

**Application For Costs
In Trade Mark Application Nos. T02/14847F
By Principal Financial Group Inc**

And

**Objection
By First Principal Financial Pte Ltd**

*Before P Arul Selvamalar, Principal Assistant Registrar of Trade Marks
30 August 2006*

Interlocutory hearing – taxation of costs after full opposition hearing – whether new Scale of Costs applies to opposition heard before new Scale came into effect – Trade Marks (Amendment) Rules 2005, Rule 72, 73 & 75

Facts

This is an application for costs by the Opponents, Principal Financial Group Inc, pursuant to an opposition heard on 19 & 21 October 2005, concerning trade mark application T02/14847 F filed by the Applicants, First Principal Financial Pte Ltd. The Opponents had opposed the application on 5 grounds under the Trade Marks Act and succeeded on 1 ground - that the marks were confusingly similar. Therefore the decision of the Registrar delivered on 21 January 2006 was that application mark cannot proceed to registration and that the Applicants should pay the Opponents costs in the opposition proceedings. The Opponents had 1 month from the date of the decision, 21 February 2006, to file their Bill of Costs. However they filed their bill on 9 May 2006. The Applicants objected to the late filing of the Bill and an interlocutory hearing was held to determine whether the Bill should be accepted. The Bill was accepted after the hearing, with the Opponents being granted an extension of time to file the Bill late. The Opponents Bill applied the new Scale of Costs in the Fourth Schedule of the Trade Mark (Amendment) Rules 2005, which came into effect on 1 January 2006. The Applicants objected to the application of the new Scale and argued that the old Scale of Costs in the Trade Mark Rules should apply as the opposition was heard on 19 & 21 October 2005 before the date of the amendment. However the Opponents responded that as there were no savings provisions in the Trade Marks (Amendment) Rules 2005, the new Scale applies.

Decision

The Trade Mark Rules which came into effect on 15 January 1999, were amended by the Trade Mark (Amendment) Rules 2005 which came into effect on 1 January 2006. There is no transitional provision in the 2005 Rules which preserve the old Rule relating to the Scale of Costs. Therefore the new Scale of Costs will apply in this case.

The Opponents first Statutory Declaration in support of the opposition was 1765 pages long and was filed as 5 volumes. 26 pages contained the statements made by the deponent and the remainder 1739 pages contained 21 exhibits. These exhibits contained inter alia, pages from magazines and annual reports, worldwide trade mark reports, materials relating to investment funds, information about the Multinational Insurance Association and materials from seminars and conferences. Magazine pages alone comprised almost 2 volumes of the 5 volumes filed. The Registrar found that not all the exhibits were relevant to the opposition. Therefore the cost of the preparation of the first Statutory Declaration should reflect that.

	Amount Sought	Amount Awarded
Filing Notice of Opposition	\$300	\$300
Preparing 1st Statutory declaration	\$1600	\$600
Preparing 2nd Statutory declaration	\$1600	-
Reviewing:		
i. Counter Statement	\$800	\$300
ii. Amended counter statement	\$800	\$100
iii. Applicants statutory declaration	\$800	\$400
iv. Applicants submissions and Bundle of Authorities	\$800	-

Preparing for PHR	\$800	-
Preparing for hearing	\$2000	\$1200
Attendance at hearing on 19 & 20 Oct 05	\$800 \$800	\$800 \$400
Drawing Bill of Costs	\$15	\$15
Attending taxation hearing	\$300	\$150
Filing fees for: i. Notice of Opposition ii. Form TM 13	\$340 \$400	\$340 \$400
Disbursements		
Photocopying:		
i. 1st statutory declaration	\$794.25	\$794.25
ii. 2nd statutory declaration	\$14.85	\$14.85
iii. Written Submissions	\$11.25	\$11.25
iv. Bundles of Authorities	\$114.30	\$114.30
v. Additional Written Submissions	\$6.75	\$6.75
vi. Additional Bundle of Authorities	\$47.70	\$47.70
GST on Disbursements (5% of \$989.10)	-	\$49.46
Total	\$13,393.56	\$ 6,643.56

The Opponent are therefore awarded a total of \$6,643.56 to be paid by the Applicants to the Opponents within 2 months from the date of this decision.

Legislation referred to:

- Trade Marks (Amendment) Rules 2005, Rules 72, 73 & 75

Representation:

- Ms Theresa O'Connor (Infinitus Law Corporation) for the Applicants
- Mr P Sivakumar (Joseph Lopez & Co) for the Opponents

Date of Decision: 29 November 2006