

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3054780

BY HOMEMAKER SOLUTIONS

TO REGISTER THE TRADE MARK

OUR HOUSE
Our House
(series of two)

IN CLASS 35

AND OPPOSITION THERETO UNDER NO 403124 BY

OURHOUSE (UK) LIMITED

Background and pleadings

1. On 8 May 2014, Homemaker Solutions (“the applicant”) applied to register the following trade mark application as a series of two:

OUR HOUSE

Our House

2. The application was accepted and published on 25 July 2014 for the following class 35 services¹:

Retail services, retail store services and electronic shopping retail services connected with the sale of a variety of consumer goods, namely, computers, hi-fi, equipment, cameras, telephony equipment, televisions, video and DVD players, sound recording apparatus, radios, home office equipment and home office furniture, electrical equipment, namely, refrigerators, microwave ovens, coffee makers, toasters, white goods, hair dryers, furniture, washing machines, spin dryers; the bringing together, for the benefit of others, of a variety of consumer goods, namely, computers, hi-fi equipment, cameras, telephony equipment, televisions, video and DVD players, sound recording apparatus, radios, office equipment and office furniture, electrical equipment, namely, refrigerators, microwave ovens, coffee makers, toasters, white goods, hair dryers, furniture, washing machines, spin dryers in a wholesale and/or retail outlet, via the Internet, by electronic means, by mail order or by means of telecommunications; presentation of goods on communication media, for retail purposes; none of the aforesaid services relating to the sale or letting of real estate, real estate management services or estate agency services.

3. Ourhouse (UK) Limited (“the opponent”) opposes the trade mark on the basis of Section 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier UK Trade Mark no. 2552269 (“the earlier mark”). Pertinent details of the earlier mark are below:

Mark (series of two): ourhouse
 Our House

Filing date: 7 July 2010

Date of entry in the register: 15 October 2010

Services:

Class 35: Advertising; business management; business management assistance; commercial or industrial management assistance; business management services; consultancy and advisory services relating to business management; business advisory services; business management advisory services; business assistance services; provision of business advice to start

¹ The application was originally filed for a broader class 35 specification and class 36, though a number of amendments to the list of services were filed.

up companies; provision of business advice to facilitate the growth of companies; provision of business advice to facilitate e-business and electronic commerce; export credit management; business administration; office functions; provision of business information, business enquiries; business consultancy services; advertising of financial services; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; accountancy; auctioneering; trade fairs; data processing; provision of business information; advisory, consultancy and information services relating to all the aforesaid services.

Class 36: Insurance; financial affairs; monetary affairs; real estate affairs; estate agency services; property management services; mortgage and savings services; mortgage protection policies; re-mortgage services; mortgage brokerage; mortgage advice; information and advisory services on mortgages; information and advisory services on property; mortgage consultancy; mortgage services; mortgage packaging; advice relating to mortgages for residential properties; advice services relating to enhancement of mortgages; advisory services relating to mortgages; agency services for lending on mortgage; arranging of loan agreements in relation to mortgage bonds; mortgage services; arranging of mortgages; commercial mortgage brokerage; financial services relating to mortgages; financial services relating to the issuance and sale of mortgage-backed securities; lending on mortgage; mortgage and savings services; mortgage banking; mortgage brokerage; mortgage lending; issuing of mortgage bonds; mortgage financing services; mortgage loan services; insurance services for the protection of mortgages; mortgage investment management; financial services relating to mortgages, mortgage administration; securing of funds for purchase of property; commercial and residential lending services; loan services; arranging and brokerage of personal loans, commercial loans, secured loans, unsecured loans, loans payable in instalments; credit reference and credit checking services; underwriting services; mortgage insurance; mortgage protection policies; provision of mortgage loan insurance; insurance services; accident, sickness and redundancy insurance; life insurance; buildings insurance; household contents insurance; pet insurance; long term sickness cover insurance; assurance services; insurance underwriting and insurance brokerage all relating to health, sickness, personal accidents and income protection and unemployment; mortgage payment protection insurance; car insurance; debt recovery services; debt counselling; debt collection agency services; debt factoring; debt management services; debt recovery agency services; debt restructuring; factoring of debts; pension services; financial services provided via the Internet; issuing of tokens of value in relation to bonus and loyalty schemes; provision of financial information; property valuations and survey; real estate affairs, real estate management; real estate development; real estate affairs; advisory and consultancy services relating to real estate affairs and ownership; real estate valuations; agency services for the leasing of real estate property; real estate appraisal services; arranging letting of real estate; arranging of leases of real estate; arranging of loan agreements secured on real estate; arranging of shared ownership of real estate; arranging the provision of finance for real estate purchase; commercial real estate agency services; consultation services relating to real estate; real

