

O/399/18

TRADE MARKS ACT 1994

TRADE MARK APPLICATION No. 3242017

BY FAB PARTNERS LP

AND

OPPOSITION No. 410537

BY GB GAS HOLDINGS LIMITED

Decision on Costs

1. FAB Partners LP (“the applicant”) applied to register CENTRICUS as a trade mark for various services in classes 35 and 36.

2. The application was opposed on 16th October 2017 by GB Gas Holdings Limited (“the opponent”). The opposition was based on 4 earlier EU and UK trade mark consisting of, or containing, the word CENTRICA. The opponent also claimed to own an earlier right in the word CENTRICA as a result of having traded under that name since 1997 in relation to:

“Supply of energy, electricity and gas; generation of electricity; installation and maintenance of central heating and gas appliances; repair and maintenance of plumbing and drains, locks, alarms and security apparatus; insurance; business auditing and information services and provision of reports.”

3. The opponent asked for the application to be refused on the grounds that registration of the mark would be contrary to sections 5(2) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

4. On 19th March 2018, the opponent filed a form TM7G requesting to add an additional ground of opposition. The additional ground was based on s.5(3) of the Act. The opponent claimed that the earlier marks had a reputation in the UK/EU and that use of the applicant’s mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.

5. By way of explanation for its failure to include this ground at the outset, the opponent stated that:

“Oppositions should not be based lightly on s.5(3). When the opposition was filed there was insufficient time to assess whether the opposition based on s.5(3) might succeed.

Having reviewed the Opponent's evidence of use of the trade marks, following the Applicant's request for the Opponent to prove use of the registrations which form the basis of the subject opposition, the Opponent considers that it would have sufficient evidence to support a claim that it enjoys a reputation in its CENTRICA mark in the United Kingdom.

In view of the public interest in the avoidance of undue plurality of proceedings, the Opponent considers that the subject opposition should be considered on the basis of s5(3) in addition to the grounds under which the opposition was originally filed. This would enable the Registrar to consider all possible grounds for opposing the application in suit at the same time.

The Opponent also considers that the Applicant would not be unfairly prejudiced by adding this ground to the opposition since it has not filed substantive evidence or submissions at this stage of the proceedings. To the extent that it is necessary for the Applicant to amend its Counterstatement or incur any other consequential costs at this stage, the Opponent confirms that it is willing to bear the costs of and occasioned by the amendment requested.”

6. The applicant opposed the application to amend the opponent's statement of grounds. Essentially, the applicant's position was that the opponent must have known if it had a reputation when it filed the notice of opposition. Consequently, the application represented a belated change of heart, which should be refused.

7. Following a case management conference (“CMC”) on 3rd May 2018, I accepted the amendment to the opponent's grounds of opposition (subject to one restriction which is not relevant for present purposes) on condition that the opponent met the applicant's reasonable costs of amending its counterstatement.

8. I invited the applicant to submit a breakdown of such costs with its amended counterstatement, which it did on 21st May. The applicant claimed £335 for attending the CMC and £704 for preparing the amended counterstatement. Both excluding VAT.

9. The opponent was given an opportunity to comment on this claim, which it did on 12th June. The opponent objected to any costs being awarded against it for the CMC. It made no comments about the amount claimed for preparing the counterstatement.

10. I agree that the applicant is not entitled to costs for the CMC. It is true that the opponent's application for amendment was the reason for the CMC, but it is also true that I rejected the applicant's opposition to that application.

11. The opponent did not comment on the amount the applicant claims as the actual cost of preparing the revised counterstatement. However, given the limited changes required to the original counterstatement in order to deal with the additional ground of opposition, I consider that £704 is excessive. The changes should not have required more than one hour and a half to complete and submit.

12. Rule 67 of the Trade Mark Rules 2008 gives the registrar the power to award costs. In the circumstances, I will allow the applicant £450 for the cost of preparing an amended counterstatement.

13. I therefore order GB Gas Holdings Limited to pay FAB Partners LP the sum of £450 within 42 days of the date shown below.

Dated this 03rd Day of July 2018

**Allan James
For the Registrar**