TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 94569

IN THE NAME OF FOREIGN SUPPLEMENT TRADE MARK LIMITED

TO TRADE MARK APPLICATION No. 2416626

IN THE NAME OF MAXIMUSCLE LTD

SUPPLEMENTARY DECISION

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1. In my decision issued under reference BL O-048-10 on 8 February 2010 I determined: (1) that paragraphs [79] and [80] of the decision of Mr. George Salthouse issued in Opposition No. 94569 under reference BL O-154-09 on 4 May 2009 should be struck out; and (2) that the question of costs (i.e. the question of how and by whom the costs of the Registry proceedings in that Opposition were to be borne and paid) should be remitted to the Hearing Officer for determination de novo in accordance with the Trade Marks Act 1994 and the Trade Marks Rules 2008 upon the basis and in the light of the paragraphs of his decision (paragraphs 1 to 78) which remained unaffected by the Opponent's appeal.

2. I left over for determination in a supplementary decision: (1) the question of how and by whom the costs of the Opponent's appeal were to be borne and paid; and (2) the

question whether there should be a stay of the Applicant's pending appeal against the Hearing Officer's refusal of registration under Section 3(6) of the 1994 Act.

3. Both parties filed written submissions in relation to those questions. Neither party requested a hearing. My supplementary decision is as follows.

4. With regard to question (2), I consider that there should be a stay of the Applicant's pending appeal. I note that neither party has suggested otherwise. I therefore determine:

(1) that the Applicant's pending appeal against the Hearing Officer's decision upholding the Opponent's objection to registration under Section 3(6) of the 1994 Act be stayed until further order of this tribunal;

(2) that each party has permission to apply to this tribunal in writing and on notice to the other party for the stay imposed at (1) above to be lifted and for directions as to the further conduct of the presently stayed appeal;

(3) that the question of how and by whom the costs of the presently stayed appeal (including the costs of the Applicant's successful appeal against the decision issued by Mrs. Ann Corbett under reference BL O-368-09 on 24 November 2009) are to be borne and paid be reserved for consideration as part of the final determination of the Applicant's appeal in respect of the Opponent's objection under Section 3(6).

5. With regard to question (1), the Opponent submits that the costs of its appeal against the Hearing Officer's decision on costs in Opposition No. 94569 should be treated either as costs in the Applicant's pending appeal or as costs carried by the determination noted at paragraph 1(2) above.

6. The Applicant submits that *'it should have the costs of the appeal in any event'*. It does so essentially upon the basis: (1) that the Hearing Officer's failure to give sufficient reasons for his decision on costs under Rule 69 of the Trade Marks Rules 2008 provided the Opponent with a lucky escape from the inadequate presentation of its claim for costs in the Registry; and (2) that the Opponent succeeded in obtaining the opportunity to escape by means only of a late amendment to its Grounds of Appeal, which carried less costs than the grounds it pursued without success on the basis of its original Grounds of Appeal.

7. What the Opponent has gained by its appeal is the opportunity to put forward a claim for costs which it could and should have advanced before the Hearing Officer first time around. I see no reason why the Applicant should be ordered to pay anything towards the amount by which the Opponent's costs of making that claim have been increased by the appeal it brought in order to retrieve its position in that regard. Still less do I see any reason for making such an order in circumstances where no sustainable grounds for allowing the Opponent to retrieve its position were raised in its original Grounds of Appeal.

8. I think that the costs inflicted upon the Applicant by the Opponent's appeal were surplus to the reasonable and proper requirements of the Opposition proceedings to an extent which should be marked by an award of costs in favour of the Applicant. That calls for a distinction to be drawn between the costs of the Applicant's own appeal (which are covered by paragraph 4(3) above) and its costs of the Opponent's appeal.

9. The Applicant has provided no figures to guide me in that connection. It simply asks for an award of costs *'assessed on the standard scale in the ordinary way'*. On the basis of the materials before me and in accordance with my sense of proportion in relation to the amount of time, effort and money that is liable to have been spent upon the preparation and presentation of the Applicant's defence to the case raised by the Opponent in its original Grounds of Appeal, I think it would be appropriate to require payment of £1,800 as a contribution towards the Applicant's costs of the Opponent's appeal. I therefore direct the Opponent to pay £1,800 to the Applicant in respect of such costs within 21 days of the date of this decision.

10. It is suggested in the written submissions I have received that I should give directions for the determination of the question I have remitted to the Hearing Officer (see paragraph 1(2) above). I decline to do so. The Hearing Officer and the parties are now in the same position as if there had never been a decision on costs in relation to the Registry proceedings in Opposition No. 94569. It is for the Hearing Officer to give such directions

as he may consider necessary or expedient for the purpose of ensuring that the remitted question of costs is decided in accordance with the Act and the Rules.

Geoffrey Hobbs Q.C.

19 February 2010

Roland Mallinson of Taylor Wessing LLP provided written submissions on behalf of the Opponent.

Giles Fernando instructed by Barlow Robbins LLP provided written submissions on behalf of the Applicant.