O/0250/26

TRADE MARKS ACT 1994

SUPPLEMENTARY DECISION ON COSTS

IN THE MATTER OF APPLICATION NO. UK00003887822
BY AN CONCRETE LTD
TO REGISTER THE TRADE MARK:

MISFITS BOXING

IN CLASSES 9, 16, 35, 36, 38, 41 AND 45
AND
IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 441520
BY WASSERMAN BOXING LIMITED

AND

IN THE MATTER OF APPLICATION NO. UK00003930871
BY WASSERMAN BOXING LIMITED
TO REGISTER THE TRADE MARK:

Misfits Boxing

IN CLASSES 25 AND 41
AND
IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 445002
BY AN CONCRETE LTD

BACKGROUND

1. This case concerns two consolidated oppositions between Wasserman Boxing Limited ("WBL") and AN CONCRETE LTD ("ANC").

2. I issued a decision in this matter on 8 January 2026 (BL-O/0010/26). WBL was successful in the opposition against ANC's application no. UK00003887822; it was also successful in defending its application no. UK00003930871 against ANC's opposition.

3. In relation to costs, my decision stated as follows:

> "**COSTS**
>
> 73. WBL has been successful, and it is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award WBL the sum of £2,400 as a contribution towards the costs of proceedings. The sum is calculated as follows:
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> Filing a notice of opposition and considering the counterstatement: £400
> Filing a counterstatement and considering the notice of opposition: £400
> Filing evidence: £1,000
> Filing submissions in lieu: £400
> Official Fees: £200
> Total: £2,400
>
> 74. I therefore order AN CONCRETE LTD to pay Wasserman Boxing Limited the sum of £2,400, however, since WBL already has £2,000 of it, ANC will only need to pay a further £400. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings."

4. On 9 January 2026, WBL's representatives wrote to the Tribunal stating that my decision did not address their request for an award of costs "off the scale". They stated as follows:

> *"We note that the Hearing Office has not addressed our client's request for the award of costs "off the scale" in the sum of £28,810.87. That request, and the detailed reasoning for that request, can be found at paragraphs 60 – 82 of our client's written submissions in lieu dated 2 December 2024. We attach a copy of those written submissions together with Annex B to those submissions.*
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> *We refer to section 6.8.5 of the Tribunal Section of the Manual of Trade Marks Practice which states that "Once the Hearing Officer has given their decision in writing and provided a full statement of reasons for that decision, they become 'functus officio', that is, their role is complete and they can take no further action in the matter adjudicated upon. Queries or explanations in relation to the decision reached cannot be entertained and must be pursued through appeal mechanisms… The Hearing Officer may however issue a supplementary decision to clarify his original intention or to correct clerical errors or to deal with costs." (our emphasis)*
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> *We therefore respectfully request that, in accordance with this section, the Hearing Officer issues a supplementary decision which addresses our client's request relating to costs "off the scale".*

5. WBL's representatives wrote again on 2 February 2026, confirming that any appeal against my decision would be limited to the costs award. On 3 February 2026, the Tribunal replied confirming that I would issue a supplemental decision in which I would give a new deadline for appeal, so they needed not to be concerned about the appeal deadline for the substantive decision.

COSTS DECISION

6. I have reviewed WBL's request and I confirm the costs award contained in my decision of 8 January 2026. I now provide my reasons in full for refusing WBL's request for an award of costs off the scale.

7. I shall start with WBL’s request. It stated (emphasis added):

“Costs

60. Section 68 of the Act and Rule 67 of the Trade Mark Rules 2008 gives the Registrar a wide discretion to award reasonable costs. Further, Anthony Watson QC sitting as a deputy judge in Rizla Ltd’s Application [1993] RPC 365 at [377] accepted that the Registrar has the power to award costs on a compensatory basis: “As a matter of jurisdiction, I entertain no doubt that if the Comptroller were of the view that a case had been brought without any bona fide belief that it was soundly based or if any other way he were satisfied that his jurisdiction was being used other than for the purpose of resolving genuine disputes, he has the power to order compensatory costs. It would be a strange result if the Comptroller were powerless to order more than a contribution from a party who had clearly abused the Comptroller’s jurisdiction”.

