

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3611893
BY YES SOCIETY LIMITED
TO REGISTER A SERIES OF FOUR TRADE MARKS



IN CLASS 41
AND
OPPOSITION THERETO
UNDER NO. 425456
BY THE VETERANS' FOUNDATION

Background and pleadings

1. On 25 August 2022, I issued a decision where I refused the application to register the trade marks shown on the cover page of this decision. In relation to costs, I stated:

“60. At the hearing, Ms McGrath requested that the opponent be granted permission to make cost submissions after a substantive decision has been issued. Accordingly, I direct that the opponent file written submissions on costs within 14 days of the date of this decision. I will then assess the costs I consider to be reasonable and issue a supplementary costs decision. Once the costs have been decided, I will set an appeal deadline.”

2. On 7 September 2022, the opponent filed written submissions; the relevant paragraph is reproduced below:

“6. It is submitted that the Applicant’s case was self-evidently without merit from the outset and that the Applicant was provided with ample opportunity to withdraw the application before the evidence rounds (and before the parties incurred significant costs). It is submitted that the application was improperly brought and prosecuted; under the circumstances the Applicant’s conduct has been unreasonable and as a result the opponent respectfully requests off-scale costs.

7. If the Hearing Officer does not agree that the off the scale costs should be awarded, we respectfully request that the circumstances justify the maximum scale costs of £2850. The opponent’s actual costs exceeded this amount.”

Decision

3. Off-scale costs are usually awarded when a party has behaved unreasonably, employed delaying tactics or otherwise breached the rules.¹ I do not consider that refusing to withdraw an application early in a proceeding would constitute unreasonable behaviour to warrant off-scale costs. As nothing in the opponent's submission suggests that the applicant was engaged in any such behaviour or breached any rules, I dismiss the opponent's request for off-scale costs.
4. As the opponent has been successful, it is entitled to a contribution towards its costs as per Tribunal Practice Notice ("TPN") 2/2016. I acknowledge the opponent's submissions that their costs exceeded the maximum scale costs of £2850; however, costs are contributory, not compensatory. Considering the extent of evidence filed and also bearing in mind that the hearing, attended only by the opponent, was not particularly lengthy, I do not consider that the requested costs of £2850 is justified, in the circumstances of this case. I award costs to the opponent on the following basis:

Filing a notice of opposition and considering the applicant's counterstatement	£400
Filing evidence	£700
Preparing for and attending hearing:	£600
Official fee:	£200
Total:	£1900

5. I order YES Society Limited to pay The Veterans' Foundation the sum of £1,900. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal is unsuccessful.

¹TPN4/2007

Appeal Period

6. The appeal period in relation to this decision on costs and the substantive decision issued on 25 August 2022 begins from the date of this supplementary decision.

Dated this 30th day of September 2022

Karol Thomas

For the Registrar

The Comptroller-General