

O-302-21

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3461076

BY KISMAT KONNECTIONS LTD

TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASS 45

AND

OPPOSITION THERETO UNDER NO. 420332

BY RAJA KOHLI

BACKGROUND AND PLEADINGS

1. On 24 January 2020, Kismat Konnections Ltd (“the applicant”) filed trade mark application number UK00003461076 for the mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 21 February 2020, in respect of the following services:

Class 45 Dating agency services; Dating services; Dating services provided through social networking; Agency services (Dating-); Computer dating services; Internet based dating, matchmaking and personal introduction services; Internet dating services; Video dating services.

2. Mr Raja Kohli (“the opponent”) filed a Form TM7a (“TM7a”) dated 27 February 2020, notifying the applicant of its intention to file an opposition against its application. The opponent subsequently filed a Form TM7 (“TM7”) on 20 May 2020, opposing the application on the basis of sections 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”).

3. On 29 May 2020, the Tribunal wrote to the opponent (copying the correspondence to the applicant) acknowledging its TM7 and highlighting that the name of the opponent given on the TM7 did not match that given on the TM7a. The Tribunal requested clarification on that matter and, also, further information for the grounds relied upon. The opponent was given a deadline of 10 July 2020 to file an amended TM7.

4. The opponent responded to the Tribunal in an email dated 30 May 2020, in which it was explained that the opponent had simply entered the applicant’s name in the field provided for the opponent’s name, in error.

5. In an official letter dated 1 June 2020, sent to both parties, the Tribunal, addressing the opponent, wrote as follows:

“I acknowledge receipt of your email dated 30 May 2020 which confirms Raja Kohli is the opponent in the above matter, advising the name of the applicant was given on the Form TM7a in error.

Notwithstanding the typographical error on the form, whereby the applicant’s details were input on the Form TM7a where the opponent should have been named, the intention of the opponent was to file a Form TM7a.

The preliminary view of the Registry, therefore, is to **accept** the Form TM7 in the name of Raja Kohli.

[...]

If either party disagrees with the preliminary view they should request a hearing within 28 days from the date of this letter; that is on or before **29 June 2020.**”

6. In an email to the Tribunal dated 4 June 2020, the applicant requested a hearing to challenge the preliminary view. A joint hearing was scheduled for 30 June 2020 and both parties were notified of the details in an official letter dated 17 June 2020. The opponent confirmed it would be attending but the applicant did not.

7. The joint hearing took place before Leisa Davies, Hearing Officer, on 30 June 2020, by telephone conference. The opponent attended, representing himself; the applicant did not attend, despite multiple attempts to contact the telephone number on record. The Hearing Officer wrote to both parties on the same day with the following decision:

“After considering Mr Kohli’s submissions made orally at the hearing, my decision is that the details given on the Form TM7a, in so far as the name of the Applicant was erroneously entered in place of the Opponent’s name, constituted an obvious error which should be corrected under the provisions of Rule 74. The Opponent’s details will therefore be recorded as Mr Raja Kohli.”

8. In an official letter dated 3 July 2020, the Tribunal requested that the opponent filed an amended TM7, rectifying the issues raised in the Tribunal’s letter of 29 May 2020.

9. The opponent filed an amended TM7, which was served on the applicant on 27 August 2020. The deadline for the applicant to file its Form TM8 (Notice of defence and counterstatement) (“TM8”) was 27 October 2020, communicated by the Tribunal in the serving letter.

10. The applicant did not file a TM8 by the deadline and so, in an official letter dated 25 November 2020, the Tribunal advised both parties of its preliminary view to deem the application as abandoned. Either party, if it disagreed with the preliminary view,

was to provide full written reasons and request a hearing by 9 December 2020. This correspondence was returned undelivered to the applicant.

11. In an official letter dated 24 December 2020, the Tribunal advised both parties that the application had been deemed abandoned under Rule 18(2) and that following the opponent's application for an award of costs (received by email on 23 December 2020), both parties were invited to submit comments on the issue of costs by 14 January 2021. No comments were received.

12. In an official letter dated 4 February 2021, the Tribunal issued a preliminary view awarding the opponent the sum of £320 as a contribution towards its costs, broken down as: £120 for the filing of the TM7 and attendance at the hearing; and £200 for the official fee. The deadline to request a hearing to challenge the preliminary view was 18 February 2021.

13. On 4 February 2021, the opponent sent an email to the Tribunal requesting a hearing on the basis that the award of costs was too low and referred to similar proceedings in which a higher award was made. The Tribunal responded to the opponent, by email, on 8 February 2021, requesting: (i) written reasons for challenging the preliminary view and (ii) completion of the attached costs pro-forma including a breakdown of the actual costs incurred, both of which were to be filed prior to the hearing. The opponent's attention was also brought to the Litigants in Person (Costs and Expenses) Act 1975 (as amended) ("the Litigants in Person Act").

