

BL O/507/22

Date: Tuesday, 7th June 2022

Before:

MR. GEOFFREY HOBBS QC
(Sitting as the Appointed Person)
Remotely via MS Teams

**In the Matter of UK Trade Mark Application Nos. 3472981, 3492737 & 3492741
by Personal Trainer Ltd (Applicant / Appellant)**

and

**In the Matter of Oppositions Thereto under Nos. 420582, 421049 & 421051
by Shine TV Limited (Opponent / Respondent)**

**Appeal against the Award of Off-Scale Costs made by Ms Heather Harrison on
behalf of the Registrar of Trade Marks in Decision BL O/288/22 (4 April 2022)**

MS. SIMI SAHDRA appeared for the **Appellant**

MR. PETER DAWSON of Wiggin LLP appeared for the **Respondent**

APPROVED DECISION

Transcript of the Stenograph Notes of Marten Walsh Cherer Ltd
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THE APPOINTED PERSON:

Shine TV Limited opposed three applications by Personal Trainer Limited to register trade marks containing the words **MASTER CHEF** for use in respect of services listed in classes 41 and 42 of the Nice Classification.

The opponent's objections to registration failed in relation to the applicant's requests for registration in class 42 but succeeded in relation to the requests for registration in class 41, for the reasons given by Ms. Heather Harrison in the decision she issued on behalf of the Registrar of Trade Marks under reference BL O/288/22 on 4 April 2022.

The Hearing Officer dealt with the costs of the opposition proceedings in paragraphs [140] to [156] of her decision. In paragraph [141] she set out the basis on which the opponent had requested an award of above-scale costs in its favour.

“[141] The opponent has had the greater share of success and is entitled to an award of costs. It asks for costs on the scale with an additional award off the scale for the costs arising from what it describes as the applicant's unreasonable behaviour. It says that the applicant has behaved unreasonably by (i) persistently failing to copy correspondence, despite reminders from the tribunal; (ii) filing defences late, leading to an unnecessary hearing; (iii) missing its deadline to object to a preliminary view about the opponent's evidence, leading to an unnecessary hearing; (iv) alleging that the opponent had fabricated evidence. The opponent also seeks its costs for preparing written submissions on costs. In total, it seeks an uplift of £5,826 in addition to its scale costs. The applicant filed written submissions in response to the opponent's request, which I keep in mind.”

She acceded to the request on the basis of the opponent's submissions in relation to points (i) and (iii) but rejected it as to the remainder of the request.

She addressed point (i) in paragraphs [142] to [147] of her decision. It is sufficient for present purposes to set out what she said in paragraphs [146] and [147].

“[146] Having reviewed the files, it is clear that the opening stages of these proceedings were marred by failures by the applicant (and, it must be said, the tribunal). Letters issued by the tribunal all contain the instruction, ‘if you wish to correspond by email please reply to tribunalsection@ipo.gov.uk and ensure your email is copied to the other party’. I can understand that unrepresented litigants not initiated in tribunal proceedings may not realise why it is important to copy correspondence of all types or fully appreciate the consequences of failing to do so, which are only spelled out in the practice manual and TPNs with which they may not be familiar, but the direction itself is very clear. Further, once it has been made clear to parties that any correspondence must be copied, the position is starker. I note here that my letter to the parties following the CMC on 2 February 2021

warned that a failure to copy correspondence may be treated as unreasonable behaviour and have implications for costs.

“[147] I accept that the applicant made an effort to copy most of its correspondence after the first CMC. Some of the correspondence which was not copied is extremely trivial, such as the emails chasing a response and asking whether deadlines expired at 5 p.m. or a different time. So inconsequential are these enquiries that, had they been made by telephone, I doubt that any record would exist on the official files. The more important breaches are the failure to copy the TM9R and the costs pro forma. The applicant’s position that the opponent was unreasonable to ask for a copy of the costs pro forma after 5 p.m. is untenable: The opponent should have been copied at the time of filing. It was also plainly unreasonable of the applicant to ignore directions to copy its emails of 2 February 2021. Although not all of the correspondence which was not copied was critical to proceedings, the applicant’s failure to send it to the opponent has undoubtedly caused the opponent extra work in reviewing its files, chasing correspondence and advising the tribunal that it has not had sight of documents. The opponent’s schedule indicates that £2,260 was incurred as a result of the ‘persistent failure to copy and late filed defences leading to additional costs and issues with consolidation, including an unnecessary hearing’; it does not specify exactly how much time/money was expended as a direct result of the failure to copy correspondence. I consider a sum of £1,000 is appropriate.”

She dealt with point (iii) in paragraphs [150] and [151] in the following terms:

“[150] The next part of the opponent’s request concerns the CMC held on 17 June 2017. The facts are as follows. On 23 April 2021, the opponent requested permission to file more than the 300 pages of evidence usually permitted. On 27 April 2021, a preliminary view was issued refusing the opponent’s request. On 10 May 2021, the opponent filed 380 pages of evidence and filed a revised request for permission to exceed 300 pages. A preliminary view issued on 12 May 2021 allowed the request and set a deadline of 19 May 2021 for either side to request a hearing, with a CMC provisionally booked for 4 June 2021. On 21 May 2021, the applicant wrote to the tribunal. Initially, the applicant was told that it had responded out of time and, as it had not requested a hearing, the tribunal intended to proceed on the basis that there was no formal objection to the preliminary view. When it became apparent that the applicant did wish to object to the preliminary view, I appointed a CMC for 17 June (the provisional CMC had already been vacated). Briefly, at the CMC the applicant did not attempt to argue that I should use my discretion to allow its objection to the preliminary view out of time. The sole basis of its submissions was that it had objected in time, by email on 18 May 2021. I had not seen any such email, nor had the opponent’s representative. I reserved my decision and allowed the applicant time

to file a copy of that email. An email from the hearings clerk immediately after the CMC asked the applicant to file the email by 5 p.m. that day and warned that, if it did not do so, I would make a decision based on the papers on file. No communication of any kind was received from the applicant. I issued my decision accordingly, which concluded that the email said to have been sent on 18 May 2021 did not exist. This prompted a complaint from the applicant that it had not been advised that there would be a short deadline for providing the email and a response from the tribunal that I had no power to revisit the decision I had made.

[151] My view is that the applicant's behaviour regarding this CMC was unreasonable. It chose to rely on the alleged filing of an objection on time but was unable to provide any substantiation for that claim. Had an email been sent on 18 May 2021, it would have been a simple matter to provide it. Instead, I was compelled to conclude that the applicant had misled the tribunal as to the email's existence. That was not necessarily a deliberate act but it is not appropriate for a party to require a CMC to be appointed, causing the other party to incur costs, and attempt to rely upon evidence which it is not itself sure exists. Even if it is true that the email was sent by the "operations team" and was more difficult to access, the applicant was on notice from 2 June 2021 that the tribunal had not received that email. Any reasonable party would have taken steps to provide a copy of such correspondence at the earliest opportunity. At the very least, it would have explained at the CMC or in response to the hearings clerk's email that it had already or might have difficulty retrieving the message. The opponent says that it spent 3.7 hours preparing for and attending the hearing at a cost of £1,009. I think this excessive, when the opponent was essentially a passenger in the tribunal's dispute with the applicant about whether an objection was filed in time and when a request for an extension (in the event not made) is a very straightforward issue. I accept that the issue of its own evidence may have arisen but the opponent should have been familiar with the reasons why it needed to exceed the limit, having already made two requests in writing, and should not have needed a great deal of time to prepare. I think two hours in total is more appropriate and award £545."

In paragraph [156] she ordered the applicant to pay a total of £4,425 to the opponent calculated on the basis stated in paragraph [155].

"[155] In making an award, I will bear in mind that the notices of opposition and counterstatements were in large part duplicative. I also reduce the scale award by 10% because the oppositions have only partially succeeded. I award costs as follows:

Official fees (£200 x 3): £600

Filing the notices of opposition and considering the counterstatements:
£800

Preparing evidence and considering the other party's evidence: £800
Preparing for and attending the hearing: £800
Preparation of written submission on costs: £200
Less 10%: £320
Sub-total: £2,880
Off-scale award: £1,545
Total: £4,425"

The applicant now appeals against the Hearing Officer's off-scale award of £1,545.

In its form TM55P Notice and Grounds of Appeal dated 28 April 2022, it simply stated: "We would like to appeal the costs awarded to the opposition. Please see the attached document."

The attached document was to all intents and purposes the same document containing essentially the same submissions as the applicant had previously put forward in the Registry proceedings on 22 February 2022 for consideration in response to the opponent's submissions on costs dated 9 February 2021.

In effect, the applicant was inviting this Tribunal to proceed afresh, as if the Hearing Officer's decision to award £1,545 by way of off-scale costs had not been made.

However, the question for determination by this Tribunal on appeal is whether it was open to the Hearing Officer, on the evidence and materials before her, to come to the conclusions she did for the reasons she gave. If so, her decision must stand.

The Hearing Officer was entitled to proceed on the basis that the Registry's published scale figures for costs are norms to be applied or departed from, with greater or lesser willingness according to the nature and circumstances of the case; they do not have the force of statute and they do not limit (on the contrary they are subject to) the exercise of judgment and discretion which the decision-taker should bring to bear in relation to the case at hand when giving effect to the legislative provisions of section 68(1) of the Trade Marks Act 1994 and Rule 67 of the Trade Mark Rules 2008: see **AMARO GAYO COFFEE Trade Mark** BL O/257/18 (25 April 2018) at paragraphs [12] to [14].

The Hearing Officer was also entitled to proceed on the basis that litigants in adversarial proceedings in the Trade Marks Registry are required to include the opposite party in communications they send to the Registry and must expect the Registrar to treat failure to comply with that important duty as a matter which is apt to be reflected in a compensating award of costs for non-compliance: see **SOUTHERLY Trade Mark** BL O/207/22 (10 March 2022) at paragraphs [27] to [30].

The duty is not difficult to comply with. It is equally applicable to litigants who are and litigants who are not professionally represented.

The Hearing Officer did not err in approaching the question of costs in the way that she did. It is apparent from her decision that she was both careful and fair in her examination and assessment of the matters that she needed to take into account. The applicant was not able to demonstrate at the hearing before me that the decision under appeal was vitiated by any error of principle or error of assessment.

For the reasons I have given, I dismiss this appeal.

Appeal dismissed.

Appellant ordered to pay £750. to the Respondent in respect of its costs of the Appeal.

That sum is to be paid within 21 days of 7 June 2022.

It is payable in addition to the sum of £4,425. awarded by the Hearing Officer in respect of the proceedings in the Trade Marks Registry.