

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION No. 965230
IN THE NAME OF TRI-COSTAL DESIGN GROUP INC**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER No. 71909
BY JOOP! GMBH**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY THE OPPONENT
AGAINST A DECISION OF MR CJ BOWEN
DATED 14 MAY 2010**

DECISION

1. On 7 May 2008, Tri-Costal Design Group Inc. (“the Applicant”) requested the extension of protection in the United Kingdom for International Registration number 965230 concerning the trade mark represented below in respect of handbags in Class 18:

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2. Following publication in the Trade Marks Journal, the conferring of protection was opposed by JOOP! GmbH (“the Opponent”) on 19 January 2009. The ground of opposition was under section 5(2)(b) of the Trade Marks Act 1994 on the basis of the Opponent’s earlier Community trade mark number 003665114 - JOOP! - registered in Class 18 for goods including handbags.
3. There was no evidence but both sides filed written submissions. Neither party requested an oral hearing and the opposition was decided on the papers.
4. Mr. Bowen, acting for the Registrar, issued his written decision on 14 May 2010 under reference number BL O/150/10 rejecting the opposition under section 5(2)(b) and awarding the Applicant the sum of £400 towards its costs.
5. On 10 June 2010, the Opponent filed Notice of appeal to the Appointed Person under section 76 of the Act. The appeal was listed to be heard before me on 3 November 2010 but moved to 17 December 2010 to accommodate the availability of the Opponent’s Counsel.

6. I duly heard the appeal on 17 December 2010 when Ms. Anna Edwards-Stuart of Counsel appeared on behalf of the Opponent and Mr. Simon Malynicz of Counsel appeared on behalf of the Applicant. I was supplied with skeleton arguments and an agreed bundle of authorities, and each Counsel was accompanied by a representative from their instructing attorneys, Boulton Wade Tennant and Birketts LLP respectively.
7. By letters dated 23 December 2010, Boulton Wade Tennant wrote to the Treasury Solicitor's Office and the Registrar withdrawing the appeal on behalf of the Opponent.
8. Unsurprisingly due to the Christmas break, I was first informed of this by the Treasury Solicitor's Office by email on 4 January 2011.
9. On 18 January 2011, the Applicant requested an award of costs since no agreement had been reached between the parties regarding the withdrawal of the appeal. That was accompanied by a written itemised summary of the Applicant's appeal costs on 19 January 2011.
10. The Opponent provided me with written comments on the Applicant's costs summary on 24 January 2011.
11. Whilst not denying the Applicant's entitlement to a costs award, the Opponent made the following points, in brief:
 - (i) Costs should be on the standard scale.
 - (ii) The appeal was withdrawn on 23 December 2010, i.e., four working days after the hearing.
 - (iii) The Applicant originally indicated that it would not attend or be represented at the hearing but reversed that decision on 8 December 2010.
 - (iv) Applicant's Counsel's fee was high in view of the limited time and brief skeleton submissions.
 - (v) The additional time of the Applicant's agent in travelling to and attending the hearing should be disregarded together with the time spent in seeking this award.
12. Finally, the Opponent reminded me that costs in Registry proceedings were intended to be contributory and drew my attention to the Appointed Person decisions of *IT'S FRIDAY*, BL O/005/10 and *SOUTH BECK*, BL O/160/08 where the costs awards were £500 and £291.75 respectively. Be that as it may, in *IT'S FRIDAY* the appeal was withdrawn before the hearing and in *SOUTH BECK* the successful party was a litigant in person to whom special rules applied.
13. In my judgment, the Applicant is entitled to receive a costs award in its favour not least because the appeal was withdrawn *after* the hearing necessitating what turned out to be unnecessary attendance/representation. Clearly, I had an opportunity to review the Hearing Officer's decision and the grounds of/arguments on appeal, and it seems to me that the decision to pull the appeal could and ought sensibly to have been made at a much earlier stage.

14. The Applicant has included a claim for £640 for reporting/advice on the appeal, and briefing Counsel to attend the hearing. The grounds of appeal were quite short and I am prepared to allow £200 for this stage. The hearing lasted a little over one hour and I agree that Counsel's fee was therefore on the high side. I will allow £800 in respect of Counsel's attendance at the hearing and preparation of the skeleton argument. As the Applicant's attorney accepted, her additional attendance at the hearing was strictly unnecessary and I make no allowance in that respect.
15. To conclude, I will order JOOP! GmbH to pay Tri-Costal Design Group Inc. the sum of £1000 as a contribution towards its costs of the abandoned appeal, such sum to be paid together with the costs awarded by Mr. Bowen within 28 days of my decision.

Professor Ruth Annand, 2 February 2011