estate agencies; estate agents; financial and real estate services relating to the sale and purchase of commercial premises; negotiating and arranging leases for the rental of property; arranging of lease agreements; arranging of leases for the rental of commercial property; arranging of leases of real estate; financial valuation of leasehold property; lease purchase finance; financial services for the purchase of real estate and for real estate property and buildings; insurance services relating to real estate; advisory and consultancy services relating to real estate, commercial real estate and licensed premises; property investment services; property letting; property leasing; rental of accommodation; rental of property; project co-ordination and management services all relating to real estate; collections of rent, tenant management services; estate management services; property portfolio management services; control of rent reviews and lease renewals; credit services for export sales; export factoring; export finance services; financial credit services for exporters; loaning of securities; advisory, consultancy and information services relating to all the aforesaid services.

Class 45: Administration services being legal services for businesses; legal services; legal services relating to business; provision of information relating to legal services; provision of legal services; advisory services being legal advice relating to consumers rights; advisory services being legal advice relating to the rights of landlords; advisory services being legal advice relating to the rights of tenants; arranging for the provision of legal services; information services relating to legal matters; legal consultancy services; legal enquiry services; computerised conveyancing services; conveyancing; legal services relating to conveyancing; legal information research services; legal information services; legal investigation services; legal services relating to business; legal services relating to property; legal services relating to commercial property; legal services relating to rental property; legal services relating to domestic property; legal services relating to letting of property; legal services relating to statutory powers.

4. The opponent argues that the respective services are similar. The opponent states that the respective marks are identical regardless of whether the words Our House are conjoined or in upper or lower case since they claim that this would be easily missed and go unnoticed by the average consumer.

5. The applicant filed a counterstatement denying the claims made, admitting that the marks are practically identical.

6. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary.

7. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. A Hearing took place before me via the telephone, with the opponent represented by Mr Kieron Taylor of Swindell & Pearson Ltd. The applicant initially stated that they would attend a hearing then two working days prior to the hearing they advised that they would be filing written submissions in lieu.

EVIDENCE

Opponent's evidence in chief

8. Rather than file evidence, the opponent opted to file written submissions in chief.

Applicant's evidence

Witness statement of Mr Colin Bell and exhibits CB1 – CB9

9. Mr Bell is a Partner within the commercial and intellectual property team at Brabners LLP, the applicant's professional representatives. This is a position he has held since 2014. The relevant exhibits attached to Mr Bell's witness statement are summarised below:

- Exhibit CB1 consists of print outs from the eBay website "which indicate that eBay does not provide auctioneering services and expressly states that it is not an auctioneer. eBay is an online marketplace or venue it is not an auction house, nor an auctioneer, nor does it conduct auctions."²
- Exhibits CB3 and CB4 consist of a selection of Google maps street views of various estate agents owned or connected with the opponent. They show a variety of other types of businesses in close proximity to the opponent's stores.
- Exhibit CB5 consists of details of the applicants store locations which show that there are no estate agents nearby.
- Exhibit CB6 consists of a selection of print out of various company names from Companies House and Experian which include the term OUR HOUSE. Since Company name registrations are entirely separate and different to trade mark rights and registrations, they do not have any bearing on these proceedings.
- Exhibit CB7 is an extract from the UK trade marks register of a third party trade mark registration (copy below)³. It covers class 36 property letting agency services and includes the words OUR HOUSE.



- Exhibit CB8 consists of third party use of OUR HOUSE in relation to identical or similar services to those of the opponent.

² Paragraph 4a of the witness statement

³ UK Trade Mark Registration no. 2532203

- Exhibit CR9 consists of a selection of examples of how the opponent is currently using the mark OUR HOUSE which the applicant claims to be in conjunction with other elements rather than the format it is registered.

Opponent's evidence in reply

Two witness statements of Kieron Peter Mark Taylor and exhibits KPMT01 – KPMT03

10. Mr Taylor is a trade mark attorney and the opponent's professional representative. Mr Taylor attached a number of exhibits to his witness statement. They are summarised as follows:

- Exhibit KPMT01 are a selection of Google map prints out of various streets in Derby. Mr Taylor highlights that the streets contain three different estate agents and that a short walk away there is an electronic store called Lester and Nix.
- Exhibit KPMT02 consists of a selection of web print outs for Euronics, which sell white goods and are in close proximity to a mortgage advice centre (Burchell Edwards) and an estate agents (Attenborough).
- Exhibit KPMT03 consists of various web pages downloaded from eBay and Farrer and Co. One of the print out from eBay refers to itself as "offering auctions and also "buy it now" i.e. fixed price services". One of the print outs from Farrer & Co, dated November 2009, refers to eBay as an online auction house.

