

TRADE MARKS ACT 1994

IN THE MATTER OF:
TRADE MARK APPLICATION NO. 3522371



BY ZEE BEST GERMAN DONER COMPANY LTD
(Applicant/Respondent)

AND

IN THE MATTER OF
OPPOSITION NO. 422427
BY GDK INTERNATIONAL LIMITED
(Opponent/Appellant)

AND

IN THE MATTER OF
AN APPEAL TO THE APPOINTED PERSON
AGAINST DECISION NO. O/276/22
OF MS. BEVERLEY HEDLEY DATED 31 MARCH 2022

DECISION ON COSTS

INTRODUCTION

1. By my Decision No. BL O/0062/23 I rejected the appeal of GDK International Limited against Decision No. O/276/22 of Ms. Beverley Hedley dated 31 March 2022 in Opposition No. 422427 and confirmed that the opposition to application no. Registration No. 3522371 for the trade mark depicted above had failed in its entirety.

2. The Applicant Zee Best German Doner Company Ltd having been wholly successful in resisting the Opposition and the subsequent Appeal it is entitled to a contribution to its costs. At first instance the Applicant was given the opportunity to submit the standard costs pro forma but since it failed to do so, the Hearing Officer declined to make a costs award in respect of the Opposition.
3. On appeal I directed that should the Applicant want costs, it should submit details so that the assessment could be made.
4. The Applicant submitted the following schedule of costs:

“Trademark NO: UK00003522371

Opposition NO: OP000422427

Dear sirs

Please find below our submission for our costs proforma

Tribunal cost proforma

Notice of defence 700 hours

Considering forms filed by

The other party 436 hours

Total 1,136 hours

Zero form fees

Preparing evidence 200 hours

Preparing statements 15 hours

Gathering advice 30 hours

Total 245 hours

Preparing for hearing

Gathering information 30 hours

Seeking advice 30 hours

Submitting forms/corresponding 5 hours

Total 65 hours

No other expenses

Total hours spent is 1446

Please note as I was self-represented and was unaware we could claim costs the case started in October 2020 and the final day spent was 11th July 2022

The total days between each response was totalled to 503 days 308 of those days I've spent 3-4 hours responding to emails , gathering evidence and advice and submitting forms

Thank you for your help

Zee best doner

Oguzhan erel" (*sic*)

5. In response to this the Appellant's attorneys submitted:

"We would be grateful if account is taken of the fact that the applicant was unrepresented and that unrepresented parties generally incur lower costs because they do not have to pay legal fees.

Whilst it is appreciated that the applicant will have spent time reviewing the case and preparing submissions filed, we respectfully submit that the number of hours indicated by the applicant appears to be excessive given the fact the both the counterstatement and respondent's notice submitted during the proceedings were very brief and minimal evidence was submitted by the applicant.

For example, it is not clear why a total of 700 hours was required to complete the TM8 form that was submitted (which contained a very brief counterstatement). Nor is it apparent why 245 hours were taken to prepare the 17 pages of evidence that were submitted – noting that the first 7 pages of this evidence would appear to be photos/photocopies of the same sheet of paper and no witness statement was submitted to support same. The applicant has also not qualified the "seeking advice" time which has been logged in the pro-forma.

Finally, it is noted that if the total number of hours claimed by the applicant was taken into account the total amount awarded would in fact greatly exceed the maximum amount payable on the scale to represented parties.

We would be obliged if the above submissions are considered by the Appointed Person when reaching his decision on what is reasonable in the circumstances.”

DECISION

6. It is well established that an award of costs in the Registry is contributory, not compensatory, and are usually by reference to the Registry’s standard scale of costs. At the Hearing before me I understood both parties to agree that the standard scale should be the starting point. For unrepresented parties, the cost of the time spent on the matter is assessed in line with Practice Direction 46.5 sub. 3.4 of the Civil Procedure Rules, which stipulates an hourly rate of £19 subject (in the absence of a request for off-scale costs) to the maxima of the Registry’s standard scale of costs.

7. The first point to note is that the Applicant appears to be retroactively seeking costs for the first-instance case. Mr Erel states:

“Please note as I was self-represented and was unaware we could claim costs the case started in October 2020 and the final day spent was 11th July 2022”

8. The Applicant did not file a cross-appeal seeking a revision of the Hearing Officer’s costs order below. Furthermore, notwithstanding the Applicant was self-represented, the Hearing Officer’s decision stated clearly:

61) As the applicant has been successful, it is, in principle, entitled to a contribution towards its costs. In an official letter to the applicant, dated 10 December 2021, the applicant was advised that, if it intended to make a request for an award for costs it should complete and return the relevant costs proforma by 07 January 2022. The same letter stated, inter alia, that:

“If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded.”

62) No costs proforma has been filed by the applicant and no official fees have been paid by the applicant in these proceedings. I therefore do not consider it appropriate to make an award of costs.

9. The Applicant should therefore have been well aware that it could have claimed costs below. Insofar as the costs now claimed seek costs in relation to the opposition hearing, I decline to revisit the Hearing Officer's order. I also observe, in passing, that the time claimed was, as the Opponent observes, excessive given the actual steps taken by the Applicant in its conduct of the Opposition, which on the face of it were minimal.
10. As to costs on the Appeal, I assume (since neither party appeared below) that these are covered by the 65 hours claimed for "Preparing for Hearing".
11. The Applicant undoubtedly expended time and effort in reviewing the Notice of Appeal and preparing its skeleton argument. Whilst from a lawyers' perspective the skeleton may not, on the face of it, suggest a great deal of time was expended on it I recognise that a litigant-in-person is quite likely to spend a considerable amount of time seeking to understand the nature of the appeal, how to respond, what the law might be and so on.
12. Furthermore, the Applicant was represented at the Appeal hearing and whilst that lasted just a couple of hours, there will have been some preparation involved.
13. Nevertheless, it is not clear to me that a total claim of 60 hours for "gathering information" and "seeking advice" is reasonably reflected in the content or conduct of the defence of appeal before me. I also bear in mind that the costs award is contributory, not compensatory.
14. In this situation there is no real science to the assessment, and I must use my discretion to decide what is fair and reasonable. Applying a broad brush, doing the best I can on the basis of the information and materials before me, it seems to me that for the appeal a reasonable assessment would be that the Applicant should be awarded costs of £750 by way of costs for this appeal.

15. I therefore order that the Appellant/Opponent pays the Respondent/Applicant total costs of £750 within 21 days of the date of this Decision on Costs.

Philip Harris

Appointed Person

18 September 2023