O/0635/26

COSTS DECISION IN CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. UK4013264
IN THE NAME OF HOLIDAY EXTRAS LTD
AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO.S 448575 AND 448576 BY HX GROUP LTD

AND

IN THE MATTER OF THE UK DESIGNATION OF INTERNATIONAL
REGISTRATION NO. 1787403
IN THE NAME OF HX GROUP LTD
AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 449687 BY HOLIDAY EXTRAS LTD

AND

IN THE MATTER OF UK REGISTRATION NO. 3816157
IN THE NAME OF HX GROUP LTD
AND THE APPLICATION FOR A DECLARATION OF
INVALIDITY THEREOF
UNDER NO. 507699 BY HOLIDAY EXTRAS LTD

AND

IN THE MATTER OF UK REGISTRATION NO. 3816172 AND THE UK DESIGNATIONS
OF INTERNATIONAL REGISTRATION NO.S 1726798; 1726799; AND 1740214
IN THE NAME OF HOLIDAY EXTRAS LTD
AND THE APPLICATIONS FOR A DECLARATION OF INVALIDITY
THEREOF UNDER NO.S 507700; 507701; 507702; AND 507704
BY HX GROUP LTD

BACKGROUND

1. There are eight actions involved in these consolidated proceedings,[1] namely:

(i) Two oppositions, each brought under section 5(2)(b) of the Trade Marks Act 1994 ("The Act") by HX GROUP LTD ("**HXG**"), against the UK application No.UK4013264,[2] filed by Holiday Extras Ltd ("**HEL**"); and

(ii) One opposition, brought under sections 3(4), 3(4A), 3(6), 5(4)(a) and 5(4A) of the Act by **HEL,** against the UK designation of International Registration ("IR") No. 1787403, filed by **HXG**; and

(iii) Three applications for a declaration of invalidity of a UK designation of an IR, being No.s 1726798, 1726799 and 1740214, each held by **HXG**, brought by **HEL** under sections 3(4), 3(4A), 3(6), 5(4)(a) and 5(4A) of the Act; and

(iv) Two applications for a declaration of invalidity of a UK trade mark registration, being against UK3816157 and UK3816172, each owned by **HXG**, brought under sections 3(4), 3(4A), 3(6), 5(4)(a) and 5(4A) by **HEL**.

2. In these proceedings, HXG is represented by Howard Kennedy LLP, and HEL is represented by Ipulse - David Rickard.

3. Prior to consolidation of the eight cases, the two oppositions brought by HXG were duly served on HEL following the receipt of an acceptable form TM7 for each case.

4. However, the form TM7 filed in opposition of the IR, and the five applications for a declaration of invalidity (form TM26(i)), all filed by HEL, were each considered unacceptable. In each case, HEL was invited to file an amended form TM7 or TM26(i)

[1] In a letter dated 5 August 2025, the Registry confirmed to the parties that having considered the nature of the claims in the individual cases, it considered it appropriate to consolidate the proceedings.

[2] While two separate opposition proceedings were filed against the same application number, the oppositions were originally filed by two different opponents, being Hurtigruten Expedition Cruise AS and Hurtigruten Group AS, with the opponents each seeking to rely on different earlier marks in each case. In each of the six other cases which form these consolidated proceedings, either the TM owner or the opponent/cancellation applicant was recorded as either Hurtigruten Expedition Cruise AS or Hurtigruten Group AS. In a letter dated 28 January 2025, the representative to both entities, being Howard Kennedy LLP, confirmed that in all of these related cases, Hurtigruten Expedition Cruise AS and Hurtigruten Group AS had assigned the respective trade marks to HX Group Ltd. The details have since been recorded accordingly.

to address the issues highlighted by the Tribunal in the corresponding letter which clearly outlined the deficiencies of each particular case. HEL was afforded several attempts to file a suitably amended form TM7/TM26(i). In relation to each case, on 8 December 2024, the Tribunal allowed HEL a final period of two weeks to file an amended form TM7 and TM26(i) and statement of grounds, which it stated should be filed on or before 23 December 2024, as follows:

