

O-139-09

TRADE MARKS ACT 1994

**SUPPLEMENTARY DECISION (COSTS)
IN THE MATTER OF APPLICATION NO 2430056
BY DWELL RETAIL LIMITED
TO REGISTER THE TRADE MARK:**

DWELL

IN CLASSES 2, 4, 8, 9, 14, 16, 18, 20, 21, 25, 27, 28, 31, 39, 41, 42, 43

AND

**IN THE MATTER OF OPPOSITION NO 95271
BY DWELL LLC**

TRADE MARKS ACT 1994

SUPPLEMENTARY DECISION (COSTS) IN THE MATTER OF Application No 2430056 By Dwell Retail Limited

to register a trade mark in classes 2, 4, 8, 9, 14, 16, 18, 20, 21, 25, 27, 28, 31, 39, 41, 42 & 43

and

IN THE MATTER OF Opposition No 95271 By Dwell LLC

1. On 17 March 2009 I issued a decision in relation to the above proceedings. I held that the opposition by Dwell LLC ("*LLC*") to the registration of Dwell Retail Limited's ("*Retail*") trade mark application was partially successful. I summarised the outcome thus:

"Summary

91. To summarise my findings, the opposition succeeds in relation to:

Class 9: Electronic publications; publications in electronic form supplied on-line from a database or from facilities provided on the Internet or other network (including web-sites).

Class 16: Printed matter and printed publications; magazines and journals; books, periodicals, booklets.

92. But fails in relation to:

Class 16: Advertising and promotional materials; school stationery

Class 41: Publishing services; electronic publishing; production of sound and video recordings; training and teaching services; information and advisory services relating to any of the above.

Class 42: Design services; industrial design services, consumer product design services; interior design services; packaging design; planning and design of offices; graphic design services; the design of books, newspapers, magazines, catalogues, brochures, publications, printed matter and publicity and advertising material; advisory, consultancy and information services relating to all the aforesaid."

2. In relation to costs I stated:

"Costs

93. Counsel requested an opportunity to make written submissions on costs. Although this struck me as a little unusual, I agreed to do so as there were

clearly things going on behind the scenes to which I am not party. To assist the parties, I indicate that based on the measure of success that has been achieved by both parties, my inclination would be to make no award of costs. However, I will make a decision on the matter after receiving written submissions. One month from the date of this decision is allowed for receipt of written submissions on this point, and this point alone.”

3. Both parties have now filed its written submissions. In summary, *LLC* argue that the case was fought and won (won from its point of view) on the issue of magazines and publications and that the other goods and services were merely peripheral and contributed little by way of time (and money) expended by either party. *Retail*, on the other hand, argue that they were proportionately more successful and note that *LLC*'s claim was too wide.

4. I have taken the above submissions into account, but they do not disturb my initial view that neither party should be favoured with an award of costs. The outcome was reasonably equal and although some of the goods and services on which the opposition failed were clearly peripheral (e.g. school stationery) others were not so peripheral (e.g. design services). In any event, the fact remains that *LLC* cast its opposition more widely than it was able to justify.

5. The appeal period in relation to the substantive decision (which I initially suspended) will run in parallel with the appeal period in relation to this supplementary decision on costs.

Dated this 20th day of May 2009

**Oliver Morris
For the Registrar
The Comptroller-General**