

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**OPPOSITION No. 93972**

**IN THE NAME OF FIANNA FAIL**

**TO TRADE MARK APPLICATION No. 2396543**

**IN THE NAME OF PATRICK MELLY**

**AND IN THE MATTER OF:**

**OPPOSITION No. 93974**

**IN THE NAME OF FINE GAEL**

**TO TRADE MARK APPLICATION No. 2396544**

**IN THE NAME OF PATRICK MELLY**

---

**SUPPLEMENTARY DECISION**

---

1. I upheld the above-mentioned oppositions to the above-mentioned trade mark applications for the reasons given in my Decision issued under reference BL O-043-08 on 15 February 2008.

2. Mr Melly was directed to pay Fianna Fail £8,000 as a contribution towards the costs of its opposition in the Registry and on appeal. He was also directed to pay Fine Gael £8,000 as a contribution towards the costs of its opposition in the Registry and on

appeal. Both sums were set to be paid within 21 days after the date of the Decision (i.e on or before 7 March 2008).

3. By letter dated 4 March 2008 Mr Melly applied for a stay of payment of the costs awards pending the outcome of any appeals that might be brought in respect of the recent decisions of the Opposition Division of the Community Trade Marks Office in which: (1) Opposition No. B 1,002,221 in the name of Fianna Fail (the political party) to Community Trade Mark Application No. 4565123 **FIANNA FAIL** in the name of Fianna Fail Ltd (Company No. 05473573) was rejected on 15 January 2008; and (2) Opposition No. B 1,002,080 in the name of Fine Gael (the political party) to Community Trade Mark Application No. 4565107 **FINE GAEL** in the name of Fine Gael Ltd (Company No. 05473574) was rejected on 18 December 2007. The opponent organisation was in each case ordered to pay the costs of the applicant company. As noted in my Decision of 15 February 2008, Mr Melly became a director of each company on incorporation and thereafter remained its one and only recorded director. Also as noted in my Decision of 15 February 2008, he and they had and have no connection or association with the political organisations Fianna Fail and Fine Gael.

4. In his letter applying for a stay of payment of the costs awards in the present proceedings Mr Melly stated as follows:

I am in receipt of your decision in relation to the appeal of Fine Gael (The Political Party) Opposition No 93974 and the appeal of Fianna Fail (The Political Party) Opposition No 93972. While I respect the integrity of the adjudicatory process in relation to the registration of trademarks, I am disappointed at your finding that I acted in bad faith in relation to the registrations, while accepting your right to

reach the conclusion which you reached nevertheless I would like to point out that my motivation was always honourable in the context of striving to achieve the greater good.

As the decision has now been reached and in the context of the amount of costs awarded to the opponents of the applications for which my companies are liable, I respectfully appeal to your office that a stay be put on the payment of the award of costs until such time as any appeal by the opponents to the Community Trade Marks Office in relation to any decision by the CTM Office to award my companies trademark status, is determined in my companies favour or otherwise.

5. The application for a stay is resisted by Fianna Fail and Fine Gael. In the absence of any request for a hearing, I assume that the parties are content for me to deal with the application on the basis of their written representations.

6. Mr Melly has put forward no evidence of financial hardship or inability to pay the sums I awarded in respect of costs. He seems to be proposing: (1) that there should be one overall settling of costs obligations between him and his companies on the one hand and the opponent organisations on the other; and (2) that this should not take place until the final conclusion of the opposition proceedings in which his companies have thus far been successful in the Community Trade Marks Office. That is to say, he wishes to postpone the financial consequences of having been found liable for applying in bad faith for registration of the trade marks **FIANNA FAIL** and **FINE GAEL** in the United Kingdom until such time as it has been finally decided whether his companies can maintain their parallel applications for registration of the trade marks **FIANNA FAIL** and **FINE GAEL** under the Community Trade Mark Regulation in the face of oppositions by the opponent

organisations which do not (because they cannot) raise objections to registration on the ground of bad faith.

7. Bad faith is a ground of invalidity which can only be raised post-registration under Article 51(1)(b) of the Community Trade Mark Regulation. It is not clear whether or when the companies' applications for registration will proceed to the point at which they might be attacked under Article 51(1)(b). I am left in a position of some uncertainty as to what may be happening with regard to those applications.

8. The time for appealing against the Opposition Division decisions of 18 December 2007 and 15 January 2008 was in each case two months from the date of notification of the decision as prescribed by Article 59 of the Community Trade Mark Regulation. However, for reasons which escape me the opponent organisations are silent on the subject of notices of appeal in their written response dated 10 March 2008 to Mr Melly's application for a stay. Their representatives, Rouse & Co International Ltd, simply stated as follows:

The Applicant has asked for a stay regarding the payment of the award of costs until the opposition proceedings against the Applicant's Community trade marks have been finalised.

We submit that the proceedings before the Community Trade Mark Office are completely separate and have no relevance as regards this decision and/or any impact on the award of costs. Accordingly, the successful parties in these proceedings before the Appointed Person are entitled to the costs following the issuance of the decision and the order for costs.

In the circumstances, we see no justification for a stay regarding the award of costs and request that the Appointed

Person rejects the Applicant's request and confirms his direction on costs as set out in his decision of 15 February.

If there were to be no appeals against the Opposition Division decisions, the application for a stay pending the outcome of the non-occurring appeals would be based on a misassumption and the opponent organisations would presumably have said as much in their representatives' letter of 10 March 2008. In the absence of any representations to that effect, I infer that the Opposition Division decisions will be the subject of appeals as presupposed by Mr Melly's application for a stay.

9. The appeals will necessarily be based on grounds approximating to those on which I found in favour of Mr Melly (and proportionately reduced the amounts of costs awarded to the opponent organisations) in my Decision of 15 February 2008. They will not raise any objections to registration under Article 51(1)(b) of the Community Trade Mark Regulation which could be said to cover substantially the same ground as the objections to registration which I upheld at the national level (with proportionate orders for costs in favour of the opponent organisations) under Section 3(6) of the Trade Marks Act 1994. There is, therefore, no overlap or inter-action between the objections under Section 3(6) upon which the opponent organisations succeeded before me and the objections under Article 8(4) and Articles 8(1) and 8(2)(c) of the Community Trade Mark Regulation upon which Mr Melly's companies succeeded in the opposition proceedings before the Community Trade Marks Office.

10. That, together with the overall justice of ensuring that costs payable are paid promptly, and the absence of any evidence of financial hardship or inability to pay the

sums I awarded, leads me to the clear conclusion that Mr Melly's application for a stay should be rejected.

11. In reaching that conclusion I have assumed without deciding that I would have the power to modify the operation of a previously pronounced order as to costs in appropriate circumstances (cf the decision of Mr Richard Arnold QC sitting as the Appointed Person in Reed Midem Organisation SA v Helen Hyde No. 2 BL O-333-05, 22 December 2005).

**Geoffrey Hobbs QC**  
17 March 2008