

**O/0752/23**

**DECISION ON COSTS**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**TRADE MARK REGISTRATION NO.**

**UK00003276285**

**IN THE NAMES OF**

**CHRISTOPHER TYMKOW,  
ANDREW BARR,  
MICHAEL FOGG  
AND MARTIN MCSHEA**

**IN CLASS 41**

**AND**

**AN APPLICATION FOR A DECLARATION**

**OF INVALIDITY THERETO UNDER NO.**

**CA000503388**

## **BACKGROUND**

1. On 5 March 2021, the Registry received a Form TM26(I), signed and dated 12 October 2020, from “Clapton Football Club”. (As further explained below, the name of the cancellation applicant was subsequently changed to “Clapton Football Club 1878 Limited”.)
2. The Form TM26(I) was an application to have trade mark registration UK00003276285, owned by Christopher Tymkow, Andrew Barr, Michael Fogg, and Martin McShea (“the registered proprietors”), declared invalid under section 47(2) of the Trade Marks Act 1994 (“the Act”), based on the grounds set out in sections 3(1), 3(6) and 5(4)(a) of the Act. The Registry served the Form TM26(I) on the registered proprietors by letter on 13 April 2021.

### **Notice of intention**

3. Part 6 of the Form TM26(I) asked the cancellation applicant if it had informed the registered owner/holder of its intention to seek invalidation of the registration of their trade mark. The cancellation applicant duly filled in the box confirming that the invalidation notification date was 16 September 2020.

### **Name change**

4. Following service of the Form TM26(I) on 13 April 2021, there is extensive correspondence on file concerning the validity of the cancellation applicant’s Form TM26(I), culminating in a letter from the Registry dated 13 October 2021. This letter dealt with the question of the name of the cancellation applicant in the case before me, but also in respect of the cancellation applicant’s trade mark application, UK00003484390, which was subject to opposition in case OP000423332. The letter gave the cancellation applicant until 27 October 2021 to file the appropriate paperwork (a Form TM26R, a Form TM33, and a witness statement).
5. On 27 October 2021, the Registry received a Form TM26R in respect of UK00003484390, changing the name of the recorded owner from “Clapton Football Club 1878” to “Clapton Football Club 1878 Limited”. The Form TM26R was signed by Vincent McBean, who is also the signatory to the Form TM26(I) in the case before me.

6. In the same correspondence of 27 October 2021, there were two witness statements from Mr McBean confirming that the trade mark owner in the opposition case to which the applied for mark UK00003484390 was subject – OP000423332 – should be “Clapton Football Club 1878 Limited” and not “Clapton Football Club 1878”.
7. I quote paragraphs 2 and 4 from Mr McBean’s second witness statement:

“2. As previously stated, the omittance of the word 'Limited' was because of an oversight; and any other errors that may have been were only due to typos and nothing more which again has now been rectified.

4. I request the IPO to make the necessary changes under trademark: UK00003484390, Opposition No: OP000423332 and Trademark: UK00003276285 to reflect to the information provided.”
8. The Registry considered the reference to the registered mark UK00003276285 as being to the cancellation application CA000503388, that mark being subject to an invalidity action in that case. On that basis, the Registry considered itself to be in receipt of a written request to change the name of the cancellation applicant to “Clapton Football Club 1878 Limited” and from that point on the Registry referred to the cancellation applicant as such.

### **Surrender of trade mark UK00003276285**

9. On 23 June 2022, writing on behalf of the proprietors of UK00003276285, Andrew Barr emailed the registry, copying in the solicitors for the cancellation applicant, giving notice that the proprietors surrendered that trade mark registration with immediate effect. Following confirmations from the other proprietors,<sup>1</sup> the registered mark UK00003276285 was surrendered on 23 November 2022.

### **Cancellation applicant withdrawal and costs request**

10. On 6 January 2023, the cancellation applicant withdrew its application CA000503388 for a declaration of invalidity and sought costs. The Registry requested the registered proprietors’ comments on this request for costs.

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<sup>1</sup> With the exception of Michael Fogg who had sadly passed away on 9 May 2020.

