

O/464/11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2454142  
BY ALLORO RESTAURANTS LIMITED TO REGISTER THE TRADE MARK**

**ALLORO**

**IN CLASS 43**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 96511  
BY ALLORI LIMITED**

**AND**

**IN THE MATTER OF REGISTRATION NO 2416357 IN THE NAME OF ALLORI  
LIMITED IN RESPECT OF THE FOLLOWING TRADE MARK IN CLASSES  
17, 35, 37, 39 AND 43:**

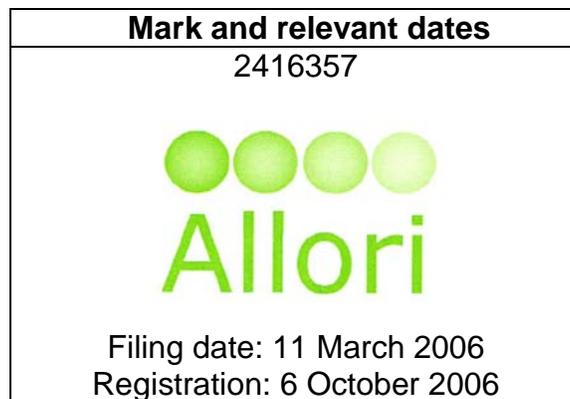


**AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO  
UNDER NO 83459 BY ALLORO RESTAURANTS LIMITED**

## BACKGROUND

1) On 30 April 2007, Alloro Restaurants Limited (hereafter “ARL”) applied under the Trade Marks Act 1994 (“the Act”) for registration of the mark ALLORO in respect of *Restaurant, cafe, bar and catering services* in Class 43.

2) On 21 December 2007, the application was published in the Trade Marks Journal and on 29 February 2008, Allori Limited (hereafter “AL”) filed notice of opposition to the application. The single ground of opposition is that ARL’s mark is similar to an earlier mark (the relevant details are shown below) belonging to AL and it is in respect of services that are identical or similar to its *services for providing food and drink* in Class 43 (it does not rely upon any other services listed in its registration). It, therefore, falls foul of Section 5(2)(b) of the Act.



3) On 17 April 2009, ARL filed an application to declare invalid the registration relied upon by AL. The ground of invalidation is based upon Section 5(4)(a) of the Act. ARL claims that it has used its mark ALLORO in London since at least the year 2000 in respect of *restaurant services, bar services; provision of food and drink; provision of private dining rooms, and associated catering services*. It claims that AL’s mark is contrary to the law of passing off in respect of the partial list of services recorded in the table below.

Relevant services
<b>Class 35:</b> [...]; <i>wholesale services connected with the sale of meat, fish, poultry and game; retail services connected with the sale of meat, fish, poultry and game; wholesale green grocery services connected with the sale of vegetables, fresh fruits, garden, market garden and farm produce; retail green grocery services connected with the sale of vegetables, fresh fruits, garden, market garden and farm produce.</i>
<b>Class 43:</b> <i>Services for providing food and drink, temporary accommodation.</i>

- 4) Both parties filed counterstatements denying each other's claims in the respective proceedings. The proceedings were subsequently consolidated.
- 5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 10 November 2011 when ARL was represented by Ben Longstaff of Counsel, instructed by Kilburn & Strode. AL did not attend.

## **Evidence**

### ***ARL's evidence***

6) This takes the form of two witness statements by Paul Andrew Singer and one each by Peter Richards, Fay Maschler and Sharon Kirby.

7) Mr Singer is a Solicitor and Managing Director of A to Z Restaurants Limited trading as London Fine Wine Dining Group. He explains that ARL is a subsidiary company of A to Z Restaurants Limited. In his first witness statement, dated 19 March 2009, he provides a copy of an article from Foodepedia.co.uk at Exhibit PAS1. This article, dated December 2008, references "London Fine Dining Group's destination restaurants" and includes the following text:

"Alloro is a truly authentic, fine dining Italian restaurant, which offers deceptively simple cuisine made from superlative ingredients. A favourite of local Mayfair residents, visiting celebrities and business people, its followers simply wouldn't eat anywhere else. [www.alloro-restaurant.co.uk](http://www.alloro-restaurant.co.uk)"

8) Mr Singer provides information about other, individually named, prestigious restaurants that his company operate and also industry awards the company has won. None of these relate to its ALLORO restaurant.

