

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 50542

IN THE NAME OF B G STAR PRODUCTIONS INC

TO APPLICATION No. 2205160

FOR REGISTRATION OF A TRADE MARK IN CLASS 41

IN THE NAME OF RICHARD ST CLAIR

DECISION

1. In a written decision issued on 2nd August 2002 Mr. M. Knight, Principal Hearing Officer acting on behalf of the Registrar of Trade Marks, rejected an application by Mr. Richard St. Clair (*“the Applicant”*) to register the designation **TY-BO** as a trade mark for use in relation to *“training, practical training; all relating to martial arts, floor and air movements”* in Class 41.

2. He did so on the basis that the application conflicted with the rights enjoyed by B G Star Productions Inc. (*“the Opponent”*) under Section 5(2)(b) of the Trade Marks Act 1994 as proprietor of the earlier trade mark **TAE BO** registered in the United Kingdom under number 2194377 and in the Community Trade Marks Office under number E 1126432 for use in relation to *“instructional teaching services for aerobics and martial arts, motivational teaching services”* in Class 41.

3. He considered the words in issue to be visibly distinguishable, but audibly indistinguishable and conceptually similar with confusion as to trade origin being likely to ensue if they were used concurrently in relation to the identical or virtually identical services in Class 41 for which they were respectively specified.

4. He rejected the contention raised in paragraph 6 of the Applicant's Counter-Statement that there had been use sufficient to demonstrate that **TY-BO** and **TAE BO** could be used concurrently without causing confusion among people in the market for services of the kind in issue.

5. He ordered the Applicant to pay £800 as a contribution towards the Opponent's costs of the opposition.

6. On 30th August 2002 the Applicant gave notice of appeal to an Appointed Person under Section 76 of the Act on the following grounds:

(1) the finding that the pronunciation of "**TAE**" is properly pronounced as "**TIE**" is incorrect. I can call witnesses from the Tae Kwan Do Association that the correct pronunciation is "**TAY**". I therefore consider that the decision has been reached on an incorrect factual basis. The Opponent did not suggest it until the day before the hearing in his written submissions that this was the case and therefore I was not in a position to call evidence about it at the time.

(2) I disagree with the finding that the honest concurrent use was insufficient to overcome the possibility of confusion. I was using the name "**Ty Bo**"

before the respondent's mark came into use in this country and I do not believe there is a likelihood of confusion between the two in the minds of the general public.

7. The appeal was fixed for hearing before me on 31st January 2003. The Applicant did not attend. Nothing was heard from him and attempts to contact him were unsuccessful. I decided not to proceed in his absence and directed the Treasury Solicitor's Department to write to him at his address for service informing him that in view of his non-attendance at the hearing, his appeal would be deemed abandoned at 4.30 p.m. on 21st February 2003 if he had not in the meantime notified the Treasury Solicitor's Department that he intended to proceed with the appeal and asked for the hearing of it to be re-fixed. The costs of the appeal were reserved.

8. Nothing further was heard from the Applicant. On 25th February 2003 I issued a Default Notice and Directions with a view to determination of the Opponent's request for an award of costs in respect of the abandoned appeal. An itemised summary of the work and expenditure covered by the Opponent's claim for costs was provided on 5th March 2003. The Applicant provided no comments or observations in response to the contents of the summary.

9. The summary presented a claim for costs in the sum of £4,603.50 on the following basis:

<u>Description</u>	<u>Costs Incurred</u> £
22 November to 02 December 2002 Correspondence and discussions with Treasury Solicitor's Department and the Trade Mark Registry in relation to the previously unnotified Appeal. Considering and reporting Appeal to instructing attorneys. - Time: 36 mins @ £235/hr.	140.00
13 January to 15 January 2003. Preparing case for Counsel and discussions with Counsel - Time: 6 hrs @ £235/hr	1410.00
15 January to 31 January 2003 Counsel's charges for considering brief and Appeal to Appointed Person, preparing and drafting of Skeleton Arguments, telephone conference and attending Hearing	2200.00
31 January 2003 Preparing for hearing and attendance at Hearing Time: 2 hrs @ £235/hr.	470.00
Travelling to and from Hearing. Time: 1 hr 42 mins @ 2/3 of £235/hr	266.00
05 February to 27 February 2003 Reporting outcome of Hearing and seeking further instructions in relation to the Default Notice from instructing principal attorneys. Time: 30 mins @ £235/hr.	117.50
	<u>£4603.50</u>

