

O-005-10

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2278584 by Associated Newspapers Limited to register the trade marks IT'S FRIDAY! and ITS FRIDAY in Class 16

AND IN THE MATTER OF OPPOSITION thereto under No 93787 by Christopher Alan Simpson

ON APPEAL from the decision of Mr Edward Smith dated 17 July 2009

DECISION

1. On 21 August 2001, Associated Newspapers Limited applied to register a series of two trade marks in Class 16, namely IT'S FRIDAY and IT'S FRIDAY!. The application was published on 1st July 2005.
2. On 3rd October 2005, Mr Christopher Simpson filed a notice of opposition based on grounds under section 5 (1) and (2) and relying in particular upon his earlier Community trade mark registration No. 1425446 for the mark "ITSFRIDAY".
3. The opposition proceeded to a hearing before Mr Edward Smith on behalf of the Registrar on 14th May 2009. Mr Smith produced a written Decision dated 17th July 2009, in which he upheld the opposition in its entirety and also refused a stay sought by the applicant pending the hearing of its own application for revocation of Mr Simpson's CTM.

4. On 14th August 2009, the applicant lodged a form TM55 attaching Grounds of Appeal apparently running to 16 paragraphs, on two pages. I say "apparently", because the copy of the Grounds of Appeal in my bundle includes only the second of those pages. For present purposes, I do not think that this apparent omission matters.
5. The appeal was listed for a hearing before me on 21st December 2009, but on the 9th December Messrs Haseltine Lake, who act for the applicant in this matter, wrote to all concerned to say that their client wished to withdraw the appeal.
6. That left outstanding the issue of the opponent's costs of the appeal. I understand that there had been some discussions or negotiations between the parties prior to the applicant's withdrawal of its appeal, but these did not resolve the question of the costs of the appeal. The opponent's trade mark attorney sought payment of Mr Simpson's costs and provided me with a set of fee notes showing the amounts incurred.
7. Haseltine Lake made some submissions in relation to the costs claimed, which did not dispute liability for costs in principle, but argued that costs awarded should be scale costs, there being no reason for an award of costs off the scale.
8. It seems to me that it is plainly right that the applicant should pay the opponent an appropriate sum as a contribution to the costs of the appeal which the applicant has now abandoned. I have read carefully the correspondence which has been provided to me by both sides' trade mark attorneys, and I accept the applicant's attorney's submissions that there are no grounds shown for an award of costs of the scale in this case. In particular, the mere fact that the appeal was abandoned prior to the

hearing does not itself justify any higher level of costs than that which might have been awarded had the hearing proceeded.

9. The documentation supplied by the opponent's attorney, which includes fee notes, shows that both she and counsel had spent time considering the merits of the appeal prior to 9th December. Some small sums may also have been spent before that date towards preparation for the hearing of the appeal. Other sums, however, seem to me to have related to the discussions between the parties, rather than to preparation for the appeal.
10. In the circumstances, it seems to me to be appropriate for the applicant to make a contribution towards the opponent's costs in the sum of £500. I will order the applicant to pay that sum, together with the costs awarded by Mr Smith, by 5 pm on Tuesday 19th January 2010.

Amanda Michaels
11 January 2010