O-145-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 2585447
BY DUNCRYNE LTD
TO REGISTER econic & ECONIC
AS A SERIES OF 2 TRADE MARKS

IN CLASSES 17, 19, 20 & 37

AND:

OPPOSITION THERETO UNDER NO. 102696
BY EVONIK INDUSTRIES AG

BACKGROUND

1.On 23 October 2012, I issued an interim decision in these proceedings. In that decision I said:

> "29. Subject to successful registration of EI's trade mark in respect of relevant goods and services, its opposition will succeed in relation to DL's goods and services in classes 17, 19 and 37. Consequently, I cannot give a final decision in relation to these proceedings until EI's EVONIK trade mark is finally determined.
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> 30. I direct that EI advise me within one month of the final determination of its EVONIK trade mark of the outcome of the application. On receipt of this information I will issue a supplementary decision giving a full determination of the opposition proceedings and making an award of costs."

2. In a letter dated 7 March 2013 (but sent to the TMR on 21 March 2013), Elkington & Fife LLP ("EK"), EI's professional representatives in this matter, said:

> "We are writing...to advise that the earlier CTM918426 has now reached the registration stage..."

3. Attached to that letter was a printout obtained from www.oami.europa.eu on 7 March 2013 indicating that IR 918426 (upon which the opposition was based) was published as registered on 1 February 2013; I note the registration retains all of the goods in classes 17, 19 and 37 upon which my earlier comparison of goods was based (paragraphs 14 to 20 of my earlier decision refers).

Outcome of the opposition

4. In view of the above, EI's opposition to DL's goods in classes 17, 19 and 37 succeeds; DL's goods in class 20 which are no longer opposed by EI may proceed to registration.

Costs

5. As EI has been successful, it is entitled to a contribution towards its costs. In reaching a conclusion on costs, I note that in its counterstatement DL said:

> "14...[DL] upon receiving Form TM7A, contacted [EI's] representatives, and [EI's] representatives made no attempt to provide any further details beyond those that were provided in Form TM7A, which provided no information regarding the basis of opposition. This should be taken into account when deciding the level of the award of costs."

6. In his witness statement dated 5 April 2012, Mr Peter Charlton of EK responded to this allegation in the following terms:

> "4. With regard to paragraph 14 of the Counterstatement, what [DL's] attorneys say in the second sentence is not correct. My file includes a contemporaneous handwritten file note of a telephone conversation between myself and Mr Ken Forrest of Duncryne on 31 October 2011. This note reads "he asked if oppo was only to cl.17 (not of interest to them). I said it's probably to 17, 19 and 37 and told him of E918426". In other words, I did inform [DL] of the basis for the opposition."

7. In response to the above, in his witness statement dated 1 June 2012, Mr Forrest said:

> "4...It is my recollection that during the said telephone conversation between myself and Mr Charlton of 31 October 2011, that I asked Mr Charlton to advise me of the basis of the threatened opposition...I was attempting to understand the basis for his client's concerns. In particular, I was trying to ascertain whether his client's concerns were directed only against class 17.
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> 5...I do not know if Mr Charlton was aware that I am a lay person. I found that Mr Charlton was either unwilling or unable to shed any light on the basis of the opposition. He may have mentioned the Community trade mark number that he refers to in his witness statement, but without further explanation, reference to this number alone would not have made meant anything to me at that time. I do not recall Mr Charlton providing any meaningful explanation regarding the basis for his client's concerns.
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> 6. I therefore maintain that my understanding after speaking with Mr Charlton was that he had provided no information beyond that which was available to me on the form TM7A. The information provided was insufficient for me to shed any light on the basis of the threatened opposition, in particular his client's concerns."

8. In its submissions EI said:

> "5. [EI] has shown that it did advise [DL] of the basis of the opposition before that opposition was filed, and therefore it cannot be penalised in costs on this point. Although [EI] has belatedly withdrawn its opposition in respect of class 20, it appears that this had no effect on [DL's] handling of the matter and therefore is equally irrelevant as regard costs. We think that costs should follow the decision in the normal way."

9. There is no dispute that prior to filing the Form TM7 on 24 November 2011, EI filed a Form TM7a on 24 October 2011 and, on 31 October 2011, Mr Charlton of EK spoke to Mr Forrest of DL regarding the basis of EI's opposition. Mr Forrest accepts that during that conversation Mr Charlton "may have mentioned" EI's earlier trade mark; this accords with Mr Charlton's account of their telephone conversation. Although there appears to have been some confusion surrounding the state of Mr Forrest's knowledge during that telephone conversation, it appears to me, in view of the contents of Mr

Charlton's contemporaneous file note (which is mentioned in his witness statement but which has not been provided in evidence), that at the conclusion of that conversation Mr Forrest should have understood, even if the significance of the trade mark number provided by Mr Charlton did not advance matters, that at that point EI's opposition was likely to be directed at DL's goods and services in classes 17, 19 and 37. The position is, therefore, that prior to launching its opposition, EI filed a Form TM7a, the parties discussed, and EI indicated the scope of its potential opposition, and having received the Form TM7 DL chose to defend its position. In those circumstances, I think EI is entitled to a contribution towards the cost of preparing Mr Charlton's witness statement and reviewing Mr Forrest's witness statement in response. However, in awarding costs in this regard, I will bear in mind the operative parts of both parties' witness statements i.e. one paragraph in Mr Charlton's statement and four paragraphs in Mr Forrest's statement in reply.

10. I will also keep in mind that while in its notice of opposition EI opposed all of the goods in DL's trade mark and relied upon all of the goods present in its earlier trade mark, in its written submissions it withdrew its opposition to DL's goods in class 20 and limited the goods upon which it relied to those in classes 17, 19 and 37. However, given the manner in which DL approached these issues in both its counterstatement and written submissions, these are not factors which, in my view, are likely to have increased DL's costs to any significant extent. Bearing all the above in mind, I award costs to EI on the following basis:

Preparing a statement and considering DL's statement:	£300
Preparing evidence and considering DL's evidence:	£100
Written submissions:	£300
Official fee:	£200
Total:	**£900**

11. I order Duncryne Ltd to pay to Evonik Industries AG the sum of £900. 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. The period for appeal against the interim decision runs concurrently with the appeal period for this supplementary decision.

Dated this 8th day of April 2013

C J BOWEN
For the Registrar

The Comptroller-General