

O-406-16

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3054968

BY KERRY-ANN LOUTH

TO REGISTER:



AS A TRADE MARK IN CLASSES 16, 35, 37 & 45

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 403230 BY INTUIT INC.

SUPPLEMENTARY DECISION ON COSTS

BACKGROUND

1. On 16 March 2016, I issued an interim decision in these proceedings (BL O-142-16). Having concluded that the opposition succeeded in full against the only class in the application that had been opposed, I stated:

“32. Whilst the opponent has been wholly successful in relation to the only services it opposed i.e. those in class 35, my decision is a provisional one. I cannot give a final decision to refuse registration of the application in relation to those services until such time as one or other of the opponent’s MINT trade marks has achieved registration for the services being relied upon in these proceedings. In the meantime, the application insofar as it covers goods and services in classes 16, 37 and 45 which have not been opposed may proceed to registration. In order for this to be done, the applicant would have to file a request to divide the application accordingly.

Next steps

“33. I direct the opponent to advise me within one month of the date on which its earlier applications are finally determined. Registration of one of the earlier applications for the services being relied upon will, of course, suffice for the opposition to succeed. On receipt of this information, I will issue a supplementary decision giving a full determination of the opposition proceedings and informing the parties of my decision in respect of an award of costs. Finally, as mentioned above, if a request for division is made, the application may proceed to registration in relation to the goods and services in classes 16, 37 and 45.”

2. In a letter dated 15 August 2016, the opponent’s professional representatives notified the Tribunal that the fate of UK trade mark no. 3035455 had been determined by the Appointed Person, Ms Amanda Michaels, in her decision of 8 August 2016 (BL O-381-

16). In that decision, Ms Michaels allowed the trade mark mentioned to proceed to registration for the following services in class 35:

Business management; business administration; office functions; accounting; book-keeping; administrative accounting; company and business information; compilation of statistics; price comparison services; compilation of information into computer databases; data search in computer files for others; computerised file management; providing comparisons of the products and services of others, including through computer or communication networks, the internet, social media and software applications.

The trade mark was entered in the register on 19 August 2016.

3. In my interim decision, I stated:

12. “Book-keeping and accountancy services” in the application are identical to “accounting” and “book-keeping” in the earlier applications. As the remaining services in the application i.e. “accountancy tax advice; payroll advisory services; payroll accountancy services; preparation of tax returns” would all, in my view, be encompassed by, at least, the term “accountancy” in the earlier applications, these services are identical on the principles outlined in *Meric*.

4. As one can see, the specification for which the opponent’s trade mark has now been registered retains all of the services i.e. “book-keeping” and “accounting” upon which my interim decision was based.

Conclusion

5. The opposition succeeds in relation to class 35 of the application. The application, insofar as it covers goods and services in classes 16, 37 and 45 which have not been opposed, may proceed to registration.

Costs

6. Awards of costs are governed by Tribunal Practice Notice (“TPN”) 4 of 2007. As the opponent has been successful, it is entitled to a contribution towards its costs. Using the TPN mentioned as a guide, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant’s statement:	£200
Filing of written submissions:	£200
Official fee:	£100
Total:	£500

7. I order Kerry-Ann Louth to pay to Intuit Inc. the sum of **£500**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of August 2016

C J BOWEN

For the Registrar

The Comptroller-General