

O-079-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 1045622 IN THE  
NAME OF MATTHIEU VAXELAIRE**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 72255 BY JOJO MAMAN BÉBÉ LIMITED**

## BACKGROUND

1. On 27 March 2012 I issued an interim decision in these proceedings (BL O/140/12), and on 5 December 2012 I issued a supplementary decision (BL O-484-12). In the supplementary decision I said, inter alia:

“6. In a letter dated 19 November 2012, JMB’s professional representatives, Urquhart Dykes & Lord LLP (“UDL”), informed the tribunal that the CTM in question had achieved registration. A review of the printout provided by UDL (obtained from [www.oami.europa.eu](http://www.oami.europa.eu) on 15 November 2012), indicates that the CTM (which remains in the name of JMB), achieved registration on 9 November 2012 and did so in relation to, inter alia, all the goods and services I identified in paragraph 3 of my original decision.

7. In those circumstances, the conclusions reached in my original decision stand and JMB’s opposition to MV’s designation succeeds in relation to:

Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; umbrellas, parasols and walking sticks [in class 18],

and:

Clothing, footwear, headgear [in class 25],

but fails in relation to:

Animal skins; whips, harness and saddlery [in class 18].

8. I order Matthieu Vaxelaire to pay JoJo Maman Bébé Limited the sum of **£1300** as a contribution towards the costs incurred by it in dealing with these proceedings. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.”

2. My decision was sent to the parties by Royal Mail Special Delivery on 5 December 2012 and a period expiring on 2 January 2013 was allowed for any appeal to be filed.

3. In a letter sent by facsimile to the TMR at 16.52 on Friday 21 December 2012, MV’s agents Baker & McKenzie (“BM”) said, inter alia:

“Please note that the international registration 1045622 in the name of [MV] was cancelled at the request of the trade mark owner on May 21, 2012.

Therefore it seems to me that the opposition proceedings have become without object and that no further decision should have been made.

Would you please take this into consideration and possibly revisit the decision that has been made.”

4. In a further letter dated 2 January 2013 (and received by the TMR on 3 January), BM filed a form TM9 and fee sheet to request a 1 month extension of the period for appeal. The reasons for the extension were:

“pending request for explanation sent on December 21, 2012...

lack of availability of my client because the end of the year vacation period.”

The TMR’s records appear to indicate that the fee (which was paid by bank transfer) was received on 7 January.

5. On 3 January, the TMR sent a copy of BM’s letter of 21 December 2012 to UDL and said:

“The Hearing Officer has suspended the appeal period and asks for your comments on the attached letter on or before 17 January 2013.”

6. In a letter dated 14 January 2013, UDL responded in detail to BM’s letter; I shall return to this letter below.

7. In an official letter dated 16 January 2013, BM was allowed until 28 January 2013 to comment on UDL’s letter of 14 January.

8. BM responded in a letter dated 28 January 2013. Having explained that the TMR’s letter of 16 January had only been received by it on 25 January (and had only reached the person responsible at BM on the morning of 28 January), BM asked for the deadline for its comments to be extended until 1 February. In that letter BM said:

“Because:

UK is not my client’s most targeted market;

my client owns a CTM registration for his trade mark JOJO;

and with a view to avoiding the costs tied to the opposition in the UK, my clients has decided – without prejudice – to cancel its international registration for the UK. This cancellation was registered on 21 May 2012.

It seems to me that – to the extent there is no international registration for the UK anymore – the opposition proceedings become without purpose, except possibly to rule on the opposition costs.

For that reason, the Hearing Officer's decision dated 5 December 2012 was unexpected to my client and I apply for an additional 2 week period (running from the date of your decision) to possibly lodge an appeal against the 5 December 2012 decision."

9. In an official letter dated 29 January 2013, BM was allowed until 1 February to provide further comments; the TMR's records indicate that nothing further has been received from BM.

10. On 7 February 2013, UDL wrote to the TMR. In that letter, UDL comment on what it considers to be the inappropriateness of the approach adopted by the TMR (as summarised above); I return to this point below.

### **Chronology of events**

11. As mentioned above, my interim decision in these proceedings was issued to the parties on 27 March 2012. On 19 November 2012 UDL advised the TMR that JMB's CTM application no. 6387757 had achieved registration. My decision of 5 December 2012 was issued on the basis of that indication and the information before me at that time and an appeal period expiring on 2 January 2013 was set. However, it later emerged that on 21 May 2012 i.e. after my interim decision had been issued, MV had cancelled his international registration insofar as it designated the United Kingdom. In its letter of 14 January 2013, UDL said:

"It is also noted that at no time did [MV] advise either [JMB] or the UK IPO that it had withdrawn its international trade mark...It allowed the proceedings to continue in other words."

As this information had not been made available to either UDL or the TMR, it was not a factor I was aware of or took into account in reaching my supplementary decision.

