these earlier classes nor do they challenge them now.

Briefly, the opponents mark use prominent block text within a thick wave (sic) style device of constant colour without shading or gradation. Our mark uses text of a different font outside and to the right of a half cross device which employs shading and gradation and simultaneously represents a "V" for victory and a cross section of the England flag in motion. The opponent's mark is fundamentally the word "GAS" super imposed on a background shape of block colour evoking a commercial corporate image whilst ours is symbolic of national pride and is designed to convey very different feelings and information to that of the opponents mark.

Furthermore, our mark is clearly of different style, dimension and creative concept. The words "The England Team" are so prominent and meaningful in every day language that

when supported by the device no one could seriously confuse the opponent's mark with ours. The opponent's objection is groundless and should be dismissed.

We believe that the opposition is so clearly flawed that an order to costs me (sic) awarded in our favour."

7. Only Grotto filed evidence; both sides seek an award of costs in their favour. A hearing was held on 31 October 2007 at which England was represented by its Managing Director, Mr Haydn Price. Grotto were not represented at the hearing but filed written submissions in lieu of attendance, which I shall take into account when reaching a decision.

EVIDENCE

Grotto's evidence

8. This consists of a witness statement, dated 5 March 2007, by Gillian Smaggasgale. Ms Smaggasgale is a Trade Mark and Patent Attorney and a Partner in the firm of W. P. Thompson & Co (hereafter WPT) who are Grotto's professional representatives in these proceedings. She confirms that she is authorised to speak on Grotto's behalf, adding that she makes her statement on the basis of information known to her and from personal experience.

9. For the most part Ms Smaggasgale's witness statement consists of submissions on the respective parties' trade marks and goods, and the case law relating to Section 5(2) of the Act; while it is not necessary for me to summarise these submissions here, I will of course bear them in mind when reaching a decision. I do note exhibits GHS-1 and GHS-2 to her witness statement, which consist of a letter (dated 30 November 2006) and an e-mail (dated 17 January 2007) sent by Ms Smaggasgale to England in an attempt to settle these proceedings amicably. I am asked to bear these documents in mind when determining the issue of costs.

DECISION

10. The sole ground of opposition is based on section 5(2)(b) of the Act. This reads:

"5.-(2) A trade mark shall not be registered if because -

(a)

(b) it is similar to an earlier mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

An earlier right is defined in section 6 of the Act, the relevant parts of which state:

"6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

11. In these proceedings Grotto is relying on three trade marks. These trade marks have application dates of: 8 July 1996 (with priority claimed from 29 January 1996), 10 October 1997 (with priority claimed from 9 September 1997) and 23 September 2002, all of which are prior to 11 January 2006 which is the filing date of the application in suit; I note that CTM No. 2867463 is still shown on the Trade Marks Registry database as a new application i.e. it is not yet registered. All three are “earlier trade marks” as defined by Section 6(1) of the Act..

12. In reaching a decision I take into account the well established guidance provided by the European Court of Justice (ECJ) in: *Sabel BV v. Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723.

It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and circumspect and observant – but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG + Adidas Benelux BV*, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

The average consumer and the nature of the purchasing decision

13. The vast majority of the opposed goods in classes 14, 16, 18, 25 and 28 are, in my view, likely to be bought by members of the general public. All of these goods are, in my view, most likely to be bought by self selection either from a shelf, from a catalogue or on-line, and as a result, it is the visual and conceptual characteristics of the respective trade marks that are likely to be the most important. However, I do not rule out that telephone ordering, oral requests for the goods (particularly in relation to the sale of the class 14 goods in a retail setting) or that oral recommendations may play a part in the selection process. The value of the various goods that are opposed may vary considerably from, for example, expensive watches or jewellery in class 14 to inexpensive pencil sharpeners and erasers in class 16.

14. Given the nature of the goods particularly in classes 14, 18 and 25 which are for wear or for personal use, it is likely, in my view, that the average consumer will pay a reasonable degree of attention to the goods and their trade marks. The cost of goods in class 16 can vary; some may be low value items which would not be bought with a great deal of care and consideration. The less consideration and care taken in the purchasing process the greater the opportunity for confusion to arise. Similarly some of the goods in class 28 may be expensive and bought with a good deal of care and consideration, for example, golf clubs. Other goods for example Christmas decorations, may be relatively inexpensive and the purchasing process for these goods would not be such a considered one.