10. The issues raised by the notice of appeal were very straightforward. I think it would have taken less than an hour, making reasonable allowance for properly directed and focused submissions on both sides, to reach a determination on the merits at a substantive hearing of the appeal.

11. It also appears to me that in circumstances where the trade mark attorney responsible for defending the Principal Hearing Officer's decision on appeal was

responsible for the conduct of the opposition in the Registry and where the opposition was rightly regarded as suitable for determination in the Registry without recourse to a hearing, it would not be appropriate to require the Applicant to underwrite the Opponent's decision to incur further costs in connection with the preparation and presentation of the appeal that were more than 5 times larger than the sum awarded to it in respect of the self same proceedings at first instance.

12. I also consider that the Applicant should not be held responsible in costs for the failure on the part of the Registry to inform the Opponent of his duly filed appeal. He, no less than the Opponent, was entitled to expect the Registry to comply with the requirements of Rule 63(3) of the Trade Marks Rules 2000.

13. Drawing upon the long-established practice in Registry proceedings of using published scale figures (see Annex B to Tribunal Practice Note 2/2000) as norms to be applied or departed from with greater or lesser willingness according to the circumstances of the given case, I take the view that £850 would be a proportionate and fair sum to require the Applicant to pay by way of contribution to the Opponent's costs of the abandoned appeal.

14. I direct the Applicant to pay that sum to the Opponent within 14 days of the date of this decision. For the avoidance of doubt, I confirm that the sum I have awarded is payable by the Applicant to the Opponent in addition to the sum of £800 awarded by the Principal Hearing Officer in his decision dated 2nd August 2002.

Geoffrey Hobbs Q.C.
3rd April 2003.

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 50542

IN THE NAME OF NCP MARKETING GROUP INC

TO APPLICATION No. 2205160

FOR REGISTRATION OF A TRADE MARK IN CLASS 41

IN THE NAME OF RICHARD ST CLAIR

DEFAULT NOTICE AND DIRECTIONS

1. I refer to the Decision I gave on the basis of the non-attendance of Mr. Richard St Clair at the hearing fixed for consideration of his appeal in the above matter on 31st January 2003.
2. The Treasury Solicitor's Department has received no notification of any intention by Mr St Clair to proceed with his appeal. In default of such notification, the appeal is now deemed abandoned in accordance with my earlier Decision.
3. The question of how and by whom the costs of the appeal are to be borne and paid has yet to be determined.
4. I understand that the Respondent wishes to apply for an award of costs in its favour.
5. As indicated in my decision dated 12th June 2002 in the matter of Revocation/Invalidity Application No. 10921 (SRIS 0-269-02) I consider that I

have the power to make an award of costs in respect of the abandoned appeal. A copy of that decision is supplied herewith.

6. In order to determine the application for costs in the present case I require:
 - (1) an itemised summary of the work and expenditure covered by the Respondent's claim for costs, this to be provided in writing on or before 7th March 2003;
 - (2) any observations that Mr. St Clair may wish to make in relation to the contents of the summary referred to in (1) above, such observations to be provided in writing on or before 21st March 2003;
 - (3) any observations that the Respondent may wish to make in reply thereto, such observations to be provided in writing on or before 28th March 2003.
7. Written material provided in accordance with the directions given in paragraph 6 above should be sent to the Treasury Solicitor's Department (reference LT2/8063L/AGP/A9) and at the same time copied to the opposite party.
8. I shall not issue a decision in relation to the Respondent's request until after 28th March 2003. I shall thereafter proceed to a determination on the basis of the papers on file if neither party has by that date requested a hearing to consider the matter.

Geoffrey Hobbs QC

25th February 2003