61. Paragraphs 5 and 6 of Tribunal Practice Notice 1/2023:

61.1 states that “the Tribunal retains the discretion to award costs “off the scale” to deal proportionately with unreasonable behaviour”;

61.2 provides the following examples of what might constitute unreasonable behaviour:

61.2.1 “behaviour designed to delay, frustrate or unreasonably increase the costs/burden on the other party”; and

61.2.2 “if a losing party unreasonably rejected efforts to settle a dispute before an action was launched or a hearing held”; and

61.3 states that “the level of off-scale costs will, generally speaking, be commensurate with the extra expenditure a party has incurred as a result of the unreasonable behaviour”.

62. In DTTM Operations LLC v Trump International Limited (Case BL O-409-18) at [60] – [63], Mr Matthew Williams, acting for the Registrar, referred to the following factors as justification for a finding that an award for off the scale costs be made against the applicant:

62.1 where there are "aspects of the case where the Applicant can have no bona fide belief that its defence of the Opponent's claims was soundly based";

62.2 "a disdainful disregard for the opposition costs of the other side"; and

62.3 a "well-evidenced pattern of abusive behaviour".

63. WB requests compensation of all costs incurred by WB, and not just those that would normally be awarded in accordance with the official scale. WB's costs incurred to date are itemised at Annex B to these submissions and total £28,810.87.

*64. This request is made on the basis of the submission that Mr Odame-Nyadu (both in his personal capacity and in his capacity as the sole director of ANC) has acted unreasonably (and, it is submitted, in **bad faith**) before and during the course of the Consolidated Proceedings and of WB's Opposition and ANC's Opposition pre-consolidation.*

65. In support of this submission, WB relies on the circumstances set out below."

8. The circumstances relied upon by WBL are as follows:

1. Mr Odame-Nyadu/ANC's knowledge.
2. Fabrication of ANC's evidence.
3. Assignment of ANC's Application.

4. Conduct in other, unrelated UKIPO proceedings.

9. I will address those circumstances in turn.

Mr Odame-Nyadu/ANC's knowledge

10. As noted above, Mr Odame-Nyadu is the sole director of ANC.

11. WBL's argues that given Mr Odame-Nyadu's knowledge of the world of boxing and the extensive and highly publicised use of WBL's mark in the field of boxing prior to the filing date of ANC's application (i.e. 10 March 2023), Mr Odame-Nyadu must have been, at that date, aware of the renown of WBL's mark in the world of boxing. WBL further argues that notwithstanding this, during the proceedings Mr Odame-Nyadu denied that he was aware of WBL's use of its mark in the UK before 16 May 2023 (and therefore on or before the filing date). WBL also points out that on 16 May 2023, before WBL filed its opposition, WBL's representatives wrote to Mr Odame-Nyadu to put him on notice of WBL's use of its mark since June 2022, the extent of such use and the goodwill arising therefrom. A copy of that letter, to which no response was received from Mr Odame-Nyadu, was filed in evidence by Mr Odame-Nyadu as exhibit MF3.

12. Accordingly, WBL's proposition is that: (i) given Mr Odame-Nyadu's alleged business and WBL's use of its sign in the field of boxing, Mr Odame-Nyadu was aware of WBL's mark when ANC filed the contested application and (ii) alternatively, Mr Odame-Nyadu was certainly aware of WBL's mark before WBL filed its opposition because he was made aware of it by way of a pre-action letter that WBL sent on 16 May 2023. In either scenario, WBL submits that:

a. Mr Odame-Nyadu unreasonably rejected WBL's efforts to settle the dispute before WBL's opposition was filed by failing to withdraw ANC's application following receipt of WBL's letter dated 16 May 2023.

b. Mr Odame-Nyadu sought to defend ANC's application against WBL's opposition and sought to oppose WBL's application in circumstances where he had no *bona fide* belief that such a defence/opposition was soundly based.

c. Mr Odame-Nyadu's behaviour in putting WBL to proof of its goodwill was designed to delay, frustrate and unreasonably increase the cost and burden on WBL and resulted in WBL having to incur in excess of £11,000 in preparing WBL's evidence.

d. Mr Odame-Nyadu/ANC continued to both defend WBL's opposition and oppose WBL's application in circumstances where Mr Odame-Nyadu/ANC had no *bona fide* belief that such a defence/opposition was soundly based, particularly after WBL had established, through the filing of its evidence, that it was the proprietor of an earlier trade mark right when compared with ANC's mark.

