

BL O/0901/23

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 431343

IN THE NAME OF MULBERRY COMPANY (DESIGN) LTD

TO TRADE MARK APPLICATION No. 3729527

IN THE NAME OF ULBRRY LTD

DECISION

1. Opposition No. 431343 (in the name of Mulberry Company (Design) Ltd) to Trade Mark Application No. 3729527 (in the name of Ulbrry Ltd) was rejected for the reasons given by Ms Rosie Le Breton on behalf of the Registrar of Trade Marks in a Decision issued under reference BL O/0227/23 on 02 March 2023.
2. The Opposition was by consent determined on the basis of the papers on file, which included written submissions filed by the parties in lieu of a hearing.
3. The Hearing Officer decided that the marks **MULBERRY** and **ULBRRY** could at the relevant date (06 December 2021) be used concurrently for identical — and so also for similar — goods of the kind in issue in Classes 18 and 25 without giving rise to the existence of a likelihood of confusion within the scope of s.5(2)(b) of the Trade Marks Act 1994.
4. For the reasons she gave in paras [64] and [65] of her Decision, she made no order for costs:

64. *The applicant has been successful and would normally be entitled to a contribution towards its costs. On 22 November 2022, the Tribunal wrote to the applicant attaching a costs pro-forma and stating as follows:*

“What to do if you intend to request costs”

If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party. Please send these by e-mail to tribunalhearings@ipo.gov.uk.

*If there is to be a "decision from the papers" this should be provided by **15 December 2022***

...

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."

65. *The applicant did not provide a completed costs pro-forma, and in the circumstances, I make no cost award in relation to this opposition.*

5. I pause to emphasise two matters at this point in my Decision.
6. First: The fact that the Trade Mark Applicant was conducting its case in the Registry without professional representation did not relieve it of the need to comply with the directions given in the official letter of 22 November 2022. The Supreme Court has confirmed that unrepresented litigants are, in principle, required to adhere to the same standards of compliance with rules and orders as represented parties: Barton v Wright Hassall LLP [2018] UKSC 12 at para. [18] (where Lord Sumption JSC noted that: *“Unless the rules and practice directions are particularly inaccessible or obscure, it is reasonable to expect a litigant in person to familiarise himself with the rules which apply to any step which he is about to take.”*).
7. Second: The Official letter of 22 November 2022 clearly set a deadline of 15 December 2022 for filing the required Tribunal Costs Pro Forma. That deadline was extendable on application to the Registrar under r.77 of the Trade Marks Rules 2008. However, the Trade Mark Applicant made no attempt to apply for an extension of time and said nothing at all about the costs of the Opposition proceedings in the Written Submissions which it filed on 15 December 2022 in support of the contested application for registration. Its failure to comply with the 15 December 2022 deadline cannot be regularised by this Tribunal: the powers conferred by r.73(4) do not include a power for the Appointed Person to grant a retroactive — or any — extension of time under r.77.

8. On 29 March 2023, the Applicant filed a Form TM55P Notice of Appeal to an Appointed Person under s.76 of the 1994 Act simply stating as its **“Reasons for appeal”** in Box 6: **“For our costs to be heard and considered please. Exhibit UL1: Shows ULBRRY’s Tribunal Costs pro forma as at 28th February 2023. Exhibit UL2: Shows reason for Trade Loss of 14 months. Exhibit UL3: Shows every quarter (3 months) of Trade Loss (no sales and incurred costs) during litigation.”**

9. Exhibit UL1 included the following itemisations in relation to work done and time spent:

Notice of Opposition: 40/00 (40 hrs)
Notice of Cancellation: 00/00 (0 hrs)
Notice of Defence: 36/00 (36 hrs)
Considering forms filed by the other party: 76/00 (76 hrs)

@ £320 per hour

TOTAL £48,640.00

Considering and commenting on the other side’s evidence / written submissions: 101/00 (101 hrs)

Preparing evidence / written submissions: 63/00 (63 hrs)

TOTAL 164/00 (164 hrs)

TRADE LOSS of 14 months (Damages): 9,408/00 (9,408 hrs) £40,103.00

INCURRED COSTS of 14 months: £4,823.07

TOTAL 9,408/00 (9,408 hrs) £44,926.07

10. The hearing of the Appeal took place before me by videolink on 01 September 2023. The Applicant was represented by Ms Ayesha Jalal (a director of the company) and an unidentified male speaker who intervened audibly during the hearing from an off-screen position in the room where she was sitting. Having intervened initially for the purpose of prompting Ms Jalal on points he thought she needed to make, he progressively intervened for the purpose of arguing the Appeal along with her on the Applicant’s behalf.