9) At Exhibit PAS3, Mr Singer provides two articles from the catersearch.com website. The first, carrying a 2009 copyright notice and printed on 4 February 2009, is a company profile of "A to Z Restaurants" and under the heading of "Timeline", it includes the following:

"June 2000: The group opens Teca in January and Alloro in August. Both are Italian restaurants located in Mayfair."

10) The second article, dated 21 September 2006, is about Claudio Pulze, described as "one of London's most influential and prolific restaurateurs". It reports that he owns seventeen eateries including "the seven-strong A-Z Restaurants group, which includes the Michelin-starred Aubergine, Zafferano, L'Oranger, two Memories of China, Alloro and Spiga Soho." It also refers to the A-Z Restaurant group being set up in 1993.

11) Mr Singer states that the ALLORO restaurant is located in the same building as Sir Rocco Forte's Brown's Hotel and that he was keen to ensure the calibre of the restaurant was in keeping with the adjoining hotel. Mr Singer explains that the ALLORO restaurant quickly became known as a fine dining restaurant with several reviews appearing around the time that it opened. Two of these reviews are provided at Exhibit PAS4. The first is from *The Guardian* newspaper and dated 5 August 2000. The second is from *The Independent* newspaper and dated 18 November 2000. The latter describes it as "... a hip London restaurant..." and "...hyped to contend for the title of London's best Italian."

12) At Exhibit PAS5, Mr Singer provides a printout from the website caterersearch.com, dated 26 July 2001. This is an article about ALLORI's head chef, Michele Brogi, and his first year at the restaurant. He is described as having "a fantastic first year" with the restaurant enjoying "an array of positive reviews". The same exhibit also contains a number of reviews that appeared in the *Time Out Eating and Drinking* guide from the years 2005, 2008 and 2009. The first of these indicates that it is "of its type, very good indeed". The second, dated 28 March 2008, describes the restaurant as an "elegant Mayfair veteran". The third, dated 18 March 2009 refers to the restaurant's "popularity and wide appeal" and states that "it remains one of London's prime venues for high-end Italian cooking".

13) Exhibit PAS6 includes a further review. This is by Matthew Norman, an award winning restaurant critic for both the *Sunday Telegraph* and *The Guardian* newspapers. A to Z Restaurants Limited has a number of Michelin starred restaurants and Mr Norman expressed the view that the ALLORO restaurant was also deserving of such an accolade. The exhibit also includes a review of the restaurant that appeared in the 2007 restaurant guide of the UK lifestyle magazine, *Tatler*. It describes it as "a lovely New Italian". An extract from *Tatler's* 2009 guide is also provided and reviews the restaurant in a positive light. Finally, the exhibit also contains an extract from caterersearch.com illustrating that in March 2001, ALLORO won an award for "menu of the month".

14) At Exhibit PAS7, Mr Singer provides documents illustrating the chain of ownership of the goodwill associated with the restaurant ("Assignment of goodwill") ending with ARL. The Deed transferring the goodwill and dated 13 May 2005 recorded that £860,006 was paid for the goodwill.

15) Mr Singer states that it is increasingly common for restaurants to use their name on associated products and services and cites another restaurant in ARL's group, ZAFFERANO, that also has a delicatessen in the same name as the restaurant. He also cites the Italian chef, Carluccio, who has a chain of restaurants and delicatessens in the UK.

16) In Mr Singer's second witness statement, dated 14 September 2009, he provides information regarding the ALLORO restaurants "Earnings before

Interest, Taxes, Depreciation and Amortization” otherwise known as “EBITDA”. He explains that this is the industry standard performance indicator in assessing the value of a restaurant. He provides the following figures for ARL:

<b>Year ending</b>	<b>Turnover</b>	<b>EBITDA</b>
May 2007	£1,849,732	£354,812
May 2008	£1,880,292	£398,887
May 2009	£1,690,959	£294,223

17) Mr Singer estimates, from these figures, that the value of the ALLORO restaurant is between £1,471,110 and £2,942,220.

18) Mr Singer explains that a PR agency was employed until December 2008 on a retainer of £5000 plus VAT per month to promote the group of restaurants that includes ALLORO.

19) In his witness statement, Mr Richards states that he is General Manager for Nell Gwynn House and has been asked by a former colleague, David Herbert, who now works for London Fine Dining Group, to “talk about” his experience of the ALLORO restaurant during the period when he worked nearby. He was employed as General Manager of Brown’s Hotel between March 2000 and February 2002.