Preliminary issues

11. The applicant's evidence relies on a number of factors which Mr Bell says will avoid any likelihood of confusion or connection being made between the marks. These are that:

- i) The opponent uses its mark in a format different to what has been registered.
- ii) There are other similar marks registered which co-exist with the opponent's earlier mark.
- iii) There are a number of company registrations for the same or similar marks.

12. These are familiar arguments in trade mark oppositions which are more commonly adopted by private litigants. Before considering the merits of this case, it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

13. A trade mark registration is essentially a claim to a piece of legal property. Every registered mark is entitled to legal protection against the use or registration of the same or similar trade marks for the same or similar goods/services, if there is a

likelihood of confusion. Until a trade mark has been registered for five years, it is entitled to protection in relation to all the goods/services for which it is registered. Consequently, the opponent's earlier UK mark must be protected for the services for which it is registered in classes 35, 36 and 45 without the opponent needing to prove any use of the OUR HOUSE and Our House mark in relation to those services. Therefore, even if the opponent has been using the mark in a different format, this is not relevant to these proceedings and this argument is dismissed.

14. The applicant also seeks to rely on the existence of other similar marks on the UK and Community trade mark registers in order to show that such marks can co-exist without a likelihood of confusion. In *Henkel KGaA v Deutsches Patent- und Markenamt*, Case C-218/01, the Court of Justice of the European Union found that:

“65... The fact that an identical trade mark has been registered in one Member State as a mark for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter's decision to grant or refuse registration of a trade mark.

On the other hand, the fact that a trade mark has been registered in one Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark for goods or services similar to those for which the first trade mark was registered.”

15. In the absence of evidence that the marks are in use on a scale that might have led to confusion, it cannot be shown that the public have got used to distinguishing between them without confusion. It is therefore well established that the mere existence of similar marks on trade mark registers neither increases nor decreases the likelihood of confusion between one such mark and another trade mark in a different ownership. The ‘state of the register’ evidence is therefore of no weight. The position is no different in respect to company registrations.

DECISION

Section 5(2)(a)

16. Section 5(2)(a) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the trade mark is protected...there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Comparison of marks

17. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union held at paragraph 54 that:

“... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

18. The respective trade marks are shown below:

Earlier series of two trade marks	Contested series of two trade marks
ourhouse Our House	OUR HOUSE Our House

19. The competing trade marks consist of the words Our House. Therefore, they are clearly literally identical. Whether the marks are presented as “Our House” or “OUR HOUSE” does not alter the conclusion that they are identical. It is noted that the other mark in the series is conjoined (ourhouse) though since I have already found the marks to be identical, this does not put the opponent in any better position.

Comparison of services

20. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

21. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular

whether they are, or are likely to be, found on the same or different shelves;

- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

Applicant's services	Opponent's services
<p>Class 35</p> <p>Retail services, retail store services and electronic shopping retail services connected with the sale of a variety of consumer goods, namely, computers, hi-fi, equipment, cameras, telephony equipment, televisions, video and DVD players, sound recording apparatus, radios, home office equipment and home office furniture, electrical equipment, namely, refrigerators, microwave ovens, coffee makers, toasters, white goods, hair dryers, furniture, washing machines, spin dryers;</p> <p>the bringing together, for the benefit of others, of a variety of consumer goods, namely, computers, hi-fi equipment, cameras, telephony equipment, televisions, video and DVD players, sound recording apparatus, radios, office equipment and office furniture, electrical equipment, namely, refrigerators, microwave ovens, coffee makers, toasters, white goods, hair dryers, furniture, washing machines, spin dryers in a wholesale and/or retail outlet, via the Internet, by electronic means, by mail order or by means of telecommunications;</p> <p>presentation of goods on communication media, for retail purposes;</p> <p>none of the aforesaid services relating to the sale or letting of real estate, real estate management services or estate agency services.</p>	<p>Class 35</p> <p>Advertising; business management; business management assistance; commercial or industrial management assistance; business management services; consultancy and advisory services relating to business management; business advisory services; business management advisory services; business assistance services; provision of business advice to start up companies; provision of business advice to facilitate the growth of companies; provision of business advice to facilitate e-business and electronic commerce; export credit management; business administration; office functions; provision of business information, business enquiries; business consultancy services; advertising of financial services; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; accountancy; auctioneering; trade fairs; data processing; provision of business information; advisory, consultancy and information services relating to all the aforesaid services.</p> <p>Class 36: real estate affairs; estate agency services</p>

