

O/0556/26

DECISION ON COSTS

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. UK00004177705
IN THE NAME OF LÈGENDE PARIS LIMITED**

LÈGENDE PARIS

AS TRADE MARK IN CLASSES 25 AND 35

AND

**OPPOSITIONS THERETO NO. OP000454353
BY
LEEMARCUS MARTIN**

Background and pleadings

1. On 22 March 2025, LÈGENDE PARIS LIMITED (***“the Applicant”***) applied to register in the UK the trade mark shown on the cover page of this decision under number UK00004177705 in respect of goods and services in classes 25 and 35 (***“the Contested Mark”***). Details of the application was subsequently published for opposition purposes on 25 April 2025.
2. On 23 May 2025, Leemarcus Martin (***“the Opponent”***) filed Form TM7, opposing the application in full under sections 5(2)(a), 5(2)(b) and 5(3) of the Trade Marks Act 1994 (***“the Act”***). Following a few amendments of the TM7, with official letter of 6 August 2025 the Registrar allowed the opposition to continue for sections 5(2)(b) and 5(3) relying on earlier mark UK00004051764 as well as section 5(3) relying on earlier mark UK00004051761.
3. The Applicant is represented by McDaniels Law and the Opponent is not legally represented.
4. In its statement of grounds the Opponent contended that given the visual and conceptual similarities between the marks and the identity between the goods at hand, there exists a high likelihood of confusion including a likelihood of commercial association.
5. On 15 August 2025, the Applicant informed the Registrar that two cancellation actions had been filed against the earlier rights forming the basis of the opposition at hand (i.e., invalidation proceedings numbers CA000508960 and CA000508961). A consolidation request was filed accordingly.
6. On 11 September 2025, the Registrar informed the parties that the invalidation actions were undefended and that if no appeals were filed in these proceedings, the opposition would be withdrawn as there would be no earlier marks upon which to rely. The opposition proceedings were therefore suspended.
7. On 24 October 2025, the Registrar informed the parties that as no appeals had been received with regard to cancellation actions number CA000508960 and CA000508961, there were no basis for the opposition to continue and it was withdrawn.

8. On 15 January 2026, the Applicant filed for off-scale costs because of the Opponent's "vexatious and unreasonable conduct" in the proceedings and for having unduly prolonged the proceedings because of "spurious filing of Form TM7 with his subsequent failure to engage with [the] proceedings". The Applicant also filed a bill itemising the costs it had incurred totalling at £2,715.
9. On 8 May 2026, the Registry wrote to the parties issuing its preliminary view as follows:

"I acknowledge receipt of the applicant's request for an off-the-scale costs received on 20 January 2026. It is noted that the opponent has not filed any comments in response.

The comments made in the applicant's request have been considered and they are advised that costs in proceedings before the office are awarded after consideration of guidance given by the standard published scale. However, the Registrar also has the freedom to award costs off the scale to deal proportionately with unreasonable behaviour. Please see Tribunal Practice Notice 4/2007.

After reviewing the file, it is the preliminary view of the Tribunal that the applicant's request for off-the-scale costs should be refused and instead to award costs from the scale of £250.00 in favour of the applicant. This amount is reached as follows:

Considering the opponent's Form TM7	£250.00
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TOTAL	£250.00
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In reaching its decision, the Tribunal has identified no vexatious or unreasonable conduct by the opponent in these proceedings. It is noted that the opponent has engaged with the proceedings, including by submitting a number of amended Forms TM7. The Tribunal's view is that the applicant has not identified anything that would suggest that the filing of the Form TM7 was spurious.

Any award of costs is considered to be on a contributory not compensatory basis.”

10. On 21 May 2026, the Applicant requested a hearing on the matter.

11. The hearing took place before me on 18 May 2026 by way of telephone conference.

The Applicant was represented by Mr Jerome Mattis. The Opponent did not attend.

12. At the hearing, I outlined that the remit of the hearing was to determine whether an off-scale costs award was justifiable under the applicable Tribunal Practice Notices (“TPNs”), Trade Mark Rules 2008 (“the Rules”), the Manual, and case law.

13. I will address Mr Mattis’ arguments presented at the hearing later in this decision.

Legislation and Guidance

14. Section 68 of the Act reads as follows:

“(1) Provision may be made by rules empowering the registrar, in any proceedings before him under this Act –

(a) to award any party such costs as he may consider reasonable, and

(b) to direct how and by what parties they are to be paid. [...]”

15. Rule 67 of the Trade Marks Rules 2008 provides:

“The registrar may, in any proceedings under the Act or these Rules, by order award to any party such costs as the registrar may consider reasonable, and direct how and what parties they are to be paid.”

