

IN THE MATTER OF APPLICATION NO. 2250127

IN THE NAME OF AXEL E. HERTLEIN

AND IN THE MATTER OF OPPOSITION NO. 52294 THERETO BY  
ROTHMANS OF PALL MALL LIMITED (LONDON) AND ROTHMANS OF  
PALL MALL LIMITED (SWITZERLAND)

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DECISION

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1. This issue before me is one of costs. On the 20<sup>th</sup> October 2000 Axel E. Hertlein (“the Applicant”) applied to register the trade mark FAIRLIGHT in respect of various goods in Class 34.
2. On the 20<sup>th</sup> March 2001 notice of opposition to the application was filed by Rothmans of Pall Mall Limited (London) and Rothmans of Pall Mall (Switzerland) (“the Opponents”).
3. The matter came on for hearing before Ann Corbett, the Hearing Officer acting for the Registrar. At the hearing the Applicant was represented by Mr Stobbs of Boulton Wade and Tennant, and the Opponents by Mr Malynicz of Counsel, instructed by BATmark Ltd. By a written decision dated the 16<sup>th</sup> September 2003 the Hearing Officer dismissed the opposition. She noted that the case was somewhat unusual in that the Applicant did not file any evidence and that this

should be reflected in the costs award. Accordingly she ordered the Opponents to pay to the Applicant the sum of £1,000.

4. On the 14<sup>th</sup> October 2003 the Opponents gave notice of their intention to appeal against that decision to an Appointed Person under section 76 of the Act. The matter came on for a hearing before me the 23<sup>rd</sup> February 2004. At that hearing the Applicant and the Opponents were represented as before. The Registrar was represented by Mr. Edenborough of Counsel.
5. At the hearing the Registrar requested that I refer the appeal to the High Court pursuant to section 76(3) of the Act. Both the Applicant and the Opponents opposed that request. Having heard submissions from all parties I indicated that I intended to refer the appeal to the High Court and that I would give my reasons in writing. I did so in a decision dated the 3rd March 2004. With the agreement of the parties, I directed that the costs of the appeal be reserved.
6. Following my decision the Opponents decided not to pursue the appeal. In the circumstances the Applicant now asks for an award of costs.
7. I invited the parties to make their submissions on costs by correspondence and they have done so. They have also agreed that the matter be disposed of on the basis of those submissions and without the need for a further oral hearing.
8. I think it is clear that if an appeal is abandoned then an appropriate order for costs should normally be made in favour of the respondent to the appeal. This course has now been followed in many cases before the Appointed Person (see, for example, *VFM's Application*, a decision of Mr Hobbs Q.C. dated the 12th June 2002). Indeed, the Opponents do not suggest otherwise.
9. The Applicant contends that he has been put to considerable expense in defending the appeal and that his costs have been increased through having to address the issue of the requested reference to the High Court. In the circumstances he seeks an award of £2,000 as a contribution to his costs of the

appeal. The Opponents submit that an appropriate award in respect of the appeal would be £1,000.

10. In deciding the appropriate award it seems to me that the following points are relevant. First, the costs awarded by the Hearing Officer reflected the fact that the Applicant did not file any evidence in support of the application. In terms of evidence, this was not a complex case.
11. Secondly, the request for a reference to the High Court was made by the Registrar and not by either of the parties. In fact, both parties opposed the request.
12. Thirdly, I am sure that some additional costs were incurred before the hearing as a result of the request for a reference. But I am not satisfied that they were substantial. The position taken by the Applicant at the hearing before me in relation to the request for a reference was the same as in relation the appeal itself, namely that this was a simple case and that the Hearing Officer plainly arrived at the correct decision.
13. Fourthly, the Opponents took no steps to pursue the appeal before the High Court and accordingly there is no suggestion that the Applicant incurred any further expense in relation to the appeal following the hearing before me.
14. In all the circumstances I have come to the conclusion that a proportionate sum to award the Applicant in respect of the costs of the appeal is £1,250. I therefore direct that the Opponents pay that sum to the Applicant on a like basis to that ordered by the Hearing Officer.

David Kitchin QC

24<sup>th</sup> March 2005