> "**A final period of two weeks is allowed to file an amended Form TM7 and statement of grounds. Please do so on or before 23 December 2024.**
>
> ***If you choose not to amend the Form TM7 and statement of grounds, or the amended form does not adequately particularise the grounds for opposition, the Registry may decide to strike out any such grounds which it considers are inappropriate or not properly explained.***"
>
> Or
>
> "**A final period of two weeks is allowed to file an amended Form TM26(I) and statement of grounds. Please do so on or before 23 December 2024.**
>
> ***If you choose not to amend the form TM26(I) and statement of grounds, or the amended form does not adequately particularise the grounds for invalidation, the Registry may decide to strike out any such grounds which it considers are inappropriate or not properly explained.***"

5. As no response was received in relation to any of the cases, on 20 January 2025, the Tribunal issued the preliminary view that the section 3(4A) and section 5(4)(a)[3] grounds of the opposition/invalidation actions by HEL should be struck out and that the proceedings be allowed to proceed under the section 3(4) and 3(6) grounds only, which at the time were considered to be sufficiently pleaded.

6. HEL responded to the Tribunal letters on the same date, and filed amended forms for each of the cases. In the accompanying letters, HEL stated that "We take the

[3] With the section 5(4A) grounds relating directly to the condition mentioned in section 5(4)(a).

precaution of requesting a hearing in the event that any objection remains that cannot be resolved by written communication". No reason was given as to why the deadline of 23 December 2024, which had been missed by almost one month, had not been met. Further, the amended forms filed alongside the letters were, upon examination, still considered to be insufficiently pleaded, and had only been filed following the letter from the Tribunal issuing the preliminary view. Therefore, a hearing was duly appointed to be held on 12 February 2025. The letter from the Tribunal confirming the hearing date, issued on 28 January 2025, included the following information:

> "I hereby give you notice that the Hearing will take place on **Wednesday 12 February 2025** at **11.00am** via the **Teams Telephone Conference Link**. Please note that it is standard practice for hearings to be held giving 14 days notice from the date on which the notice is sent. <u>Whilst your request for a hearing date after the 7 May 2025 is noted, it is considered that further delay in this matter would be prejudicial to the other side.</u>
>
> As per the guidance at point 6.7.1 of the Tribunal section of the manual of trade marks practice, if within 5 days of the date of the notice either party provides the Hearings Clerk <u>with exceptional reasons as to why it cannot make the appointed date, or arrange representation for that date</u>, then another date may be appointed which will be within 7 days of the first date. No party will be permitted to reject two dates/times." (<u>My emphasis</u>)

7. David Rickard of Ipulse on behalf of HEL responded, stating that as he was travelling overseas and not able to attend a hearing before 7 May 2025, he was requesting that the hearing be rescheduled to a date after his return.

8. In a letter dated 30 January 2025, the Tribunal advised that, as explained in the previous letter of 28 January 2025, it was considered that such a lengthy delay to the proceedings would be prejudicial to the other party. Further, as per the guidance at point 6.4 of the Tribunal section of the manual of trade marks practice, representation at the hearing by another person may be arranged, or alternatively, written submissions could be relied on in lieu of attendance at the hearing. An alternative hearing date of 19 February 2025 was provided.

9. In the meantime, the other party requested that the hearing appointed on 12 February 2025 go ahead, and as Mr Rickard had not confirmed attendance by either himself or a different representative on either date, the hearing date was duly confirmed.

10. At the hearing, which was attended by the representatives to HXG, HXG requested that the claim under the 3(4) ground, also be struck out in each of the cases as it submitted that the claim brought under this ground did not apply and had no prospect of success. In the skeleton arguments filed prior to the hearing, HXG stated that if the preliminary view was maintained, it would be seeking off-the-scale costs in relation to the costs of the hearing, citing HEL's "repeated failure to comply with directions, late filings and hopeless arguments, which together amount to an abuse of process." I explained at the hearing that as the proceedings would continue in relation to the 3(6) grounds as a minimum, any requests for costs, including those incurred up to this point in the proceedings, would be considered at the determination of the substantive case and should therefore be submitted accordingly for such consideration.

