

Application for Costs
In Trade Mark Application Nos. T96/13388E, T96/13389C, T96/13390G & T96/13393A By Resorts World Bhd

And

Objection
By Kellogg Company

Before P Arul Selvamalar, Principal Assistant Registrar of Trade Marks
16 January 2007

This is an application for costs by the Applicants, Resorts World Bhd, pursuant to the hearing of oppositions to their trade mark application nos. T96/13388E, T96/13389C, T96/13390G and T96/13393A in 4 classes. The oppositions were filed by Kellogg Company and were heard on 27 June 2006. The Opponents were unsuccessful in all 4 oppositions and the Registrar decided that application marks may proceed to registration. The Registrar also ordered that the Opponents pay the Applicants' costs in defending their applications. The Applicants filed their Bills of Costs with respect to each opposition and the Opponents disputed the amounts claimed as disbursements (except filing fees) and for attendance and preparation for hearing. The Opponents argued that as the 4 oppositions were heard on the same day, the cost of preparation and attendance at the hearing should be on a reducing scale.

The Applicants argued that although the 4 oppositions were heard together they were filed at different times, in 1999, 2000 and 2001 and that they prepared a different submission for each class of opposition. They argued that therefore they should be entitled to the cost of preparing and attendance for each opposition. The Applicants claims for disbursements (excluding filing fees) in the 4 oppositions were as follows, class 28: \$5,328.97, class 21: \$1,025, class 25: \$844 and class 16: \$1,652. The Applicants argued that a lot of research was done for the oppositions and that although the research was done for all 4 oppositions, the research was charged to 1 file, namely, the opposition in class 28. The Registrar requested that the Applicants justify their claim for disbursements by writing to the Registrar after the costs hearing. The Applicants wrote to the Registrar 2 weeks later, stating that there was an error in their claim for disbursements. They said that the amounts claimed as disbursements should be as follows, class 28: \$5211.05, class 21: \$385.08, class 25: \$1,589.36 and class 16 : \$1575.09.

Decision

The 4 oppositions were heard on the same day, therefore the Applicants are entitled to the cost of attendance at a hearing for one day. However with respect to preparation for the hearing, the Applicants are entitled to costs in each opposition albeit on a reducing scale. With respect to disbursements, the Registrar will usually allow photocopying charges at a rate of \$0.15 cents per page in the relevant documents namely, pleadings, statutory declarations, written submissions and bundles of authorities. However the Applicants did not elaborate on their claim for photocopying by stating the number of pages in the relevant documents. Neither did they produce supporting documents for the remainder of their claims like postage, telephone calls, courier, search charges over the internet and fax. Even after they claimed these items, they still claimed for items like printing, outgoing mail, transport and incidentals. When asked to justify their claim, the applicants responded by stating that their original claims were in error and stated different amounts to be claimed for each class which were quite different from the original amounts claimed. Further in the opposition in class 21, they claimed the filing fee paid to register the change of their office address with IPOS. This is not a cost the Opponents should incur for having opposed their application in that class. The Registrar will therefore not award the claims for searches over the internet, printing, outgoing mail, transport and incidentals and award only postage, telephone calls, courier, photocopying and facsimile charges as disbursements.

T96/13388E (class 28)	Amount sought	Amount awarded
Reviewing Notice of Opposition	\$800	\$300

Drawing and filing Counter Statement	\$300	\$300
Reviewing Amended Notice of Opposition	\$500	\$100
Drawing & Filing amended counter statement	\$300	\$100
Reviewing Opponents' 1st Statutory Declaration (SD)	\$800	\$600
Preparing Applicants SD	\$1600	\$1000
Preparing for interlocutory proceedings (CMC)	\$500	-
Attending interlocutory hearing (CMC)	\$500	-
Reviewing Opponents 2nd SD	\$800	\$400
Preparing for hearing	\$2000	\$1600
Attendance at hearing	\$800	\$200
Drawing Bill of Costs	\$45	\$20
Attending taxation hearing	\$300	\$75
Filing fees for:		
i. Counter Statement	\$325	\$325
ii. Form TM 13	\$650	\$650
Disbursements	\$5328.97 \$5211.05	\$738.92
postage	2.84	2.84
telephone calls	84.84	84.84
courier	201.94	201.94
photocopying	432.20	432.20
fax	17.10	17.10
searches	4193.80	-
printing	25.35	-
outgoing mails	3.72	-
transport	50.92	-
incidentals	193.34	-
Total	\$15,431.05	\$6408.92

