

**BLO/0422/25**

**IN THE MATTER OF APPLICATION NO. 3997868**

**IN THE NAME OF**

**AARON DAVIES**

**FOR THE FOLLOWING TRADE MARK IN CLASSES 9, 16, 25, 28, 35 AND 41**

**INFAMOUS BY B. MALONE**

**AND OPPOSITION THERETO 447350**

**BY**

**NATHAN ORR**

## BACKGROUND AND PLEADINGS

1. On 3 January 2024, Arron Davies (“the applicant”) applied to register the trade mark on the cover page of this decision. On 7 May 2024 (“the opponent”) opposed the application under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) relying on its earlier trade mark INFAMOUS, being registered under number 3804877 with filing and registration dates of 30 June 2022 and 14 October 2022, respectively.

2. The applicant was represented by Brabners LLP, and the opponent represented himself.

3. On the 20 March 2024, a TM7a (Notice of intended opposition) was filed by the opponent; the TM7 (Notice of opposition and statement of grounds) was filed 7 May 2024. On 12 August 2024, a TM9C was filed by the applicant. The applicant notified the registry by way of email, dated 10 December 2024, that they wished to withdraw their application. The opposition proceedings were subsequently concluded, and the opponent made a request for an award of costs in his favour.

4. The Opponent was invited to complete a pro forma providing an accurate estimate of the number of hours spent on a range of given activities relating to the prosecution of the proceedings. The opponent filed a claim totalling the official fee of £200, £240 for a solicitor’s advice and 141 hours. Subsequently, this figure was assessed by the Registry and a preliminary view was issued by way of letter dated 17 March 2025 reducing those costs to a total of £176 (inclusive of the official fee). The claim for costs for an unrepresented party was in accordance with The Litigants in Person (Costs and Expenses) Act 1975 which sets payment at a rate of £19.00 per hour. The opponent challenged the preliminary view – on the basis that the costs had been excessively reduced in light of the work undertaken. The applicant submitted that the opponent’s costs request had not been *“appropriately particularised or justified and should be limited to the £200 Official Fee for the TM7”*.<sup>1</sup>

5. The opponent requested that the matter be listed for a hearing. The hearing took place before me via telephone conference on 15 April 2024. Mr Orr was in

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<sup>1</sup> Applicant’s costs comments dated 11 March 2025

attendance. Brabners LLP contacted the Tribunal stating that they would not be attending the hearing; the applicant provided submissions in lieu of attendance.

6. This decision is to determine whether and to what extent a cost award should be granted, having regard to all the submissions and correspondence filed by the parties, to the relevant sections of the Act and the relevant Tribunal Practice Notices (“TPN”). The costs assessment must be approached on what is proportionate and reasonable in all the circumstances taking into account the underlying principles that any award of costs is not to represent a full cost recovery but rather a realistic contribution.

### The costs proforma

7. Below is a copy of the opponent’s cost proforma filed, detailing descriptions of activity undertaken, and the time spent completing each activity. As mentioned previously, the applicant did not attend the hearing but provided submissions in lieu, they are in response to this costs proforma, and the detailed schedule of activities created. Therefore, for ease of reference, I have attached a copy of the schedule, to easily contextualise the applicant’s submissions.

