

O-097-08

TRADE MARKS ACT 1994

TRADE MARK REGISTRATION No.1129348

IN THE NAME OF RICHARD WILKINSON

AND

APPLICATION No. 82401 BY GA MODEFINE S.A.

TO REVOKE THE TRADE MARK FOR NON-USE

Background

1. On 30 January 2006 Modefine S.A. applied to revoke trade mark registration No. 1129348 in its entirety on the grounds of non-use in the five year period from 1 March 1992 to 1 March 1997.
2. The trade mark in question consists of the word ‘Gio’ and is registered for “articles of clothing for women”.
3. The current proprietor, Mr Richard Wilkinson, filed a defence and a witness statement dated 8 May 2006 in which he claimed that the mark had been used in relation to a range of goods in Class 25. He subsequently filed a further witness statement from a Mr John Roskalns, who was a Director of the company that owned the trade mark during the relevant five year period. Mr Roskalns described use of the mark during that period in relation to a wide range of goods in Class 25.
4. The matter was listed for a substantive hearing on 18 July 2007. Shortly before then the applicant requested that the proprietor’s witnesses attend the hearing for cross examination. This was initially resisted by the proprietor. I therefore heard a preliminary application for a direction that the witnesses attend for cross examination at the hearing on 18 July 2007. I directed that the witnesses attend for cross examination and adjourned the hearing to a date to be agreed by the parties. I directed that the costs of the adjourned hearing be carried over and assessed at the conclusion of the re-convened hearing.
5. It became clear at the adjourned hearing that the applicant was confused as to the period(s) of non-use placed in issue by its application. An amended application was filed shortly after seeking to add a second period of non-use – 27 October 2000 – 27 October 2005. That application for amendment was accepted. I ordered the applicant to pay the registered proprietor £400 towards its costs of dealing with the amendment application, which I understand was duly paid.
5. The applicant subsequently filed an amended counterstatement seeking revocation of the registration of the mark in respect of all goods other than “adult ladies stockings and suspender belts”. This appears to have reflected the applicant’s analysis of the extent of the use of the mark shown by Mr Wilkinson’s first witness statement.
6. As a consequence of the addition to the application of a second period of claimed non-use, the proprietor was permitted to file additional evidence addressing the question of the use of the mark ‘Gio’ in that later period. The proprietor subsequently filed a further witness statement from Mr Wilkinson with exhibits claiming to substantiate the use of the mark in the second relevant period in relation to a wider range of goods than implicitly conceded by the applicant in its amended application.
7. The application for revocation was subsequently withdrawn.
8. The registered proprietor now seeks an award of costs. In relation to the costs associated with amendment of the applicant’s application and the adjournment of the hearing listed for 18 July, the proprietor says that its costs – of around £1000 - were

wasted and it therefore seeks an award above the Registrar's usual scale of costs for these matters.

9. The applicant was given an opportunity to comment on this request but no comments were received.

10. There can be no dispute that the registered proprietor is entitled to award of costs on the usual basis in relation to the filing of the original defence and the evidence that it has filed. The original application was brief (too brief as it turned out), as was the counterstatement. The evidence was fairly basic. I will therefore award the registered proprietor only £300 for considering the application and filing a defence, and a further £600 towards the cost of the evidence it filed.

11. Both sides instructed counsel for the adjourned hearing, which lasted for most of a morning. The registered proprietor says that the cost of this and handling the amendment application was "in the region of £1000". I have already awarded the registered proprietor £400 for the amendment application. So, in effect, the registered proprietor is asking for a further £600. In one sense the applicant was successful at the adjourned hearing in obtaining a direction that the proprietor's witnesses attend for cross examination. On the other hand the effect of making the application so late was that the hearing had to be adjourned. In my judgment the applicant is more responsible for that outcome than the registered proprietor. I will therefore award the registered proprietor a further £300 towards the cost of the adjourned hearing. In addition to the £400 already paid, this means that the applicant should pay the registered proprietor the further sum of £1200. This is well within the Registrar's scale of costs. Subject to any appeal, this sum should be paid within 28 days of the date of this decision.

Dated this 3rd Day of April 2008

**Allan James
For the Registrar**