20) Mr Richards states that he was responsible for collecting rent on the properties leased out by the hotel’s owners. The lease for a restaurant in the premises now occupied by ALLORO commenced in 1996 and is due to expire in 2015. He recalls the ALLORO restaurant opening a few months or so after his arrival and always appeared to be busy for both lunches and dinners. He was aware that the restaurant was set up by Claudio Pulze, a well-known character in the restaurant and hospitality trade. He states that customers at the restaurant included corporate clients from the local financial sector companies, business people and tourists from both the UK and elsewhere.

21) Ms Maschler, in her witness statement, states that she is a restaurant critic for the *Evening Standard*, a position she has held for 37 years. Ms Maschler conducted a professional review of the ALLORO restaurant in August 2000. This review was republished on the website [www.thisislondon.co.uk](http://www.thisislondon.co.uk) and a copy of this is provided at Exhibit FM2. Ms Maschler describes how the restaurant’s head chef, Michele Brogi, had previously worked with the widely known chef Giorgio Locatelli, proprietor of the Michelin-starred *Locanda Locatelli* restaurant and previously head chef at *Zafferano* restaurant which is also part of the same group of restaurants as the ALLORO.

22) To the best of Ms Maschler’s knowledge, there has been an ALLORO restaurant at the current premises since her visit in 2000. She states that it quickly gained a reputation as a fine dining Italian restaurant in London.

### ***AL's Evidence***

23) This consists of a witness statement by Darren Taylor, director of AL. This contains numerous submissions that I will bear in mind, but I will not detail here.

### ***ARL's Evidence in reply***

24) This consists of a further witness statement, dated 30 September 2010, by Mr Singer. He states that the figure of £860,006 being the value of the goodwill in the business when it was assigned in 2005 was a value proposed by the administrator and based on the EBITDA with the fixtures and fittings being "written down" in the valuation of the assets.

25) Mr Singer states that, following a review of all the restaurants in the group, trade mark registrations were sort for the names of them, including ALLORO. These were all filed on the same day, namely 30 April 2007. Due to the absence of any challenge to the unregistered mark ALLORO in the preceding seven years, full clearance searches were not conducted.

26) Mr Singer also makes a number of submissions that I will keep in mind but not detail here.

### **DECISION**

27) For AL to be successful in its opposition based upon Section 5(2)(b), it must have a valid earlier right to rely upon. ARL's application for invalidation relates to the validity of this earlier mark and therefore it is logical that I begin by considering the invalidation action first. This proceeds to final determination on the basis of Section 5(4)(a) of the Act, with such grounds being relevant in invalidation proceedings in view of the provisions of Section 47(2) of the Act. The relevant parts of Section 47 of the Act read as follows:

"47. - (1) ...

(2) The registration of a trade mark may be declared invalid on the ground-

(a) [...]

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration."

28) Section 5(4)(a) reads:

“5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) .....

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark”.

29) The requirements for this ground have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. Adapted to an invalidation action, the three elements that must be present can be summarised as follows:

(1) that the applicant for invalidation’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the proprietor (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the proprietor are goods or services of the applicant; and

(3) that the applicant has suffered or are likely to suffer damage as a result of the erroneous belief engendered by the proprietor’s misrepresentation.

### The Material Date

30) The material date for determining claims is normally the date is the filing date of the registration in suit (*Last Minute Network Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Joined Cases T-114/07 and T-115), that is to say 11 March 2006. The earlier right must have been acquired prior to that date (Article 4.4(b) of First Council Directive 89/104 on which the UK Act is based). Another possible relevant date is the date of the filing of the application for invalidation (see the comments of Ruth Annand, sitting as the Appointed Person in paragraph 36, BL O-227-05 *Omega*), namely 17 April 2009. ARL must demonstrate that it had a protectable goodwill at the first of these dates and also, possibly the second.

## Goodwill

31) In order to make an assessment of whether or not ARL has goodwill in a business conducted under the ALLORO mark, I must be possessed of sufficient information to reach an informed conclusion (See *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19) and the evidence should show that the goodwill extends to the goods and services claimed as of the relevant date (see *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat)).

32) At the hearing, Mr Longstaff claimed that ARL's goodwill identified by the mark ALLORO was in respect of *restaurant services, provision of food and drink, and bar services*.

