

O-0513-25

TRADE MARKS ACT 1994

DECISION ON COSTS

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3749857
BY SIMPLY ASOEBI LTD. IN RESPECT OF THE TRADE MARK**

Simply Asoebi

IN CLASSES 24, 25, 35 AND 40

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 434131 BY
TEMITAYO OLUWAROTOMI AWOKOYA**

BACKGROUND AND PLEADINGS

1. Simply Asoebi Ltd (hereafter “the applicant”) applied to register the trade mark no. 3749857 “Simply Asoebi” in the UK in respect of goods in Class 24 and 25 and services in Class 35 and 40 (hereafter “the contested mark”). Its filing date was 1 February 2022 and it was subsequently published for opposition purposes on 18 March 2022.

2. On 29 June 2022, Temitayo Oluwarotomi Awokoya (hereafter “the opponent”) opposed the application in full on the basis of section 3(6) and section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), the latter based upon similarity in respect of the earlier mark 3192014 **Aso-ebi** registered for goods in Class 25 and 28. The section 3(6) ground was subsequently struck out because, on its own, the claim that there was an absence of due diligence is insufficient to demonstrate dishonest state of mind or intention and because no evidence has been filed to substantiate the claim of bad faith.

3. The earlier mark had been registered for more than five years before the filing date of the contested mark and, consequently, it was potentially subject to the use provisions under the Act.¹

4. The applicant filed a counterstatement denying the claims and requesting that the opponent provide proof of use

5. The opponent was represented at various points in these proceedings. At the time of filing the opposition and for the following month, he appointed IP Together Limited who was replaced by Neo Percept IP a month later. It ceased to represent the opponent after a period of three months. The opponent’s evidence was filed when unrepresented just under a month later. After four months of self-representation, the opponent appointed Mathys & Squire LLP who represented the opponent at a case management conference held in March 2023 and filed evidence and written

¹ See section 6A of the Act.

submissions on the opponent's behalf in April 2023. In February 2024, the opponent informed the Registry that he was seeking to appoint new representation, but no further representation has been appointed.

6. The proceedings eventually progressed to a hearing on 11 March 2025. At the hearing, the opponent informed me that he was withdrawing the opposition. As a consequence, the only issue still to be decided is that of costs and I invited both parties to provide written submissions on the issue which they duly provided.

DECISION ON COSTS

7. It is notable to me considerations that the proceedings have taken two years and nine months to reach a hearing in respect of, what was a straightforward section 5(2) opposition. The way the proceedings were conducted by the opponent is relevant to my considerations because it resulted in significant delays leading to an associated increase in costs to the applicant. It is also highly relevant to the issue of costs that the opponent withdrew the opposition at such a late stage in the proceedings.

8. The applicant submits that:

- (i) The proceedings have taken almost 3 years and have been unusually prolonged;
- (ii) There have been significant delays due to the opponent changing representative on a number of occasions and engaging in substantial direct correspondence with the Registry and not following normal procedures for copying all correspondence to the other side;
- (iii) Time-consuming CMCs and a final hearing have been requested by the opponent (against the wishes of the applicant);
- (iv) The final hearing had been fully prepared by the representative for the applicant;
- (v) Taking account of the above points and the significant delays in the processing of the case, the mount of legal work and associated costs for the applicant has been unusually large for such a case;

- (vi) The opponent's behaviour must be found to be unreasonable for opposition proceedings of this kind.

9. The applicant submits that the scale of costs that should be applicable to these proceedings is the scale that applied from 1 February 2023, however, as set out in the applicable Tribunal Practice Notice (TPN 1/2023), the scale that applies to these proceedings (that commenced on 13 June 2022) is that set out in TPN 2/2016. Nevertheless, I have discretion² to award costs that are not constrained by the scale.

10. The opponent submitted that each party should bear its own costs.³ On 31 March 2025, the opponent also sent, under cover of an email, three photographs of handwritten statements and apologising and stating that "we intend [sic] to send proper bank statements wrt [sic] the legal fees incurred vis our opposition to Simply Aso Ebi LTD." By email of 5 April 2025, the opponent duly sent seven personal bank statements in an attempt to illustrate his costs in the proceedings. Having withdrawn the opposition, it is the applicant who is deemed to have been successful and it is the applicant and not the opponent who is entitled to an award of costs. Therefore, it is not necessary for me to comment on the opponent's emails and attachments because they are irrelevant when considering the appropriate level of costs in favour of the applicant.

