

O-336-16

**SUPPLEMENTARY DECISION ON COSTS**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NOS 3089999, 3088956 AND 3096882  
BY ZENDEGII FRILL LIMITED TO REGISTER THE TRADE MARKS**



**VARIOUSLY IN CLASSES 5, 30 AND 32**

**AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO UNDER  
NOS 403997, 403998 AND 404041  
BY DAIRY CREST LIMITED**

**AND**

**IN THE MATTER OF REGISTRATION NO 2524330  
FOR THE TRADE MARK "FRIJJ"  
IN CLASSES 29, 30 AND 32  
IN THE NAME OF DAIRY CREST LIMITED  
AND THE CONSOLIDATED APPLICATION FOR REVOCATION THERETO  
UNDER NO 500727  
BY ZENDEGII FRILL LIMITED**

1) In my decision issued on 10 May 2016 under the BL number O/231/16, my conclusions and comments on costs were as follows:

### **“Conclusions**

110) ZFL’s revocation application is successful in respect all the goods of DCL’s 2424330 registration, except for the following:

**Class 29:** *Beverages made with milk; milk predominating beverages; milk shakes and flavoured milk drinks.*

111) DCL’s oppositions fail in their entirety.

### **COSTS**

112) ZFL has been partially successful in its revocation action relating to DCL’s 2524330 mark and wholly successful in the three opposition proceedings against its marks. All four proceedings were consolidated leading to a reduction in the overall costs, but nevertheless, the reasonably complex matrix of issues made this more complicated proceedings. However, it is my view that the award of costs can still be made based on the published scale. At the hearing, Ms Cookson made a request to make written submissions on costs. I allow 14 days from the date of this decision, but remind Ms Cookson of my preliminary comments earlier in this paragraph. DCL is permitted a further 14 days to provide any submissions it wishes to make regarding costs. I will then issue a supplementary decision on costs, taking account of these submissions. The date for appeal against all matters will commence on issue of the supplementary decision.”

2) Subsequent to issuing my decision, the IPO was notified by email of 18 May 2016, that Muller UK & Ireland Group LLP (hereafter “Muller”) have acquired, by assignment, ownership of the registered marks relied upon by DCL in its oppositions including UK registration 2524330 that was also the subject of ZFL’s application for

revocation. Further, it was also notified that Cleveland were no longer acting for this party and that Gemma Wisniewski of Muller is now the contact.

3) In its written submissions, ZFL (Zendegii Frill Limited) submits that because since the hearing DCL (Dairy Crest Limited) has assigned all its earlier marks to Muller and because Muller has not intervened, the costs order must be made against DCL, despite no longer being the owner of the earlier marks. I do not necessarily agree. By email of 18 May 2016, Ms Wisniewski, on behalf of Muller, stated her view that DCL should no longer be party to the proceedings and that they should be replaced by Muller. As Muller are now the proprietor of the earlier marks, it is permissible that it is substituted as the opponent subject to it providing the necessary undertaking that it stands by any order of costs made in respect of these proceedings.

4) In light of the above, I wrote to Ms Wisniewski on 23 June 2016 to obtain written confirmation that Muller provide the necessary undertaking. It was allowed until 7 July 2016 to provide it, however, no such undertaking has been received. In light of this, the opponent in these proceedings remains DCL and, therefore, I issue the following decision with costs awarded against DCL.

## **DECISION**

5) In accordance with my directions in paragraph 112 of that decision, ZFL provided written submissions on costs, but DCL did not.

6) I note from the submissions made on behalf of ZFL that the evidence relied upon by DCL in Opposition 402877 was adopted into the current proceedings without amendment.

7) ZFL accept that a costs award based upon the published scale is appropriate, but that factors that need to be taken into account are the number of grounds raised, the volume of evidence submitted, the fact that a case management conference (“cmc”) was held in July and that a considerable amount of time and preparation was spent conducting the proceedings and in the consideration of a fair specification. ZFL therefore propose costs as follows:

Item	Scale	Proposal
Cancellation fee	£200	£200
Reviewing 3 x Form TM7s (each over 100 pages) and filing 3 x Form TM8s	£200 - £600 x 3	£800
CMC, July 2015		£300
Preparing evidence and considering other side's evidence	£500 to £2000	£2000
Hearing	Up to £1500 x 4	£1500
TOTAL		£4,800

8) I agree with these proposed costs except the costs in respect of the cmc. The purpose of the cmc was to give directions regarding ZFL's attempt to submit expert evidence and its request to suspend the oppositions to await the outcome of the revocation action. I directed against ZFL regarding these points and, consequently, it would not be correct to award costs, in its favour, in respect of the cmc. The amount it suggests (£300) is reasonable, but this is awarded to the other side (i.e. the award of costs to ZFL are reduced by this amount).

9) In summary, the award of costs in favour of ZFL, includes the costs claimed in the above schedule, except for the £300 claimed in respect of the cmc. Costs relating to all other aspects of the proceedings are based on the normal scale. Consequently, I award costs on the following basis:

Cancellation fee	£200
Considering statements and preparing counterstatement	£800
Preparing own evidence & considering other side's	£2000
Preparing and attending hearing	£1500
CMC	(£300)
<b>Total:</b>	<b>£4,200</b>

10) I order Dairy Crest Limited to pay Zendegii Frill Limited the sum of £4,200 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

**Dated this 14th day of July 2016**

**Mark Bryant**  
**For the Registrar**  
**The Comptroller-General**