Comparison of goods

15. At the hearing, Mr Price accepted that the goods contained in Grotto's earlier trade marks were for the most part the same or similar to the goods of his application.

Comparison of trade marks

16. It is well established that the average consumer is considered to be someone who is reasonably well informed, circumspect and observant, who perceives trade marks as a whole and does not pause to analyse their various details; in addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of

them he/she has kept in his or her mind. I have also to bear in mind the distinctive and dominant components of the respective trade marks.

17. In their statement of case (see paragraph 5 above) and in their written submissions, Grotto argue that, given the nature of the words appearing in the trade marks in the application, the distinctive and dominant element of these trade marks is what they describe as a tick device. In their counterstatement and at the hearing, England argue that this is not how the device element present in their trade marks should be viewed. At the hearing Mr Price said:

“...So I think my point is that throughout this opposition they keep saying that our mark is a tick, our mark is a V for victory, that is representative of a flag flying in the wind, which then makes the shape of a V for victory” (Transcript page 21, line F).

18. In their written submissions Grotto comment that this explanation of England’s trade marks is not understood or accepted by them. At the hearing Mr Price explained that when animated England’s trade marks would take on the appearance mentioned above. However, England have not applied for a mark or series of marks incorporating movement, so it is on the basis of the marks as applied for i.e. as a combination of words and (a static) device that I must compare the respective trade marks.

19. At the hearing Mr Price pointed out that in addition to a device element, Grotto’s earlier trade marks contain either the word GAS or the words BLUE JEANS GAS. He added that the trade marks presented in red were even less similar to Grotto’s trade marks than those presented in black and white; he also argued that the words present in the trade marks should not be discounted as Grotto suggest. While Mr Price was prepared to accept that England’s trade marks presented in black and white offered Grotto the best prospect of success in these proceedings, he argued strongly that given the various differences mentioned above, the respective trade marks were still completely dissimilar.

20. Grotto’s earlier trade marks all contain the same device element accompanied by the word GAS in CTM No. 2867463 and the words BLUE JEANS GAS in CTM Nos: 306050 and 654624. GAS is neither descriptive nor allusive to the goods in classes 14, 18, 25 and 28 on which Grotto are relying for the purpose of this opposition. The word GAS may well have a descriptive meaning in relation to, for example, printed matter in Class 16, but not I think in relation to other goods in that class such as paint brushes, typewriters and pens.

21. The words BLUE JEANS are so well known as to require no further explanation; in relation to the majority of the articles of clothing appearing in the Class 25 element of CTM No. 306050 the words would have a descriptive meaning. The same cannot be said in relation to the remaining goods in class 14 or indeed the goods in class 18 of CTM No. 654624, although I accept that the words alone may have a descriptive meaning in the context of, for example, periodicals appearing in the class 16 element of that registration.

22. In the context in which it appears in Grotto’s trade marks, the device element serves, in my view, very much as a background on which Grotto’s word trade marks are presented, and is

unlikely in my view to be taken as a dominant element. If the device element has distinctiveness in its own right, then this distinctiveness is, in my view, very limited.

23. Stemming from these findings, I have concluded that the distinctive and dominant elements of Grotto's trade marks are as follows: in relation to CTM 2867463, the distinctive and dominant component is (in relation to goods in classes 14, 18, 25 and 28) the word GAS as it is in relation to some of the goods in class 16 but not others. While the device element may be a distinctive component, it is subsumed by the other element in the trade mark. In relation to CTM No. 306050, the words BLUE JEANS and GAS are both distinctive and dominant components in relation to the goods in Class 14 as is the word GAS in relation to goods in class 25. The words BLUE JEANS are not in my view a distinctive or dominant feature of the trade mark in relation to the goods in class 25; my view of the device element present in the trade mark is the same as that above. Finally, in relation to CTM No.654624, the words BLUE JEANS and GAS are both in my view distinctive and dominant components in relation to goods in class 18 as they are in relation to some but not all of the goods in class 16. My view of the device element remains the same.

24. Having identified what I consider to be the distinctive and dominant components of Grotto's trade marks, it is now appropriate for me to consider the respective parties' trade marks from the visual, oral and conceptual standpoints mentioned in the case law.

