

O/621/17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO 754834
TIGERCAT IN THE NAME OF TIGERCAT INTERNATIONAL INC

AND

IN THE MATTER OF AN APPLICATION FOR REVOCATION (NON
USE) BY CATERPILLAR INC

Background

1. On 19th September 2017, I issued a substantive decision in respect of cancellation proceedings No 501155. The outcome being that International Registration No WO754834 for the mark TIGERCAT, should be partially revoked, with the following considered to be a fair specification reflecting the use made:

Class 07:

Forestry machines and parts and components therefore.

Class 12:

Forestry vehicles, namely skidders and forwarders and parts and components therefore.

2. At the hearing, the registered proprietor's representative indicated that it would potentially seek costs off the usual scale. This is because, in its view, the applicant for revocation (a competitor of the registered proprietor), had acted unreasonably in bringing the revocation action as it (according to the registered proprietor) was fully aware that genuine use of TIGERCAT had been made. The registered proprietor requested that it be allowed time to file submissions on costs once the substantive issues had been resolved.
3. Upon issuing the substantive decision, I allowed both parties a period of time in which to file submissions on costs. I have not included a summary of the submissions filed. However, I have fully considered the points raised therein, including the comments made by both parties regarding the strategy and tactics employed during these proceedings. I accept that based upon the evidence filed, it was, arguably, open to the applicant to have conceded that TIGERCAT has been used in respect of some of the goods. That said, the registered proprietor could also arguably have made further concessions

regarding use. It should be noted that during the decision, I explicitly state that drawing a distinction between machines and vehicles is difficult. This, therefore, has not been a straightforward revocation (non use) decision. Considering all the matters in the round, I cannot agree that either party has acted unreasonably during these proceedings. The outcome of the substantive decision fairly reflects the use made of TIGERCAT by the registered proprietor. The specification for which the trade mark is registered is noticeably reduced as a result and it was the applicant's right to challenge the use made as it saw fit. I will not therefore make an award of costs to the registered proprietor.

4. It is clear that the applicant for revocation has been proportionally more successful and as such it is entitled to a contribution towards its costs. I therefore award Caterpillar Inc the amount of £1800. This reflects the proportion of success achieved and is made up of the following elements:

Application for revocation plus statutory fee - £300

Considering evidence - £650

Preparing and filing evidence - £200

Preparation for and attendance at a Hearing - £650

TOTAL - £1800

5. I therefore order Tigercat International Inc. to pay Caterpillar Inc the amount of £1800. This amount should be paid within 14 days of the date of this decision or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful. It should be noted that the appeal period in respect of this decision and that of the substantive decision, dated 19th September 2017, (BL O/440/17) will run concurrently from the date of this costs decision.

O/621/17

Dated this 5th day of December 2017

L White

Louise White

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