13. I cannot see that there is anything in these points which could justify an award of costs off the scale.

14. As regard point (a), ANC's application was opposed by WBL based upon Section 5(4)(a) of the Act. However, WBL's allegation that ANC was aware of WBL's mark when it filed its application (1) is based on assumptions and it is neither proven nor conceded and (2) appears to relate to bad faith, a ground which was not pleaded. In any event, the mere fact that an applicant knew that another party used an identical or similar trade mark in the UK does not establish bad faith: *Lindt, Koton* (paragraph 55).[1] The applicant may have reasonably believed that it was entitled to apply to register the mark, e.g. where there had been honest concurrent use of the marks: *Hotel Cipriani*.[2]

15. Likewise, the fact that ANC persisted in both defending its application and opposing WBL's application after WBL put it on notice of its claims is not, without anything more, unreasonable behaviour. The trade mark system allows owners of earlier rights to oppose trade mark applications; it also allows trade mark applicants to defend their applications: ANC's conduct fall within the band of what it was legitimately entitled to do (in its capacity as the owner of an earlier pending trade mark application which was also subject to an opposition). Furthermore, whilst in civil litigation parties are expected to attempt resolution through mediation or negotiation, <u>it is not</u>

[1] *Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property* Office (EUIPO) (C-104/18) EU:C:2019:724 ("Koton")
[2] *Hotel Cipriani SRL and Others v Cipriani (Grosvenor Street) Limited and Others,* 2010 EWCA Civ 110 (CA)

mandatory. Unless the court orders the parties to engage in mediation or other forms of alternative dispute resolution (ADR),[3] parties are free to progress and resolve their dispute through litigation. The same principle applies to trade mark oppositions. In addition, there is no rule which imposes on a party an obligation to admit or concede a claim for passing off, or the existence of goodwill, even if the evidence filed by the party claiming the goodwill/passing off supports their claims. If it was otherwise, the requirements of proof of use, reputation and goodwill would be futile at least for all big players in the market; this is because they would be able to argue that their counterpart must be aware of their use, reputation and goodwill and must accept it. Indeed, it would be a dangerous precedent were I to accept WBL's argument that an applicant refusing to concede the opponent's claim to goodwill would be unreasonable. Likewise, even if there was a successful bad faith ground, that would mean that all such cases would be suitable for off-scale costs, which clearly is not right. Lastly, the fact that I eventually decided in WBL's favour, does not mean that there was no reasonable ground for bringing ANC's opposition or defending ANC's application, and at no point WBL applied to strike out ANC's pleadings or cases.

16. There is one more point here. Whilst WBL alleges that Mr Odame-Nyadu unreasonably rejected WBL's efforts to settle the dispute before WBL's opposition was filed by failing to withdraw ANC's application following receipt of WBL's letter dated 16 May 2023, I have seen that letter, and it does not actually contain an offer to settle. An offer to settle must contain an offer or a compromise – on the contrary WBL's letter was a pre-action letter that notified and outlined WBL's claim and invited ANC to withdraw their application without offering anything in exchange. Whilst it is recommended to respond to pre-action letters to avoid misunderstanding, Mr Odame-Nyadu was not obliged to respond in any way and cannot be said to have acted unreasonably by not doing so.

Fabrication of ANC's evidence

17. WBL argues that Mr Odame-Nyadu filed ANC's evidence which is wholly unsubstantiated and subsequently failed to prove the matters set out in WBL's letter

[3] CPR 1.4 (e) and 3.1 (o) expressly provide that the court may order the parties to engage in ADR

dated 7 June 2024 by the stipulated deadline or at all. Nevertheless, WBL argues that it was required to instruct Mills & Reeve LLP to review ANC's evidence, put Mr Odame-Nyadu to proof of ANC's evidence, prepare and file WBL's evidence in reply and make submissions in response to Mr Odame Nyadu's letter to the Registrar dated 24 June 2024 in which he requested that the Registrar reject WBL's evidence in reply.