Visual similarity

25. In their statement of case and written submissions Grotto argue that the words THE ENGLAND TEAM lack distinctive character in relation to merchandise available to fans of England's sporting teams and as such would be overlooked by the average consumer; they have however provided no evidence to support this contention. If they are correct, the highpoint of their case is that the device element appearing in England's trade marks is similar to the device element appearing in their own trade marks. However, this analysis ignores the fact that their trade marks also contain either the word GAS or the words BLUE JEANS GAS in addition to that device element, and in a context where for the most part the words GAS and BLUE JEANS GAS would, in my view, be considered by the average consumer to be the distinctive and dominant components. There is no evidence that the average consumer would perceive the respective parties device elements as tick devices. However, were the average consumer to consider both device elements to be representations of ticks, given the presence in Grotto's trade marks of the word elements combined with the manner in which the device element appears in those trade marks, there is, in my view, at best only a very minimal degree of visual similarity between the respective trade marks. In reaching this conclusion I have not found it necessary to differentiate between the various trade marks present in the application: the colour element present in two of the trade marks does not in my view, and with respect to Mr Price's submissions at the hearing, affect the position.

Oral similarity

26. Once again assuming Grotto are correct and the words THE ENGLAND TEAM would be ignored, Grotto's trade marks would in my view be referred to as GAS or BLUE JEANS GAS

trade marks. Given the nature and positioning of the device element in Grotto's trade marks, I see no reason why the average consumer would attempt to articulate it. Consequently there is, in my view, no oral similarity between the respective trade marks.

Conceptual similarity

27. The word elements in the respective trade marks convey quite different conceptual messages. However, if Grotto are correct in relation to the distinctiveness of the words THE ENGLAND TEAM and the words were to be ignored by the average consumer, their trade marks would still (given the nature and positioning of the device element) in my view be referred to and remembered as GAS and BLUE JEAN GAS. These words have well known meanings and as a result there is in my view no conceptual similarity between the respective trade marks.

28. In summary, I have concluded that the respective parties' trade marks share only a very minimal degree of visual similarity, and that there is no oral or conceptual similarity.

Likelihood of confusion

29. When determining whether there is a likelihood of confusion a number of factors need to be considered. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the goods and vice versa. In these proceedings I have concluded that the opposed goods in England's application are the same or similar to those contained in Grotto's earlier trade marks, but that the respective parties' trade marks share only a very minimal degree of visual similarity and no oral or conceptual similarity. It is also necessary for me to consider the distinctive character of the earlier trade marks as the more distinctive the earlier trade marks (either inherently or as a result of any use that has been made of them) the greater the likelihood of confusion. The distinctive character of the earlier trade marks must be appraised by reference to the goods in respect of which registration is sought and also by reference to the way it will be perceived by the average consumer. Grotto have not provided any evidence in these proceedings as to what use, if any, they might have made of their earlier trade marks in the UK; I have therefore only the inherent characteristics of the trade marks to consider. My views on the distinctive character of Grotto's earlier trade marks are at paragraphs 20 to 22 above. Other than for those goods in class 16 in which the words GAS or BLUE JEANS may be given a descriptive significance, Grotto's trade marks, whilst not in the category of an invented word or words, are nonetheless in my view trade marks deserving of a good degree of protection. However, the distinctive elements present in Grotto's trade marks are alien to England's trade marks, and cannot as a result assist them.

30. Bearing all these factors in mind, in my view, the significant differences between the respective parties' trade marks more than offsets the identity or similarity in the goods. Consequently, there is, in my view, no likelihood of either direct confusion i.e. that the trade marks will be mistaken for one another, or indirect confusion on the basis that the average consumer would think that goods sold under England's trade marks were from an undertaking that was economically linked to Grotto; the sole ground of opposition based on Section 5(2)(b) of the Act fails accordingly.

Costs

31. England have been successful and are entitled to a contribution towards their costs. In their written submissions, Grotto say in relation to costs:

“7. The observations in paragraphs 23 and 25 of the first Witness Statement of Gillian Helen Smaggasgale are maintained....”.

These paragraphs read:

“23. In the unlikely event that the Hearing Officer rejects this opposition, I believe that any order of costs made against the Opponent should be made from the scale set out in Tribunal Practice Notice (TPN 2/2000). Given that the Hearing Officer acknowledged that the respective goods are similar or identical and that there is a degree of similarity between the marks in question, it is apparent that this opposition is not spuriously raised and that there is a serious case to be decided.

25. As the Opponent has attempted to resolve this dispute amicably in order to avoid unnecessary expenditure, in the event that the opposition is rejected, it would be inequitable to award costs against them other than those identified on the scale mentioned above for expenses incurred by the applicant in proceeding with this opposition.”

