

BL O/547/22

TRADE MARKS ACT 1994

SUPPLEMENTARY DECISION

IN THE MATTER OF APPLICATION NO 3431949

BY

TAMARA RATTIGAN

TO REGISTER THE TRADE MARK



IN CLASS 41

AND

THE OPPOSITION THERETO UNDER NO 419166

BY

TRIUMPH INTERNATIONAL INC.

BACKGROUND

1. On 10 January 2022, I issued a decision in these proceedings. That decision dealt with the opponent's claims under sections 5(4)(b) and 5(3) of the Trade Marks Act 1994 (hereinafter 'the Act'). The opposition failed in respect of both grounds.

2. I had previously stayed the opponent's claim under section 5(2)(b) of the Act due to a late request by the applicant for proof of use of the opponent's earlier marks which affected the opponent's logo mark which was not relied on under the section 5(3) ground and for which evidence had not been filed.

3. At the conclusion of the substantive decision, I directed that a case management conference (CMC) be arranged to discuss whether or not the opponent wished to continue its opposition under section 5(2)(b) of the Act. It was duly held on 27 January 2022 and the opponent confirmed its intention to proceed with its opposition under the section 5(2)(b) ground. I gave the opponent until 28 March 2022 by which to file its evidence.

4. On the due date the opponent requested a threeweek extension. This was agreed and a new date of 19 April 2022 was set for the opponent to file its evidence.

5. On the second due date the opponent wrote to the tribunal and requested a suspension of the outstanding ground in order to discuss settlement with the applicant. The following day, on 20 April, the applicant wrote to the tribunal confirming that no settlement proposal had been made to it by the opponent and that the 'IPO should proceed with the consequential steps'.

6. On 27 April I advised the opponent that it either needed to request an extension in which to file its evidence, which I would consider, or the opponent should withdraw its opposition based on the 5(2)(b) ground. This was communicated to the opponent the same day and a date of 4 May was given by which time a retrospective extension of time would need to be filed to the tribunal. By 24 May no correspondence on the matter had been received from the opponent and I directed the 5(2)(b) ground be deemed withdrawn. The costs issue now falls to be decided.

7. Mr Wood, who represented the applicant at the hearing, made submissions on costs in an email dated 24 January 2022. There are three points from this email that I need to consider, in addition to the award itself:

1. Off scale costs

8. Rule 67 of the Trade Mark Rules 2008 gives the registrar the power to award costs. Mr Wood submits that the opponent claimed its strongest ground of opposition was its case under section 5(4)(b) which failed at the first hurdle, being insufficiently pleaded and unsupported by evidence. With regard to the opponent's claim under the 5(3) ground, Mr Wood submits that 'the evidence could not, in any sense of the word, be considered to go to the services for which repute was claimed:

"The UKIPO has dealt in the past with questions of whether a case which is hopeless should give rise to costs off the scale – see by way of example case O/532/17 LAMBRETTA. We say that a professional firm of attorneys will have understood that in any copyright claim it is essential to plead and prove the issues in paragraph 28 of the decision, and these requirements were in any event the subject matter of TPN 1/2010. As such the Opponent must have known its case under s.5(4) was hopeless from the very point that the notice of opposition was filed.

In relation to the case under s.5(3), it is incumbent on a party to consider their case after the filing of their evidence in chief. The Opponent should have considered their case at this point and it was clear that it was hopeless. In relation to that part of the case the Opponent should be required to give costs above the scale from the point that it filed its evidence in chief."

9. I agree with Mr Wood that the pleaded cases under 5(4)(a) and 5(3) were, to say the least, weaker than average. However, I remind myself that the opponent was in the position of relying on these two grounds only, at the hearing, due to a very late request to correct an error in the applicant's case. The applicant had requested proof of use in its initial defence and then neglected to do the same when it was asked to

amend its TM8 to remove evidence from it. This omission was only noticed by Mr Wood when preparing for the hearing. In short, up until a week prior to the hearing, the opponent had expected to rely on its earlier marks, under the 5(2)(b) ground, for all of the goods and services for which they were registered.

10. Consequently, I do not intend to award costs above the usual scale in these circumstances, as the case run by the opponent on the day was not the one it realistically expected to make in the run up to the hearing.

2. Appropriate award for preparing for the hearing

11. With regard to the award for the hearing itself and the preparation for it, Mr Wood submits:

“In relation to the hearing there was a professional representative (the writer) and as such the calculation of that stage should be on the usual basis rather than as an represented party, although the £294.50 is claimed in addition as the hearing itself requires not just the attendance and skeleton argument, but also the preparation (which was done to some extent by the Applicant such that there should be an award for the Applicant’s work).”

