

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION Nos 12242 and 12243 by Keith Hill for the Invalidation of Trade mark Registration Nos 2128646A & 2128638A in the name of Golden Rose Communications Plc

Decision on Costs

1. Following the registered proprietor's failure to file a counterstatement in response to Mr K Hill's applications to invalidate the trade marks registered under numbers 2128646A and 2128638A, those applications were determined in Mr Hill's favour.
2. The Registrar subsequently wrote to the parties on 2 August 2001 advising that her preliminary view was that Mr Hill was entitled in each case to an award of £600 as a contribution towards his costs.
3. That view was reached despite an assertion in a letter dated 13 June 2001 from Mr T G Pendered of R. G. C. Jenkins, Trade Mark Attorneys for the registered proprietor, to the effect that the invalidation action had been launched without prior notice to his firm or to his clients.
4. Mr Hill responded to the Registrar's letter on 6 August requesting an award of costs off the Registrar's usual scale on the grounds that the registered proprietor had acted unreasonably since August 1997.
5. Mr Pendered responded to the Registrar's letter on 9 August repeating that neither R.G.C Jenkins, the registered proprietor's solicitors (Simmons & Simmons) nor "as far as we (R.G.C. Jenkins) had been able to determine, the proprietor themselves" had received any advance warning of Mr Hill's intention to commence these proceedings. On this footing, Mr Pendered submitted that Mr Hill should lose any right to an award of costs.
6. An interlocutory hearing was scheduled for 5 September to resolve the matter. R.G.C. Jenkins indicated from the outset that the registered proprietor did not intend to be represented at the hearing.
7. Mr Hill did attend the hearing and provided me with a skeleton argument and statement of case setting out his position in some detail.
8. Having heard Mr Hill's submissions and considered the written submissions of R.G.C.Jenkins on behalf of the registered proprietor, I determined that the original award of costs should stand and that Mr Hill was entitled to an additional award of costs of £300 in recognition of the time and inconvenience he had been put to in order to rebut the assertion that he had launched the proceedings without prior notice to the other side.
9. My reasons for refusing to increase the proposed award of £600 towards Mr Hill's costs in each of the invalidation actions are that:
 - i) Mr Hill's allegation of unreasonable behaviour appeared to me to relate largely to actions of the registered proprietor outwith these proceedings - indeed, having failed

to file a defence in either case, the registered proprietor took no effective part in the substantive invalidation proceedings;

ii) the proposed award of costs is based upon the Registrar's (recently revised) scale of costs which is not meant to fully compensate parties to proceedings although, in this case, appears to me to cover the full reasonable costs of filing the applications for invalidation.

10. My reasons for refusing the registered proprietor's request to withhold costs from the applicant are that:

i) The registered proprietor's sole objection to the proposed award of costs is that no notice was given prior to the commencement of the action;

ii) Although Tribunal Practice Notice 2/2000 indicates that costs may be affected if a losing party unreasonably rejects efforts to resolve a dispute before an action was launched, and although it is good practice for parties contemplating invalidation action to make efforts to settle before resorting to legal action, there is no practice that costs should be withheld from a successful party on the grounds that the action was launched without notice - costs normally follow the event;

iii) In any case, Mr Hill has produced a copy of a letter dated 2 October 2000 (the proceedings commenced in January 2001) from himself to the registered proprietor (marked for the attention of its Chief Executive, a Richard Wheatly) giving notice of his intention to start invalidation proceedings in the absence of a settlement;

iv) All that has been put up in response to this is the letter from R.G.C.Jenkins submitting in equivocal terms that "*so far as we have been able to determine*" the registered proprietor received no advance notice;

v) Prior to the hearing, Mr Hill produced copy of an itemised telephone bill showing that a call was made on 3 October 2000 from Mr Hill's number to a number that appears to be the registered proprietor's fax number - Mr Hill explained to me that the difference in the dates is attributable to the fact that he faxed the letter dated 2 October 2000 after midnight;

vi) The registered proprietor's representatives were sent copies of these documents before the hearing but made no further comment.

11. My reasons for awarding Mr Hill a further £300 in costs are that:

i) Mr Hill had to undertake further work and attend a hearing in order to rebut submissions made on behalf of the registered proprietor, which have not been substantiated;

ii) I consider £300 to be a suitable contribution towards the costs that Mr Hill reasonably incurred, including preparing several letters to the Registrar about the truth of the registered proprietor's complaint, the costs of producing a telephone record and the cost of attending the hearing;

iii) Mr Hill's produced a skeleton argument and statement of case that raised a significant number of other arguments, including contravention of articles 4, 8, 10 & 14 of the European Convention of Human Rights, which when properly analysed relate to a) the actions of the registered proprietor in making the applications for registration, b) other matters in dispute between the parties and, c) the inconvenience that Mr Hill has faced in putting the record straight with regard to the "no notice before proceedings" point;

iv) I consider that the additional costs I have awarded are sufficient to address point "c". I do not consider that it is appropriate to take points "a" or "b" into account.

12. Although Mr Hill's skeleton argument might be read otherwise, he confirmed to me at the hearing that he was not seeking an award of costs against anyone other than the registered proprietor.

13. I therefore confirm the Registrar's preliminary decision and order the registered proprietor to pay Mr Hill the sum of £1200 in respect of the successful applications for invalidation, and a further £300 in respect of the subsequent hearing on costs, making £1500 in total. This sum to be paid within seven days of the end of the period allowed for appeal.

Dated this 18 Day of September 2001

**Allan James
For the Registrar
The Comptroller General**

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by Keith Hill for the Invalidation of Trade Mark Registration Nos
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SUPPLEMENTARY DECISION

1. In a written decision by Mr Allan James on costs in these proceedings, dated 18 September 2001, Mr James ordered the registered proprietors to pay the applicant, Mr Keith Hill, a total sum of £1500 costs. The registered proprietor's name as detailed on the register stands as Golden Rose Communications Plc.
2. Following the issuance of that earlier decision, Mr Hill asserted in writing that the registered proprietor's name had changed from that detailed on the register. Documentary evidence was filed to support this assertion. The documents provided by Mr Hill demonstrate that the name of the registered proprietor changed on 12 December 1999 to Jazz FM Plc.
3. The above information was brought to the attention of the registered proprietors through their appointed trade mark attorneys RGC Jenkins & Co. An opportunity was provided for comment, no comments or observations were received. Consequently Mr Hill's assertions have not been challenged by the registered proprietors.
4. This supplementary decision is to confirm that the costs ordered in these proceedings by Mr James for the sum of £1500 is against the registered proprietors:

Golden Rose Communications Plc now known as Jazz FM Plc

5. This supplementary decision does not effect the timing of the payment of the costs which remains as detailed in the decision of Mr James dated 18 September 2001.

Dated this 22 Day of October 2001

**Oliver J Morris
For the Registrar
The Comptroller General**