32. Grotto’s written submissions continue:

“7. The Applicant has taken actions which have incurred expense, but which were not forced upon them by this opposition. In particular, we understand that the Applicants intend to seek costs as they have chosen to file a divisional application. However, this is a matter for the Applicants and is not something that should be taken into account when awarding cost orders.

8. It is OHIM’s practice not to award costs to a successful and unrepresented party other than to reimburse any official fees directly relating to the opposition. Thus a successful unrepresented opponent will receive a cost order amounting to the opposition fee and a successful unrepresented applicant receives no cost order. We submit that this practice should be followed in the unlikely event that this opposition is unsuccessful.

9. Further, and whatever the outcome of the opposition, we request our costs in the preparation of the written submissions which were redundant due to the Applicant’s extremely late request for a hearing.

10. In the unlikely event that the opposition is rejected, and the Hearing Officer decides that costs are payable to the Applicant, we submit that it would be inequitable to award costs against the Opponent other than those identified on the scale for expenses incurred by the Applicant in proceeding with the opposition.”

33. At the hearing Mr Price also addressed me on the issue of costs. Before I deal with his comments, some background is, I think, necessary. On 28 June 2007 the TMR wrote to the parties indicating that the evidential rounds were considered complete and asking them if they wanted to be heard or if they were content for a decision to be taken from the papers on file. Deadlines of 28 July and 9 August respectively were allowed. A copy of the letter sent to England at their address for service of 1 Victoria Square, Birmingham, B1 1BD was returned by the Royal Mail to the TMR on 10 July annotated "Return to sender not known at this address", "addressee has gone away". On 9 August, WPT wrote to the TMR indicating that they were content for a decision to be taken from the papers on file and at the same time provided their written submissions; their letter contained the following text: "Cc: The England Team Ltd". On 14 August, the TMR received an e-mail from Mr Price, the relevant part of which states:

"Further to our telephone conversation, I left for Dubai just over 2 months ago and prior to my departure prepared our response to the "Evidence" of the opposing party. We posted this to your office and presumed that you had received it. I am still abroad at present and have not seen any of your notices.

...We then asked that the matter be listed for a hearing in Newport.

...However, in our letter we asked that we would like the matter dealt with at a hearing rather than through correspondence.

Although the deadline seems to have past, I hope you will take the above circumstances into account and grant a hearing for this matter.

I am still abroad but can be contacted by email."

34. As requested by Mr Price, the TMR then corresponded with him by e-mail regarding a date for a hearing to be held. On 17 August, the TMR wrote to the parties by post (a copy also being sent by e-mail to Mr Price) indicating that a hearing would take place on 26 September. The letter indicated that the hearing would take place in London, via the video conferencing facility and that the Hearing Officer would be located in Newport. On 22 August, England's letter (sent to the address mentioned above) was returned by the Royal Mail to the TMR once again annotated "addressee has gone away".

35. On 28 August, WPT wrote to the TMR. I do not propose to reproduce their letter here in full but the most pertinent extracts are, in my view, as follows:

"...the Applicants have now requested a hearing and that the Registry propose to grant the request. We submit that to do so would be wholly inappropriate and an abuse of process.

The Applicant had sufficient time to request a hearing before the deadline. The fact that one of their members was abroad is not persuasive. In this day of modern communication, it is quite apparent that the person involved would have been in daily contact with their office.

In the circumstances, we believe that it would be appropriate for the Decision to be taken on the papers as this procedure is now in train. In the event that the Registry do not believe that this is appropriate, we request that a decision on this point be issued so that it can be the subject of an appeal.”

36. On 3 September, the TMR wrote to the parties. In an e-mail to Mr Price, the official letter notes that: (i) Rule 10 of the Trade Marks Rules 2000 (as amended) requires the applicant to have an address for service in the United Kingdom, the European Economic Area (EEA) or the Channel Islands, (ii) that mail sent to the 1 Victoria Square address in Birmingham has been returned by the Royal Mail on the basis that the addressee had gone away, (iii) that an address at Wentworth Road had not been recorded as the official address for service as no request to this effect had been received, (iv) that as indicated above the Rules require an address for service and a period of two months was allowed for such an address to be supplied, failing which the application would be treated as abandoned, and (v) the hearing scheduled for 26 September was postponed.

