

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION NO. 51367

IN THE NAME OF REDENVELOPE INC

TO APPLICATION NO. 2205212

TO REGISTER A SERIES OF TRADE MARKS IN CLASSES 9, 14, 16, 18, 21, 22, 25, 26, 33, 36, 39, 41 AND 42

IN THE NAME OF RED LETTER DAYS PLC

DECISION

1. For the reasons given in a written decision issued on 17th May 2002 (following an interlocutory hearing on 21st March 2002) Mr. Oliver Morris acting on behalf of the Registrar of Trade Marks refused to allow the Opponent an extension of time within which to file evidence under Rule 13(10) of the Trade Marks Rules 2000 in the above opposition proceedings.
2. The costs of the application were reserved to be dealt with at the conclusion of the proceedings.
3. On 14th June 2002 the Opponent gave notice of appeal to an Appointed Person under Section 76 of the Trade Marks Act 1994.
4. At the request of the Opponent, the hearing of the appeal was deferred pending the outcome of other Registry proceedings. It was eventually listed to be heard before me on 31st March 2003.

5. On 21st March 2003 the Opponent's solicitors (Messrs Field Fisher Waterhouse) notified the Treasury Solicitor's Department that their client no longer wished to proceed with the appeal listed for 31st March 2003.

6. On 25th March 2003 the Applicant's trade mark attorneys (Messrs. Urquhart-Dykes & Lord) wrote to the Treasury Solicitor's Department requesting an award of costs in respect of the withdrawn appeal.

7. On 1st April 2003 I gave directions for the filing of an itemised summary of the work and expenditure covered by the Applicant's claim for costs and also for the filing of written observations in relation to the contents of the summary.

8. Reduced to the form of a summary, the claim for costs is as follows:

May 2002

Reviewing the written decision issued under Rule 62(2) on 17th May 2002; 65 minutes at £200 per hour £216.67

July 2002

Checking whether notice of appeal had been filed; subsequently reviewing grounds of appeal and advising client; 50 minutes at £200 per hour £166.67

15th January to 21st March 2003

Administrative matters relating to the defence of the appeal; estimated at approximately 30 minutes at £200 per hour £100.00

9. The Opponent submits that there should be no order for costs because the appeal was not so much withdrawn as rendered unnecessary by the outcome of a hearing which took place before Ms. Ann Corbett acting on behalf of the Registrar on 22nd August 2002.

10. Ms. Corbett decided that the evidence filed by the Applicant under Rule 13(9) should, in part, be struck out. The time for appealing against her decision did not begin to run until 12th November 2002. It expired without presentation of an appeal by either party. The Opponent nevertheless kept its previously filed appeal in place until 25th March 2003. In response to a request for information (letter from Treasury Solicitor's department dated 16th January 2003) it specifically confirmed (letter of 27th January 2003) that it wished to proceed with its appeal against the decision issued on 17th May 2002. I am left with the clear impression that the Opponent intended, before and after the hearing on 22nd August 2002, to keep all of its options open with regard to the prosecution of the appeal it had filed on 14th June 2002. That is sufficient, in my view, to justify an award of costs in favour of the Applicant following the withdrawal of the appeal on 25th March 2003.

11. The Opponent objects to the first of the items noted in paragraph 8 above on the ground that it relates to work carried out prior to the filing of the notice of appeal. However, the allowability of that work in the context of the present claim for costs depends upon its pertinence to the appeal rather than the date upon which the work was undertaken.

12. It is clear that the formal written decision dated 17th May 2002 was reviewed by both parties prior to the filing of the notice of appeal dated 14th June 2002. They both turned their attention to it in the knowledge that permission to appeal was not required and that the time for appeal was still running. It seems reasonable to suppose that they each examined the decision from the same perspective: that of a party considering the sustainability of it in the event of an appeal. I think the reality of the situation is that they

worked on opposite sides of the same coin and that their preliminary assessments of the decision were carried forward in their prosecution and defence of the subsequently filed appeal. I therefore decline to exclude the Applicant's preliminary assessment from the scope of its claim for costs.

13. There is no objection either as to the allowability or the amount of the second of the items noted in paragraph 8 above.

14. The third of the items noted in paragraph 8 above is based on an estimate that appears to be reasonable in the light of: (i) the way in which the appeal has been conducted; and (ii) contents of the invoices provided (as confidential attachments) with the Applicant's observations in reply dated 29th April 2003.

15. I consider that £450 would be a fair and proportionate sum to require the Opponent to pay by way of contribution to the Applicant's costs of the withdrawn appeal.

16. I direct the Opponent pay that sum to the Applicant within 14 days of the date of this decision.

17. For completeness I record that it was agreed that my decision on costs should be given without recourse to a hearing.

Geoffrey Hobbs Q.C.

6th May 2003.