

O-053-06

**TRADE MARKS ACT 1994**

**SUPPLEMENTARY DECISION**

**IN THE MATTER OF APPLICATION No. 761893  
BY MULLER & EILBRACHT B.V.  
TO REGISTER THE TRADE MARK  
REPORT COLLECTION  
IN CLASSES 3, 14, 18 & 25**

**AND IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 70738  
BY FIN.ING S.R.L.**

## BACKGROUND

1) On 7 January 2004 Dr Trott issued a provisional decision in relation to this opposition. The decision was provisional as the final outcome depended upon the registration of a Community Trade Mark application.

2) In the original decision Mr Trott stated the following:

“57. As I have said, this decision has a provisional element to it. But it is final where based on the opponent’s UK registrations. The opposition to the applicant’s mark is thus successful in relation to the goods in Class 25, but fails in respect of the goods in Class 3:

‘Cosmetics, soaps, perfumery, essential oils, deodorants for personal use, sun tanning preparations.’

58. However, it should be noted that the opponent’s success for:

Class 14: ‘Precious metals and their alloys and goods in precious metal or coated therewith, not included in other classes’ and

Class 18: ‘.umbrellas, parasols and walking sticks; whips, harness and saddlery’

depends on their CTMs. This part of my decision is an interim one: if CTM No. 1731389 fails to proceed to registration, the above goods will be added to the following for which the application here is allowed to proceed, that is for the Class 3 goods. It is the responsibility of the parties, in particular opponent, to inform me of the fate of the CTM applications. I will then produce a final decision on this element of my judgment, where I will also determine the issue of costs (see below).”

3) The opponent’s CTM 1731389 has now been registered for, inter alia:

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

4) The opposition is therefore also successful in relation to the following items::

In Class 14: Precious metals and their alloys and goods in precious metal or coated therewith, not included in other classes.

In Class 18: Umbrellas, parasols and walking sticks; whips, harness and saddlery.

5) In his original decision Dr Trott did not determine costs. In his decision he said:

“59. As I have stated, owing to the provisional nature of elements of my decision, I will refrain from making a costs order at this stage. However, I want to make the following comments in relation to costs.

60. Ms. McFarland cited the withdrawal of the grounds under s. 5(4) and 5(3) the day before the hearing as something that should be factored into the costs assessment. I note from her skeleton argument that significant effort had been expended by the applicant in dealing with these withdrawn grounds. I think Ms. MacFarland is right in this: in particular, the ground under s. 5(3) was never supportable, and should have been withdrawn at an early stage. I will make a costs order as part of my finalised decision when the fate of the CTMs is known.”

6) As the opponent was successful it is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £900. 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.

**Dated this 20<sup>th</sup> day of February 2006**

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