11. On 15 February 2023, the registered proprietors submitted a letter with their comments. The core argument was, “We consider the name of the cancellation applicant was never changed from Clapton Football Club to Clapton Football Club 1878.”
12. On 19 May 2023, the Registry issued a preliminary view on the matter. It noted the registered proprietors’ position was that the cancellation applicant had failed to change its name from “Clapton Football Club” to “Clapton Football Club 1878 Limited”, as had been directed in the Registry’s letter of 13 October 2021 (as noted in paragraph 4 above). The Registry explained itself as follows:

“a Form TM26R was filed for related proceedings which requested the change of owner of related UK Trade Mark UK00003484390 and, in the accompanying Witness Statement of Vince McBean, the requested changes to the above proceedings were also requested. Therefore, as the request to change the name of the cancellation applicant from ‘Clapton Football Club’ to ‘Clapton Football Club 1878 Limited’ was made in writing, the Registry updated its records accordingly.”
13. The preliminary view also gave an award of £400 - comprising £200 for the fee payable under Form TM26(I) and £200 for the process of completing and filing it. The letter concluded: “If either party disagrees with the preliminary view given above, they should request a hearing on or before **2 June 2023**.”
14. On 2 June 2023, the registered proprietors sent a letter to the Registry detailing their objections to the preliminary view and requesting a hearing.
15. The registered proprietors’ letter queried the basis for the cancellation applicant’s change of name. Their argument was: “This issue does not amount to a change of name but a replacement of entity as the new Cancellation Applicant.”
16. The registered proprietors failed to see how the cancellation applicant could refer to itself in its letters giving notice of its intention to launch proceedings and subsequent iterations of Form TM26(I) as “Clapton Football Club” and then state that the cancellation application should have been in the name of “Clapton Football Club 1878 Limited.”

## HEARING

17. The hearing took place before me on Monday 3 July 2023.
18. Mr Robert Barr and Mr Christopher Tymkow attended as two of the registered proprietors and litigants in person. Mr Barr acted as the spokesperson for the registered proprietors.
19. Mr Gabriel Awosika attended as the solicitor acting for the cancellation applicant and provided a skeleton argument ahead of the hearing.
20. As litigants in person, the registered proprietors were not required to submit a skeleton argument, nor did they do so. However, I have taken account of the registered proprietors' letter of 2 June 2023.
21. Mr Barr began by querying the cancellation applicant's skeleton argument in that it was headed up in the name of "Clapton Football Club". Mr Awosika confirmed that the cancellation applicant was "Clapton Football Club 1878 Limited".
22. Mr Barr repeated some of the points raised in the registered proprietors' letter of 2 June 2023 and added that there was no fiduciary connection between "Clapton Football Club" and "Clapton Football Club 1878 Ltd", save for the common presence of Mr Vincent Joseph McBean.
23. Mr Barr called into question Mr McBean's previous conduct as a company director and his motivation in stating that the name of the cancellation applicant should have been "Clapton Football Club 1878 Limited". Mr Barr considered Mr McBean's motivation to have been that he had found out that the original basis of the cancellation application, being on behalf of a members' club, was not valid. As such, Mr Barr was sceptical about the reasons given for the request for a change of name i.e. that the name stated originally was due to a typographical error.
24. I questioned Mr Awosika about the heading of the cancellation applicant's skeleton argument. It was headed up as a matter for the High Court of Justice and the Queen's Bench Division involving "Clapton Football Club".
25. Mr Awosika replied that the document was sent over by his PA and it had "no bearing as to the issues that stand in this matter". However, Mr Awosika maintained that he was

always acting for “Clapton Football Club 1878 Limited”. He conceded that he initially started contact with the registered proprietors as “Clapton Football Club”. However, that was changed, and the Registry accepted that request for a change and the matter was never raised again as proceedings were taken forward.

26. Mr Awosika moved on to say that there was also a claim before the IPEC which resulted in the registered proprietors serving a notice to surrender their trade mark.