14. A hearing was scheduled for 24 February 2021, the details of which were sent by the Tribunal to both parties in an official letter dated 8 February 2021. The opponent confirmed attendance; the applicant did not.

THE HEARING

Representation

15. The hearing took place before me, by telephone, on 24 February 2021. The opponent, Mr Kholi, attended, representing himself. The applicant did not attend and did not file submissions in lieu of attendance. Despite the Tribunal's written request to Mr Kholi on 8 February 2021, he did not file written reasons for his disagreement with the costs order, nor did he complete a costs pro-forma.

Hearing discussion

16. At the hearing, I asked Mr Kohli for his reasons for disagreeing with the costs award at issue. Mr Kohli referred to previous proceedings, in which he was awarded higher costs. Mr Kohli submitted that the current proceedings were more time consuming because a hearing took place that required preparation.

17. Mr Kohli also made reference to the applicant's "disruptive behaviour" and that it requested a hearing to challenge the preliminary view of the Registry to allow the TM7 but did not then attend that hearing.

18. I then asked Mr Kohli what costs award he would consider appropriate in this case: his reply was that, after a quick calculation, the hours spent on the case total 160. I referred Mr Kohli to the costs pro-forma he was sent, but did not complete, and explained that I needed a breakdown of what activities were undertaken and how long each of them took. Based on an 8-hour working day, Mr Kohli submitted the following:

| | |
|----------------------------------------------|---------------------------|
| Completing Form TM7 and the amended Form TM7 | 5 days (40 hours) |
| Research and preparation for hearing | 2 days (16 hours) |
| Communicating with the other side | 3 days (24 hours) |
| Administration | 2 days (16 hours) |
| Total | 12 days (96 hours) |

19. I pointed out to Mr Kohli that this sum differed to the 160 hours previously put forward. Mr Kohli submitted that the time taken "in [his] eyes" totals 160 hours, but that 96 would be acceptable.

20. Referring to the claimed five days taken to complete the two TM7s, I asked Mr Kohli whether the research undertaken to complete the TM7 in the previous proceedings helped him with the same form in this case, given that he relied upon the same unregistered mark and that the opposition was based on the same grounds. Mr Kohli said that it would have helped him, but that it took him longer this time as he wanted to improve upon the forms filed in the previous proceedings and so did more research.

21. I asked Mr Kohli whether he had any further submissions to make, which he did not.

22. At the conclusion of the hearing, I reserved my judgment to give me an opportunity to reflect on the submissions made by Mr Kohli. I advised Mr Kohli that my decision would be issued, in writing, in due course.

DECISION

Statutory provisions

23. Section 68 of the Act and Rule 67 of the Trade Marks Rules 2008 read as follows:

“68. (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.”

and

“67. 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 by what parties they are to be paid.”

24. Various Tribunal Practice Notices (“TPNs”) have also been issued over the years in relation to the award for costs in proceedings. In particular, I take note of TPN 2/2016, which, at Annex A, sets out the headings of the activities upon which any contribution of costs is to be assessed, which reads as follows:

Annex A

Scale of costs applicable in proceedings commenced on or after 1st July 2016

| Task | Cost |
|--------------------------------------------------------------------------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Preparing a statement and considering the other side's statement | From £200 to £650 depending on the nature of the statements, for example their complexity and relevance. |
| Preparing evidence and considering and commenting on the other side's evidence | From £500 if the evidence is light to £2200 if the evidence is substantial. The award could go above this range in exceptionally large cases but will be cut down if the successful party had filed a significant amount of unnecessary evidence. |
| Preparing for and attending a hearing | Up to £1600 per day of hearing, capped at £3300 for the full hearing unless one side has behaved unreasonably. From £300 to £550 for preparation of submissions, depending on their substance, if there is no oral hearing. |
| Expenses | (a) Official fees arising from the action and paid by the successful party (other than fees for extensions of time). (b) The reasonable travel and accommodation expenses for any witnesses of the successful party required to attend a hearing for cross examination. |

25. Section (3) of TPN 2/2016 explains that the updates made to the scale of costs maintain an underlying contribution-not-compensation approach, as below:

The new scale

(3) Annex A to [TPN 4/2007](#) puts figures to the scale of costs in respect of an award in proceedings commenced on or after 03 December 2007. This scale has not been revised since November 2007 and it now needs updating to take better account of the real costs currently involved in litigation before the Comptroller whilst still maintaining the underlying contribution-not-compensation approach. The new scale at Annex A to this Notice will be applicable in respect of awards of costs in proceedings commenced on or after 1 July 2016. For proceedings commenced before that date, the scale, published as Annex A to [TPN 4/2007](#), will continue to apply. The new scale does not affect the £500 cap on costs in fast track trade mark opposition proceedings.