11. Following the hearing, I wrote to the parties to confirm that the preliminary view to strike out the claims under section 3(4)(A) and section 5(4)(a)[4] had been upheld. On further consideration of the request to strike out the 3(4) ground, I agreed that the points made by HXG in this respect were valid and so issued an additional preliminary view to this effect, inviting HEL, should it disagree with the additional PV, to provide written submissions as to why it disagreed. In the letter, I stated that if no response was received on or before the given date of 14 March 2025, or if the reasons provided did not adequately justify why the view to strike out the 3(4) ground should not be upheld, the view would be confirmed and the relevant papers served on the other side in each case.

12. In a letter dated 14 March 2025, HEL accepted the additional preliminary view concerning the deletion of the section 3(4) ground, although it continued to protest against the decision to uphold the original preliminary view to strike out the section 3(4)(A) and section 5(4)(a)/5(4A) grounds.

[4] And by consequence, section 5(4A).

13. As a consequence of the strike-out actions, the form TM7 and forms TM26(i) were each served on 30 April 2025, with each of the cases proceeding under the section 3(6) grounds only. In each case, a form TM8 Notice of defence and counterstatement, was filed by HXG, on or before the given deadline in which to do so.

14. On 28 August 2025, HEL sent a letter to the Tribunal requesting the withdrawal of the application to register UK4013264 (OP448575 and OP448576) and the withdrawal of the opposition against WO1787403 as well as withdrawing the invalidation actions against UK3816157, UK3816172, WO1726798, WO1726799, and WO1740214. The withdrawal requests were made on the basis that each party bear its own costs.

15. On 3 September 2025, the Tribunal confirmed by letter the withdrawal of each of the cases.

16. On 26 September 2025, HXG sent a request for off-the-scale costs.

Legislation and Guidance

17. Section 68 of the Act states as follows:

> "(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."

18. Rule 67 of the Trade Mark Rules 2008 provides:

> "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."

19. Tribunal Practice Notice ("TPN") 1/2023 sets out the scale of costs in proceedings commenced on or after 1 February 2023. In relation to off-scale costs, the TPN directs that any such claim will need to be supported by a bill itemizing the actual costs incurred.

20. While HXG initially requested off scale costs, it is noted that the request did not include a bill itemizing the actual costs incurred, as per the requirement set out in the TPN.

21. On 14 October 2025, in response to the request for costs by HXG, HEL sent an email to the Tribunal in which it stated that "We resist and object strenuously to any award of costs in this matter", referring to its earlier request to withdraw each of the actions "on the basis that each party bear its own costs".

22. On 2 December 2025, the Tribunal issued a preliminary view on costs which was replaced by a revised preliminary view on 12 December 2025, awarding total costs of £2,200 to be made in favour of HXG. The letter detailed how the amount of the award had been calculated, stating as follows:

> "The Tribunal has considered the request for costs in line with Tribunal Practice Notice 1/2023 and has noted the similarity of the grounds pleaded in the cancellation proceedings, therefore the amount awarded for considering the Form TM26(I)s and TM8s has been reduced for cancellations CA000507700, CA000507701, CA000507702 and CA000507704**.** It is our preliminary view that an award of £2200 in favour of HX Group Ltd would be appropriate. This amount is reached as follows:

Filing Form TM7 – 448575	250.00
Statutory Fee – 448575	100.00
Filing Form TM7 – 448576	250.00
Statutory Fee – 448576	100.00
Considering Form TM7 – 449687	125.00
Filing Form TM8 – 449687	250.00
Considering Form TM26(I) – 507699	125.00

Filing Form TM8 – 507699	250.00
Considering Form TM26(I) – 507700	62.50
Filing Form TM8 – 507700	125.00
Considering Form TM26(I) – 507701	62.50
Filing Form TM8 – 507701	125.00
Considering Form TM26(I) – 507702	62.50
Filing Form TM8 – 507702	125.00
Considering Form TM26(I) – 507704	62.50
Filing Form TM8 – 507704	125.00
Total	**2200.00**

If either party disagrees with the preliminary view, they should request a hearing on, or before, **29 December 2025.”**

23. On 22 December 2025, HXG queried why the award of costs breakdown had not included any allowance for attendance at the procedural hearing held on 12 February 2025, asking that the same be considered when awarding costs in these proceedings.