NOO, NOC, Notice of Opposition/ Notice of Cancellation/ NoT	TYPE OF EVIDENCE	BRIEF DESCRIPTION OF ACTIVITY	TIME SPENT IN HOURS / MINS	FEES OCCURRED	
NOO	Notice of opposition Email	Email from AD	Preparing evidence once notification from Aaron Davies	3 hours	
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	3 hours	
NOO	Telephone Call	Telephone call to trademark team	Initial advice from Trademark team as to the procedure to follow and research and	3 hours	
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	2 hours	
NOO	Telephone Call	Telephone calls to solicitors	Further advice regarding procedure and next steps to numerous solicitors including	14 hours	
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	2 hours	
NOO	Email	Email submission of TM7	First attempt at filing the TM7	4 hours	
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	2 hours	
NOO	Telephone Call	Telephone call to trademark team	Advice on whether it was completed correctly and what fee to pay and then recom	2 hours	
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	2 hours	
NOO	Telephone Call	Telephone call to solicitors	Updated solicitor and asked for advice re fees to represent - told to file TM7 and get	30 mins	
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	2 hours	
NOO	Email	Email from Trademark asking to	Preparing evidence and resubmission	4 hours	
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	2 hours	
NOO	Telephone Call	Telephone call to trademark team	Further advice from Trademark team as to the procedure to follow	1 hour 30 mins	
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	2 hours	
NOO	Research	Research into Aaron Davies	Research into Aaron Davies brand infamous and noted that he is using the brand ar	8 hours	
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	2 hours	
NOO	Fee for trademark	Fee for TM7 - £200		30 mins	£200
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	2 hours	
NOO	Telephone call	Telephone call to solicitor for ad	Telephone call to solicitor (McDaniels Law) for advice and payment £240	2 hours	£240
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	2 hours	
NOO	Email	Email from AD solicitor		1 hour	
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	2 hours	
NOO	Email	Email response to AD solicitor		3 hours	
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	4 hours	£220
NOO	Government Website	Preparation of this document to support application for fees for TM7		2 hours	
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	2 hours	
NOO	Government website	Applied to Trademark team for further trademark for aftershave and accessories		2 hours	
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	2 hours	
NOO	Email with offer from AD Solicitor	Email with offer of 2k and rese	Email with offer of 2k and research and repl, including talks with solicitor and email	6 hours	
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	4 hours	
NOO	Email to reject offer	Email to reject offer		30 mins	
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	2 hours	
NOO	Email to advise you would be open to a cooling off	Cooling off period research and emails - Email to advise you would be open to a cooling off period		4 hours	
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	2 hours	
NOO	Email from myself to advise I was ok with a cooling	Email from myself to advise I was ok with a cooling off period		30 mins	
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	2 hours	
NOO	Email to advise they had not continued with the of	Email to advise they had not continued with the offer, talks with solicitors and trademark team and research		4 hours	
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	2 hours 30 mins	
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	2 hours	
NOO	Preparation of this document to support applica	Preparation of this document to support application for TM9C and research and advice from solicitors ,emails , tele		6 hours	
NOO	Research and fact finding	Research and fact finding	Preparing evidence once notification from Aaron Davies	3 hours	
NOO	Research into Infringement	<a href="https://www.justice.gov.uk/courts/procedure-rules/civil/rules/part63">https://www.justice.gov.uk/courts/procedure-rules/civil/rules/part63</a>		17 hours	
All time has been added together with Notice of Opposition and considering forms from other party					
OFFICIAL FEES		TOTALS	141 hours, however I think I have spent much more time on this, it has impacted		
Email evidence and correspondence to my solicitor showing process and pathways completed					

### The parties’ submissions

8. The applicant's submissions can be summarised as follows:
- The applicant notes the opponent has filed a costs pro forma referencing £200 for the TM7, £240 for solicitor's fees, over 48 hours "*preparing evidence/written submissions and considering and commenting on the other sides evidence/written submissions*" and over 40 hours for "*other expenses*". The time claimed in respect of all matters totalling over 141 hours.
  - The opponent's costs should be awarded on the standard scale of costs as set out in the TPN; the most the parties should be entitled to is between £200 and £750 for costs for "*preparing a statement and considering the other sides statement*".
  - Costs awards by the IPO are contributory not compensatory.
  - Any costs awarded should be towards the lower end of the £250-£750 scale to account for the fact the opponent has only prepared its TM7 and statement of grounds and did not incur any costs or time in reviewing the applicant's TM8 or counterstatement.
  - After the TM7 was filed a brief settlement discussion took place between the parties, the applicant withdrew its application before the end of the cooling off period. No TM8 or counterstatement was filed by the opponent.
  - There was no requirement to prepare evidence or consider evidence; therefore, no costs should be awarded for anything related to evidence. Entries into the cost pro forma/spreadsheet relating to evidence of written submissions should therefore be disregarded.
  - The official fee for the TM7 are the only expenses the opponent has created; no expenses, travel or accommodation for witnesses to attend the hearing for cross-examination have been created. Any entry relating to other expenses should be disregarded.

- There is no basis to award off scale costs.
- The opponent had to refile its TM7 multiple times due to deficiencies before it was accepted by the UKIPO. The applicant should not be responsible for any time or costs incurred by the opponent to rectify its own deficiencies.
- That they consider the time spent indicated by the opponent to be inaccurate, inflated and not recoverable. By way of example only, they note:
  - entries totalling over 50 hours refer to “*research on fact-finding*” and “*preparing evidence once notification from Aaron Davies*” without any particular realisation or justification.
  - 14 hours contacting many solicitors of which none were engaged or instructed by the opponent to represent it in this matter. This time should not be recoverable in any event, as it indicates significant unnecessary duplication of time.
  - Two hours for a new trade mark application. This is relevant to the opposition.
  - Six hours preparing form TM9C. This document was prepared by the applicant’s representative on behalf of the applicant not the opponent.
  - 17 hours spent researching into infringement and part 36 of the Civil Procedure Rules. This is irrelevant to the opposition.
  - Reference is made to the notice of opposition, notice of cancellation, notice of defence and evidence. However, the only document filed in this matter is the TM7; there is no cancellation action, no defence counterstatement and no evidence.
  - 15 hours refer to the notice of cancellation defence. However, there was no cancellation action, and no defence filed in relation to this opposition.