33) In respect of *restaurant services*, Mr Singer has put in evidence a number of reviews of ARL's ALLORO restaurant located in Mayfair, London. Two of these reviews are dated in August 2000 and correspond to Mr Singer's statement that the restaurant opened in that month. Further reviews are exhibited from 2004, 2005, 2007, 2008 and 2009 respectively. These reviews appeared in a variety of websites, national newspapers and a national magazine. A number of press articles have been written about the restaurant or mention the restaurant when discussing ARL's group of restaurants and in one example from 2001, discusses head chef, Michele Brogi's first year at the restaurant.

34) Further, Mr Singer has disclosed turnover levels in the range of £1.6 million to £1.9 million a year between 2007 and 2009. He also stated that the restaurant group, as a whole, had a £5k/month marketing spend, however, there is no indication as to how much of this, if any, relates to the ALLORO restaurant. In addition, he provides evidence to illustrate that when the restaurant was sold in 2005, its current owners paid £860k for the goodwill in the business. This figure was queried by Mr Taylor in his written submissions as the assignment document did not appear to place a figure on the kitchen, restaurant and bar equipment. In his third witness statement, Mr Singer explained that the value of the goodwill was that proposed by the administrator and based on the EBITDA with the fixtures and fittings being "written down" in the valuation of the assets. I see no reason to question this explanation further and the assignment provides supportive evidence of the existence of goodwill in the business at that time.

35) In addition to drawing my attention to the evidence referred to above, at the hearing, Mr Longstaff submitted that goodwill residing in the ALLORO restaurant business was boosted by ARL's association with other restaurants in the group. I do not find this to be a particularly persuasive argument. It is true that the ALLORO restaurant is part of a small group of restaurants, some of which have been awarded *Michelin* stars. Nevertheless, there is no evidence before me that the users of ALLORO's restaurant services will be aware of the fact that it is part of this group. Whilst the review in *The Guardian* newspaper refers to the

restaurant “being founded by the owners of the acclaimed Zafferano [..]” may suggest some shared goodwill with that restaurant, there is a lack of evidence demonstrating that such a link will be generally known by ALLORO’s customers. Additionally, there are a number of articles that discuss the restaurant group, noting that ALLORO is part of the group, but these appear on the website “caterersearch”. This website carries the strap line “The complete information source for hospitality”. This strongly implies that it is targeted at the trade rather than the consumers of hospitality and, as such, I do not consider that it demonstrates that the consumer of ALLORO’s services will recognise the restaurant as part of a group of restaurants with its own higher level of goodwill.

36) In light of all of the above, it is clear to me that ALLORO is the name of a restaurant that has been trading continuously since August 2000.

37) At the hearing, Mr Longstaff attempted to persuade me that ALLORO’s goodwill extended beyond *restaurant services*. Firstly, he submitted that as the restaurant also had a bar, then its goodwill extended to *bar services*. Secondly, he contended that the goodwill extended to *provision of food and drink*, more generally, because the restaurant operates private dining rooms and because it is now common in the trade for restaurants to be associated with delicatessens as exemplified by the *Carluccios* chain of restaurants. I am wholly unpersuaded by this argument. Whilst there is a reference in ARL’s statement of case to the provision of private dining rooms, there is no evidence of this. Even if such evidence had been forthcoming, it is not clear to me that this would take ARL’s goodwill beyond *restaurant services* anyway because the provision of private dining rooms may be seen as merely a subset of restaurant services. Whilst the ALLORO restaurant may also have a bar area, there is no evidence that this is anything other than a subsidiary service to the restaurant facilities and as such it will not contribute to a goodwill that extends beyond *restaurant services*. In respect to the second limb of Mr Longstaff’s argument, he relies on the fact that another restaurant in the group called *Zafferano* has a delicatessen and that there are numerous independent cafes and restaurants which also have a delicatessen or farm shops. Whilst I acknowledge that such business models exist, there is no evidence before me that ARL’s goodwill, identified by the sign ALLORO, extends to such services.

38) Therefore, I am not persuaded by these arguments and conclude that the goodwill identified by the mark ALLORO does not extend to such services.

39) The goodwill that does exist in the ALLORO restaurant business is as a result of its trade from one location in London. Mr Longstaff pointed to the evidence of Mr Richards where he described how the restaurant attracted corporate clients from the local financial sector companies, business people and tourists from the UK and elsewhere. On the basis of this, Mr Longstaff submitted that the goodwill identified by the mark ALLORO extended across the UK.