24. On 24 February 2026, the Tribunal responded to confirm that costs in relation to the procedural hearing had been omitted in error, and issued a preliminary view that an additional £1,900 be added to reflect the time spent in relation to the hearing, taking the overall costs award to £4,600.[5] In the same letter, the Tribunal addressed the position of HEL with regard to the withdrawal of the actions on the basis that each party bear its own cost, as follows:

> “The submissions that the withdrawal of all eight actions was made on the basis that each party bears its own costs are duly noted. However, in circumstances where a party has withdrawn either an opposition or cancellation action or decides not to continue with its defence of an action brought against it, it is normal practice for the other side to seek an award of costs against the party requesting the withdrawal. The parties would not be expected “to bear its own costs” in such circumstances unless that was explicitly agreed by the parties

[5] I will return to this figure later in the decision.

beforehand. At the hearing held on 12 February 2025, it was made clear by HX Group Ltd that it would be seeking costs.

It is regrettable that this was not clarified in the letter dated 3 September 2025, sent by the Tribunal, in which it confirmed that the request to withdraw all eight actions had been actioned. Nonetheless, it is considered that a costs award against Holiday Extras Ltd is supportable. Contrary to the submissions made that "it had already been agreed that each party bear its own costs" the Tribunal has not had sight of any such agreement.

For the avoidance of doubt, and as outlined in the letter to the parties dated 12 December 2025, the sum of £2,200 was awarded to include the official fees at £100 each for the filing of 2 x Form TM7 (OP448575 and OP448576), with the remainder being awarded to reflect the preparation of the various statements and for considering the respective statements of the other side in each of the actions. The amounts awarded are considered to be reasonable based on the content of the statements filed by each of the parties. Any duplication of the content between the various actions has been taken into consideration when making the award, which is made in line with the published scale of costs under Annex A of TPN 1/2023.

The preliminary view is therefore that a costs award is justified and that the previous view should be amended to a total cost award of £4,600 in favour of HX Group Ltd. This includes the original sum of £2,200 plus the additional sum of £1,900 to reflect the time spent in relation to the hearing held on 12 February 2025.

If either party disagrees with the preliminary view, they should request a hearing by the deadline of **10 March 2026**. Please note that costs resulting from any such hearing may also be incurred. If neither party requests to be heard on or before the given deadline, the preliminary view on costs will be confirmed."

25. While neither party actively disagreed with, nor requested to be heard on the

preliminary view, following several more rounds of correspondence between the parties and the Tribunal, on 9 June 2026 the Tribunal wrote to both sides to say that having carefully considered the latest submissions from both parties, the Tribunal considered that the preliminary view proposing a total costs award of £4,600 to be both fair and commensurate. In the letter, the Tribunal directed that, should no further reply by either party be received on or before 17 June 2026, then the preliminary view on costs would be confirmed.

OVERALL CONCLUSION ON COSTS

26. Given that no response has been received from either party, and in line with the scale of costs provided in TPN 1/2023, I make the following award in favour of HXG:

Statutory fees for filing 2 x oppositions; and the preparation of the various statements and for considering the respective statements of the other side in each of the actions, as per the breakdown provided under paragraph 22 of this decision:	£2,200.00
Preparing for and attending a procedural hearing:	£1,900.00
Total	**£4,100.00**

27. While I note that the total sum given in the preliminary view was £4,600.00, it is clear that this was an error in the calculation of the two sums of £2,200 and £1,900. As such, subject to any successful appeal, the total sum of £4,100 is awarded.

28. I therefore order Holiday Extras Ltd to pay HX GROUP LTD the sum of £4,100.00. The above 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 21st day of July 2026

Suzanne Hitchings
For the Registrar,
the Comptroller-General