

O-428-11

TRADE MARKS ACT 1994

SUPPLEMENTARY COSTS DECISION

**IN THE MATTER OF APPLICATION NO 2497564
BY
PARAS PHARMACEUTICALS LIMITED
TO REGISTER THE TRADE MARK**



IN CLASS 5

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO 98728
BY
LYNPHA VITALE SRL**

Trade Marks Act 1994
IN THE MATTER OF application number 2497564
By Paras Pharmaceuticals Limited
To register the trade mark



In Class 5
AND IN THE MATTER OF opposition thereto
Under no. 98728
By Lynpha Vitale SRL

1. My decision in this matter was issued on 11 October 2011.
2. It has been brought to my attention by Ian Grussell of Berwin Leighton Paisner LLP, acting for the opponent, that the cost award included in my decision did not take account of submissions made in respect of a procedural hearing that took place on 27 April 2010. As a consequence, I have reviewed matters and now issue this supplementary decision as regards costs.

BACKGROUND

3. Application 2497564 was filed on 12 February 2009. Following the filing of the applicant's counter-statement dates were set for each of the parties to file evidence.
4. On 5 August 2009 the opponent filed submissions in support of the opposition in the form of a copy of its earlier right, Community Trade Mark (CTM) 6080899, which was registered at OHIM on 12 March 2009.
5. On 19 October 2009 the applicant submitted a letter to the Tribunal stating that it had applied for a transfer of ownership of the above mentioned CTM, into its own name, pursuant to Article 18 of the Community Trade Mark Regulations 40/94. In addition, it requested suspension of the proceedings to await the outcome of the transfer request filed at OHIM.
6. On 2 December 2009 the opponent wrote to the Tribunal contesting the request for suspension. Following the receipt of comments from both parties the Tribunal issued a preliminary view confirming that proceedings would be suspended. This was dated 22 January 2010.
7. On 16 February 2010 the opponent requested a hearing on the matter of suspension, which was subsequently arranged for 27 April 2010, with the agreement of both parties.
8. At the request of the Hearing Officer an email was sent to the applicant's representative, on 26 April 2010, requesting an update as to the progress of the transfer of ownership application at OHIM. On 27 April 2010 the applicant confirmed that its application had been rejected on 19 January 2010.

9. The procedural hearing was held on 27 April 2010 as arranged. The applicant did not attend. The suspension issue at OHIM had fallen away and as a result the Hearing Officer ordered the continuation of the proceedings. During the hearing the opponent requested an award for costs off the scale in respect of the hearing. A breakdown of costs was provided to the Tribunal on 12 May 2010 amounting to a request for an award totalling £2377.

10. As is usual practice, comments were invited from the applicant in respect of the off the scale costs request and to date no comments have been received by the Tribunal.

Case law

11. Anthony Watson QC in *Rizla Ltd's Application*¹, stated that a case should be regarded as exceptional, and therefore attract costs off the scale, if it can be shown that "*the losing party has abused the process of the Comptroller by commencing or maintaining a case without a genuine belief that there is an issue to be tried.*"

Decision on costs

12. At the time of requesting the suspension to these proceedings on 19 October 2009 the applicant did not know the outcome of its application to OHIM for a transfer of ownership of CTM 6080899, therefore, the request cannot be held to have been made without a genuine belief that the issue was a genuine one.

13. Following further correspondence which I have outlined above, the Tribunal issued a preliminary view on 22 January 2010 to suspend proceedings awaiting the outcome of the OHIM decision. On 26 February 2010 the opponent requested to be heard on the matter.

14. The applicant has confirmed in its email of 27 April 2010 that OHIM rejected its application on 19 January 2010. It is possible that when the Tribunal issued its preliminary view three days later the applicant may not have been aware that its application had been rejected. However, by 26 February 2010, when the opponent requested to be heard on the matter and certainly by 27 April 2010 when the matter came before the Tribunal, the applicant can reasonably be expected to have been aware that its application for transfer of ownership at OHIM had been rejected and that consequently the need for suspension no longer existed but it took no action to inform the Tribunal of this.

15. Having taken all of these factors into account and bearing in mind the guidance in *Rizla*, I find that an award for costs off the scale is appropriate in this case. I have considered the breakdown of costs provided by the opponent and conclude that an award of **£1200** as a contribution to its costs is appropriate in this case.

¹ [1993] RPC 365 at Page 377

16. I therefore amend my earlier decision issued on 11 October 2011 so as to reflect a new award of costs. The amended cost award in respect of these proceedings is therefore as follows:

Preparing a statement and considering the other side's statement:	£200
Official fee:	£200
Costs in respect of the procedural hearing held 27 April 2010	£1200
Total:	£1600

17. I order Paras Pharmaceuticals Limited to pay Lynpha Vitale SRL the sum of £1600. This sum is to be paid within seven days of the expiry of the appeal period, which is set in respect of this supplementary decision, or within seven days of the final determination if any appeal against opposition 98728 is unsuccessful.

Dated this 30th day of November 2011

**Ms Al Skilton
For the Registrar,
the Comptroller-General**