

O-273-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2443186
BY SANTEAU LIMITED TO REGISTER A
TRADE MARK IN CLASS 32**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 95309 BY O2 HOLDINGS LIMITED**

BACKGROUND

1. On 17 October 2008, I issued a provisional decision (No. O/286/08) in relation to this opposition. In paragraph 44 of my decision I said:

“44. O2 have been successful but I cannot give a final decision in these proceedings until such time as O2’s application is finally determined. I therefore direct that O2 advise me within one month of the final determination of CTM application No. 4423745 of the outcome of that application. On receipt of this information I will issue a supplementary decision giving a full determination of the opposition proceedings and making an award of costs.”

2. On 12 June 2009, the applicant’s representatives Walker Morris, wrote to the Trade Marks Registry (TMR). They did so in the following terms:

“Application Number 2443186 is hereby withdrawn.”

3. On 23 June 2009, the TMR asked the opponent’s representatives, at that time Boulton Wade Tennant, if they wished to comment on the above letter.

4. On 30 June 2009, Boulton Wade Tennant wrote to the TMR. Their letter contained the following sentence:

“We also look forward to the Hearing Officer’s decision in relation to the Award of Costs in the interim decision, in which the Opponent was successful.”

5. In a letter dated 24 July 2009, Walker Morris said:

“Whilst the interim decision in this case did go in favour of the Opponent, the decision was dependant on the final determination of the Opponent’s CTM application No. 4423745 which, to our knowledge, is still pending and subject to opposition proceedings.

The Applicant’s decision to withdraw its application No. 2443186 was made on commercial grounds and should not be regarded as an admission that the Opponent’s case was well founded.

In the circumstances we think it appropriate that each party should bear its own costs but we reserve the right to make further submissions if the Registrar decides to make an award.”

6. On 11 August 2009, the opponent’s new representatives, ipulse, responded to this letter in the following terms:

“We note that the decision to withdraw this application has been taken for commercial reasons. We would simply point out that this is irrelevant to the

determination of costs award in contentious proceedings. The Opponent was forced to go to considerable expense to oppose this application (and others owned by this party), and the application has now been withdrawn. The opposition has therefore been successful.

We are not asking for an exceptional award, but we feel that an award of costs on the scale would be appropriate in this case.”

Decision

7. Having considered the parties' comments, it is the opponent's position that is to be preferred. Although the fate of their earlier right is still to be determined, their opposition under section 5(2)(b) of the Act was successful albeit provisionally so. I have little doubt that this success was a significant factor in the applicant's decision to withdraw their application rather than await the final determination of the earlier right. In simple terms, the opponent achieved their goal; the applicant did not. In those circumstances, I think an award of costs to the opponent is appropriate.

8. At the hearing Ms Thomas-Peter commented on what she considered to be the “stock” nature of the opponent's evidence and she queried the need for evidence to be filed from other jurisdictions. In response, Mr Stobbs commented that given the nature of the grounds pleaded and the variations in the trade marks relied upon, all of the opponent's evidence was, in his view, relevant. Other than these comments, at the hearing the parties agreed that costs should follow the event and be from the Trade Marks Registry's published scale. Taking all matters into account, I award costs to the opponent on the following basis:

Notice of Opposition and accompanying statement: £300

Statutory fee: £200

Considering statement of case in reply: £200

Preparing and filing evidence: £500

Preparation for and attendance at the hearing: £500

Total £1,700

9. I order Santeau Limited to pay to O2 Holdings Limited the sum of £1,700. This sum is 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 8th day of September 2009

C J BOWEN

For the Registrar

The Comptroller-General