

O/127/12

TRADE MARKS ACT 1994

SUPPLEMENTARY DECISION ON COSTS

**IN THE MATTER OF AN APPLICATION (No 83407) BY
THE GASTRIC BALLOON CENTRE LTD
TO INVALIDATE TRADE MARK REGISTRATION 2496089 IN THE NAME OF
BARIATRIC SURGERY GROUP LIMITED
IN RESPECT OF THE MARK:**

**National Gastric Balloon Centre &
National Obesity Surgery Centre**

THE BACKGROUND AND THE PLEADINGS

1) On 20 January 2012 I issued a substantive decision in these proceedings in which I refused an application for a declaration of invalidity in respect of the subject registration. In relation to costs I stated:

“49) At the end of the hearing I agreed with the parties that an opportunity would be provided to make written submissions in relation to costs. The proceedings have a chequered history, so such submissions should reflect at least the following points:

The proprietor’s late evidence;

The applicant’s late challenge to the proprietor’s late evidence;

The additional ground of opposition (which was unsuccessful) and the request for disclosure;

The failure to comply with my direction regarding disclosure in a timely and appropriate manner.

The cross-examination of Mr Ali.

The outcome of the decision.”

50) I will allow a period of 28 days from the date of this decision in order for written submissions on costs to be made. I will then issue a supplementary decision dealing with the costs issue. The appeal period for this substantive decision will run concurrently with the appeal period for my decision on costs.”

2) Both parties accepted the invitation to file written submissions on costs. On behalf of the applicant, it was submitted that there was no reason to depart from the standard scale. It highlighted some of the above factors and submitted, effectively, that they balanced each other out. It added that the cross-examination it pursued of the proprietor’s witness is unlikely to be exceptional in terms of costs and that cross-examination in bad faith cases is usually necessary and important to enable a decision to be reached. The proprietor’s submissions focused on the fact that it had been successful and, that it not only sought its scale costs, but that costs off the scale should be awarded. The off scale claim is made on the basis of what is said to be an unreasonable addition of a section 3(6) ground and a subsequent request for disclosure which is described as a fishing exercise, the disclosure request was also said to have been blown out of proportion in respect of comments made about the manner in which it had been met. In terms of the proprietor’s late evidence, it accepts that this was late but that the applicant was not prejudiced by it and it is within the scope of the typical

type of conduct before the tribunal. It also accepts that there was nothing wrong, specifically, in the applicant's request to cross-examine the proprietor's witness.

3) As I stated in my substantive decision, the proceedings have a chequered history. Whilst I note and bear in mind what the proprietor states regarding the section 3(6) claim and the request for disclosure, I agree with the applicant that both sides have contributed in roughly equal ways to the less than satisfactory manner in which the proceedings progressed. All things considered, I agree that matters have balanced each other out. I will, therefore, make my assessment with regard to the standard scale. In terms of the cross-examination of Mr Ali, I make no specific award in relation to this. Although Mr Ali was on the "winning" side, I found the most helpful part of his cross-examination to relate to the lack of goodwill on the part of the winning side. In view of all this, I hereby order Gastric Balloon Centre Ltd to pay Bariatric Surgery Group Limited the sum of £2400. This is calculated as follows:

Preparing a statement and considering the other side's statement - £400

Filing and considering evidence - £1000

Attending the hearing - £1000

4) The above sum should 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 appeal period in relation to this supplementary decision will run concurrently with my earlier substantive decision.

Dated this 22nd day of March 2012

**Oliver Morris
For the Registrar
The Comptroller-General**