

**O-240-18**

**DECISION ON COSTS**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3203966 BY JUVENTUS FOOTBALL  
CLUB S.P.A. TO REGISTER THE FOLLOWING TRADE MARK**



**IN CLASSES 25, 28 AND 41**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 409011  
BY J&JOY SA**

## **BACKGROUND AND PLEADINGS**

1) Juventus Football Club S.p.A (hereafter “the applicant”) applied to register trade mark no. 3203966 on 23 December 2016

2) J&Joy SA (hereafter “the opponent”) opposed the trade mark on the basis of section 5(2)(b) and section 5(3) of the Trade Marks Act 1994 (“the Act”). The opposition was directed against all the goods and services on the basis of earlier EU trade mark no. 011411601. The applicant filed a counterstatement where it denied the claims made.

3) Both sides request costs in their favour and both sides filed evidence

4) A Hearing was scheduled to take place on 22 March 2018, however, at 4.39pm the day before, CMS Cameron McKenna Nabarro Olswang LLP, the representative of the opponent informed the Registry by e-mail that the opponent would like to withdraw the opposition.

5) Beck Greener, the representative for the applicant responded by claiming that:

- it had spent considerable time drafting and filing a skeleton argument and preparing for the hearing;
- only when offering to exchange skeleton arguments did the opponent inform the applicant that it would not be attending the hearing, but even then made no indication that it would be withdrawing the opposition;
- in these circumstances, it is unjust and unreasonable to expect the applicant to meet the costs of preparing for the hearing.

6) The applicant, therefore, requested costs in line with the standard scale for the period up to the hearing and indemnity costs above the standard scale for costs incurred in preparing for the hearing. This latter element of the claim was particularised as 16 hours at an hourly rate of £285, totalling £4560.

7) A period of 14 days was allowed for the applicant to provide written submissions of the issue of costs. It did so, by email, on 3 April 2018. The points made can be summarised as follows:

- the opponent filed short submissions and little evidence;
- the applicant took the decision to withdraw the opposition to avoid additional costs;
- costs should be the minimal award and also the minimal award of indemnity;
- costs before the Registry are contributory and not compensatory.

8) In light of the opponent withdrawing the opposition, the applicant is the successful party in the proceedings and is entitled to a contribution towards its costs. I have reviewed the submissions and evidence filed in support of each parties' case and I do not agree with the opponent's submission that the opponent filed little evidence. It provided details of third party use of J and JJ marks to support its case that it is commonplace for the letter(s) "J" or "JJ" to be used in the field concerned. A reasonable amount of work had clearly been done and whilst costs on the normal scale have been requested and are wholly appropriate, I do not agree that they should be on the minimum of the scale.

9) I note that the opponent's submission that costs before the Registry are contributory and not compensatory. I agree that this is true in the majority of cases but Rule 67 of the Trade Mark Rules provides the Registry with a broad discretion to "award to any party such costs as the register may consider reasonable". Consequently, I am not restricted to making an order only in respect of contributory costs and I may depart from the published scale to make an award of costs that I consider reasonable.

10) Taking all of the above into account, together with the submissions on behalf of the parties, I find that the lateness of the withdrawal of the opposition led to the applicant incurring unnecessary and avoidable costs in respect of its representative's

preparations for the hearing and the request of £4560 in respect of this appears reasonable.

11) Taking account of this and that the other elements of the cost award are governed by Annex A of Tribunal Practice Notice (TPN) 2 of 2016, I award costs as follows:

Considering other side's statement and preparing counterstatement	£300
Considering other side's evidence and preparing own evidence	£800
Preparing skeleton argument and for attendance at hearing	£4560
<b>Total:</b>	<b>£5660</b>

12) I order J&Joy SA to pay to Juventus Football Club S.p.A. the sum of **£5660**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 17<sup>th</sup> day of April 2018**

**Mark Bryant**  
**For the Registrar**  
**The Comptroller-General**