

**BL O/0407/24**

**TRADE MARKS ACT 1994**

IN THE MATTER OF  
TRADE MARK APPLICATION  
NO. UK00003456807

Invicta Education



(Series of 2)

In the name of  
Leigh Melanie Onslow, The Countess of Onslow  
(also known as Viscountess Cranley ne Jones-Fenleigh)  
and Others  
("APPLICANT/RESPONDENT")

AND  
OPPOSITION NO. 420853  
BY  
INVICTA S.p.A.  
("OPPONENT/APPELLANT")

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF  
MS. Suzanne Hitchings (O/0288/23) DATED 20 March 2023

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DECISION AS TO COSTS

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Invicta SpA was represented by  
Ms Marine Body, Trade Mark Attorney of Bromhead Johnson

The Applicant/Respondent did not appear and took no part in the proceedings.

Hearing date: 27 July 2023.

### **Introduction**

1. This was an appeal by Invicta SpA ("the Opponent") against decision BL O/0288/23 of Ms Suzanne Hitchings, sitting as a Hearing Officer on behalf of the Registrar of Trade Marks, dated 20 March 2023.

2. The Applicant's application No. UK00003456807 Invicta Education (Series) was filed on 9 January 2020. The Application covered classes 9, 16, 28 and 41. The specification was vast, covering – if my computer search function is to be believed – at least 2,448 semi-colon separated items. The full specification covered 23 pages of an Annex to the Decision.
3. The application was opposed by the Opponent based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). This provides as follows:

*5 Relative grounds for refusal of registration.*

...

*(2) A trade mark shall not be registered if because...*

*(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark*

4. The Opponent relied on the following Earlier Trade Mark:  
International Registration No. WE12010011 INVICTA  
(Now, after EU Completion Day, UK Registration No. 00801201001)  
International Registration date: 13 December 2013  
Date Protection Granted in the EU: 15 August 2018  
Protected for goods and services in the EU in Classes 9, 16, 25 and 35.

This specification, too, was lengthy, although not on a par with the Applicant's.

5. The specifications of both parties' marks are reproduced in full in the Annex to Decision O/0288/23 and I shall not reproduce them in full here.
6. Neither party requested to be heard on the matter at first instance. The Opponent filed submissions in lieu.
7. After considering the papers the Hearing Officer allowed the Opposition in part, refusing the application for some of the goods and services.

### **The Appeal**

8. On 5 May 2023 the Opponent filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.
9. The Appeal was on a very narrow basis, namely that there were numerous inconsistencies in the Decision insofar as it dealt with the identity/similarity of goods/services. In effect, the case was that there were many instances where goods/services or their equivalents were found to be identical/similar in one finding, but dissimilar in the next.
10. No Respondent's Notice was filed and the Applicant played no part in the Appeal.
11. After a hearing on 27th July 2023, it appeared to me that many of the disputed items were inconsistencies which could have arisen from clerical errors or oversights by the Hearing Officer in analysing the enormous and unwieldy size of the applicant's specification. I make no criticism of the Hearing Officer. Whilst the Applicant and its representatives will have had their reasons, on the face of it the specification was literally the proverbial "kitchen sink" and such specifications are pre-disposed to lead to errors of analysis by virtue of their very size and repetitive monotony.
12. I asked the Opponent's Representatives whether, prior to filing the Appeal, they had taken any steps to draw these matters to the attention of the Hearing Officer with a view to correction. The response was that they had not done so, on the basis that they considered *"the possibility to request a supplementary decision from the Hearing Officer to correct clerical errors or the intention of the hearing officer were not relevant for inconsistencies"* (sic).
13. I therefore directed that the Hearing Officer should review their decision to consider whether there was power to issue a supplementary decision to correct any unintended irregularities in their comparison of the goods and services at issue in the original decision. In my Direction, I also asked the Hearing Officer that if such a decision was issued they should also consider whether the Registrar should make a payment to the Opponent in respect of the costs (including of this Appeal) occasioned by such errors.

14. The Hearing Officer subsequently issued a Supplementary Decision, BL O/0133/24, in which they accepted that there had been an irregularity in procedure capable of correction under Rule 74 of the Trade Mark Rules 2008, resulting in the belated success of the opposition against the great majority (but not all) of the goods and services the subject of this appeal. However, the Hearing Officer did not, for whatever reason, deal with my request for them to consider the Opponent's costs occasioned by the irregularities.

15. The Opponent did not appeal the Supplementary Decision. At my prompting (to both parties) regarding the fate and costs of the instant appeal, the Opponent emailed the Office on 10 April:

*"In reply to the UKIPO Official letter of 3rd April 2024 in relation to the above case, we submit that the instant appeal can be withdrawn following the Supplementary Decision.*

*Therefore, we kindly request the refund of the appeal fee and on-scale costs for (the Opponent's Trade Mark Attorney's) attendance to the Appeal hearing."*

16. The Applicant did not respond.

### **Decision on Costs**

17. As noted above, notwithstanding the Supplementary Decision did not entirely find in the Opponent's favour it resulted in sufficient correction for the instant Appeal to be withdrawn. That being the case, the Appeal being discontinued at the Opponent's behest, the Opponent is not entitled to its costs (which would usually have included the Appeal fee).

18. Indeed, in principle, following a withdrawal it would usually be the case that the adverse party – in this case the Applicant – would be entitled to *its* costs. However, the Applicant has not requested them so I need not consider this matter further.

19. The Hearing Officer's original costs order, that both parties shall bear their own costs in the Opposition, stands.

20. As to the Opponent's request for a refund of the Appeal Fee, presumably by the Registrar, that it is not an order within my powers.

21. Nevertheless, since the Appeal arose in large part from irregularities in procedure, I have given thought as to whether I might, once again, invite the Registrar to give this request their consideration.
22. First, I note that insofar as the result of the Supplementary Decision is effectively akin to what was being considered on this appeal, the Opponent was mostly, but not wholly, successful. It has not raised any additional appeal, nor maintained this appeal for any of the items in respect of which it was unsuccessful in the Supplementary Decision.
23. I am also of the view that this matter could possibly have been resolved without the need for an Appeal at all, if the Opponent had only raised its concerns directly with the Hearing Officer within the original Appeal period.
24. I therefore decline to invite the Registrar to consider a refund of the Appeal fee. There is nothing to stop the Opponent taking this up with the Registrar directly, however.

**Conclusion**

25. The Appeal is withdrawn. The Decision, as corrected by Supplemental Decision No. BL O/0133/24, stands.
26. No order as to costs.

**Philip Harris**

Appointed Person

01/05/2024