12. BM's letter (in which it effectively claimed there had been an irregularity in procedure) was received by the TMR on the afternoon of the Friday before the Christmas/New year holiday period. Given the proximity of the deadline for an appeal to be filed, I am satisfied that in the circumstances described above, and bearing in mind that under rule 77(1) of the Trade Marks Rules 2008 the registrar may extend the period for appeal on his own initiative, the TMR's approach in modifying (by suspension) the appeal period for BM's claim to be considered was, as a consequence, reasonable (I accept it would have been more appropriate for the TMR to have extended rather than suspended the appeal period but note that the effect of each action is the same in practice); I note in passing that UDL did not challenge this approach in its letter of 14 January 2013. However, even if that approach is considered arguable and assuming that what appears to be the late filing of the form TM9 and the associated fee could be adequately explained, it is, in my view, highly likely that MV's request for additional time to consider appealing my supplementary decision would have been granted. Given the nature of the new information BM had brought to the TMR's attention, it is, in my view,

far more appropriate for the matter to be dealt with by the TMR at first instance, than by an appeal tribunal de novo (in fact, an appeal tribunal may have remitted the matter back to the TMR to consider in any case). In addition, the TMR's approach is likely, in my view, to have reduced time and costs for all concerned. Given my comments above, it follows that I am also satisfied that the approach subsequently adopted by the TMR (including granting BM a short discretionary extension of 4 days in response to BM's letter of 28 January 2013) was also appropriate.

## **Decision**

13. In its letter of 14 January 2013, UDL said:

“Even if one takes into account the fact that the opposition decision was only suspended in relation to a limited number of goods in class 18, [JMB] clearly succeeded in its opposition based on its United Kingdom registrations and on the section 5(4)(a) ground. These grounds were separate from that based on [JMB's] CTM and the opposition largely succeeded on these grounds. This decision was made well before [MV] withdrew its international registration and so [JMB] is fully entitled to have the decision in its favour and also to retain the award of costs.

The substantive grounds of the opposition were based on the status of both parties' marks as at the date the opposition was filed and as at the date the merits of the opposition were considered by the hearing officer and an interim decision was issued. Those are the relevant dates and at all those relevant dates, [MV's] international mark was valid and in force. It was not withdrawn until well after the time the UK IPO had considered both parties cases based on the state of their trade marks as at the date the opposition was filed. If [MV] wished to avoid the opposition proceedings continuing, it could have and should have withdrawn its IR rather than allowing opposition proceedings to continue. [JMB] took and prosecuted the opposition case in good faith.

[MV's] contention therefore that the opposition proceedings were rendered without object on 21 May 2012 is clearly fanciful as the opposition proceedings in their substantive form had been completed well before that date, they were prosecuted and completed whilst the international registration was still on the register and in force; the only matter outstanding was the conclusion of the community opposition proceedings against [JMB's] community mark.

[JMB] is, therefore, entitled to have the decision confirmed in its favour to the remaining goods in class 18 (the opposition having already been substantially decided in [JMB's] favour based on the existence of its two United Kingdom registrations and its goodwill and reputation in its marks in the United Kingdom well before the date [MV's] IR was withdrawn.”

14. There are three points I need to consider. First, insofar as BM may be claiming that there was an irregularity in procedure when my supplementary decision was issued,

given the timing of BM's letter to the TMR in which it advised that MV had renounced the designation of his international registration in the UK, I do not accept that my supplementary decision issued on 5 December was procedurally irregular in any respect; my decision stands. Secondly, as MV has renounced the designation of his international registration in the UK, whether my supplementary decision in these proceedings, as BM argues, becomes without object, and thirdly, costs. Notwithstanding UDL's comments reproduced above, it appears to me that the effect of MV renouncing the UK designation of his international registration in May 2012 means that there is no longer an extant UK designation to which the substantive conclusions I reached in my earlier decision can be applied. However, that does not, of course, mean that it was not a valid decision at the time it was issued. Insofar as costs are concerned, in its letter of 28 January BM said: "...except possibly to rule on the opposition costs." Thus it appears that BM accepts that a determination on costs is appropriate

15. In my interim decision of 27 March I said:

"66. JMB has been largely successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, and irrespective of the outcome of application No. 6387757, I award costs to JMB on the following basis:

Preparing a statement and considering MV's statement:	£300
Preparing evidence:	£500
Official fee:	£200
Written submissions:	£300
<b>Total:</b>	<b>£1300"</b>

16. Although I have concluded that the substantive conclusions reached in my earlier decision are now without object, MV did not renounce the UK designation of his international registration until 21 May 2012 i.e. after my interim decision was issued. In those circumstances, JMB is clearly still entitled to the costs identified in my supplementary decision. In addition, it appears that at no point before BM's letter of 21 December 2012 had either UDL or the TMR been notified that this action had taken place. In its letter of 14 January 2013 UDL said:

"[JMB] also respectfully seeks an award of costs in relation to having to respond to [MV's] application to render the opposition decision nugatory."

17. Although JMB has been unsuccessful on the without object point, the fact remains that MV did not, in a timely manner, notify either JMB or the TMR that he had renounced his UK designation. This failure will have resulted in additional work and

costs for JMB. In those circumstances, I shall make an additional award of costs in the amount of £300 to JMB as a contribution towards the costs incurred by it in dealing with the circumstances leading to the issue of this further decision.

18. I order Matthieu Vaxelaire to pay JoJo Maman Bébé Limited the sum of **£1600** as a contribution towards the costs incurred by it in dealing with these proceedings. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal is unsuccessful. Although the appeal period set by the TMR in its letter of 5 December is still extant, for the sake of convenience, the period to appeal against both my supplementary decision and this decision will be 28 days beginning with the date this decision is sent to the parties by the TMR.

**Dated this 21st day of February 2013**

**C J BOWEN**  
**For the Registrar**  
**The Comptroller-General**