

O-484-12

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 1045622 IN THE
NAME OF MATTHIEU VAXELAIRE**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 72255 BY JOJO MAMAN BÉBÉ LIMITED**

BACKGROUND

1. On 27 March 2012, I issued a decision in the above proceedings (BL O/140/12). In that decision I said:

“Conclusion under section 5(2)(b)

58. JMB’s opposition based upon registration Nos: 2349755 and 2134348 succeeds in relation to the class 25 element of MV’s designation and in relation to the following goods in class 18: Leather and imitations of leather and goods made of these materials and not included in other classes, travelling bags. If and when application No. 6387757 is registered, and assuming the specification in class 18 survives in its current form JMB’s opposition will also succeed in relation to trunks, umbrellas, parasols and walking sticks. JMB’s opposition has failed in relation to: animal skins, whips, harness and saddlery.”

2. Insofar as the opposition under section 5(4)(a) of the Act was concerned, I concluded:

“64. It is clear from the above, that the proximity of trade is a highly relevant factor. In my view, the area of trade in which JMB operates and the area of trade in the objectionable goods which remain, are simply too different for, in the words of Millet LJ, the public to suppose that JMB has made itself responsible for the quality of MV’s animal skins, whips, harness and saddlery. JMB’s opposition based upon section 5(4)(a) to the remaining objectionable goods, fails.”

3. My overall conclusion was as follows:

“65. JMB’s opposition under section 5(2)(b) of the Act has succeeded to the extent indicated above in classes 18 and 25 based upon its registered trade marks. Insofar as JMB’s opposition has succeeded in relation to the additional goods in class 18, it will be necessary to await the registration of No. 6387757.”

4. In relation to costs, I said:

“JMB has been largely successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, and irrespective of the outcome of application No. 6387757, I award costs to JMB on the following basis:

Preparing a statement and considering MV’s statement:	£300
Preparing evidence:	£500
Official fee:	£200

Written submissions:	£300
Total:	£1300.”

5. Finally, I directed that JMB advise the tribunal of the outcome of CTM application no. 6387757 within one month of its registration or refusal. I explained that I would then issue a supplementary decision from which the appeal period for both the substantive and costs issues would commence.

Supplementary decision

6. In a letter dated 19 November 2012, JMB’s professional representatives, Urquhart Dykes & Lord LLP (“UDL”), informed the tribunal that the CTM in question had achieved registration. A review of the printout provided by UDL (obtained from www.oami.europa.eu on 15 November 2012), indicates that the CTM (which remains in the name of JMB), achieved registration on 9 November 2012 and did so in relation to, inter alia, all the goods and services I identified in paragraph 3 of my original decision.

7. In those circumstances, the conclusions reached in my original decision stand and JMB’s opposition to MV’s designation succeeds in relation to:

Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; umbrellas, parasols and walking sticks [in class 18],

and:

Clothing, footwear, headgear [in class 25],

but fails in relation to:

Animal skins; whips, harness and saddlery [in class 18].

8. I order Matthieu Vaxelaire to pay JoJo Maman Bébé Limited the sum of **£1300** as a contribution towards the costs incurred by it in dealing with these proceedings. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of December 2012

C J BOWEN
For the Registrar
The Comptroller-General