

TRADE MARKS ACT 1995

DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS WITH REASONS

Re: Review of taxation of costs in the matter of opposition by Societe Guy Laroche to registration of trade mark application 925452(9) - **ROBERT LA ROCHE** - filed in the name of Uniopt GmbH.

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| DELEGATE: | Deirdre O'Brien |
| DECISION: | Reg 21.13(4) review of taxation of costs Taxation affirmed – cost of preparing written submissions for consideration at hearing allowed. |

Background

1. The opposition by Societe Guy Laroche ('the opponent') to registration of trade mark application 925452 was unsuccessful and costs were awarded against it.¹ Uniopt GmbH ('the applicant') duly filed a bill of costs pursuant to reg 21.12(4) of the *Trade Marks Regulations 1995* ('the Regulations') and the opponent was given an opportunity to comment. It objected to the applicant's inclusion of costs incurred in preparing the case for hearing.
2. The bill of costs was taxed by a delegate of the Registrar who allowed the applicant's claim whereupon the opponent asked for a review of the taxation as allowed by reg21.13(4). I was delegated by the Registrar to carry out the review.
3. I advised the opponent by letter that I did not intend to vary the taxation. I gave the opponent an opportunity to ask to be heard in the matter but it did not do so.

Reasons

4. Schedule 8 to the Regulations lists the allowable items in a bill of costs where costs have been awarded pursuant to section 221 of the *Trade Marks Act 1995*. Item 9 in part 1 of schedule 8 is 'preparation of cases for hearing'. Although a hearing was held in this opposition it was not requested by the applicant, nor did the applicant attend.

¹ [2005] ATMO 54 (30 September 2005)

This is the basis for the opponent's objection to the inclusion of item 9 in the taxation of costs.

5. It is the Registrar's practice to regard the preparation of written submissions for consideration at a hearing in the same manner as the preparation of argument to be presented in person at the hearing. There is a note to this effect in the Trade Marks Manual of Practice and Procedure at paragraph 4.1 of part 55.
6. In this case the applicant filed written submissions by its agent which were nine pages in length and which addressed each of the grounds in the notice of opposition and the opponent's evidence. Those submissions were considered at the hearing and were the subject of submissions in rebuttal by the opponent. The applicant incurred costs in preparing its case for hearing and I am satisfied it is appropriate that it be reimbursed according to the official scale.

Decision

7. Having reviewed the taxation, I affirm it and confirm that the certified costs will include the amount of \$360 for costs incurred in preparing the case for hearing.

Deirdre O'Brien
Trade Marks Hearings
24 July 2006