

O/0742/25

TRADE MARKS ACT 1994

IN THE MATTER OF UK TRADE MARK APPLICATION NUMBERS

**3923518, 3950886, 3953622, 3954305, 3923429, 3923469, 3953626, 3954253,
3954246, 3954234, 3954216, 4065996, 3923598, 3923561, 3953598, 3953588,
3953606, 3953638, 3971193, 3971200, 3971256, 3971258, 3971265, 3971270,
3971278, 3954315, 3954680, 3954735, 3954744, 3954727, 3954752, 3955408,
3956843, 3956851, 3956889, 3956858, 3956839, 3954669, 3975351, 3958326,
3958292 AND 3958318**

BY THE UNIVERSITY OF BOLTON

AND

THE OPPOSITIONS THERETO UNDER NUMBERS

**444398, 444627, 444626, 444635, 444400, 444401, 444634, 444636, 444628,
444632, 444633, 448750, 444487, 444488, 444622, 444623, 444624, 444625,
444782, 444783, 444784, 444786, 444787, 444789, 444790, 444489, 444643,
444644, 444645, 444646, 444647, 444648, 444649, 444650, 444651, 444653,
444654, 444642, 444810, 444820, 444814 AND 444819**

BY MANCHESTER METROPOLITAN UNIVERSITY

BACKGROUND

The Tribunal proceedings

1. The University of Bolton (“the Applicant”) applied to register in the UK the trade marks listed on the cover page of this decision (“the applications”). The applications were filed between 16 June 2023 and 20 June 2024, inclusive.
2. Manchester Metropolitan University (“the Opponent”) opposed, by filing a Form TM7, each of the applications under one or more of the following sections of the Trade Marks Act 1994 (“the Act”): 5(2)(b), 5(3), 5(4)(a) and 3(6).
3. The Applicant defended each opposition by filing a Form TM8.
4. Once defended, the oppositions were separated into five groups and the cases therein consolidated, as set out below:

Opposition no.	Application no.
Group 4	
444398	3923518
444627	3950886
444626	3953622
444635	3954305
444400	3923429
444401	3923469
444634	3953626
444636	3954253
444628	3954246
444632	3954234
444633	3954216
448750	4065996
Group 6	
444487	3923598
444488	3923561
444622	3953598
444623	3953588
444624	3953606
444625	3953638
444782	3971193

444783	3971200
444784	3971256
444786	3971258
444787	3971265
444789	3971270
444790	3971278
Group 7	
444489	3954315
444643	3954680
444644	3954735
444645	3954744
444646	3954727
444647	3954752
444648	3955408
444649	3956843
444650	3956851
444651	3956889
444653	3956858
444654	3956839
444642	3954669
Group 11	
444810	3975351
Group 12	
444820	3958326
444814	3958292
444819	3958318

5. Upon consolidation, groups 4, 6, 11 and 12 were suspended and the deadline for the Opponent's evidence in chief in group 7 was set as 14 October 2024. On 14 October 2024, the Opponent filed evidence in chief in the form of a witness statement and 29 corresponding exhibits. The evidence was admitted, and the Tribunal set the deadline for the Applicant's evidence in chief as 14 December 2024.

6. On 26 November 2024, the Applicant notified the Tribunal that it was withdrawing all its applications, i.e. all those listed in the table above.

7. On 23 December 2024, the Opponent made a request for an award of costs, accompanied by related submissions. The Applicant filed submissions on costs on 17 February 2025.

8. Throughout the proceedings, the Applicant has been represented by Eversheds Sutherland (International) LLP and the Opponent by HGF Limited.

The Applicant's name change

9. It is apparent from the various filings with the Tribunal that the applications were filed in anticipation of the Applicant changing its name to the University of Greater Manchester, or to Greater Manchester University. This proposed name change was agreed upon by the Applicant's Governing Body in May 2023 and an application to the Office for Students ("OfS") was made in August 2023.

10. The OfS launched a consultation on the proposed name change on 21 March 2024, with a closing date of 2 May 2024. A decision by the OfS on the proposed name change was expected following the conclusion of the consultation process. However, by 24 November 2024, a decision had not been handed down by the OfS and so the Applicant made the decision to withdraw its applications.

11. For the entire duration of these proceedings, the proposed name change was either in the consultation period or was being considered by the OfS. During this time, the parties neither entered a "cooling off" period, nor requested a suspension or to jointly stay the proceedings pending the OfS' decision.

12. On 19 December 2024, after the withdrawals of the applications had been actioned, the OfS communicated its decision to approve the Applicant's name change from the University of Bolton to the University of Greater Manchester.

PRELIMINARY POINT

13. In some circumstances, it is appropriate to issue a preliminary view on costs. However, given the scale and complexity of these proceedings I consider it impracticable to suitably address the submissions and make a thorough calculation of any award, communicated by means of a preliminary view. Accordingly, and on the additional basis that both parties have filed submissions on costs, it is appropriate to issue this decision on costs.

