

**Application for Costs
in Trade Mark Application No. T06/01541A
by Hannah Holdings Pte Ltd**

And

**Objection
by Incontech Pte Ltd**

*Before P Arul Selvamalar, Principal Assistant Registrar of Trade Marks
13 September 2006*

Interlocutory hearing – whether opponent entitled to cost of filing notice of opposition - opponent did not seek voluntarily withdrawal of application before filing notice of opposition - Trade Marks (Amendment) Rules 2005, Rule 72 & 75

Facts

This is an application for costs by the Opponents, Hannah Holdings Pte Ltd in trade mark application T06/01541A for the mark TRIMSLIM in class 5, filed by the Applicants, Incontech Pte Ltd on 1 February 2006. On 1 October 2004, the Opponents and the Applicants had entered into a joint venture agreement regarding the distribution of TRIMSLIM products. Pursuant to the agreement, the Opponents purchased from the Applicants the trade marks TRIMSLIM in classes 3, 5 and 44. The Applicants transferred to the Opponents their trade mark application in class 44 in accordance with the agreement. However the applications in classes 3 and 5 were not transferred. These applications were abandoned because the applicants thought that once the class 44 application was registered, they need not follow up on the applications in classes 3 and 5.

On 1 February 2006, the Applicants say that they realised that the proper class for these products should be class 5 and therefore they filed a new application to register the mark TRIMSLIM in class 5. They say that they made this application in order to fulfill their obligation under the agreement but on 26 March 2006 they gave notice to terminate the agreement because of a dispute. They did not inform the Opponents that they were filing a new application in class 5 to fulfill their obligation under the agreement.

The Opponents found out that the Applicants had filed the new application by doing a search at the IPOS and they filed an opposition to the application on 3 May 2006. They did not ask the Applicants to voluntarily withdraw the application before filing the Notice of Opposition. On 18 May 2006, after being served with a copy of the Notice of Opposition, the Applicants wrote to the HMD to withdraw the application. It was withdrawn on 30 June 2006.

The Opponents are seeking costs of Drawing and Filing the Notice of Opposition (\$300), Preparing Evidence for the hearing (\$360), Preparing for the hearing (\$400) and Disbursements (\$440). The Applicants state that the Opponents have already sought the cost of filing the Notice of Opposition in a DC Suit filed by them in relation to the agreement, therefore they should not be entitled to these costs. The Applicants seek costs of having to object to the Opponents application for costs at this interlocutory hearing.

Decision

The Registrar does not have sufficient evidence before her to determine whether the Applicants did apply for the mark in this case to fulfill their obligations under the agreement. I have also taken note that the Applicants could have informed the Opponents that they are making this application. However the fact remains that the Opponents did not seek a voluntary withdrawal of the application, when they found out that the Applicants had filed the application, before filing the Notice of Opposition. Therefore Opponents cost of Drawing and Filing the Notice of Opposition (\$300) and Disbursements comprising the filing fee (\$340) and other disbursements (\$100), should be borne by the Opponents.

With respect to the interlocutory hearing and the Opponents cost of preparing evidence for the hearing and for attending the interlocutory hearing, I am of the view that it should be borne by the Opponents. I am also of the view that the Applicants costs in objecting to this application for costs by the Opponents and attending the hearing should be borne by the Applicants. This is an appropriate case to order that each party should bear its own costs of the interlocutory hearing.

Legislation referred to:

- Trade Marks (Amendment) Rules 2005, Rules 72 & 75

Representation:

- Mr. Ng Hwee Lon (Veritas Law Corporation) for the Applicants
- Mr. Chia Kok Peng (Robert Wang & Woo LLC) for the Opponents

Date of Decision: 5 December 2006