18. Accordingly, WBL invited the Registrar to infer that Mr Odame-Nyadu (i) fabricated ANC's evidence for the purpose of the proceedings at issue in a deliberate attempt to mislead the Registrar and, in doing so, (ii) demonstrated abusive behaviour.

19. I do not think there is anything in this point either.

20. ANC's evidence consists of a witness statement from Mr Odame-Nyadu dated 1 April 2024. It is very brief (containing only 7 substantive paragraphs), and its main points are that Mr Odame-Nyadu established his business Misfits Boxing in November 2021 and that this business operates as a non-profit organisation in the UK dedicated to enhancing the health and wellbeing of the underprivileged by organising sporting events, and provide sporting services. The other evidential point made by Mr Odame-Nyadu is about the letter of 16 May 2023 following which he states he became aware of WBL; the rest of the evidence is a mix of evidence and legal submissions with Mr Odame-Nyadu pointing out that the claims made by WBL reveals that their use commenced a mere seven months prior to ANC's trade mark registration and after one month of the events his business allegedly organised. On this basis, Mr Odame-Nyadu said that he disputed WBL's assertion of having established a protectable goodwill associated with the sign.

21. Most significantly, contrary to what WBL asserts under this point, WBL's evidence in reply was not trigged by what Mr Odame-Nyadu said in his witness statement. In fact, WBL initially wrote to the Tribunal on 5 April 2024 to confirm that they did not wish to file evidence of fact in reply. However, subsequently, on 7 June 2024, they wrote again saying that new information had come to light which they were investigating and which could require them to file evidence of fact in reply. However, the only evidence in reply that WBL filed was a witness statement from Jasmine Fearnley dated 24 June 2024. Ms Fearnley is a senior associate employed by WBL's legal representative and

her witness statement was accompanied by one exhibit, being that labelled JF1. Her evidence was only a vehicle for introducing a copy of a letter dated 7 June 2024 she sent to ANC requesting further evidence of facts which were referred to in some of the exhibits attached to Mr Odame-Nyadu's witness statement.

22. First, quite clearly, that is an unusual way of going about the matter. Given that the onus falls upon the witness to prove the facts stated in his/her statement, I cannot see why and on which basis WBL decided to send a letter to Mr Odame-Nyadu personally asking him to prove the following:

- The dates of creation of each of the documents contained in the Exhibits marked MF1, MF2 and MF6 to Mr Odame-Nyadu's witness statement – these relate to a logo, flyers and a business strategy allegedly used/devised in relation to ANC's business.

- How, where and when each of the flyers contained in Exhibit MF2 were distributed and who they were distributed to.

- That each of the events to which the flyers contained in Exhibit MF2 relate took place, the location of each event, how many attendees there were at each event and your total expenditure on, and total revenue received from, each of the events.

23. First, WBL could have challenged that evidence within the proceedings; I am not sure what was the logic of challenging the veracity of Mr Odame-Nyadu's evidence in that way. Second, I cannot see what difference the proof requested would have made for the purpose of WBL's claim for passing off, given that there was no issue with the relevant date because in its defence, ANC admitted that the relevant date from which WBL must establish the existence of a protectable goodwill is the filing date of the opposed application (i.e. 10 March 2023). Hence, the facts in relation to which Mr Odame-Nyadu gave evidence could have been relevant only if the relevant date was at issue. This is because if Mr Odame-Nyadu had established that he used the contested mark prior to the filing date, I would

have needed to consider WBL's passing off claim at the start of the behaviour complained about (as well as at the filing date).[4] However, given ANC's concession about the relevant date, that was not an issue.

24. Hence, I reject this point because:

- Whilst WBL's representatives had to review ANC's evidence, that is the normal next step where a party files evidence and Mr Odame-Nyadu was entitled to file evidence. The evidence was brief and concise and did not require anything over and above what parties normally deal with in evidence.

