

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION
Nos 1281471, 1521713 and 1521717 IN THE NAME OF
GROUPEMENT CARTE BLEU**

AND

**IN THE MATTER OF REVOCATION PROCEEDINGS
THERETO BY CB RICHARD ELLIS INC UNDER
REVOCATION Nos 12212, 12281 and 12282**

TRADE MARKS ACT 1994

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Nos 181471, 1521713 and 1521717 in the name of
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**IN THE MATTER OF Revocation proceedings
thereto by CB Richard Ellis Inc under Revocation
Nos 12212, 12281 and 12282**

DECISION

1. My decision in respect of the above set of proceedings was issued on 23 November 2001. Following written and oral submissions by the parties I determined that the registered proprietors' opposition to all the applications for revocation was deemed to be withdrawn because evidence of use of the trade marks in suit, by the registered proprietor or with his consent by others, as required by the Act and Rules, had not been filed. However, in giving my decision I reserved the matter of costs and allowed the parties a period in which to submit written comments as to whether and to whom costs should be awarded.
2. The registered proprietor, Groupement Carte Bleu, has not submitted any comments. The applicants for revocation, CB Richard Ellis Inc, through their representatives, Field Fisher Waterhouse in a letter dated 27 November 2001 did submit comments seeking costs off the scale in the sum of £7,888. I have taken these comments into account in reaching the decision set out below.
3. It is clear from the decision in Rizla's Application [1993] RPC 365 that the Registrar has the discretion to award costs to any party in proceedings before her. Though that was a case decided under the Patents Act 1977 I see no difference between the statutory provisions there and those in the Trade Marks Act 1994. That said, it has been for sometime and remains so that costs in all proceedings before the Patent Office are normally awarded by reference to a scale of costs (see Tribunal Practice Notice TPN 2/2000). However, that Notice states that there are circumstances in which a Hearing Officer will depart from the scale if appropriate. Paragraph 9 of that Notice states:-

"9. It would be impossible to indicate all of the circumstances in which a Hearing Officer could or should depart from the scale of costs; indeed it would be wrong to attempt to fetter his or her discretion in such a way. The overriding factor is to act judicially in all the facts of a case. That being the case, it is possible to conceive of examples. A party seeking an amendment to its statement of case which, if granted,

would cause the other side to have to amend its statement or would lead to the filing of further evidence, might expect to incur a costs penalty if the amendment had clearly been avoidable. In another example, the costs associated with evidence filed in respect of grounds which are in the event not pursued at the main or substantive hearing might lead to an award which departs from the scale. Costs may also be affected if a losing party unreasonably rejected efforts to settle a dispute before an action was launched or a hearing held, or unreasonably declined the opportunity of an appropriate form of Alternative Dispute Resolution (ADR). A party's unnotified failure to attend a hearing would also be a relevant factor."

4. Field Fisher Waterhouse submitted that the registered proprietor in these cases knew at all times that they were not in a position to prove use of their trade marks and this was borne out by the nature of the material filed by the proprietor's agents on 15 June 2001 (downloaded internet material which was not sufficient to show use of their trade marks during the relevant five year period). Accordingly, the registered proprietors were not in a position to maintain their case. Thus they could not have had a genuine belief that there was an issue to be tried. Had the registered proprietors simply not filed their Form TM8 and Counterstatement there would have been a summary judgment and it would not have been necessary for the applicants for revocation to pursue this matter to the preliminary hearing on 7 November 2001. The applicants therefore request that costs be awarded off the scale in line with the decision of *Rizla Limited's Application* [1993] RPC 365 where on page 377 of his judgment, Anthony Watson QC, sitting as a Deputy Judge of the High Court, stated:

"I believe a case such as the present can only be regarded as exceptional if it can be shown that the losing party has abused the process of the Comptroller by commencing or maintaining a case without a genuine belief that there is an issue to be tried".

5. I have to say that I do not consider that the registered proprietors', or their representatives' actions suggest that they had no belief that there was an issue to be tried. All the indications are to the contrary. They did file a defence; they did file material which they claimed showed use of the trade marks; they did provide written submissions in support of their claim. The fact that I held that the material filed on the instructions of the registered proprietors' French instructing attorneys was not evidence of use in the relevant period and that the instructing attorneys were misguided in asking Marks & Clerk to compile such material does not, in my view, mean that I should infer that they considered there was no issue to be tried. The applicants' submissions on the point are therefore rejected.

6. On the basis of all of the facts before me I see no reason to depart from the Comptroller's Scale of Costs which would suggest the applicants should be awarded the following:

Fee for Application for Revocation (x 3)	£ 600
Perusing registered proprietors Counterstatement and evidence of use (x 3)	£ 600
Attendance at Preliminary Hearing	£ <u>200</u> £1400

7. However, in view of the novel nature of the issues I accept that some greater than usual preparations might have been necessary by the applicants. Thus a further £300 is added to the above for this work.

8. I order the registered proprietors Groupement Carte Bleu to pay to the applicants for revocation, CB Richard Ellis Inc, the sum of £1700. This sum is to be paid within 7 days of the date of this order or within 7 days of the final determination of this issue in the event of an unsuccessful appeal.

Dated this 17 day of January 2002

M KNIGHT
For the Registrar
the Comptroller-General