

O/810/21

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. UK00003410726 AND UK00003424337

BY GADGETSERVICES.COM LTD

TO REGISTER THE FOLLOWING MARKS:



AND



IN CLASS 25

AND IN THE MATTER OF OPPOSITIONS THERETO

UNDER NOS. 418056 AND 418717

BY THE FOOTBALL ASSOCIATION PREMIER LEAGUE LIMITED

BACKGROUND

1. On 9 March 2021, I issued a provisional decision in the above identified consolidated proceedings.¹ In both oppositions, I found in favour of the opponent under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

2. The mark relied upon by the opponent for the purposes of its opposition based upon section 5(2)(b) of the Act was UK trade mark no. 3356650 for the mark **PREM**. At the time of my decision, the earlier mark was subject to challenge by way of invalidation proceedings (under no. 503641) brought against it by the applicant in this case. As a result, my decision stated:

“CONCLUSION

70. This is a provisional decision because the opponent has only succeeded under section 5(2)(b) of the Act and the earlier mark relied upon is subject to an application for invalidity.

71. When the outcome of the application for invalidity is decided, I will issue a supplementary decision which will include a decision on costs. The appeal period will run from the date of the supplementary decision.

DIRECTION TO THE OPPONENT

72. I direct that the opponent inform me when invalidation application no. 503641 is decided.”

3. On 27 October 2021, the opponent wrote to the Tribunal to confirm that the application for invalidation against the earlier mark had been deemed withdrawn.

¹ O/148/21

SUPPLEMENTARY DECISION

4. Paragraphs 70 to 72, as expressed in my decision of 9 March 2021, are to be replaced as follows:

“CONCLUSION

70. The application for invalidation against the earlier mark has been deemed withdrawn. Consequently, the validity of the earlier mark is no longer in dispute.

71. As a result, the oppositions succeed in their entirety and the applications are refused.

COSTS

72. As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In making this award, I bear in mind that whilst the opponent paid a £200 official fee per opposition, it was only successful under section 5(2)(b) (which would have attracted a lower fee of only £100). I also note that whilst the opponent filed evidence, its evidence did not assist its case. In the circumstances, I award the opponent the sum of **£1,800**, calculated as follows:

Filing Notices of opposition and considering the applicant's counterstatements	£350
Filing evidence and consider the applicant's evidence	£550
Preparation for and attendance at hearing	£700
Official fee (£100 x2)	£200
Total	£1,800

73. I therefore order GadgetServices.com Ltd to pay The Football Association Premier League Limited the sum of £1,800. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.”

5. Taking account of the amendments above, my provisional decision in favour of the opponent dated 9 March 2021 together with the associated award of costs above becomes final, subject to any appeal. The appeal period begins from the date of this supplemental decision.

Dated this 2nd day of November 2021

S WILSON

For the Registrar