16. TPN 1/2023, at Annex A, sets out the scale of costs applicable:

Scale of costs in proceedings commenced on or after 1 February 2023

Task	Costs
Preparing a statement and considering the other side's statement	From £250 to £750 depending on the nature of the statements, for example their complexity and relevance
Preparing evidence and considering and commenting on the other side's evidence	From £600 if the evidence is light to £2600 if the evidence is substantial. The award could go above this range in exceptionally large cases but will be cut down if the successful party had filed a significant amount of unnecessary evidence
Preparing for and attending a hearing (including procedural hearings) or submissions-in-lieu	Up to £1900 per day of hearing, capped at £3900 for the full hearing unless one side has behaved unreasonably. From £350 to £650 for preparation of submissions, depending on their substance, if there is no oral hearing
Expenses	(a) Official fees arising from the action and paid by the successful party (other than fees for extensions of time) (b) The reasonable travel and accommodation expenses for any witnesses of the successful party required to attend a hearing for cross examination

17. TPN 1/2023 brings together and updates the guidance from previous TPNs about costs in trade mark, patent and design tribunal proceedings (the previous TPNs being 2/2016, 2/2015, 4/2007 & 2/2000). It also updates the scale of costs. The new scale applies to proceedings commenced on, or after, 1 February 2023. TPN 1/2023 maintains that off scale costs may be given in certain circumstances, the relevant section of which is copied below:

“Off-scale costs

5. Notwithstanding the published scale, the Tribunal retains the discretion to award costs “off the scale” to deal proportionately with unreasonable behaviour. It is not possible to set out all the circumstances in which a Hearing Officer might depart from the scale. It is worth clarifying though that just because a party has lost, this in itself is not indicative of unreasonable behaviour. Some

examples of what might constitute unreasonable behaviour include a party seeking an (avoidable) amendment to its statement of case which, if granted, would cause the other party to have to amend its statement or would lead to the filing of further evidence. Other examples include behaviour designed to delay, frustrate or unreasonably increase the costs/burden on the other party and/or repeated breaches of procedural rules. Off-scale costs may also be awarded if a losing party unreasonably rejected efforts to settle a dispute before an action was launched or a hearing held, or unreasonably declined the opportunity of an appropriate form of Alternative Dispute Resolution.

6. 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. Any claim for costs approaching full compensation or for “extra costs” will need to be supported by a bill itemizing the actual costs incurred. There may be some circumstances where costs below the minimum indicated by the published scale are awarded. For example, a party who does not follow a suggestion from the Hearing Officer as to the most efficient means of managing the case, may only be entitled to whatever award they would have received if they had followed the Hearing Officer’s suggestion.”

Decision

18. At the hearing Mr Mattis reiterated his off-scale costs request on the basis that Mr Martin behaved unreasonably and vexatiously insofar as, prior to the proceedings, he refused to mediate, escalated with an opposition and he based the opposition in bad faith on earlier rights that were later declared invalid.

19. Whilst I appreciate that Mr Martin’s conduct forced the Applicant to engage in different proceedings to protect its rights, I also note that everything that Mr Martin did was within his rights and it does not amount either to unreasonable or vexatious behaviour.

20. Looking at the itemised bill that Mr Mattis provided to justify his off-scale costs request, I note that it features a long list of tasks that Mr Mattis’ attorney carried out. I pointed out to Mr Mattis that in the proceedings at hand, all the Applicant did was to file a suspension request. Mr Mattis clarified that the actions listed in the bill

concern all the background activities that the attorney carried out in relation to the proceedings. I nonetheless find that this does not justify a £2,715 bill for proceedings where only a suspension request was filed, also bearing in mind that a suspension request is not within the list of the activities set out in Annex A for which parties can claim costs.

21. Additionally, Mr Mattis contended that Mr Martin's behaviour forced the Applicant to engage in the invalidation proceedings. To this regard, I note that the instant decision exclusively concerns the opposition proceedings and I cannot take into account the costs for parallel proceedings that were not consolidated.

22. Mr Mattis requested that, if I were to refuse the off-scale costs request, I should allow the higher scale of costs in line with TPN 1/2023. This amounts to £750. Mr Mattis justified this request on the basis that the Opponent filed three amended versions of the Form TM7 that required consideration by the Applicant. As pointed out at the hearing, I note that the proceedings were withdrawn before the Applicant could file a TM8. Therefore, I have no evidence that the Applicant had to consider these Forms TM7 to file his counterstatement. In any case, even if I had evidence of this, the amendments provided by the Opponent for the Forms TM7 were not such to justify an end-of-scale costs ward.

23. As a final point, Mr Mattis argued that the Applicant incurred in higher costs because the Opponent did not engage in the proceedings. First, as already found in the preliminary view, I note that the Opponent did engage with the proceedings, including by submitting a number of amended Forms TM7. Second, even if I were to find that the Opponent did not properly engage with the proceedings, I do not see how this would amount to unreasonable and/or vexatious behaviour by the Opponent that made the Applicant to incur higher costs.

Conclusion

24. It is my view that the Opponent has not behaved unreasonably or attempted to delay the proceedings intentionally to warrant anything other than on-scale costs for the Applicant. It is also my view that higher-end costs are not justifiable in this instance. In reaching my conclusion and awarding the costs accordingly, I also

bear in mind that the statement of grounds (and subsequent amendments) filed by the Opponent were not particularly complex.

Outcome

52. Following from the above I uphold the preliminary view that the Opponent's behaviour does not warrant for off-scale (or higher-end) costs in favour of the Applicant.

53. Having concluded that there is nothing to suggest that an off-scale award of costs is appropriate, I am guided in this decision by the scale of costs set out in TPN 1/2023, as shown earlier in this decision.

Overall conclusion on costs

54. Following from the above, within the scale of the TPN 1/2023 I intend to award the Applicant the following costs:

Considering the Opponent's Form TM7 and statement of grounds	£250
Total	£250

55. I hereby order Leemarcus Martin to pay LÈGENDE PARIS LIMITED the sum of **£250**. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 30th day of June 2026

Andrea Rossi

For the Registrar