Applicant's "Retail services..." and "the bringing together, for the benefit of others..." v the opponent's "auctioneering" services

22. During the hearing Mr Taylor referred me to the Registrar's decision of O-276-10⁴ where it was considered whether class 35 "auctioneering services" are similar to the retailing of various goods. In particular, Mr Taylor referred me to paragraph 42 which states:

"Mr Stobbs argued that the retail services as covered by VEL's CTM 1471143 includes *auctioneering*, as listed in Mr Casey's application, and that computer *programming services* in Class 42 of the same CTM are very similar to Mr

⁴ *Michael Casey v Virgin Enterprises Limited* (BL O-276-10) "CARBON VIRGIN"

Casey's *data processing*. Considering the similarity with *auctioneering* first, such services are a specialist form of selling products where such products are sold to the highest bidder. Such services are generally provided by specialist auctioneers and not by traditional retailers. Certainly, there is no evidence before me to suggest otherwise. Whilst there may be some competition between the respective services, the specialist nature of an auction service is such as to limit the actual instances of competition. Further, it will also result in the average consumer being less likely to expect a retailer to also provide auction services and *vice versa*. That said, the intended purpose of auctioneering is similar to that of retailing as they are both concerned with selling products. Taking all of this into account, Mr Casey's *auctioneering* shares a moderately low level of similarity with VEL's *retail services*."

23. The applicant argues that auctioneering services are specialist services which differ in nature, purpose, users and have different trade channels. It is also argued that since the opponent could not identify any company other than eBay that provides retail and auction services then they could not be similar. In my view, the respective services are similar for the reasons set out in the Registrar's decision O-276-10. The intended purpose and nature of the respective services are, in essence, to sell goods to consumers. Further, users of auctioneering services will also use retail services (given that retail services are used by the public at large). In view of all of the aforementioned, I consider the services to be similar to a low degree.

Applicant's "Presentation of goods on communication media, for retail purposes" v opponent's "advertising" services

24. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated at paragraph 29 that:

"In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

25. The opponent's services include the broad term "advertising". In my view, the "presentation of goods on communication media, for retail purposes" are services for placing goods or services on communication media in order for others to view or potentially purchase them. I consider this to be akin to advertising and, applying the principle set out in *Merich*, if they are not identical, then they highly similar.

26. It is noted that the application contains the limitation "none of the aforesaid relating to the sale or letting of real estate, real estate management services or estate agency services". Notional use of the services covered by the opponent's list of services means that the limitation has no bearing in the assessment of whether the services are similar or not.

Average consumer and the purchasing act

27. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

28. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described at paragraph 60 the average consumer in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

29. The services in question are retail and the bringing together for the benefit of others services of various electrical goods, plus the presentation of unspecified goods. In relation to the retail services, the average consumer will be the general public at large. The purchase of the services is visual, although I do not discount an aural aspect. In order to ensure that the goods purchased from the retailer are of good quality, safe and reliable the level of attention will be above medium but not high.

30. With regard to the “presentation of goods on communication media, for retail purposes”, I consider this to be a service provided to others intended to present a person’s or business’ goods or services in an aesthetically pleasing manner which will help those who require a platform for their goods or services to sell. These services would be used following a visual inspection of various websites, though I do not discount aural considerations. Since the services are likely to have a direct impact on the service requestor, I consider the level of care and attention to be above average, but not high.

Distinctive character of the earlier trade mark

31. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV, Case C-342/97* the CJEU stated at paragraphs 22 and 23 that:

“In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined

Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

32. The earlier mark comprises of two well known words, our and house. Together they mean the collective possession of a home. Since the mark is registered it is *prima facie* valid and therefore distinctive⁵. However given the normal meaning of the words I consider the distinctive character to be low.

Likelihood of Confusion

33. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. This includes keeping in mind the whole mark comparison, because the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. One of the principles in the authorities states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*).