12. I disagree with this approach. Mr Wood is effectively asking me to award the same work twice. He is a professional representative who was brought in to represent the applicant at the hearing and is perfectly capable of making the necessary preparations to attend that hearing. Scale costs for that work will be awarded, but I will not making an additional award for the applicant who took no part in the hearing.

3. Multiple oppositions

13. Related opposition 419167 was based on section 5(4)(a) only and concerned the same parties as this case. It was withdrawn by the IPO on 1 March 2021, for lack of evidence. This opposition was not consolidated with the opposition for which costs are being awarded in this case. The correct time to request costs for the withdrawn

opposition was March 2021, or shortly thereafter. It is not appropriate to request costs nearly a year later via a decision in another case. Accordingly, I decline to award costs for opposition 419167 in this cost award.

The cost award

14. The applicant has been successful and is entitled to a contribution towards the costs incurred in these proceedings.

15. The Registrar awards costs on a scale published in Tribunal Practice Notice (TPN) 2/2016. Scale costs are intended to provide a contribution towards the cost of proceedings, not to provide full compensatory costs.

16. For unrepresented parties the tribunal relies on the Litigants in Person (Costs and Expenses) Act 1975 (as amended) which sets the minimum level of compensation for litigants in person in court proceedings at £19.00 per hour. This is the amount normally applied and I see no reason to deviate from it.

17. The applicant represented herself until the hearing stage so I will award costs up to that point at the £19.00 per hour rate applicable to self-representing litigants. The costs for the hearing will be on the usual scale for professional representatives, as contained within the TPN (referred to above).

18. The applicant has provided a detailed breakdown of costs incurred by the applicant as well as a useful summary of those costs, which is as follows:

Stage	Total time (hours)
Pre-action	5
Reviewing opposition and preparing and filing defence and counterstatement	41
Opponent's request for extension of time	2
Considering opponent's evidence	17

Preparing own evidence	42
Considering evidence in reply	209
Preparing for and attending a hearing	15.5

19. Worked out at £19 per hour, Mr Wood concludes that the applicant is entitled to £2536.5. It should be noted that there is no right to be awarded the amount claimed. The award is subject to an assessment of the reasonableness of the claim and I remind myself that costs are contributory not compensatory. I also bear in mind that costs payable for litigants in person should not exceed the scale costs normally awarded to professional representatives, for the same work.

20. I have already found that the applicant is not entitled to the claimed hours for preparing for and attending the hearing. Mr Wood attended the hearing and prepared for it so an assessment of that under the usual tribunal scale will be added to the applicant's litigant in person costs.

21. Five hours are claimed for reviewing pre-action correspondence. This amounted to a two page letter from the IPO and a one page TM7a. Whilst I appreciate the applicant was not represented and of course scrutiny of legal paperwork will take longer in those circumstances, it should not take more than an hour to read two short letters.

22. Forty-one hours are claimed for reviewing the opposition and preparing and filing a defence and counterstatement. Much of the work for which costs are claimed arose from a mistake on the part of the applicant when it included evidence within its counterstatement. As a result, several rounds of correspondence and re-filings were necessary before the defence was in order. I do not intend to make a cost award to the applicant for work which arose from its own error. Ten hours seems sufficient for an unrepresented party to understand the case against them and file a TM8 (which is a one-page document).

23. Two hours have been claimed for 'opponent's request of extension of time'. It is not clear to me that the request gave rise to any work being carried out by the applicant

beyond reading the request and then reading the letter from the tribunal which allowed a shorter extension than that requested by the opponent. I make no award for this claim.

24. Throughout its breakdown of costs the applicant has claimed hours for reading and sending emails. For example, one hour is claimed for sending an email with an attached witness statement and evidence, one hour is claimed for reading an email from the tribunal about the opponent's evidence being refused for excess pages. I find these claims to be unreasonable and excessive. Having looked back over this case and bearing in mind the fact that the applicant was representing herself at this stage, I find that ten hours was adequate to assess the opponent's evidence and 20 hours (rather than the claimed 42 hours) was sufficient for the applicant to compile her own evidence, which comprises, for the most part, results of internet searches.

25. Five hours is sufficient for considering the opponent's evidence in reply, which consisted of a short witness statement and exhibits which are prints taken from the applicant's own website and social media pages, and with which it was familiar.

26. Taking all of this into account the cost award is as follows:

Unrepresented party costs for 46 hours @ £19 per hour	£874
Preparing for and attending a hearing (based on TPN 2/16)	£800
Total:	£1674

27. I order Triumph International Inc. to pay Tamara Rattigan the sum of £1674. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23rd day of June 2022

Al Skilton
For the Registrar,
The Comptroller-General

