MR HOBBS: On 9th July 1996 Madgecourt Limited of Barnet in Hertfordshire applied to register the designation MCL PARFUMS DE PARIS as a trade mark for use in relation to the following specification of goods:

> "Soaps; medicated soaps, hand creams; face creams; toiletries; deodorants; perfumes; lipsticks; hair lotions; face powders; depilatories, suntanning preparations (cosmetics); shaving preparations; dentifrices; all included in Class 3."

The application was subsequently opposed by the Federation des Industries de la Parfumerie on various grounds. At the heart of the opponent's objections was an allegation that the use of the words "Parfums de Paris" as part of the mark in suit would tell a lie about the provenance of the applicant's goods because, contrary to the impression created by the use of those words, its goods would not be connected in the course of trade or business with any perfume house established in Paris.

In its counter statement dated 21st April 1997, the applicant comprehensively denied that its application was open to objection on any of the grounds alleged against it. According to a statutory declaration made by Linda Bray on behalf of the opponent on 7th August 1997, she had spoken to Mr Hamalis of the applicant on 15th January 1997 and he had told her that the products which the applicant intended to supply under the mark in suit would be manufactured in Paris.

It appears that she asked him to let her have evidence of that fact. He is said to have asked her what evidence would be required. She apparently indicated that a statement in writing as to the true position would be appropriate.

In a statutory declaration made by Mr Tony Hamalis on behalf of the applicant on 7th October 1997, it was indicated that the applicant was "prepared to obtain the perfume (oil) which is the active ingredient in terms of its use of the products under the application number 2104616 from France in order to avoid any confusion to the origination of the products."

Attached to this statutory declaration was a letter dated 6th October 1997 from a Mr Bernard Mahoney of Robertet (UK) Limited informing the applicant as follows:

> "I would confirm that we are able to have selected fragrance compounds manufactured by our parent company in Grasse. If you can let me know which fragrances you would like manufactured in France I will submit samples and a new quotation to you. The normal lead time for Grasse compounds is approximately four weeks. I look forward to hearing from you in due course."

Grasse is the perfume capital of France. It is sometimes described as the perfume capital of the world. It is approximately 15 kilometres north-west of Cannes.

The opposition proceeded to a hearing before Mr Knight, Principal Hearing Officer acting for the Registrar of Trade

Marks, on 8th September 1999. At that hearing it was indicated on behalf of the applicant that finished products bearing the mark in suit would be manufactured in the United Kingdom. In his decision, issued on 30th November 1999, the Principal Hearing Officer upheld the opponent's primary objection to registration. He said on page 10, lines 1 to 7:

> "It seems to me, having regard to the evidence and submissions, that because of the inclusion in the trade mark of the term "PARFUMS DE PARIS" there would be an expectation that the perfume and any of the perfumed products included in the specification would be manufactured in Paris and that if the specification of goods did not reflect that, then the trade mark would be deceptive. Also having noted that France and Paris in particular has a reputation for perfumes, it seems to me that the public would be deceived not only as to the geographical origin of the goods but may also be deceived as to their nature and quality."

He went on to say on page 10, lines 22 to 31:

> "Therefore, having regard to the reputation of Paris and France for perfumes, it seems to me that a large number of members of the public would expect, seeing perfumes or perfumed products bearing the trade mark "MCL PARFUMS DE PARIS", that the goods would be of French or Parisian origin, and would be deceived as to their quality and geographical origin if they did not. The opposition

under section 3(3)(b) therefore succeeds in relation to all of the goods of the specification apart from dentifrices which is the only item one would not expect to be perfumed and therefore the application of the trade mark in suit to those goods would not attract the same objection. The objection would, of course, be overcome by the limitation of the specification to 'all the aforementioned goods being produced in Paris or being perfumed with perfume produced in Paris'."

His conclusion, stated on page 14, lines 10 to 16, was as follows:

"The opponents have been successful only in respect of the ground based upon section 3(3)(b) of the Act insofar as all goods except dentifrices is concerned. If the applicants choose so to do they may overcome the objection to registration of the trade mark in suit for the remainder of the goods by limiting the specification of goods by the inclusion of the term set out earlier in this decision. Should they choose to do so they must file a form TM21 requesting such a limitation to the Trade Marks Registry within 1 month of the date of the decision. If they do not do so the application will proceed to registration only in respect of dentifrices."

The applicant subsequently affirmed and adopted the Principal Hearing Officer's decision on the merits of the opposition by filing a form TM21 amending the specification of

the application in suit so as to bring it into line with the Registrar's ruling.

For its part, the opponent indicated in a letter to the Registry dated 6th January 2000 that it would not be filing an appeal against the Principal Hearing Officer's decision. However, the applicant decided to appeal to an Appointed Person under section 76 of the Trade Marks Act 1994 against the Principal Hearing Officer's order for costs. The decision in relation to that aspect of the matter was as follows at page 14, lines 18 to 23:

> "Insofar as costs are concerned the opponents have had a measure of success whether or not the application is amended. In the circumstances, I order the applicants to pay to the opponents the sum of £800. If they choose to amend their specification of goods then I see no reason to reduce the order for costs accordingly. This amendment to the specification was one which could reasonably have been undertaken at an earlier stage and thus the possibility of these proceedings being abated may have been a possibility."

The applicant has appealed against the order for costs on the basis that the limitation of bringing perfume from France was something which had been suggested long before the hearing, therefore the amendment could have been made at an earlier stage if the opponent had agreed to it. It is submitted that the order requiring the applicant to pay costs

of £800 should, on that basis, be set aside.

It appears to me, having reviewed the papers in this case, that the limitation which was indicated by the Registry and ultimately accepted by the applicant was not a limitation which had previously been offered by the applicant for registration. It was narrower and stricter than the limitation which the applicant had indicated it might be willing to accept. It was only on that narrower and stricter basis that the opponent was able to obtain the satisfaction that it was seeking in relation to its objection under section 3(3)(b) of the Act.

In the circumstances, it appears to me that the Principal Hearing Officer was fully entitled to make the order for costs that he did in the decision under appeal. I am certainly not prepared to exercise the relevant discretion differently on that matter on appeal. The appeal will therefore be dismissed.

At this point there would normally be a question of costs for consideration. Your appeal has been dismissed. We have had written submissions from the agents acting for the opponent indicating that it did not intend to appear today, but it asks in paragraph 8 for the appeal to be dismissed and for costs to be awarded in their favour. That is the last paragraph of that letter of the 22nd March. Is there anything you would like to say, Mr Hamalis, about this question of whether the opponent should have any costs awarded to it in

respect of this appeal?

MR HAMALIS: Only what I have said already.

MR HOBBS: My decision is that the appeal will be dismissed with an award of costs in the sum of £100 in favour of the opponent to cover its costs of considering the notice of appeal, taking instructions and preparing written submissions for consideration at this hearing. That £100 is in addition to the £800 already awarded in its favour by the Principal Hearing Officer.

I do not think there is anything else, is there? Thank you very much indeed.

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