34. I summarise my findings as follows:

- The marks are identical.
- The distinctive character of the earlier mark is low.
- All of the applied for services are provided following a visual perusal (though aural considerations are not discounted) and the level of care and attention paid is above medium but not high.
- “Presentation of goods on communication media, for retail purposes” are (at least) highly similar to the earlier “advertising” services.
- The opponent’s “auctioneering services” are similar to a low degree to the remaining applied for retail and bringing together for the benefit of others services, namely:

⁵ Section 72 of the Trade Marks Act 1994

Retail services, retail store services and electronic shopping retail services connected with the sale of a variety of consumer goods, namely, computers, hi-fi, equipment, cameras, telephony equipment, televisions, video and DVD players, sound recording apparatus, radios, home office equipment and home office furniture, electrical equipment, namely, refrigerators, microwave ovens, coffee makers, toasters, white goods, hair dryers, furniture, washing machines, spin dryers; the bringing together, for the benefit of others, of a variety of consumer goods, namely, computers, hi-fi equipment, cameras, telephony equipment, televisions, video and DVD players, sound recording apparatus, radios, office equipment and office furniture, electrical equipment, namely, refrigerators, microwave ovens, coffee makers, toasters, white goods, hair dryers, furniture, washing machines, spin dryers in a wholesale and/or retail outlet, via the Internet, by electronic means, by mail order or by means of telecommunications; presentation of goods on communication media, for retail purposes; none of the aforesaid services relating to the sale or letting of real estate, real estate management services or estate agency services.

35. The marks are identical and some of the services are highly similar. Therefore, the opposition must succeed against the “Presentation of goods on communication media, for retail purposes”.

36. With regard to the services which I found to be low in similarity, I am of the view that this is offset by the identity between the marks. Whilst I take into consideration the low distinctive character of the earlier mark, I find that there is a likelihood of direct confusion and the opposition succeeds.

OVERALL OUTCOME

37. The opposition succeeds in its entirety. The application, subject to appeal, shall be refused for all of the applied for services.

COSTS

38. During the hearing Mr Taylor requested an award of costs off the usual scale. The basis of this claim is as follows:

- The applicant was aware of the opponent’s earlier mark and, therefore, had sufficient time to withdraw their application. Mr Taylor stated that prior to filing the notice of opposition the applicant was notified of the opponent’s earlier mark via the UK notification system, a form TM7a⁶ was filed and the parties entered into without prejudice negotiations whereby the applicant was offered a settlement which would have prevented the opposition.
- Withdrawing from the scheduled hearing at short notice, i.e. two days beforehand.

⁶ Notice of threatened opposition

- Numerous spurious specification amendments.
- Arguments which have no valid basis.

Costs awards off the scale are addressed in the Trade Marks Work Manual at section 5.6 “Costs off the scale” which states:

“It is vital that the Tribunal has the ability to award costs off the scale, approaching full compensation, to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour. In *Rizla Ltd’s application* [1993] RPC 365 (a patent case) it was held that the jurisdiction to award costs, derived from section 107 of the Patents Act 1977, conferred a very wide discretion on the Comptroller with no fetter other than to act judicially. It is considered that the principles outlined in *Rizla’s application* apply also to Tribunal proceedings. Thus, if the Tribunal felt that a case had been brought without any bona fide belief that it was soundly based or, if, in any other way, its jurisdiction was being used for anything other than resolving genuine disputes; it has the power to award compensatory costs. It would be impossible to outline all of the situations which may give rise to such an award; however, Hearing Officers have stated that the amount should be commensurate with the extra expenditure a party has incurred as the result of unreasonable behaviour on the part of the other side. This "extra costs" principle is one which Hearing Officers will take into account in assessing costs in the face of unreasonable behaviour. Hearing Officers should act judicially in all the facts of a case. It is worth clarifying that just because a party has lost, this is not indicative, in itself, of unreasonable behaviour. Any claim for costs approaching full compensation or for "extra costs" will need to be supported by a bill itemising the actual costs incurred.

Depending on the circumstances, the Tribunal may also award costs below the minimum indicated by the standard scale. For example, the Tribunal will not normally award costs which appear to exceed the reasonable costs incurred by a party.”

39. I advised Mr Taylor that I do not consider these grounds to be sufficient to support an award off the usual scale. The applicant being made aware of a possible opposition but then not withdrawing the application cannot be justification for a higher award of costs. Whilst I agree that some of the proposed specification amendments were not acceptable I believe that was a genuine attempt from the applicant to resolve this matter. With regard to the various arguments put forward, I do not consider this to be unreasonable behaviour.

40. In the circumstances I award the opponent the sum of £1100 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee	£100
Preparing a statement and considering the other side’s statement	£500

Preparing for and attending a
telephone hearing

£500

TOTAL

£1100

41. I therefore order Homemaker Solutions to pay Ourhouse (UK) Limited the sum of £1100. The above sum should 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 21st day of December 2015

MARK KING
For the Registrar,
The Comptroller-General