26. TPN 2/2016 updates and supplements TPN 4/2007 and TPN 2/2000. TPN 4/2007 maintains that off scale costs may be given in certain circumstances, the relevant section of which is copied below:

Off scale costs

5. TPN 2/2000 recognises that 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. Whilst TPN 2/2000 provides some examples of unreasonable behaviour, which could lead to an off scale award of costs, it acknowledges that it would be impossible to indicate all the circumstances in which a Hearing Officer could or should depart from the published scale of costs. The overriding factor was and remains that the Hearing Officer should act judicially in all the facts of a case. It is worth clarifying that just because a party has lost, this in itself is not indicative of unreasonable behaviour

6. TPN 2/2000 gives no guidance as to the basis on which the amount would be assessed to deal proportionately with unreasonable behaviour. In several cases since the publication of TPN 2/2000 Hearing Officers have stated that the amount should be commensurate with the extra expenditure a party has incurred as the result of unreasonable behaviour on the part of the other side. This "extra costs" principle is one which Hearing Officers will take into account in assessing costs in the face of unreasonable behaviour.

7. Any claim for cost approaching full compensation or for "extra costs" will need to be supported by a bill itemizing the actual costs incurred.

8. Depending on the circumstances the Comptroller may also award costs below the minimum indicated by the standard scale. For example, the Comptroller will not normally award costs which appear to him to exceed the reasonable costs incurred by a party.

27. Section 5.2 of the Trade Marks Manual relates to costs for unrepresented parties and reads as follows:

“ Any cost awards made in favour of an unrepresented party will include the full cost of any official fees, but will only cover 50% of the amount from the published scale. This ensures that the unrepresented party is not overcompensated for the cost of the proceedings.

[...]”

28. Section 5.2 goes on to refer to the Litigants in Person Act, which is also relevant since it sets the minimum level of compensation for litigants in person in Court proceedings at £19 per hour.

Decision

29. This decision effectively acts as a reconsideration of the costs assessment taking into account the oral submissions of Mr Kohli at the hearing.

Off scale costs

30. I will address first the conduct of the applicant. The opponent did not specifically make such a request but, since he referred to the applicant's behaviour as a reason for his challenging of the costs award, I will deal with off scale costs.

31. I note that the applicant requested a hearing which it did not then attend. I accept this would have inconvenienced both the Tribunal and the opponent. However, I am not satisfied that this constitutes a breach of the rules, delaying tactics, or unreasonable behaviour.

32. I also bear in mind the notes of the Hearing Officer, which state that the hearing at issue lasted no more than 10 minutes. I also consider it relevant that the opponent would not have had to make submissions during that hearing: the Tribunal had already made the decision to allow the opponent's TM7 into proceedings and so the applicant's non-attendance simply meant that the Tribunal's decision remained in favour of the opponent.

33. With consideration of the factors above, I find no reason for off scale costs to be considered in these proceedings. I will, however, have regard to the inconvenience caused to the opponent when calculating the costs award.

Costs on the scale

34. As I find no reason to take the costs award off the scale, I am guided in this decision by the scale of costs set out in TPN 2/2016 above, as well as the guidance on how costs should be allocated to unrepresented parties such as the opponent.

Filing of Form TM7

35. I consider the time claimed for filing a TM7 (40 hours) to be high. The content of the TM7 is minimal. However, I accept the opponent's comments that, for him, it was complex, particularly due to the nature of the grounds relied upon. In relation to the opponent's filing of two TM7s, I note that the errors made in the first TM7 were the mistake of the opponent and so it would be unjust to expect the applicant to pay for those errors.

The hearing

36. I consider the time claimed for attending a hearing (16 hours) to be excessive. The only issue to be addressed at the hearing was the acceptance of the opponent's TM7. The fact that the hearing lasted no more than 10 minutes shows me that there was very little to discuss. Having read the post-hearing letter issued by the Hearing Officer, it seems that the only submissions made by the opponent at the hearing were a repeat of his written submissions to the Tribunal on 30 May 2020 – that the applicant's name was inadvertently entered on the TM7a in place of the opponent's name. Whilst I accept that some preparation by the opponent would have been necessary, extensive research would not.

Other activities

37. The activities surrounding communication with the applicant and general administration are not costs that would be recoverable on the scale if the opponent was represented. I do not, therefore, consider that these costs are recoverable.

38. Overall, I consider a costs award for the following number of hours to be reasonable:

| | |
|---------------------------------------|-----------------|
| Preparing Form TM7 | 8 hours |
| Preparing for and attending a hearing | 2 hours |
| Total | 10 hours |

39. The opponent is also entitled to claim the official fee of £200.

40. In relation to the hours expended, I note that the Litigants in Person Act sets the minimum level of compensation for litigants in person at £19 per hour. I see no reason to award anything other than this. I therefore award the opponent the sum of £190 (10 hours at £19 per hour) and an additional £200 for official fees, totalling £390.

41. I therefore order Kismat Konnections Ltd to pay Raja Kohli the sum of £390. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 23rd day of April 2021

E VENABLES

For the Registrar