

O-320-14

**SUPPLEMENTARY DECISION**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 2587306  
BY ROUTE 77 ENERGY LTD  
TO REGISTER THE FOLLOWING SERIES OF TRADE MARKS IN CLASS 32:**



**AND**

**OPPOSITION THERETO (NO. 102879) BY LODESTAR ANSTALT**

1) In a decision dated 27 May 2014, I partially upheld an opposition under section 5(2)(b) of the Act. I held that the applied for trade mark could not be registered for the then current specification of:

Non-alcoholic drinks, excluding non-alcoholic beers

but could be registered for:

Fruit juices; mineral and aerated waters; energy drinks

2) The acceptable specification constitutes a limited version of the wider specification and was provided by the applicant's representative during the course of the hearing before me. It was provided as a fall-back specification, in the event that I held that the wider specification was not acceptable. A further term was included in the fall-back specification, but I held that this was not acceptable.

3) I permitted the applicant an opportunity after the hearing to suggest further terms that it felt were also acceptable, albeit within certain constraints. In a letter of response dated 10 June 2014, the applicant indicated that it had nothing further to add to the specification. In view of this, my decision stands as above, in that the application for registration is to be refused, save for the limited goods I have outlined. The only matter that now needs to be resolved is the issue of costs.

4) In relation to costs, the opponent submits that it was successful in relation to the opposition to the application (as it stood) until midway through the hearing when the fall-back position was given. It states that the provision of the fall-back position was very late in the day and does not adhere to the overriding objective. It also highlights that during "without prejudice save to costs" negotiations, the opponent suggested a narrower specification to the applicant which closely mirrored that which the applicant put forward at the hearing; it states that the applicant unreasonably refused to entertain a reduced specification.

5) The applicant's submissions were that each side should bear its own costs. It added that if the opponent were to seek costs in its favour (as it subsequently did) "it reserves its right to refer to without prejudice correspondence that was exchanged prior to the hearing". The applicant did not, though, file anything else by way of submission.

6) The provision of a fall-back specification is, as the name suggests, something to fall back upon if a party's primary position is not upheld. I see nothing unreasonable in the applicant pursuing this case to final decision in relation to what was the current specification, particularly bearing in mind that it had already excluded non-alcoholic beers, goods which will have been the most obviously similar product to the goods of the opponent. This is so notwithstanding that the

parties had been negotiating and that the opponent had, during the course of those negotiations, suggested specification terms which reflect some of those set out by the applicant in its fall-back. However, I note that the fall-back includes terms that were not suggested by the opponent (fruit juices) and there were other issues that the parties were negotiating upon. If the opponent truly felt that the matter could have been resolved along the lines of its earlier proposal, it could have of course have limited the scope of its opposition but it did not do so. It seems to me that the parties tried to settle, but sticking points prevented this and I do not consider either side to be at fault. Of course, I accept the point that it would have been better to provide the fall-back specification earlier, but I do not detect that this will have saved the need for the hearing or decision.

7) All things considered, my decision is that each party should bear its own costs. The appeal period in relation to my substantive decision and this decision on costs commences on the issuance of this supplementary decision.

**Dated this 22nd day of July 2014**

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