27. Mr Awosika argued that because the registered proprietors had surrendered their trade mark, his client was entitled to costs based on the IPO’s own guidance and established case law.

## **LEGISLATION AND GUIDANCE**

28. Section 68 of the Act states 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.

[...]”

29. 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.”

30. When considering the question of costs and reasonable notice, I bear in mind Tribunal Practice Notice (“TPN”) 6 of 2008:

### **“The need to provide reasonable notice**

3. ... costs are not usually awarded against rights holders or applicants who do not defend an action brought without prior notice.

5. ... an award of costs from the normal scale will usually be made to an opponent where a) a Form TM7a was filed, b) a subsequent Notice of Opposition is filed, and c) the opposition is undefended.”

## **DECISION**

31. In this case, the registered proprietors are not querying the principle of the costs award per se. They are contesting the validity of the cancellation application. They say that “Clapton Football Club” is a different entity from “Clapton Football Club 1878 Limited”.
32. The registered proprietors were contacted prior to formal action being taken, but by “Clapton Football Club”, not “Clapton Football Club 1878 Limited”.
33. I have thoroughly checked the case files, not only for this invalidation case before me (CA000503388 against UK00003276285), but also for the related opposition case OP000423332 against the trade mark application UK00003484390. I am satisfied that the relevant part of paragraph 4 of Mr McBean’s second witness statement of 27 October 2021 was correctly interpreted, the relevant part being:
- “I request the IPO to make the necessary changes under ... Trademark: UK00003276285 to reflect to the information provided.”
34. A Registry official scrutinised this part of Mr McBean’s witness statement and correctly concluded that “Trademark: UK00003276285” was a reference to the trade mark that was subject to an invalidity action by the cancellation applicant in the present case. As such, it constituted a written request to change the name of the cancellation applicant from “Clapton Football Club” to “Clapton Football Club 1878 Limited”.
35. While correspondence from the Registry post-27 October 2021, referred to “Clapton Football Club 1878 Limited”, the registered proprietors were not directly notified of the change of name. I also note that further doubt on the matter may have been cast when Mr Awosika emailed the Registry and Mr Barr on 23 November 2021<sup>2</sup> as follows: “The Claimants in the proceedings in the IPO and with IPEC are indeed different be it 'Clapton Football Club' that is currently on the TM26(I) regarding the trade mark the Claimant is

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<sup>2</sup> As per the documents sent by the registered proprietors to Mr Awosika on 5 December 2021 and copied to the Registry.

seeking to cancel that being under reference UK0000003276285; or Mr Vincent McBean himself via the IPEC claim. The fact remains that they are different.”

36. The cancellation applicant was ultimately successful. It incurred costs in compiling and submitting a Form TM26(I) up to the point where the registered proprietors withdrew their mark. However, the registered proprietors question the validity of the cancellation applicant’s change of name to “Clapton Football Club 1878 Limited” and point out that the letters before action of 16 September<sup>3</sup> referred to “Clapton Football Club”.
37. Taking a narrow view, the paperwork supplied by the cancellation applicant met the threshold for what is required to effect a change of name in an invalidity action. However, the registered proprietors were subject to considerable delays caused by the cancellation applicant before that position was arrived at. It was not unreasonable of the registered proprietors to devote resources to asking questions about the change of name. The identity of the party making the claims in the Form TM26(I) could be highly material since these claims involve key issues - the locus of goodwill and the assessment of bad faith.
38. I weigh the costs involved on the part of the registered proprietors in raising these matters against the costs that the cancellation applicant incurred up to the point that the registered proprietors surrendered their mark. I conclude that each party should bear its own costs.

## **CONCLUSION**

39. Subject to any appeal, each party will bear its own costs.

**Dated this 8th day of August 2023**

**John Williams**  
**For the Registrar**

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<sup>3</sup> While the registered proprietors referred to letters dated 9 September 2020 in their letter of 2 June 2023 and at the hearing, they subsequently contacted me to confirm that the date in question was 16 September 2020. Post-hearing, the cancellation applicant also furnished me with a copy of one of these letters which was sent through the post and dated 16 September 2020.