

O-476-12

TRADE MARKS ACT 1994

APPLICATION 2575023 BY BORDEAUX INDEX LIMITED

TO REGISTER THE MARK 'BORDEAUX INDEX'

IN CLASSES 16, 21, 33, 35, 36, 39 & 41

AND

**OPPOSITION 102315 BY CONSEIL INTERPROFESSIONNEL DU VIN DE
BORDEAUX AND INSTITUT NATIONAL DE L'ORIGINE ET DE LA QUALITE**

DECISION

1. I issued a preliminary decision in this opposition on 16 October in which I found that the opposition under s.3(4) would succeed in class 33, and would succeed in part in classes 35, 36 and 41, unless the applicant made certain amendments to the application. Other grounds of opposition under s.3(1), s.3(3), s.5(2), s.5(3) and s.5(4) all failed. This decision was subsequently published on the IPO's website as BL 0/402/12.

2. I also invited the parties to make submissions on costs.

3. The applicant subsequently filed a form TM21 making the amendments I had identified as being necessary in order to overcome the s.3(4) opposition, and made submissions on costs. I had allowed the opponents 14 days from receipt of the applicant's submissions in which to make submissions of their own. However, I did not receive any further submissions from them.

4. Post amendment the application will cover:

Class 16:

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; books, booklets, magazines, journals, brochures, leaflets, pamphlets, newsletters, periodical publications, printed publications relating to wines, newsletters relating to wines; posters; picture books; tickets, printed souvenir programmes, flyers, printed promotional literature, postcards, stickers, napkins, paper decorations namely bunting, branded banners, signs; instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes).

Class 21:

Household and kitchen utensils and containers; non-electrical instruments and materials all for cleaning purposes; coasters not of paper and other than table linen; corkscrews; decanters; drinking glasses and vessels including wine glasses; glassware; flasks (not of precious metal); glass stoppers; plastic stoppers; ice buckets; ice cube moulds; earthenware, pottery and porcelain; unworked or semi-worked glass (except used in building); bottles and containers made from glass, porcelain, earthenware or ceramics, including miniature versions of such bottles and containers; cooling equipment for beverages including cooling equipment and apparatus for wine; wine coolers; utensils for wine tasting including tubes for wine tasting; utensils for wine storage including wine racks.

Class 33:

Alcoholic beverages (except beers); but not including wine other than wines which comply with the conditions of the protected designation of origin 'Bordeaux', and not including spirit drinks other than spirit drinks which comply with protected designation

of origin 'Fine Bordeaux'; wines which comply with the protected designation of origin 'Bordeaux'.

Class 35:

Provision of retail and advisory services in relation to the buying and selling of alcoholic beverages including wine; the bringing together, for the benefit of others, of alcoholic beverages, including wine, enabling customers to conveniently view and purchase those goods from an Internet website marketing alcoholic beverages, including wine; retail services connected with the sale of wines; auctioneering of wine goods; business intermediary services in the field of buying and selling wine and related products; all relating to wines which comply with the conditions of the protected designation of origin 'Bordeaux', or spirit drinks which comply with protected designation of origin 'Fine Bordeaux'; information, advisory and consultancy services relating to all of the foregoing.

Wine tastings (promotional services); promotional services in the field of alcoholic beverages in particular in the field of wine; wine sampling; all relating to wines which comply with the conditions of the protected designation of origin 'Bordeaux', or spirit drinks which comply with protected designation of origin 'Fine Bordeaux'.

Advertising and marketing services in the field of alcoholic beverages in particular in the field of wine; import and export agencies; business advisory services in the field of buying and selling wine and related products; business advisory services in relation to wines; market analysis, namely wine markets and related markets analysis studies; economic forecasting in relation to wine goods; provision of commercial information in relation to wines; dissemination of advertising, marketing and publicity materials relating to wine.

Class 36:

Brokerage services; wine brokerage services; all relating to wines which comply with the conditions of the protected designation of origin 'Bordeaux', or spirit drinks which comply with protected designation of origin 'Fine Bordeaux'.

Financial affairs; financial services and financial services provided via the internet (other than brokerage services for alcoholic beverages); acquisition services for financial investment, namely acquisition services for financial investment in wine goods; provision of financial analysis and financial information, including via the internet; financial management and financial consultancy; investment analysis, in particular for wine goods, wine markets and related markets; preparation and provision of financial information relating to wine goods, wine markets and related markets.

Investment consultancy services relating to wine; consultancy services relating to the purchase and sale of wine; investment advisory services, in particular for the purchase and sale of wine; investment management services in relation to wine; capital and fund investment services in relation to wine; financial analysis in relation to wine goods, wine markets and related markets; provision of information on value and auction prices of wines; services in relation to valuation of wines and wine cellars.