- Given the fact that ANC's evidence was not relevant for the assessment of WBL's claim for passing off, realistically, it was not even necessary for WBL to reply to that evidence, let alone to take the unorthodox step of sending a letter to Mr Odame Nyadu requesting him to prove his claims and filing evidence to exhibit that letter (as if Mr Odame Nyadu's refusal to comply with such a request made any difference). Quite frankly, that was a waste of time for everyone involved in these proceedings.

Assignment of ANC's Application

25. Under this point, WBL invited me to infer that Mr Odame-Nyadu assigned the application no. UK00003887822 to ANC on 12 August 2024, i.e. at a late stage of the proceedings, for the sole purpose of (i) insulating himself from any adverse cost award which would otherwise be made against him personally and (ii) frustrating WBL's ability to recover any costs in the proceedings. However, following WBL's filing of its submissions in lieu on 2 December 2024, on 4 May 2025, ANC paid security for costs in the sum of £2,000. Hence, ANC's compliance with WBL's request for security for costs makes this point redundant.

Conduct in other, unrelated UKIPO proceedings

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[4] *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11

26. Under this point, WBL claims that two days before the filing date of ANC's trade mark (on 8 March 2023), Mr OdameNyadu filed (and subsequently obtained registration for) UK trade mark number UK00003886382 for the mark "CONTEMPEE" in relation to various homeware goods in classes 20 and 26, which WBL points out are entirely unrelated to Mr Odame-Nyadu's stated business activities relating to boxing and fitness events. WBL also states that that registration was subsequently assigned to another company of which Mr OdameNyadu is the sole director, CT Interests Ltd, which was incorporated on the same date as ANC and it is the subject of an invalidation action (CA000506775) by TE Brands Ltd, a company which has operated a homewares brand under and by reference to the mark "CONTEMPEE" for many years, on the basis of bad faith under Section 3(6) of the Act; it is also relied upon as a basis for Mr Odame-Nyadu's oppositions (OP000444922 and OP000444251) against TE Brands Ltd's trade mark applications (UK00003959968 and UK00003959973) for the identical mark "CONTEMPEE".

27. Further, WBL claims to be aware that, on the same date as the filing date of ANC's trade mark (10 March 2023), Mr Odame-Nyadu filed (and subsequently obtained registration for) UK trade mark number UK00003887812 for the mark "D. LOUISE" in relation to jewellery goods in class 14, which WBL points out are entirely unrelated to Mr OdameNyadu's stated business activities relating to boxing and fitness events. That registration was subsequently assigned to Nana Yaw, who WBL is aware is the name of one of Mr Odame-Nyadu's relatives; it is also the subject of an invalidation action (CA000507770) by Digital Group 1 Ltd, a company which has operated a jewellery brand under and by reference to the mark "D. LOUISE" for many years; and it is relied upon as a basis for Nana Yaw's opposition (OP000449911) against Digital Group 1 Ltd's trade mark application (UK00004091422) or the identical mark "D. LOUISE". On the basis of these allegations, WBL invites me to infer that the above circumstances demonstrate a pattern of abusive behaviour by Mr Odame-Nyadu.

28. First, whilst some of the facts stated are verifiable from public records, I refuse to do so. This is because, even if WBL was correct in stating that Mr Odame-Nyadu obtained registration for these two trade marks which are identical to trade marks used by other traders, and are subject to invalidity actions based on bad faith, there is no

indication that the bad faith claims will be (or have been) successful. Lastly, there was no bad faith claim in these proceedings on pattern of behaviour and there would need to be full evidence rounds for me to even consider this. Hence, I refuse to make the assumption WBL asks me to make.

29. For all of the above reasons, I reject all WBL's allegations of Mr Odame-Nyadu or ANC having acted unreasonably or abusively, and I confirm the award of costs made in my decision of 8 January 2026.

APPEAL PERIOD

30. The appeal period for this decision on costs (and for the section on costs of my decision BL-O/0010/26 dated 8 January 2026) will run from the date of this decision.

Dated this 24th day of March 2026

TERESA PINTO
For the Registrar