TRADE MARKS ACT 1938 (AS AMENDED)

AND TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 1560688 BY DANIEL FINZI & CO. (SUC.) LIMITED

AND

IN THE MATTER OF OPPOSITION NO. 42556 THERETO BY SEAGRAM UNITED KINGDOM LIMITED

TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994

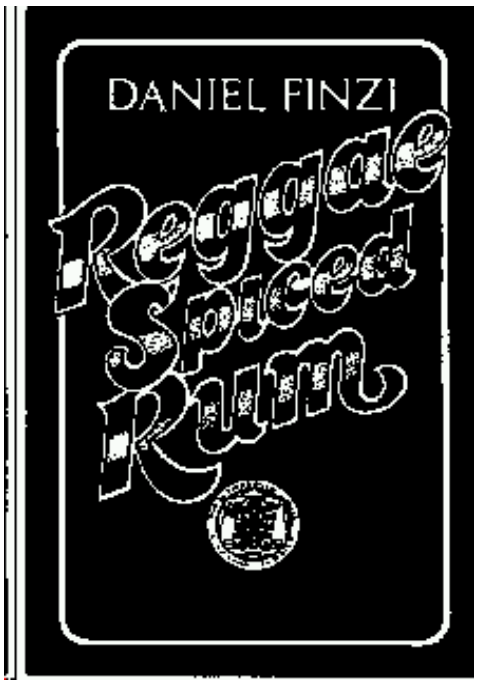
IN THE MATTER OF Application no 1560688
by Daniel Finzi & Co. (Suc.) Limited

and

IN THE MATTER OF Opposition no 42556 thereto
by Seagram United Kingdom Limited

BACKGROUND

On 29 January 1994, Daniel Finzi & Co. (Suc.) Limited of 234 Spanish Town Road, Kingston 11, Jamaica, West Indies, applied under Section 17(1) of the Trade Marks Act 1938 to register the trade mark shown below in Class 33.



The application proceeded to advertisement in Part A of the register in respect of the following specification of goods:-

> " Alcoholic beverages; all included in Class 33".

The advertisement of the mark also included the following variation clause:-

> In use in relation to goods covered by the specification other than spiced rum, the mark will be varied by the substitution of the name and description of such goods, for the words spiced rum.

On 22 May 1995, Seagram United Kingdom Limited filed notice of opposition against the application. The grounds of opposition are in summary:

1. Under Section 11 of the Act, because the label mark the subject of the application contains the word SPICED in the centre of the label, and use of the trade mark would be likely to deceive or cause confusion, given the opponents use of the mark SPICED since at least 1983, and the mark MORGAN'S SPICED since at least 1991, both of which have been used in connection with a rum based drink.

2. Under Section 12(1) of the Act, because of the opponents earlier trade marks (specify numbers and marks).

3. Under Section 17(1) of the Act, because the applicants cannot claim to be the proprietors of the trade mark in suit, and registration would constitute a serious interference with the legitimate conduct of the opponents business.

The applicants filed a counter-statement in which they admit the presence of the word SPICED in their application, and to the existence of the opponents earlier registrations, although they make no admission as to the validity of these registrations, and deny the grounds of opposition.

Both parties filed evidence in these proceedings, and the matter came to be heard on 3 November 1999, when the applicants were represented by Ms McFarland of Counsel instructed by J E Evans Jackson & Co. The opponents were represented by Mr Speck of Counsel instructed by R G C Jenkins & Co.

By the time the matter came to be heard the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later part of this decision are references to the provisions of the old law.

DECISION

At the start of the Hearing, I was informed by Mr Speck that the opponents did not intend to pursue this opposition. While Ms McFarland accepted that any limitation of the issues before the Registrar was desirable, given that this was the first notice the applicants had of the opponents intentions, she doubted that the opponents would object to an order of costs against them. In this regard, given the lateness of the notice not to pursue this opposition, and the evidence filed and preparation time involved, she asked for a higher level of costs to be awarded.

Mr Speck resisted this request. He commented that his narrowing of the issues was consistent with the reforms suggested by Lord Woolf, and as a result of this action, the Hearing had been shorter. He added that rather than be penalised for this approach, this narrowing of the issues should be encouraged.

Having considered both sides submissions, I of course agree that any narrowing of issues between the parties is always desirable. However, I note that the opponents' evidence in reply was filed in September 1997, so there has been ample time for them to withdraw this opposition. With that in mind, and given that the opposition as a totality was withdrawn, and at such a late stage in the proceedings, I do think it is appropriate to make an award of costs to the applicants, from the scale, on the basis that they won this undefended action.

I therefore direct the opponents pay to the applicants the sum of £700 as a contribution towards their costs.

Dated this 14 Day of February 2000

M Knight
For the Registrar
The Comptroller General