- The time spent is entirely disproportionate to the matter.
- The opponent claims £240 for solicitor's fees (which are stated to be the actual fees paid). As indicated above, costs award at the IPO can be contributory not compensatory and the opponent is not entitled to the recovery of all its time. In any event, the opponent was unrepresented, accordingly, and in line with IPO guidance, any costs the opponent is awarded should be further reduced on the basis the opponent was unrepresented. If the scale of costs were applied to unrepresented parties, they might receive costs in excess of what they may reasonably have incurred, which would undermine the contributory rather than compensatory approach and the indemnity principle.

9. At the hearing, the opponent submitted that he was not satisfied with the costs that had been awarded to him. The opponent was of the view that the costs awarded should be higher to reflect the considerable time and effort he expended in these proceedings.

### **Hearing**

10. Only the opponent attended the hearing, he represented himself. The applicant chose not to attend and made the submissions above.

11. In relation to any costs award, I explained that costs are awarded on a contributory rather than compensatory basis and that consequently parties are awarded a contribution towards their overall costs rather than an amount that would cover them entirely. I also set out the amount that litigants representing themselves were entitled to, i.e. £19 per hour for reasonable time incurred on activities for which costs are recoverable. Further, I explained to the applicant that costs would not be recoverable in respect of some of the activities expressed on the cost proforma, and outlined the activities that were recoverable.

### **The legislative provisions and guidance**

12. 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.”

13. In addition, The Litigants in Person (Costs and Expenses) Act 1975 sets out the hourly rate upon which unrepresented parties may claim and TPN 2/2023 sets out the headings of the activities upon which any contribution of costs is to be assessed. TPN 2/2000 enables the Hearing Officer to award actual costs when circumstances warrant it.

14. The Trade Marks Manual provides guidance in relation to unrepresented parties that appear before the Tribunal. In particular section 5.2 of the manual reads as follows:

#### **“5.2 Unrepresented parties**

Unrepresented parties generally incur lower costs because they do not have to pay legal or other professional fees. If the scale of costs were applied to unrepresented parties, they might receive costs in excess of what they may reasonably have incurred, which would undermine the contribution-notcompensation approach and the indemnity principle. Therefore, unless a Hearing Officer directs otherwise, unrepresented parties will be sent a proforma at the end of proceedings inviting them to set out the number of hours spent on the various steps of the proceedings.

If an award is to be made in favour of an unrepresented party, Hearing Officers will consider the information provided when determining the sum to be awarded. The number of hours claimed will not, however, be binding on Hearing Officers, who will continue to assess whether the time spent was reasonable in the circumstances of the case and who will retain a residual discretion in any event.

The sum to be awarded per hour will be analogous to that set out in the Civil Procedure Rules, Part 46, which is currently £19 per hour. The total amount awarded should, though, not exceed the maximum amount payable on the scale of costs (unless off-scale costs are sought). If the unrepresented party does not complete and return the proforma, no costs award will be made save in relation to official fees (except fees for extensions of time).”

15. As these proceedings were commenced after 1 February 2023, any costs award made is to be on the basis of the scale set out in TPN 1/2023. As mentioned to the opponent at the hearing, TPN 1/2023, at Annex A, sets out the scale of costs applicable for tasks that are recoverable for legal representatives. It should be observed that whilst this is aimed at amounts for legal representatives, the amount awarded to a litigant in person should not usually exceed that of the scale set out below:

## **Annex A**

### **Scale of costs in proceedings commenced on or after 1 February 2023**

<b>Task</b>	<b>Costs</b>
Preparing a statement and considering the other side’s statement	From £250 to £750 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 £600 if the evidence is light to £2600 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 (including procedural hearings) or submissions-in-lieu Up to £1900 per day of hearing, capped at £3900 for the full hearing unless one side has behaved unreasonably. From £350 to £650 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.