T96/13389E (class 21)	Amount sought	Amount awarded
Reviewing Notice of Opposition	\$800	\$300
Drawing and filing Counter Statement	\$300	\$300
Reviewing Opponents' 1st Statutory Declaration (SD)	\$800	\$500
Preparing Applicants SD	\$1600	\$800
Reviewing Opponents 2nd SD	\$800	\$300
Preparing for interlocutory proceedings	\$500	-
Attending interlocutory hearing	\$500	-
Preparing for interlocutory proceedings (CMC)	\$500	-

Attending interlocutory hearing (CMC)	\$500	-
Preparing for hearing	\$2000	\$1200
Attendance at hearing	\$800	\$20
Drawing Bill of Costs	\$45	\$20
Attending taxation hearing	\$30	\$75
Filing fees for:		
i. Counter Statement	\$325	\$325
ii. Form TM 13	\$650	\$650
Disbursements	\$1025 \$385.08	\$191.76
postage	2.40	2.40
telephone calls	24.42	24.42
courier	93.90	93.90
photocopying	45.60	45.60
fax	25.44	25.44
filing fee for tm 1 to change address for service	6.00	-
outgoing mails	18.83	-
transport	71.83	-
incidentals	96.66	-
Total	\$10,805.08	\$4,861.76

T96/13390E (class 25)	Amount sought	Amount awarded
Reviewing Notice of Opposition	\$800	\$300
Drawing and filing Counter Statement	\$300	\$300
Reviewing Amended Notice of Opposition	\$500	\$100
Drawing & Filing amended counter statement	\$300	\$100
Reviewing Opponents' Statutory Declaration (SD)	\$800	\$400
Preparing Applicants SD	\$1600	\$600
Reviewing Opponents 2nd SD	\$800	\$200
Preparing for interlocutory proceedings (CMC)	\$500	-
Attending interlocutory hearing (CMC)	\$500	-
Preparing for hearing	\$2000	\$800
Attendance at hearing	\$800	\$200
Drawing Bill of Costs	\$45	\$20
Attending taxation hearing	\$300	\$75
Filing fees for:		
i. Counter Statement	\$325	\$325
ii. Form TM 13	\$650	\$650

Disbursements	\$844 \$1589.36	\$1175.23
postage	11.48	11.48
telephone calls	10.94	10.94
courier	310.74	310.74
photocopying	815.73	815.73
fax	26.34	26.34
searches	81.70	-
printing	16.20	-
outgoing mails	4.00	-
transport	145.42	-
incidentals	166.81	-
Total	\$11,809.36	\$5,245.23

T96/13393E (class 16)	Amount sought	Amount awarded
Reviewing Notice of Opposition	\$800	\$300
Drawing and filing Counter Statement	\$300	\$300
Reviewing Opponents' Statutory Declaration (SD)	\$800	\$300
Preparing Applicants SD	\$1600	\$400
Preparing for interlocutory proceedings	\$500	-
Attending interlocutory hearing	\$500	-
Reviewing Opponents 2nd SD	\$800	\$100
Preparing for hearing	\$2000	\$400
Attendance at hearing	\$800	\$200
Drawing Bill of Costs	\$45	\$20
Attending taxation hearing	\$300	\$75
Filing fees for:		
i. Counter Statement	\$325	\$325
ii. Form TM 13	\$650	\$650
Disbursements	\$1652 \$1575.09	\$1167.13
postage	11.48	11.48
telephone calls	10.94	10.94
courier	310.74	310.74
photocopying	815.73	815.73
fax	18.24	18.24
searches	81.70	-
printing	16.20	-
outgoing mails	2.58	-
transport	140.67	-
incidentals	166.81	-
Total	\$10,995.09	\$4,237.13

The Applicants are therefore awarded a total of \$20,753.04 as costs in all four oppositions to be paid by the Opponents to the Applicants within 2 months from the date of this decision.

Legislation referred to:

- Trade Marks (Amendment) Rules 2005, Rule 73

Representation:

- Ms Low Pei Lin (Allen & Gledhill) for the Applicants
- Mr P Sivakumar (Joseph Lopez & Co) for the Opponents

Date of Decision: 30 March 2007