37. On 3 September, a Form TM33 was filed by England to change their address for service to 37 Wentworth Road, Birmingham, B17 9SN with WPT advised of the change in an official letter dated 5 September. In a letter dated 6 September, the parties were advised that the TMR’s Preliminary View was that England’s request to be heard should be allowed and a period expiring on 20 September was allowed for this view to be challenged.

38. In the event WPT did not challenge the Preliminary View. On 21 September, the TMR wrote to the parties and the case was re-listed to be heard on 31 October; the arrangements were the same as those for the original hearing. On 5 October, WPT wrote to the TMR. The contents of their letter, which I again note contains the text: “Cc: The England Team Ltd” reads as follows:

“We refer to the official letter of 21 September 2007. The opponent will not be represented at the forthcoming hearing. Written submissions will follow at least two working days prior to the Hearing.”

39. Written submissions from WPT dated 26 October and received by the TMR on that date, once again contained references to the effect that they were not attending the hearing and that the document had been copied to England.

40. At the hearing Mr Price explained to me how from his perspective he felt Grotto had conducted these proceedings. It is not necessary for me to record all of his submissions here but I think it fair to say that he felt that Grotto (or more accurately perhaps WPT) had made things much more difficult for him than perhaps needed to be the case. He confirmed that he was seeking an award of costs in respect of the divisional application he filed and made it quite clear that had he known that WPT were not attending the hearing, he would have sought to conduct the hearing from Dubai either by telephone or video conference.

41. In the light of those background facts and with the comments of the parties in mind, I now turn to determine the issue of costs in the context of: (i) England’s request for costs in respect of

the filing of a divisional application, (ii) Grotto's request for costs in respect of what they describe as their "redundant" written submissions, and (iii) England's further request for costs in respect of the manner in which Grotto (or WPT) had conducted the proceedings, particularly in light of WPT not sending Mr Price (by e-mail) a copy of their letter of 5 October and written submissions of 26 October, and the consequences of these omissions on his attendance in person at the hearing held on 31 October and the costs he had incurred as a result.

42. From the above, it is clear that the official letter of 28 June 2007 which asked the parties to indicate whether they wished to be heard or were content for a decision to be taken from the papers on file was never received by England (the letter being returned by the Royal Mail to the TMR). On 9 August, WPT indicated that they were content for a decision to be taken from the papers on file and provided written submissions. The e-mail from Mr Price of 14 August indicated that documentation had been sent by England to the TMR which had included a request that a hearing be appointed. The TMR then liaised with Mr Price by post and e-mail and in the official letter of 17 August a hearing date of 26 September was appointed (the copy of the letter sent to England by post was also returned by the Royal Mail to the TMR). On 28 August, WPT objected to a hearing being appointed and asked for a decision on the matter so that it could be appealed. On 3 September the TMR asked Mr Price to file a valid address for service. A Form TM33 indicating the change to the Wentworth Road address was filed on the same day and WPT were advised of the change in an official letter dated 5 September. On 6 September the TMR issued a Preliminary View indicating that England's request to be heard should be granted; a period expiring on 20 September was allowed for this view to be challenged. It was not, and on 21 September the TMR wrote to the parties indicating that the hearing would now be held on 31 October. On 5 October WPT wrote to the TMR (and copied the letter to England) indicating that they were not attending the hearing. Their written submissions dated 26 October were also copied to England.

43. Turning first to England's filing of the divisional application. In their written submissions, Grotto say that the filing of a divisional application is a matter for England and should not be taken into account when costs are determined. As I intimated to Mr Price at the hearing, I agree with Grotto in this regard. Whilst at the hearing Mr Price explained that WPT had not been as helpful as he would have liked when the issue of the divisional application was discussed with them, the decision to divide the application was one that rested solely with England. Given that Grotto had not opposed the goods in classes 21, 24, 26 and 30, England could have simply maintained the application in its original form and if they were unsuccessful at the conclusion of the proceedings deleted the offending classes; had they adopted such an approach no additional costs would have been incurred. In the event they wanted the unopposed classes to proceed to registration in a speedy manner; that was a decision they were entitled to take, but the consequences of that decision and any costs incurred as a result, is not something for which Grotto should be held responsible.

44. Secondly, I have Grotto's request that, given England's belated request to be heard, they be awarded costs in respect of their "redundant" written submissions. I have compared the written submissions filed by WPT on 9 August (in relation to a decision being taken from the papers on file) with those filed on 26 October (in lieu of attendance at the hearing) and note that they are virtually identical. Consequently, rather than being rendered redundant as Grotto argue, their

original written submissions did in fact form the substantial part of their later submissions; in the circumstances, I see no reason to make any adjustment in the award to England in this respect.