11. They maintained: (1) that the official letter of 22 November 2022 had — without defining or delimiting the expression “**official fees**” — exempted “**official fees**” from the requirement to file a Tribunal Costs Pro Forma when it stated “**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**”; and (2) that the Exhibits to the Notice of Appeal provided what they insisted were itemisations of time and money properly classifiable as “**official fees**” for the purposes of the Applicant’s claim for an award of costs within the latitude allowed by the supposed exemption.
12. When attempting to identify the error that the Hearing Officer was said to have made, they repeatedly made a rehearsed and impenetrable assertion to the effect that her Decision was “*wrong on the doubt of balance, on its conclusion*”: Transcript p.1, lines 3 to 5; p.6, lines 1 to 5; p.6, line 25 to p.7, line 2; p.7, lines 14 to 16; p.7, line 25 to p.8, line 2; p.8, lines 8 to 12; p.20, lines 11 to 15; p.21, lines 14 to 17.
13. The official letter of 22 November 2022 made it explicitly clear that “**If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party**” failing which “**costs, other than official fees arising from the action ... may not be awarded.**” By not filing the required Tribunal Costs Pro Forma, the Applicant opted out of the opportunity it was given to request anything “**other than official fees**” by way of costs at the conclusion of the Opposition proceedings.
14. No “**official fees**” are payable for filing a defence and defending an application for registration in opposition proceedings conducted before the UK Intellectual Property Office. The itemisations in the Exhibits to the Notice of Appeal cannot by any stretch of the imagination be taken to identify “**official fees**”. Nor can they by any stretch of the imagination be seen as an acceptable attempt to formulate a claim for costs in accordance with the long-established and well-publicised approach to awarding costs in Registry proceedings under s.68(1) of the 1994 Act and r. 67 of the 2008 Rules (as to which see AMARO GAYO COFFEE Trade Mark BL O/257/18 (25 April 2018) at paras [12] to [14] and more recently Tribunal Practice Note (TPN) 1/2023: Costs in proceedings before the Comptroller published on 24 January 2023).

15. I consider it to be symptomatic of a fundamentally flawed approach to quantification that the Exhibits to the Applicant's Notice of Appeal include a claim for 40 hours of work on the Notice of Opposition (a document which was prepared and filed by the Opponent, not by the Applicant), an across-the-board claim for remuneration at the rate of £320. per hour (when the 'litigant in person' rate analogously prescribed by CPR Practice Direction 46, para. 3.4 is currently £19. per hour) and a mountainous claim for payment equating to more than 9,500 hours' worth of time and money.
16. It was plainly open to the Hearing Officer on the information and materials before her to make no order for costs. As I have said, this Tribunal has no power to grant the Applicant a retroactive — or any — extension of time for complying with the directions given in the official letter of 22 November 2022. Even if it did, there is no basis on which the power could rationally be exercised so as to enable the Applicant to pursue a claim for costs under s.68(1) of the 1994 Act and r.67 of the 2008 Rules founded on the itemisations presented for consideration in the Exhibits to its Notice of Appeal.
17. For the reasons I have given, the Appeal is dismissed. The Applicant (Appellant) is directed to pay £1,250. to the Opponent (Respondent) in respect of its costs of the unsuccessful Appeal, to be paid within 21 days of the date of this Decision. I consider that to be a reasonable sum to award by way of costs from the perspective of the approach to quantification indicated in paras [12] to [14] of my Decision in AMARO GAYO COFFEE Trade Mark (above).

Geoffrey Hobbs KC

21 September 2023

Ms Ayesha Jalal and an unidentified male speaker appeared on behalf of the Applicant (Appellant)

Ms Stephanie Davies of Withers & Rogers LLP appeared on behalf of the Opponent (Respondent)