

TRADE MARKS ACT 1994

IN THE MATTER OF  
APPLICATIONS NO. 2051132A AND 2051132B BY RICHMOND COLLEGE, THE  
AMERICAN INTERNATIONAL UNIVERSITY IN LONDON INC. TO REGISTER A  
SERIES OF TRADE MARKS IN CLASSES 16, 25 AND 41

AND IN THE MATTER OF  
OPPOSITIONS THERETO UNDER NOS. 49471 AND 49211 BY THE AMERICAN  
COLLEGE IN LONDON LIMITED

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DECISION

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1. In January 1996 Richmond College, The American International University in London Inc. (“the Applicant”), made two applications, each to register a series of four trade marks. In February 1999 The American College in London Limited (“the Opponent”) filed notice of opposition to those applications.
2. The oppositions proceeded to a hearing which took place in July 2001 before Mr. Salthouse, the Hearing Officer acting for the Registrar. By written decisions dated the 2nd October 2001, Mr Salthouse concluded that the oppositions failed. He ordered the Opponent to pay to the Applicant the sum of £1235 in respect of each of the oppositions, as a contribution towards its costs.

3. On the 30th October 2001 the Opponent served a joint Notice of Appeal, together with accompanying Statement of Grounds of Appeal in respect of the two applications.
4. The appeals were due to be heard on the 21<sup>st</sup> February 2002. By letter dated the 13<sup>th</sup> February the Opponent indicated that the appeals were abandoned. The letter was sent to the Applicant by facsimile.
5. Following the abandonment of the appeals the Applicant has sought an additional order for costs. That request has been contested by the Opponent. The parties have each made written submissions on the question of costs and have agreed that I should deal with the question on the basis of those written submissions and without an oral hearing.
6. The Applicant has submitted that before the appeals were abandoned it had made significant steps to prepare for the hearing. Counsel was instructed, skeleton arguments were prepared, the Opponent's arguments were reviewed and the instructions of the Applicant were sought. It submits that significant costs were thereby incurred. I have not, however, been provided with details of them.
7. The Opponent has submitted that no order for costs is appropriate because the Applicant was given nine days notice of the abandonment of the appeals and that preparation for a hearing would not ordinarily have begun that far in advance of the set date.
8. I believe that where an appeal is abandoned an appropriate order for costs should normally be made in favour of the respondent to the appeal, and I so indicated in my related decision concerning application no. 2171448. This practice has now been followed in a number of cases before the Appointed

Person (see, for example, *VFM's Application*, a decision of Mr Hobbs Q.C., dated the 12<sup>th</sup> June 2002).

9. In the present case I believe that the Applicant did behave reasonably in preparing for the appeal. It seems to me that nine days is a relatively short time before the hearing of the appeal, and that by that time it was appropriate to have instructed Counsel, considered the merits of the appeal and begun to prepare for the hearing. Accordingly I am unable to accept the submission of the Opponent that no order for costs should be made because of the degree of notice given. I do accept, however, that it is not suggested that the Applicant had completed preparations for the hearing and that the costs of the hearing itself were avoided.
10. On appeal it is customary for the Appointed Person to have regard to the practice in the Registry of using published scale figures as a norm, to be adopted or departed from as the case may require. I have noted that in the present cases Mr Salthouse awarded to the Applicant £1235 in respect of each of the oppositions. I also believe that I should take account of the fact that the appeals were dealt with by way of a joint Notice and Grounds of Appeal and that the appeals must therefore have been approached and dealt with by the Applicant on that basis.
11. In all the circumstances I have come to the conclusion that a total of £500 is a reasonable and proportionate sum to award to the Applicant in respect of the two abandoned appeals. I therefore direct that the Opponent pay to the Applicant that sum in respect of the joint appeals on a like basis to that ordered by Mr Salthouse.

David Kitchin QC

17<sup>th</sup> January 2003