

TRADE MARKS ACT 1994

**IN THE MATTER of Trade Mark Registration No 1585175
by Linseal International Ltd**

and

**IN THE MATTER of an application for invalidity No 10220
by Trevor John Evans**

Background

1. The substantive decision in the above invalidity and revocation proceedings was issued on 14 April 2002. The proceedings concerned an application filed on 14 July 1998 by Trevor John Evans for a declaration of invalidity and revocation against the trade mark registered in the name of Linseal International Ltd.

2. At the main hearing, the applicant was represented by Mr Richard Meade of Counsel instructed by Ian Newbury & Co, the registered proprietors were represented by Mr Guy Tritton of Counsel instructed by Trade Mark Owners Association Ltd (now Hallmark IP Limited). The applicant for invalidity maintained and argued before me, two grounds of invalidity and a single ground of revocation. Although the bulk of the applicant's submissions concerned the ground of invalidity under section 5(4)(b), he did argue the other grounds under section 5(4)(a) and section 46(1)(d) of the Act.

3. At the conclusion of the hearing, both counsel, asked that I defer my decision on costs until the outcome of the proceedings was known. My decision on costs would then be taken on the basis of written submissions.

4. In my substantive decision, I found that the application for a declaration of invalidity under section 5(4)(b) had been made out and that the mark should be declared invalid. However, I found that the other ground of invalidity and the ground of revocation had not been made out and were dismissed.

5. Following the issue of my decision, I gave a period of time for both parties to file their written submissions. The applicant's submissions were received on 12 May 2003, the registered proprietor's submissions were received on 13 May. After a careful consideration of these submissions and the papers already on file, I give my decision as to costs in these proceedings.

Decision on Costs

7. The applicant, in his written submissions, seeks an order for his costs and supplied a schedule of costs in the matter. Costs amount to £20313-40. He seeks an award of costs on

the basis that he was successful in his application for a declaration of invalidity and that as such, costs should follow the event. In his view, the registered proprietors should have made a timely concession on the copyright point and that all the costs of the proceedings are as a result of the registered proprietors' intransigence. Although the applicant failed on the other two grounds, in his view, these were subsidiary claims and of far less significance and have not largely affected the amount of costs expended.

8. The registered proprietor submits that as the statement of grounds filed did not specifically quote any section of the Act and did not therefore adequately particularise the applicant's case, that their legal advisers had been put to extra cost in trying to translate the meaning. As the applicant was only successful on one of the grounds, it would in their view be fair for both parties to bear their own costs.

9. It is well established that in registry proceedings costs will usually be taken from the scale of costs published in Tribunal Practice Notice TPN 2/2000. As these proceedings commenced before 22 May 2000 then the costs listed at Annex B of that notice apply. The figures listed in Annex B represent a contribution towards a party's costs to proceedings. The registrar can make an award outwith the published scale. In a decision of Mr Simon Thorley, Q.C. sitting as a Deputy High Court Judge in *Re Anheuser-Busch Inc* [2002] RPC 38. He stated:

“68.....In the Tribunal Practice Note [TPN 2/2000] it is stated:

‘It is vital that the Comptroller has the ability to award costs off the scale, approaching full compensation, to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour.’

69. I believe this is correct. In particular I believe it will be correct for the hearing officer to consider seriously departing from the usual scale where he concludes that a case is unarguable. Equally the costs involved in preparing, considering and replying to evidence are generally significant and it is right that awards of costs off the usual scale should be made in circumstances where the hearing officer is satisfied that a party has unreasonably failed to consider what evidence is relevant before filing a large amount of irrelevant evidence.”

10. This case is part of a long running dispute between various parties. The two main protagonists are Mr Costello and Mr Evans. The disputes have been between a number of different companies but at its heart lies the dispute between these two individuals. Some rounds in the litigation have gone to Mr Evans' side some to Mr Costello's. I see nothing in this current dispute that warrants an award outwith the published scale. I agree that the proceedings have been protracted but in my view both parties shoulder some of the responsibility for the length of the proceedings. The copying of documents has not been very successful and many letters posts have, it seems, not reached their destination. But nothing in the conduct of the registered proprietors leads me to the view that they were acting unreasonably.

11. Nevertheless, the applicant has been successful in their action. I note the registered

proprietors' comment that he failed on two of his grounds. It seems to me that these grounds were inherently weak and that much of the evidence was not directed to the grounds. Some time could have been saved if they had not been argued but they were very much secondary grounds and did not take up that much time at the hearing.

12. Taking all these factors into account it seems to me that the applicant is entitled to a contribution towards his costs from the published scale. Working from that scale I order that the registered proprietors pay the applicant the sum of £1335-00 as a contribution towards his costs. This sum is to be paid within seven days of the expiry of the appeal period from this decision or within seven days of the final determination of any appeal on costs.

Dated this 16TH day of June 2003

**S P Rowan
For the Registrar
the Comptroller General**