

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF THE REQUEST BY LIBRA ASSOCIATION FOR PROTECTION IN THE UK OF THE FOLLOWING INTERNATIONAL REGISTRATION NO. WO0000001553828



IN CLASSES 9, 35, 36, 42 AND 45

AND THE OPPOSITION THERETO UNDER NO. 423958 BY LIQUIDPLANNER, INC.

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF N.R. MORRIS (O/585/22) DATED 8 JULY 2022.

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DECISION  
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**Introduction**

1. This is a decision on costs following the discontinuation of Libra Association's ("**Appellant**") appeal from decision O/585/22 of N.R. Morris ("**Decision**") concerning the opposition by Liquidplanner, Inc. ("**Respondent**") to International trade mark 1553828 ("**the IR**"). The IR is for the mark shown below:



2. The Appellant sought protection in respect of goods and services in classes 9, 35, 36, 42 and 45.
3. On 15 February 2021, the application was opposed by the Respondent based on section 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994. The Opposition was directed against all of the Appellant's goods and services. The Opponent relied on the following earlier mark for all of its section 5 grounds:

UK00003466932



Filing date: 14 February 2020

Publication date: 28 February 2020

Date registration completed: 9 August 2020

Priority date: 21 August 2019

Priority country: United States of America

Trade Mark from which priority claimed: 88587894.

4. The Earlier Mark is registered in respect of goods and services in classes 9 and 42.
5. In the Decision, N.R. Morris for the Registrar held that the opposition was successful in respect of most, but not all, of the goods and services for which the Appellant sought protection.
6. On 5 August 2022 the Appellant filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.
7. Subsequently, on 6 September 2022, the Appellant's representatives, Lane IP, notified the Appointed Person and the Respondent that the appeal was withdrawn with immediate effect. Thereafter, the Appointed Person to whom the appeal had initially been assigned notified the parties that he was unable to deal with the consequential issues arising out of the withdrawal, owing to a conflict. The matter was transferred to me to deal with the consequential issues.

#### **Costs**

8. There is only one consequential issue arising, and that is the matter of costs. The usual consequence of discontinuation of an appeal by an Appellant is that the Appellant pays the Respondent's costs in the appeal. It is common ground between the parties that the costs should be assessed according to the scale in Tribunal Practice Notice 2/2016.
9. The Respondent's representatives informed the Appointed Person that they had taken the following steps in relation to the appeal:
  - Reviewing the grounds of appeal;
  - Assessing (with the Respondent) whether or not to file a respondent's notice in response to the grounds of appeal;
  - Considering the further directions made by and consequential emails received from the UKIPO regarding next steps in the appeal;
  - Considering correspondence from the UKIPO relating to the identity of Appointed Person and a possible conflict of interest;
  - Considering the further directions made by and consequential emails received from the UKIPO regarding the abandonment of the appeal and next steps;
  - Considering correspondence from the UKIPO Appointed Person regarding costs.
10. Given that no hearing in the appeal was listed or took place, and no evidence was prepared, the only relevant Task in the scale in Tribunal Practice Notice 2/2016 is "Preparing a statement and considering the other side's statement", for which the recoverable costs are "From £200 to £650 depending on the nature of the statements, for example their complexity and relevance".
11. It seems to me that whereas the work done as listed in the first two bullet points above may have been towards the lower end of the range, the Respondent then had to undertake some

further work as a result of the withdrawal of the appeal. In my view, the fairest approach is to order the Appellant to pay the maximum permitted sum under this task, i.e. £650.

12. I accordingly order the Appellant to pay the Respondent the sum of £650, in addition to the £1,260 it was ordered to pay by the Hearing Officer. Both such sums should be paid within 21 days.

**Dr. Brian Whitehead**

**6 December 2022**

**Representation**

Lane IP Limited for the Holder / Appellant

Wiggin LLP for the Opponent / Respondent