Class 39:

Collection, storage, warehousing, packaging, transportation and distribution of perishable goods; collection, storage, warehousing, packaging, transportation and distribution of alcoholic beverages, in particular wine; provision of storage facilities with controlled conditions for perishable goods, in particular wine; information, advisory and consultancy services relating to all the foregoing; travel agency services, in particular travel arrangement, arranging of tours, booking of seats for travel, escorting of travellers and sightseeing (tourism) and travel arrangement in relation to wine tours. .

Class 41:

Organisation of wine tasting and wine tasting events; organisation of wine dinners; all relating to wines which comply with the conditions of the protected designation of origin 'Bordeaux', or spirit drinks which comply with protected designation of origin 'Fine Bordeaux'.

Entertainment services and organisation of corporate events (other than wine tastings and wine dinners); education and providing of training in the field of providing food and drink, gastronomy, oenology, and cooking; arranging and conducting of training workshops, colloquiums, conferences, congresses, seminars and symposiums on providing food and drink, gastronomy, oenology and cooking; services for teaching wine appreciation and knowledge of wine.

Organisation of wine tours; club services offering information to members about wine appreciation, wine tasting, wine production, wine vintages and the purchase of wine; publication of printed matter (other than publicity texts) in electronic format including on the internet or print, in the field of providing food and drink, gastronomy, oenology and cooking; publishing of printed matter relating to wine.

4. For the reasons given in my preliminary decision, I find that the opposition fails in the light of the amended application.

COSTS

5. Without the amendments, the opposition would have partly succeeded and partly failed. I indicated in my preliminary decision that I was minded to direct that each side should bear its own costs. The applicant subsequently asked for compensation costs of £23,128.11 on the basis that:

- i) The applicant had offered to amend class 33 of the application at the outset of the opposition, but the opponent had unreasonably refused to enter into negotiations with the applicant.
- ii) If there had been discussions, the applicant could have offered the amendments required in classes 35, 36 and 41 and settled the matter.
- iii) The conduct of the opposition was not conducted in line with good practice. The opponent had taken 4 attempts to set out its grounds of opposition properly and had twice had to ask for extensions of time.

6. The Registrar normally awards costs on a contribution basis within the limits set out in the published scale. The latest version of the scale is included in Tribunal Practice Notice 4/2007. However, as this Notice indicates, the Registrar has the power¹ to vary the amounts awarded from those indicated in the scale, to cover matters not mentioned in the scale, or to depart from the scale altogether and award reasonable costs on a different basis where the circumstances justify it. The courts have long recognised this discretion², provided that it is exercised on judicial principles. The Practice Notice recognises that unreasonable behaviour may justify costs on a compensatory basis.

7. As regards the applicant's first point, it is true that it offered to restrict the list of goods in class 33 as soon as the opposition was filed. However, even if the offer had been accepted, that would still have left the opponents with the cost of bringing the opposition. Further, although the applicant offered to amend its application from an early stage in the proceedings, it did not do so until after a preliminary decision had been given making the outcome of the application dependent on the amendment.

8. Parties are encouraged to try and reach a negotiated settlement where possible, but they retain the right to have their case decided by the registrar. It is not unreasonable to opt for a formal decision rather than negotiations. It appears that the opponents' concern extended to the registration of the mark for all the goods/services covered by the application. Even though my decision rejected that all encompassing objection, the opponents were entitled to take the position they did. Further, the opponents' opposition to 3 of the other 6 classes in the application succeeded in part. The applicant's indication that it could have offered to amend these classes earlier if there had been negotiations adds nothing to its complaint that the opponents would not enter into negotiations. The opponents could equally say that the applicant could have offered to amend its application in classes 35, 36 and 41 earlier than it did.

9. The opponents' difficulty in framing their pleadings is regrettable, but hardly constitutes unreasonable behaviour. It is true that the opponents sought two extensions of time, but there is nothing to suggest delaying tactics. In fact the second extension was sought for the opponents to decide whether they wanted a hearing, and they eventually decided that they did not. So granting the second extension probably reduced overall time and cost. The first extension was granted to permit the opponents to file evidence. The opponents originally asked for a 2 month extension to the usual 2 month term, primarily on the basis that evidence had to be assembled from two distinct opponents, both based in France. The caseworker indicated that this justified only a 1 month extension. The applicant objected to that and a case management conference was held at which the 1 month extension was permitted. This presents no basis to award costs to the applicant.

10. I find that the opponents have not behaved unreasonably. No departure from the usual scale is justified. And I remain of the view that as both sides have achieved a measure of success in these proceedings, each side should bear its own costs. I direct accordingly.

¹ Now under Rule 67 of the Trade Mark Rules 2008

² See *Rizla Ltd's Application* [1993] RPC 365

APPEAL

11. This is a final decision and the period for appeal will run from the date shown below.

Dated this 30th day of November 2012

**Allan James
For the Registrar**