40) There is no doubt in my mind that ARL was the owner of a protectable goodwill as a restaurant in the Mayfair area of London and that this goodwill undoubtedly extended beyond Mayfair. The restaurant would have been known more widely, and very possibly in a large proportion of London. However, other than Mr Richard's statement that tourists from the UK frequented the restaurant, there is little in the evidence to suggest that its goodwill extends across the whole of the UK. There is no indication of the number of tourists who used the restaurant. Neither is there any evidence that the restaurant was advertised outside London. Whilst I note that the restaurant provides a service at the higher end of the spectrum, it is nevertheless, not the norm for individual restaurants to have a national goodwill. In the case of ALLORO, there are a number of reviews in national papers that indicate that some goodwill may extend beyond London, but it is unclear as to the extent of this, but it is unlikely to be anywhere near as extensive as it is in London and in particular, in the vicinity where the restaurant is located. I do not believe that the fact that ALLORO is part of a group of restaurants changes this.

41) However, in this case, whether or not ARL's protectable goodwill extends beyond London or not is somewhat academic. It is well established that an opponent does not need to establish that it has a national reputation and goodwill in order to prevent the use by another party of a conflicting name or mark if it is liable to cause damage to his less-than-national goodwill and reputation (*Chelsea Man Menswear v Chelsea Girl Ltd* [1987] RPC 189). In the absence of any offer from AL to limit the geographical scope of its specification of services, I must consider that its application to register ALLORI is national in scope and will overlap with ARL's goodwill in, at least, London.

42) To summarise, I find that the restaurant business identified by the ALLORO name has a protectable goodwill in at least the London area. This goodwill is in relation to *restaurant services* and I find it does not extend to *bar services* or to the broader services of *provision of food and drink*, other than those covered by the description *restaurant services*. This was the position at both of the material dates.

#### Misrepresentation and damage

43) Having reached this conclusion, I must go on to consider if there has been misrepresentation and whether any such misrepresentation is such as to cause damage to ARL. In this respect, I am mindful of the comments of Morritt L J in the Court of Appeal decision in *Neutrogena Corporation and Anr. V Golden Limited and Anr.* [1996] RPC 473 when he confirmed that the correct test on the issue of deception or confusion was whether, on the balance of probabilities, a substantial number of ARL's customers or potential customers would be misled into purchasing AL's service in the belief that it was ARL's. Further, Lord Fraser in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 HL, stated that the owner of the goodwill must show that "he has suffered, or is really likely to

suffer, substantial damage to his property in the goodwill”. However, it is not necessary for a misrepresentation to go as far as to suggest that the services of the proprietor of the contested mark are those of the owner of the goodwill. It is sufficient if there is a misrepresentation that one business is associated with another (*Sir Robert McAlpine Ltd v Alfred McAlpine* [2004] RPC 36 at paragraph 19). Damage to goodwill may include reducing the exclusivity in a name by which the goodwill is known (*Taittinger SA v Allbev Ltd* [1993] FSR 641).

44) In his witness statement, Mr Singer submitted that the respective marks are highly similar because the word ALLORO means “bay leaf” in Italian and because the word element of AL’s mark, namely ALLORI, is merely the plural of this. It is further submitted that it is common for Italian restaurants to be named after an ingredient of the food they serve. It is submitted that because of these two points, the consumer will be deceived. I am unconvinced by this argument. The average consumer in the UK is unlikely to be aware of the meaning of either ALLORO or ALLORI. Whilst they may be words belonging to a common European language and many UK consumers will be aware of some words that belong to this language, the actual words in question are not the type of words commonly known. As such, the words are likely to be perceived as made up words. That said, there is a very high level of aural similarity and whilst the additional elements present in AL’s mark are clearly evident, there is still a high level of visual similarity. Further, the word elements of the respective marks differ only in their final letter.

