

o/933/22

**TRADE MARKS ACT 1994**

**IN THE MATTER OF UK Trade Mark Application No UK00003415984**

**by Alexander Ross Holdings Limited**

**TRUE TO NATURE Series of Marks in Class 3**

**-and-**

**Opposition No OP000423051 by The Burt's Bees Products Company**

**IN THE MATTER OF UK Trade Mark Application Number UK00003550315**

**by Alexander Ross Holdings Limited**

**SCOTTISH FINE SOAPS TRUE TO NATURE Series of Marks in Class 3**

**-and-**

**Opposition Number OP000425014 thereto by The Burt's Bees Products Company**

**IN THE MATTER OF UK Trade Mark Application No UK00003470610**

**by The Burt's Bees Products Company**

**TRUE TO NATURE in Classes 3 35**

**-and-**

**Opposition No OP000423310 thereto by Alexander Ross Holdings Limited**

**AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF**

**Mr JOHN WILLIAMS DATED 20 JULY 2022**

**DECISION ON COSTS**

1. In these consolidated proceedings, the Hearing Officer for the Registrar found in favour of Alexander Ross Holdings Limited (“ARH”). In particular, he rejected an opposition by The Burt's Bees Products Company (“BB”) in the “Lead Case” in which BB opposed registration of ARH’s “True to Nature” mark. He ordered BB to pay Alexander Ross Holdings Limited £850 in relation to the costs of the proceedings.

2. BB lodged an appeal on 17 August 2022, filing Grounds of Appeal comprising 9 pages long and including 5 separate grounds of appeal. ARH filed a 6 page Respondent's Notice dated 14 September 2022, making submissions on each of the Grounds of Appeal, but

not (it seems to me) suggesting that the decision should be upheld on any additional basis, in accordance with Rule 71(5).

3. The appeal was set down for a hearing on 20 October 2022, but on 6 October, BB's representatives wrote to withdraw the appeal.
4. ARH then sought its costs of the dealing with the appeal. It submitted at first that the BB's conduct should be taken into account when awarding costs, "including withdrawing the Appeal merely 7 working days before Skeleton Arguments for the Hearing were due." In a later communication, they stated "As Counsel was not appointed for commercial reasons, the legal costs incurred in terms of time in reviewing papers and discussing arguments, including filing a Respondent's Notice, are of the order of £890. The overall cost and toll of proceedings on the Respondent are much greater, but harder to quantify."
5. BB's response to the request for costs was to submit that this appeared to be a request for costs off the scale, but there was no basis for such an award. It submitted that any costs should be awarded bearing in mind the scale costs of TPN 2/2106.
6. As Mr Hobbs QC said in *Amaro O/257/18*

"13. The long established practice in Registry proceedings is to require payment of a contribution to the costs of a successful party, with the amount of the contribution being determined by reference to published scale figures. The scale figures are treated as norms to be applied or departed from with greater or lesser willingness according to the nature and circumstances of the case.

14. The provisions of Rule 67 ... apply via Rule 73(4) 'to the person appointed and to proceedings before the person appointed as they apply to the registrar and to proceedings before the registrar.' The Appointed Persons usually follow the approach indicated in paragraph 13 above when considering what it would be 'reasonable' to award by way of costs in relation to the appeals which come before them under s.76 of the Act. It is necessary to emphasise in that connection that the scale figures published by the Registry do not have the force of statute. 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 applicable statutory provisions.

...

17. ... an award of costs is required to reflect the effort and expenditure to which it relates without inflation for the purpose of imposing a financial penalty by way of punishment on the paying party. The determination of a 'reasonable' amount to award must depend on the nature and circumstances of the case at hand."

7. ARH has not, in my view, provided any reason why it should be awarded costs off the usual scale. Nor has it provided any itemisation of the sum of £890. Nevertheless, it appears to me that ARH has plainly incurred costs in dealing with BB's appeal, and in responding to it. I consider that it should be awarded its costs, by reference to the usual scale.
8. Doing the best I can on the limited material before me, and taking into account the scope of the matters raised on the appeal, I assess those costs at £500. I will order BB to pay that sum to ARH, together with the costs awarded by the Hearing Officer.

Amanda Michaels  
The Appointed Person  
25 October 2022