16. This decision effectively acts as a reconsideration of the costs assessment taking into account the written submissions included in the correspondence and the oral submissions at the hearing. Since the focus of the applicant's submissions is that the opponent is not entitled to a costs award, beyond the official fee of £200, on the basis of the matters outlined above, I will address the issues raised in turn.

#### *Filing form TM7*

17. I accept that the opponent, as a litigant in person, has spent time familiarising himself with the relevant law and issues of the case prior to filing his TM7. Further, I understand that unrepresented parties will take longer to prepare and consider documentation than a solicitor or trade mark attorney. That being said, I note that the opponent has claimed 14 hours for "*initial advice from trade mark team as to the procedure to follow and research and*", "*first attempt at filing the TM7*", "*advice on whether it was completed correctly and then*", "*research into preparing evidence and resubmissions*" ( I intend to address the resubmission's discussion here and the point of evidence in the paragraph below) and "*further advice from trade mark team as to the procedure to follow*". Further, I note that the opponent has claimed for the time spent emailing the applicant's solicitor.

18. I accept that the nature of the notice of opposition may be slightly more complex by virtue of the opponent relying on both sections 5(2)(b) and 5(3) grounds.

I note that the opponent had to refile its TM7 multiple times due to deficiencies before it was accepted by the UKIPO and has attempted to claim for the time spent preparing and resubmitting. Whilst it is reasonable to claim for the time spent filing the TM7 on the first occasion, the applicant should not be responsible for any time or costs incurred by the opponent to rectify its own deficiencies in the repeated filings of its TM7. Therefore, I have taken into consideration all of the various factors and consider that the award of 4 hours to be a reasonable and proportionate contributory (rather than compensatory) amount of time to be awarded to Mr Orr for this activity.

### *Lawyers*

19. The opponent has been representing himself throughout the course of the proceedings, as an unrepresented litigant. However, the opponent contacted the Tribunal to state that throughout the proceedings he had a legal representative and should be awarded costs to that effect. In response, a Form TM33P was provided by the Tribunal for the legal representative to complete to be recorded on file as the opponent's legal representative. Mr Orr stated at the hearing that the legal representative did not wish to complete the form to officially be reflected on file as the opponent's legal representative. Therefore, the opponent is recorded as an unrepresented party and will be treated as such. Whilst the opponent explained that there was some input from a solicitor in the form of advice from a legal representative; where litigants choose to represent themselves, they are not entitled to the costs incurred for seeking legal advice. Consequently, the opponent is unable to seek reimbursement for the calls made to solicitors for legal advice and no award can be made in respect of this head of costs.

20. In addition, I note that the opponent has claimed 15.5 hours for telephone calls to solicitors which is described as "*further advice regarding procedure and next steps to numerous solicitors including*" and "*updated solicitor and asked for advice re-fees to represent*". As indicated by the fact that the opponent remains an unrepresented party, and as clarified by the opponent at the hearing, the opponent did not engage any of the solicitors contacted to officially represent him in these proceedings. Further, as mentioned above, as an unrepresented party the opponent is unable to seek reimbursement the calls made to solicitors for legal advice. Therefore, no award can be made in respect of this head of costs.

### *Filing a new trade mark*

21. The cost pro forma outlines that the opponent has claimed 2 hours for *“the applied to trade mark team for further trade mark for aftershave and accessories”*. As discussed with the opponent at the hearing, it is inappropriate for the opponent to claim costs for an activity that he conducted to his benefit outside of the current opposition. Therefore, the opponent will not be reimbursed for this time.

### *Preparing evidence and considering the other side’s evidence*

22. As previously mentioned, the proceedings had progressed to the point where a TM7 was filed by the opponent, a TM9C was filed by the applicant, the parties entered into brief settlement negotiations and then the applicant withdrew the proceedings. In the costs pro forma, the opponent has claimed over 57.5 hours for *“preparing evidence once negotiation from Aaron Davies”* and *“research into preparing evidence and resubmissions”* (I intend to address the point of evidence here and the resubmissions were discussed above). As discussed with Mr Orr at the hearing, the proceedings did not reach the evidence rounds, therefore, there was no requirement to consider the other side’s evidence because they did not file evidence of which to consider. Continuing that same line, as the evidence rounds had not been reached, there was no requirement for Mr Orr to have prepared evidence. Therefore, the opponent will not be awarded costs for these activities.