11. Some of the delays in progressing the proceedings were as a result of the opponent's medical issues. Clearly, these impacted upon his ability to read emails/correspondence without assistance. I have some considerable sympathy for the opponent's circumstances in this regard and it will be obvious from the Registry's patience and willingness to allow flexibility with regard to a number of deadlines missed by the opponent, that attempts were made to make reasonable adjustments for this. However, having reviewed the progress of the case it is also clear that the opponent could and should have done more to adhere to the timetable, especially when he would have been aware that a communication from the Registry was due. This resulted in the opponent missing multiple deadlines and causing unnecessary

² Section 68(1) of the Act and rule 67, Trade Mark Rules 2008

³ In his email of 12 March 2025

delay. Further there were numerous attempts to file evidence when, despite guidance from the Registry, he repeatedly failed to comply with the necessary requirements. Similarly, confusion was caused by the opponent's use of multiple email addresses and his failure to request a change to the official record to record his favoured email address.

12. Despite his difficulties resulting from his medical condition and his regular periods spent abroad, the opponent, nevertheless, had commenced proceedings against the applicant and he had a duty to ensure that he made every effort to not impede the progress of the case. Having reviewed the case, it is clear to me that not every effort was made. For example, throughout the proceedings the opponent made a number of attempts to file evidence that was not in evidential format and this continued even after the Registry had provided information on how to file evidence. Further, the opponent was reminded on numerous occasions to use official forms (such as for requesting an extension of time or appointing a new representative), but he continued to make such requests without using the forms. These are just some examples of the difficulties the Registry encountered repeatedly through the progression of the case.

13. The applicant's costs would have been increased if, for no other reason than the need for its representative to monitor the many communications between the opponent and the Registry and report progress (or lack of it) to the applicant.

14. In summary, the proceedings were extensively delayed, taking two years and nine months to reach a hearing. This compares to approximately a year for a case of similar complexity. Therefore, I agree with the applicant regarding its claim that the proceedings were unusually prolonged and that this was as the result of the opponent's actions and inactions that delayed the proceedings at every turn. Again, it is important to acknowledge that these actions/inactions were, in part, as a result of the opponent's difficulties in reading or identifying incoming communications from the Registry. However, keeping in mind the opponent's responsibility, having commenced proceedings, to ensure that he responded to the Registry in a timely manner, I accept that there was more that the opponent could and should have done to comply with the timetable.

15. After all the delays, the opponent requested to be heard and eventually provided dates regarding his availability. The hearing was scheduled for one of these dates only for the opponent to declare his unavailability. The Registry reminded him that he had offered the date as being one where he was available, that he had a duty to remain free on that date and that the hearing would go ahead on that date. He then indicated that he would attend. At the hearing, to the surprise of myself and the applicant's representative, the opponent informed me that he was withdrawing the opposition. Regardless of the delays in progressing the case, this very late withdrawal of the opposition, on its own, merits a higher-than-normal award of costs against the opponent. As a result of such a late withdrawal, the costs incurred by the applicant for the complete defence of the opposition over nearly three years had been incurred, including preparation for and attending the hearing. I keep this in mind.

16. As mentioned earlier, the opponent is deemed to be successful in light of the opposition being withdrawn. I agree with the applicant when it submits that the "amount of legal work and associated costs for the applicant has been unusually large for such a case". Even taking account of the opponent's medical issues, his attempts, or lack of them, to comply with directions were not diligent and led to significant delay and I accept that this increased costs for the applicant.

17. In requesting costs, the applicant states that 39.05 hours have been used by its representative during the proceedings and claims scale costs of £5,900. This was broken down as follows:

(i)	Considering opponent's statement:	£500
(ii)	Preparing Form TM8 and final submissions	£500
(iii)	Considering opponent's evidence	£1000
(iv)	Preparing evidence and commenting on opponent's evidence	£1000
(v)	Preparing for and attending CMC	£500
(vi)	Preparing for and attending hearing	£1900

18. These costs strike me as reasonable with the exception of:

(a) the consideration of the opponent's Form TM7 and preparing the applicant's Form TM8. There was nothing unusual regarding costs in respect of this work and I award a total of £500; and

(b) the cost of the hearing. The scale costs that apply to a hearing are £1600 per day. The hearing lasted a matter of minutes and even if it had progressed to the giving of substantive submissions, I estimate that it would have lasted no more than 2 hours. Therefore, I consider £500 would be appropriate for attending the hearing itself, with a further £600 for preparing the skeleton arguments leading to a total of £1100.

19. In light of all of the above, I award costs to the applicant, as follows:

Considering statement of case and preparing and filing Form TM8 and counterstatement: £500

Preparing evidence and considering other side's evidence (including the additional work involved in assessing the actions of the opponent during its attempt to file acceptable evidence and evidence-in-reply): £2000

Preparation for, and attendance at the CMC: £500

Preparing for and attending the hearing: £1100

Total: £4100

20. I, therefore, order Temitayo Oluwarotomi Awokoya to pay Simply Asoebi Ltd the sum of £4100. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 9th day of June 2025

Mark Bryant
For the Registrar