45. Finally, I have England's further request for costs for, in effect, the manner in which Grotto (or WPT) had conducted the proceedings, particularly in relation to the non-copying of correspondence by WPT by e-mail to Mr Price and the consequences this had on his conduct of the substantive hearing. At the hearing Mr Price commented that WPT's letter of 5 October and their written submissions of 26 October had not been received by him, adding that had he known that Grotto were not to be represented at the hearing he would have stayed in Dubai and conducted the hearing by telephone or video conference. At the hearing he said:

Mr Price: "Yes. Because they clearly knew that I was in Dubai. I have been there for five odd months. And they knew that they should e-mail any correspondence, that there was no point sending it by post, and that I wouldn't get it. And they have had perfect and ample opportunity to email me this. They have e-mailed me other stuff over the past month." (Transcript page 50, line G).

46. The following exchange took place in relation to England's address for service:

"Hearing Officer: So this would have been sent to your address for service, but there were no arrangements in place at your address for service for this to be forwarded on to you? (Transcript page 52, line C).

Mr Price: No

Hearing Officer: Nothing at all?

Mr Price: No

Hearing Officer: Is that wise?

Mr Price: That is not a matter for discussion, if you think it's wise or not. It's the reality."

47. It is well established (see for example the decision of the Appointed Person in *Ms. Alison June Coggins v Skjelland Group AS* (BL O-340-04)), that when correspondence is sent by one party to another, the sending of that correspondence to the appropriate address for service is sufficient. Whilst I do not doubt for one moment that WPT were prepared to correspond with Mr Price by e-mail, the simple fact is they were not required to. On 5 September, WPT were notified by the TMR of the change of England's address for service. Their letter of 5 October (indicating that they were not attending the hearing) and written submissions of 26 October (once again indicating that they were not attending the hearing) were both marked as "Cc The England Team Ltd". Given that WPT had been notified of England's new address for service some one month earlier, it is in my view reasonable to infer that these letters were sent to England at the Wentworth Road address; there is certainly no evidence to the contrary.

48. Notwithstanding Mr Price's submissions to the contrary, WPT were not required to correspond with Mr Price by e-mail; they did so I assume as a matter of courtesy. As the exchange at the hearing reproduced above indicates, the fact that Mr Price was not aware of the letters sent to his address for service at Wentworth Road was because he had no arrangements in place for correspondence sent there to be forwarded to him in his absence; he asked to be heard and arrangements for the hearing were then put in place. Had Mr Price made arrangements for documents to be forwarded to him, he would have known in good time (early October at the latest) that Grotto were not going to be represented at the hearing. This would have given him ample time to take a view on whether he still wanted to attend the hearing in person, or as he suggested at the hearing, to make his submissions by telephone or video conference. The fact that he was not in a position to do this, is I am afraid of his own making, and is not a factor which in my view I ought to take into account in determining costs.

49. In the event I am left (as WPT suggest) to decide the matter on the basis of the scale of costs outlined in Tribunal Practice Notice 2 of 2000 (and not on the basis of the practice at OHIM on which they also comment). Ordinarily, I would have ordered Grotto to pay England the sum of £1200. This sum would be made up of the following elements: £200 for considering the Notice of Opposition, £300 in respect of the Statement of Case in reply, £200 for considering Grotto's evidence and £500 in respect of England's preparation for and attendance at the hearing. However, in *Adrenalin Trade Mark*, BL O/040/02, Simon Thorley QC, sitting as the appointed person, observed that:

“8 It is correct to point out that the Registrar's practice on costs does not specifically relate to litigants in person but in my judgment it could not be that a litigant in person before the Trade Mark Registry could be placed in any more favourable position than a litigant in person before the High Court as governed by the CPR. The correct approach to making an award of costs in the case of a litigant in person is considered in CPR Part 48.6.”

Part 48.6 of the Civil Procedure Rules referred to in the above passage provides as follows:

“48.6-(1) This Rule applies where the court orders (whether by summary assessment or detailed assessment) that costs of a litigant in person are to be paid by any other person.

(2) The costs allowed under this Rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative.”

50. In line with this guidance, and as England have not been professionally represented in these proceedings, I order Grotto to pay to England the sum of £800. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of December 2007

**C J BOWEN
For the Registrar
The Comptroller-General**