

O-709-18

SUPPLEMENTARY DECISION

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3138122
BY TWINKL LIMITED
TO REGISTER THE TRADE MARK**

twinkl

**IN CLASSES 9, 16, 18, 21, 28, 35, 38, 41 & 42
AND
IN THE MATTER OF OPPOSITION THERETO
UNDER No. 406304 BY
D.C. THOMSON & COMPANY LIMITED**

1) On 6 September 2018 I issued decision O-554-18 in which I found mainly in favour of Twinkl Limited (the applicant). At the hearing it was agreed that the decision would be issued and that both parties would then have the opportunity to provide written submissions on costs. Both sides have now responded regarding costs. This was a case which, certainly in the view of the IPO, should have gone to mediation. This opinion was expressed but unfortunately not agreed to by the opponent. The existing co-existence agreement and existing registrations of both parties should also have precluded certain aspects of the case. The section 5(3) and 5(4) grounds were always going to struggle given the absence of use of the opponent's mark for many years, although this does not mean it was totally without merit, residual goodwill could have played a part. The 3(6) claim based on there being no intention to use the mark was always fraught, as these rarely succeed. Having carefully considered the submissions from both parties I do not accept that an award of costs off the normal scale is justifiable as I do not accept that the behaviour of the opponent, D.C. Thomson & Company Ltd, was excessive enough to warrant such a sanction. However, nor do I accept the view of the opponent that both sides should meet their own costs. I therefore intend to award costs towards the top end of the scale which will also take into account the two Case Management Conferences which took place.

COSTS

2) As the applicant has been mainly successful it is entitled to a contribution towards its costs.

Expenses	£200
Preparing a statement and considering the other side's statement	£600
Preparing evidence & filing written submissions & attendance at CMCs.	£3500
TOTAL	£4,300

3) I order D.C. Thomson & Company Ltd to pay Twinkl Limited the sum of £4,300. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of November 2018

George W Salthouse
For the Registrar,
the Comptroller-General