### *Research*

23. In the opponent’s costs pro forma, the opponent claims 25 hours for *“research into Aaron Davies brand infamous and noted that he is using the brand”* and *“research into infringement”*. Turning to the research into infringement first, as mentioned to the opponent at the hearing, infringement is not a matter that is dealt with at the UKIPO, rather it is a ground that is raised at the courts. Since the proceedings make no mention of infringement, any time spent researching into infringement is not time that can be reimbursed. Secondly in relation to *“research into Aaron Davies brand infamous and noted that he is using the brand”*, this is not relevant in relation to the

filing of the TM7 in these proceedings. Therefore, the opponent will not be remunerated for this time spent.

#### *Settlement negotiations*

24. The opponent claimed 15 hours for “*email with offer of 2K and research and repl, including talks with solicitor and email*”, “*email to reject offer*”, and *email to advise they had not continued with the offer, talks with solicitors and trade mark team and research*” and “*email to advise you would be open to a cooling off period*”, *email from myself to advise I was okay with a cooling off period.*” I do not intend to reimburse the opponent for time spent in settlement research or negotiation.

25. I note that the opponent has claimed 6 hours for “*preparation of this document to support application for TM9C and research and advice from solicitors, emails, telephone*”. As stated to the opponent at the hearing, the opponent did not put in the application for the TM9C, rather this was done by the applicant. Therefore, any time he spent creating documentation to support that form he cannot be remunerated for. However, I do consider that the opponent would have had to spend some time understanding the cooling off period and what entailed to decide whether or not to enter into the cooling off period. Consequently, I consider that a reasonable contributory time period (not compensatory) for the opponent to be compensated for would be an hour.

#### *Preparation of cost proforma and schedule of tasks*

26. I note that within the opponent’s costs pro forma, he has claimed two hours for “*preparation of this document to support application for fees for TM7*” and there is also reference to “*preparation of this document to support application for TM9C and research and advice from solicitors, emails, telephone*” which includes reference to preparation of this document again. The context, the opponent is making reference to preparation of the cost pro forma, and the supporting schedule created describing the activities carried out by the opponent in the course of these proceedings. I do recognise the time that would have been spent on the document and the assistance that it has provided in deciding upon the appropriate time to be allocated to the opponent to reflect a reasonable contributory time (not compensatory). I consider that

it is reasonable to contribute the period of an hour to remunerate the opponent for his time.

#### *Official fee*

27. I note from the schedule of tasks and the TM7 that the opponent paid an official fee of £200. However, I note that in the initial costs award, the official fee was £100. The opponent should be remunerated for the total official fee; therefore, he will be awarded the official fee of £200.

### **CONCLUSION**

28. When assessing the amount of costs, I take into account that the opponent is an unrepresented party and as such any time taken to prepare or consider documents would have taken much longer than a solicitor or a trade mark attorney. I do not consider that £200 for merely the official fee, as argued by the applicant, would be appropriate. I have taken into account the preliminary view and the taxation undertaken and accept that 141 hours as originally claimed is an excessive amount of time for each activity and also that a proportion of that time was attributed to partially relevant information as set out above. In relation to any additional costs for a hearing, as the hearing was requested by the opponent, time taken for this activity is not recoverable.

29. It is on this basis having considered the submissions filed, having regard for the TPN's, the Trade Mark Rules 2008 and the relevant section of the Act, that an award of costs should be granted to the opponent because withdrawal of the application has resulted in the opposition being successful. The opponent has expended both time and money in pursuing an opposition. I consider that a costs award in favour of the opponent to be appropriate and nothing has been raised by the applicant to warrant not making one. As expressly mentioned to the opponent at the hearing, costs awards in these proceedings are to be contributory and not compensatory.

30. Having regard to the opposition not being defended via a form TM8, the brief settlement period entered into by the parties and the section 5(2)(b) and 5(3) grounds in the opposition as a whole and that any costs award by the Registry is contributory

rather than compensatory; I consider the following figures to be a fair and reasonable award of costs:

<b>Task</b>	<b>Time</b>
Official fee	£200
Preparing a notice of opposition (TM7)	4 hours
Cooling off period preparation	1 hour
Preparing costs pro forma schedule	1 hour

<b>Total 6 hours @ £19</b>	<b>£114</b>
<b>Official fee</b>	<b>£200</b>
<b>Total</b>	<b>£314</b>

31. I therefore award the opponent the total costs in the sum of £314

32. I therefore order Aaron Davies to pay Nathan Orr the sum of £314 as a contribution towards his costs. The 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 against this decision is unsuccessful.

**Dated this 12<sup>th</sup> day of May 2025**

**A Klass**

**For the registrar**