

O/012/21

TRADE MARKS ACT 1994

SUPPLEMENTARY DECISION

IN THE MATTER OF REGISTRATION NO. UK00003354360

IN THE NAME OF SENSO-REX LTD

FOR THE FOLLOWING TRADE MARK:

GRAVITY

IN CLASS 10

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 502497 BY GRAVITY PRODUCTS LLC

BACKGROUND

1. On 25 September 2020, I issued a provisional decision in the above identified proceedings.¹ The applicant was successful in its application for invalidation based upon sections 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 only.
2. The marks relied upon by the applicant for the purposes of those grounds of opposition were:

GRAVITY

IR designating the EU no. 1410443

G R A V I T Y

IR designating the EU no. 1410681

(together “the earlier marks”)

3. At the date of my decision, the earlier marks relied upon by the applicant had not been granted protection in the European Union. In my decision, I stated:

“CONCLUSION

99. This is a provisional decision because the earlier marks relied upon have not yet achieved protection and the application for invalidation has succeeded only on the basis of sections 5(2)(a) and 5(2)(b) of the Act.

100. When the status of the earlier marks changes to protected or refused, wholly or partially, I will issue a supplementary decision which will include a decision on costs. The appeal period will run from the date of the supplementary decision.

¹ O/474/20

DIRECTION TO THE APPLICANT

101. I direct that the applicant inform me when the status of the earlier marks changes to protected or refused, wholly or partially.”

4. On 14 December 2020, the applicant wrote to the Tribunal to confirm that the earlier marks had been successfully registered and granted protection in the European Union.²

SUPPLEMENTARY DECISION

5. Paragraphs 99 to 101, as expressed in my decision of 25 September 2020, are to be replaced as follows:

“CONCLUSION

99. The application for invalidation has been successful and the Contested Mark is hereby declared invalid in respect of all goods for which it is registered. Under section 47(6) of the Act, the registration is deemed never to have been made.

COSTS

100. As the applicant has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£1,200**, calculated as follows:

Filing a Notice of invalidation and considering the proprietor’s counterstatement	£300
--	------

² Although the UK has now left the EU, as these proceedings were commenced before 31 December 2020 (and, indeed, the preliminary decision was issued before that date), the UK’s departure from the EU does not impact upon the applicant’s ability to rely upon these marks.

Filing evidence and considering the proprietor's evidence	£600
Written submissions in lieu	£200
Official fee	£100 ³
Total	£1,200

101. I therefore order SENSO-REX LTD to pay Gravity Products LLC the sum of £1,200. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.”

6. Taking account of the amendments above, my provisional decision in favour of the applicant dated 25 September 2020 together with the associated award of costs above, becomes final subject to any appeal. The appeal period begins from the date of this supplemental decision.

Dated this 7th day of January 2021

S WILSON
For the Registrar

³ Although the official fee paid was £200, as the applicant was only successful in relation to the 5(2)(a) and 5(2)(b) grounds I only consider it appropriate to award £100 in respect of the official fee.