

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 2562512
BY AVON PRODUCTS INC. TO REGISTER THE TRADE MARK**

Pure O₂

**IN CLASS 3 AND
IN THE MATTER OF OPPOSITION
THERETO UNDER No. 101853 BY O2 HOLDINGS LIMITED**

SUPPLEMENTARY DECISION

- 1) On 21 May 2014 I issued decision O-220-14 which found in favour of O2 Holdings Limited. At the hearing it was agreed that the decision would be issued and that both parties would then have the opportunity to provide written submissions on costs in the light of my comments at the hearing regarding the conduct of the opponent in this case.
- 2) Both sides have provided comments. The opponent maintained that its conduct regarding the hearing was quite reasonable. It stated:

“ Whilst some of the earlier rights appear to give a stronger basis for opposition than others, as opposition proceedings often last some time in the UKIPO (often well over a year), and as the opponent is fighting a wide range of different trade mark cases, including cases that could impact on the scope of validity of its earlier rights, it takes the view that it needs to include this wide range of rights to ensure that it has a good range of rights to rely on when it comes to the hearing on this case.

It is true that the UKIPO requested on two occasions for a clearer identification of what goods and services the opponent deems to be similar to the coverage in the opposed application. The opponent takes the view that its pleadings were clear, and that it does not have to restrict its case by making such an identification. However, it did identify specific classes, and gave examples of the coverage in those classes that should be deemed similar to the coverage in the opposed application.

Whilst it is true that it did not restrict its coverage in the opposition within the classes in question, the opponent's submission is that this did not prejudice the applicant in any way, or at least in a significant way. In particular, the applicant's position throughout has been that it is blatantly clear that the vast majority of the classes covered by the opponent's earlier rights are not at all similar to any of the goods covered by the opposed application. If this is the case, and in relation to much of the coverage the opponent does not disagree, then no significant effort needs to be put, at least to the early stages of the case. The applicant can simply deny that there is any similarity in the goods and services in question and that the case move forward and see how the case unfolds. The applicant need not have

expended any real effort at this stage other than to deny the pleadings of the opponent.

When it came to written submissions filed by the applicant, the vast majority of these submissions relate to evidence points, and distinctive character relating to the opponent's mark. The majority of these submissions do not relate to this issue, and even if they do, need not go into any significant detail. In addition, the opponent points out that such written submissions are somewhat superfluous, and very much optional on the part of the applicant especially bearing in mind the fact that a hearing was likely. Indeed, at least in the opponent's experience it is unusual to file such written observations at that stage in the opposition, as it simply incurs costs for no real benefit to either party.

Overall, could the opponent have restricted its case to be more helpful to the Tribunal and to the applicant? Yes it could. However, it had decent tactical and strategic reasons not to, and the opponent's submission is that no real prejudice was caused to the applicant in the conduct of the case, or at least all they needed to do was simply to deny that there was any similarity in the goods and services covered by the majority of the opponent's marks."

3) I do not accept that there could ever be "decent tactical and strategic reasons" in pleading that certain goods and services were similar and maintaining this position (despite receiving two letters from the Registry asking for the pleadings to be clarified) when the opponent accepts that these same goods and services were blatantly not similar. It is precisely this action that led me to question whether the opponent's conduct was an abuse of process. It is for the opponent to state its case in its pleadings, not, as the applicant so succinctly put it in their submissions on cost, "herewith haystack, find your own needle".

4) The fact that concessions were made at the hearing, whilst welcome, does not mitigate for the work caused to the applicant, even if this was simply having to compare the specifications to realise that there was no likelihood of the Tribunal ever agreeing with the opponent's pleadings regarding similarity. It is the opponent's role to hone its pleadings to those where it can, at the very least, put forward an arguable case. If it cannot meet this very basic requirement then the goods or services in question should not be included in the pleading.

5) Turning to the evidence filed by the opponent. It was clear from the responses to my queries at the hearing that the evidence was "stock" evidence that was altered slightly to better reflect the position in the instant case. However, in altering the evidence much was left in, such as references to relevant dates, which bore no relation to anything within the instant case. Similarly, when the evidence was prepared it should have been obvious to the opponent that it did not show proof of use of two of the earlier marks relied upon. Despite this no change was made to the pleadings even when clarification was sought by the Registry. I fully agree with the views of the applicant who described the statement of Mr Holmes as "a sloppy cut and paste job".

6) In its submissions on cost the opponent also stated:

“We look forward to hearing from the Hearing Officer in relation to the issue of costs, and naturally will respect whatever decision is made in this regard and will take this into account in relation to future conduct of opposition cases.”

7) The applicant in their costs submissions stated:

“For the reasons set out in this skeleton argument the applicant respectfully invites the Hearing Officer to make no order as to the costs of the opposition number 101853, alternatively to discount or disallow the large majority of costs sought.”

8) Taking all of the above into consideration, and despite the opponent being successful in its opposition I take the unusual action of not awarding any costs. In reaching this position I take into account that other than the issues raised above this was a normal case by the standards of the Tribunal and that costs would have been awarded according to the Registry scale. The amount that would have been awarded to the opponent is offset by the additional work caused to the applicant by the unacceptable behaviour of the opponent. The parties have 28 days from the date of this decision to appeal the substantive decision issued earlier or this costs decision.

Dated this 23rd day of June 2014

**George W Salthouse
For the Registrar,
the Comptroller-General**