

O-017-15

TRADE MARKS ACT 1994

SUPPLEMENTARY DECISION

**IN THE MATTER OF JOINT APPLICATION Nos.84681, 500050 & 500049
BY OLD KENTUCKY RESTAURANTS LIMITED & G&T ON THE ROCK LIMITED
FOR THE REVOCATION OF TRADE MARK Nos. 2441805, 2427924 & 2441804
STANDING IN THE NAME OF
SOUTHERN GRAIN SPIRITS NZ LIMITED**

AND

**IN THE MATTER OF REGISTRATION Nos. 2441804, 2441805 & 2472924
STANDING IN THE NAME OF
SOUTHERN GRAIN SPIRITS NZ LIMITED**

AND

**IN THE MATTER OF JOINT REQUESTS FOR DECLARATIONS
OF INVALIDITY THERETO UNDER Nos. 500133, 500134 & 500135
BY OLD KENTUCKY RESTAURANTS LIMITED & G&T ON THE ROCK LIMITED**

AND

**IN THE MATTER OF APPLICATION No. 2627784
BY OLD KENTUCKY RESTAURANTS LIMITED
TO REGISTER THE TRADE MARK
NICHOLSON'S
IN CLASSES 32, 35 & 43**

AND

**IN THE MATTER OF OPPOSITION
THERETO UNDER No. 104197 BY
SOUTHERN GRAIN SPIRITS NZ LIMITED**

AND

**IN THE MATTER OF APPLICATION No. 3019256
BY G&T ON THE ROCK LIMITED
TO REGISTER THE TRADE MARK
LAMPLIGHTER
IN CLASS 33**

AND

**IN THE MATTER OF OPPOSITION
THERETO UNDER No. 401357 BY
SOUTHERN GRAIN SPIRITS NZ LIMITED**

1) On 8 December 2014 I issued decision O-520-14 which found mostly in favour of Old Kentucky Restaurants Ltd and G&T on the Rock Limited (hereinafter OKGT). At the hearing it was agreed that the decision would be issued and that both parties would then have the opportunity to provide written submissions on costs.

2) Only OKGT have provided comments. Southern Grain Spirits NZ Ltd (hereinafter SGS) chose to write in asking for a copy of the transcript and raising other issues not connected with the issue of costs.

3) Turning firstly to the revocation actions, I found that the defence offered by SGS in relation to the earthquakes in New Zealand were not valid reasons for non-use. It was clear that the distillery had not been damaged at all, but this was only ascertained by OKGT carrying out investigations. The other defence put forward under the revocation actions involved a sham promotional visit to the UK which required OKGT to carry out a considerable amount of work looking into the claims of SGS and also the cross examination of Mr Fitzpatrick who prevaricated throughout the cross examination making it considerably longer than if he had been totally open and honest in answering the questions put to him.

4) I now turn to the invalidity actions which were based upon section 3(6) and 5(4)(a). At the hearing Mr Fitzpatrick admitted that, at the time of his company applying for the marks in question, he was aware that a portion of the UK population was aware of the brands LAMPLIGHTER and NICHOLSON'S. I therefore found that SGS had acted in bad faith and that as the marks had residual goodwill there had been an attempt at passing off.

5) In respect of the two oppositions, these for the most part, failed. OKGT point out that the various claims made by SGS had to be investigated and for the most part were found to be false or sham. Most pertinently they point out that SGS acted in bad faith and thus an award of costs above the normal scale is justified. They provide the following breakdown:

Consultations with the attorneys on behalf of G&T regarding the actions to be taken to deal with the evidence of SGS	£4,930
Various consultations with Counsel and attorneys regarding the evidence necessary to answer SGS' evidence, the need for investigations to be carried out, consideration of what the evidence needed to cover	£11,470
Commission investigations into the activities of SGS	£14,215
Further collation and drafting of all the above into evidence for use in relation to the subject proceedings	£8,540
Attendance at the hearing by Counsel and representatives of OKGT	£21,045
TOTAL	£60,200

6) Whilst I accept that the actions of SGS caused additional work I do not accept that all of the work shown in the costs above would be regarded as over and above what is required in a normal case, where costs on the Registry scale would be awarded as a

contribution to the costs incurred. Undoubtedly the efforts of SGS to avoid its marks being revoked by claiming to have been affected by earthquakes, staging a sham promotional tour of London hostelrys caused considerable additional costs, not least the investigation of his tour and the people involved but also in the very necessary cross examination which unpicked the story being promoted by SGS. I therefore award OKGT jointly £40,000.

7) I order Southern Grain Spirits NZ Ltd to pay Old Kentucky Restaurants Ltd and G&T on the Rock Limited, jointly, the sum of £40,000. This sum 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 parties have 28 days from the date of this decision to appeal either or both the substantive decision issued earlier or this costs decision.

Dated this 14th day of January 2015

**George W Salthouse
For the Registrar,
the Comptroller-General**