45) I find it convenient to consider the level of similarity between the services in which ARL has goodwill, namely *restaurant services*, and the services that it attacks in AL’s application, by splitting AL’s services into the following three groups:

- i) *Services for providing food and drink*
- ii) *wholesale services connected with the sale of meat, fish, poultry and game; retail services connected with the sale of meat, fish, poultry and game; wholesale green grocery services connected with the sale of vegetables, fresh fruits, garden, market garden and farm produce; retail green grocery services connected with the sale of vegetables, fresh fruits, garden, market garden and farm produce*
- iii) *Temporary accommodation*

46) In respect of AL’s *services for providing food and drink*, such services include the provision of food and drink in a restaurant. As such, the term must be considered as including the services for which ARL has demonstrated a protectable goodwill. Whilst there is no need for common field of activity (*Lego Systems A/S v Lego M Lemelstrich Ltd* [1983] FSR 155), it is significant that these respective services overlap.

47) In respect of the various wholesale and retail services, Mr Longstaff referred me to Mr Singer's comments, in his second witness statement, where he claimed that because of developments in the food and drinks industry, it more likely that associated businesses will be assumed to come from same undertaking. This comment was supported by highlighting *Carluccio's* as an example of a business providing both restaurant services and the services of a delicatessen and also the fact that one of ALLORO's sister restaurants ZAFFERANO also has a delicatessen of the same name. Whilst I accept that such business models exist, I do not believe it is a model commonly adopted by the restaurant trade. Certainly, these two examples are insufficient to demonstrate otherwise. With this in mind, and acknowledging that there are some differences between the marks, leads me to conclude that there would be no misrepresentation and no damage if AL were to conduct wholesale or retail activities relating to food and drink in the same locality in which ARL's goodwill extends.

48) In respect of AL's *temporary accommodation*, Mr Longstaff argued that there is a long standing association between hotels and restaurants and many private members' clubs offer both restaurants and bedrooms. Whilst I accept that the great majority of hotels also provide restaurant services, it does not follow that the consumer familiar with the goodwill associated with the ALLORO restaurant business will, upon seeing temporary accommodation services identified by the ALLORI mark, will assume that the businesses are linked. In fact, I do not believe this is the case. The business identified by the ALLORO mark has no goodwill or reputation in respect of temporary accommodation, it is a standalone restaurant. There is no evidence to demonstrate that it is common for such individual restaurants also to include the provision of temporary accommodation in its business model. As such, and taking account of the respective marks involved, I conclude that AL's use of its mark in respect of temporary accommodation would be unlikely to result in misrepresentation and damage to ARL.

49) In summary, taking account of the similarity between the marks and that, in relation to ARL's *restaurant services* and AL's *services for providing food and drink* the respective services are, in part, identical, I find that AL's use of its mark ALLORI (and device) in London would constitute a misrepresentation and that such misrepresentation would be liable to cause damage to ARL's local goodwill. Consequently, such use would have been contrary to law. In the absence of a voluntary restriction, this finding is sufficient to engage the ground of refusal set out in Section 5(4)(a) of the Act. The application for invalidation is therefore successful in respect of AL's *services for providing food and drink*. However, it fails in respect of the other services attacked by ARL.

## **Section 5(2)(b)**

50) In light of my findings in respect of the invalidation action, the term *services for providing food and drink* has been removed from AL's registration. This was the only term it relied upon in its opposition to ARL's mark. It follows that the opposition action falls away in light of this.

51) At the hearing, Mr Longstaff submitted that if I were not to find for ARL, then I should postpone issuing my decision in respect of the opposition proceedings until such time as the outcome is known in respect of ARL's recent application to revoke AL's mark based upon a claim of non-use. In light of my findings, I do not need to consider this point further.

## **COSTS**

52) The invalidation action being partially successful and the resultant reduced scope of AL's earlier mark resulting in its opposition failing, ARL is entitled to a contribution towards its costs. Mr Longstaff requested that ARL be permitted to file written submissions on costs once my decision on the substantive issues had been made. He explained that ARL wished to make submissions that an award of costs should be made over the published scale and in their favour. He stated that its case involves reference to much without prejudice (save as to costs) material and, as such, it was not appropriate to provide those submissions at the hearing. I agree that, in the circumstances, this is the way to proceed.

53) Accordingly, ARL have fourteen days from the date of this decision to provide its written submissions (and Mr Longstaff indicated these would also relate to costs incurred as a result of the interlocutory hearing held on 2 September 2010. If AL wish to make any submissions on costs, it should do so within fourteen days of receipt of ARL submissions. I will then give my finding on costs and set the period for appeal to begin from the date from when my supplementary decision is issued.

**Dated this 20<sup>th</sup> day of December 2011**

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