

O-492-12

TRADE MARKS ACT 1994

SUPPLEMENTARY DECISION ON COSTS

**IN THE MATTER OF TRADE MARK APPLICATION 2556905
BY BLUESTAR FIBRES COMPANY LIMITED IN RESPECT OF THE
FOLLOWING TRADE MARK IN CLASSES 17, 22 & 24:**

STARAMID

AND

OPPOSITION THERETO (NO 101320) BY RHODIA CHIMIE

The background

1) On 7 August 2012 I issued a substantive decision in relation to these proceedings, the final paragraphs of which read:

“Summary

35) The opposition succeeds in relation to:

Class 17: Carbon fibres; carbon fibre non-wovens; carbon fibre composites.

Class 22: Textile fibres; raw fibrous textile materials; carbon fibres for textile use.

36) But fails in relation to:

Class 17: Carbon fibre felt; yarns and threads (other than for use in textiles).

Class 22: Yarns for textile use, carbon fibre yarns.

Class 24: Textiles; textile piece goods; fabrics; carbon fibre fabrics; fabrics of synthetic yarns and/or threads.

Costs

37) Given the roughly equal measure of success, I do not propose to favour either party with an award of costs.”

2) My decision was issued following the provision, by both sides, of written submissions. As can be seen from the above, I regarded the outcome as something of a score draw and, in the circumstances, I did not favour either party with an award of costs.

3) On 21 August 2012 an e-mail was received from J.A. Kemp & Co, the firm with conduct of these proceedings on behalf of Rhodia Chimie (“Rhodia”), the opponent in this matter. In its email it asks whether Rhodia’s submissions on costs had been borne in mind because my decision did not address the points it had raised. A response to this was sent by the IPO in the following terms:

“Whilst both parties’ submissions were fully borne in mind when dealing with the substantive matters, regretfully, the submissions in relation to costs were overlooked. In view of this, the Hearing Officer regards this as a procedural irregularity and intends to set aside his decision on costs. The substantive decision is not affected. The Hearing Officer will,

therefore, prepare a supplementary decision dealing solely with costs, and the appeal period in relation to costs will be re-set.”

4) The parties were allowed a period of 14 days to comment on the above proposed course of action. Neither party did so. In the circumstances, I hereby adopt the above procedure and issue this supplementary decision on costs which takes into account the written submissions on this issue.

The written submissions

5) The applicant for registration, Bluestar Fibres Company Limited (“Bluestar”), made only a brief reference to costs in its written submissions (which were filed by its trade mark attorneys, Marks & Clerk LLP), simply indicating that it sought an award in its favour. However, those filed by Rhodia were more detailed because it wished to highlight the difficulty it had been caused by Bluestar’s representatives “repeated failure to copy in the Opponent on its communications with the Registrar”. It refers to the failure to copy two extension of time requests and, also, Bluestar’s written submissions. This led to Rhodia having to chase these matters up by letter and/or telephone which it says has increased its costs.

What, if anything, to award?

6) There is a well established practice that places an obligation on a party to copy correspondence to the other side in the proceedings. The failure to meet this obligation has led to the issuing of letters and the making of telephone calls. In the circumstances, I agree that Rhodia should be entitled to some form of award in its favour. I note, however, that Rhodia is not itself immune from this behavior as it appears to have neglected to copy its email of 21 August 2012 to Bluestar which led Bluestar to write to the IPO requesting a copy. In all the circumstances of the case before me, I award the sum of £150 in favour of Rhodia as a contribution towards the costs incurred. Bluestar Fibres Company Limited are hereby ordered to pay Rhodia Chimie the sum of £150.

7) The above sum should be paid within seven days of the expiry of the appeal period for this supplementary decision or within seven days of the final determination of this matter if this supplementary decision is appealed.

Dated this 10th day of December 2012

**Oliver Morris
For the Registrar,
The Comptroller-General**