O-180-05

IN THE MATTER OF APPLICATION NO. 2287388
IN THE NAME OF RECKITT BENCKISER (UK) LTD

AND IN THE MATTER OF OPPOSITION NO. 90538 THERETO BY ROBERT MC BRIDE LTD

DECISION

---

1. The only issue arising on this appeal is one of costs. On 5 December 2001 Reckitt Benckiser (UK) Ltd (the applicant) applied to register the trade marks CRYSTAL AIR FRESHENER and CRYSTAL. The applications were respectively assigned numbers 2287359 and 2287388.

2. On the 29 April 2002 Robert McBride Ltd (the opponent) filed notices of oppositions to both applications.

3. The matter came on for hearing before Mr Landau, the Hearing Officer acting for the Registrar. By a written decision dated 9 August 2004 he refused both applications. In assessing costs he took into account the effectively identical nature of the statements of grounds and counterstatements. He also took into account the fact that he considered that a large amount of the evidence was not

relevant or lacked focus. He ordered the applicant to pay to the opponent the sum of £1900.

4. On the 21 September 2004 the applicant gave notice of intention to appeal to an Appointed Person under section 76 of the Trade Marks Act 1994.

5. The appeal was listed for hearing before me on the 27 May 2005.

6. On the 20 May 2005 the agents for the applicant wrote advising that the applicant was withdrawing its appeal.

7. By letter dated the 23 May 2005 the opponent now seeks an order for its costs of the appeal in the sum of £2,327.68 which, it says, represent the opponent's costs in respect of agents and counsel's fees. Copies of the relevant debit notes supporting that figure are attached to that letter.

8. I invited the agents for the applicant to provide submissions in response to that request and they have done so by letter dated 13 June 2005. In summary the applicant submits as follows:

    (a) the original award of costs reflected the fact that the opponent had filed evidence in support of the opposition, although much of it was irrelevant, that there had been a hearing and that extensive further written submissions were made after the hearing;
    (b) had the appeal proceeded to a hearing then any award of costs would likely have been in a similar sum to that ordered by the Hearing Officer;
    (c) because of the timely withdrawal of the appeal no significant costs were incurred and any award should therefore be minimal and certainly less that that ordered by the Hearing Officer.

9. Both parties agree that I should reach a decision on this issue without recourse to a hearing.

10. I think it is well established that if an appeal is abandoned then an appropriate order for costs should normally be made in favour of the respondent to the appeal and the applicant does not suggest otherwise. This course has now been followed in many cases before the Appointed Person.

11. In deciding the appropriate award in this case I think the following points are of particular relevance. First, the decision to withdraw the appeal was made only shortly before the hearing.

12. Secondly, I am quite satisfied from the debit notes supplied by the opponent that it has incurred the costs which it claims. Some of those costs relate to preparation by counsel for the appeal and they would not have been incurred had the decision to withdraw the appeal been communicated earlier.

13. Thirdly, it is nevertheless apparent from the debit notes that the costs would have been a good deal higher if the appeal had proceeded to a full hearing.

14. Fourthly, it is normal practice in appeals under section 76 of the Act to draw upon the published scale figures used by the Trade Marks Registry. If the matter had proceeded to a full hearing I would probably have directed the losing party to contribute about £1900 to the costs of the winning party.

15. In all the circumstances I have come to the conclusion that a proportionate sum to award the opponent in respect of the costs of the appeal is £1,300. I therefore direct that the applicant pay that sum to the opponent on a like basis to that ordered by the Hearing Officer.

David Kitchin QC

24 June 2005