SUBMISSIONS

14. The Opponent's request for an award of costs included the following submissions:

“As the University of Bolton was notified of the opponent's intention to oppose before the oppositions were filed, we request awards of costs in favour of the opponent, Manchester Metropolitan University.

We note that the oppositions were consolidated into groups, however, separate notices of opposition were required to be filed in respect of each application and therefore we request costs in relation to each opposition filed.

Further, in relation to the consolidated set of oppositions lead opposition no. OP000444489 [...], substantial evidence was filed. We therefore request that this is also considered by the Office and reflected in the cost order.”

15. The Applicant's submissions were lengthy; I will reproduce the pertinent points as follows:

“In our letter to the Opponent's attorneys dated 15 November 2023 [...], it was acknowledged that trade mark law is distinct from the [Office for Students] [OfS] process for naming universities. But, it was noted that the Applicant would not be able to use the name UNIVERSITY OF GREATER MANCHESTER or, indeed, GREATER MANCHESTER UNIVERSITY (which at that time was also under consideration by the Applicant) unless the OfS approved the change in name. In an attempt to avoid proceedings, the Applicant asked the Opponent not to take any action against its applications until the OfS had issued its decision. To provide further reassurance, the Applicant offered to undertake that it would withdraw its applications if the OfS refused permission for the Applicant to change its name. Given that the Applicant was not able to use the name until it had received approval from the OfS, this was a fair and reasonable offer which would have allowed the parties to avoid any opposition proceedings and unnecessary cost incurrence. The Opponent rejected the offer.

Throughout this period, the Applicant's request to change its name was being considered by the OfS. [...] By the end of the consultation process, it was anticipated that the OfS would hand down its final decision in around July 2024.

[...]

Given the Applicant was faced with an extraordinary number of oppositions by three parties, there were significant cost implications with defending all of the oppositions and, by November 2024, it was not known when the OfS decision would be handed down. Accordingly, on 25 November 2024, the Applicant informed the Opponent that its obdurate position by rejecting the Applicant's reasonable suggestion to defer all trade mark considerations until the OfS decision was known had put all parties, including the Opponent, at severe cost risk. Given the material sums involved money funded by students and the public purse, the parties' value for money responsibilities, the continued delay in the announcement of the OfS decision and the deadlines to file evidence, the Applicant had no choice but to withdraw its applications, except for the Business School Registrations. [...]

On 19 December 2024 the OfS granted permission for the Applicant to change its name to University of Greater Manchester. This decision was affirmed by the Department for Education. A subsequent application to Companies House was approved by the Secretary of State for Education in January 2025. Accordingly, with all approvals in place, the university has changed its name to University of Greater Manchester.

[...]

It is acknowledged that the Opponent is entitled to seek a costs award, although it is submitted that any award (if made) should be at the lowest scale.

For the reasons set out above, the Applicant acted reasonably throughout the matter and, indeed, if the Opponent had accepted the Applicant's sensible and

reasonable offer in November 2023, the proceedings, associated costs and time incurred would have been avoided.

[...]

In this case, the Opponent filed 40 oppositions.¹ Overall, all the statement of grounds were closely similar given that the parties, rights and grounds relied on were the same or similar. As such, the Opponent was largely able to use the same wording for each of the statements of grounds and none of them were particularly complex.

[...] Accordingly, it is submitted that the Opponent should only be entitled to recover costs at the lowest scale and, if they are considered on a per application basis, the costs award should be no more than £250 per opposition to reflect the cut and paste nature of the statement; that is £10,000 in total.

The Opponent is not entitled to any further costs awards as the proceedings were suspended, save for group 7.

In respect of group 7, one statement was filed by the Opponent. As can be seen from the scale of costs at Annex A of TPN 1/2023, the second task is entitled '*Preparing evidence and commenting on the other side's evidence*'. It is respectfully submitted that the costs should be at the lowest end of the scale. In this regard, it was not necessary for the Opponent to review or comment on any evidence as the Applicant had not filed any evidence. Also, as set out above, the statement itself was not substantial. For example, it only contained three, short paragraphs on the background to the University. Also, much of the statement merely referred to the University's online presence. Indeed, page 5 of the statement largely consists of a list of the University's social media accounts. Moreover, given the proceedings had been consolidated, each of the oppositions within group 7 should be treated as if they were a single set of proceedings rather than separate opposition proceedings in accordance with

¹ I note the Applicant has miscounted the number of oppositions, of which there are 42.

the principles set out in the Manual. As such, the costs award in respect of the statement should be no more than the lowest costs award of £600.”

CONSIDERATIONS

16. The power to award costs is provided for in the Act and the Trade Marks Rules 2008, shown below, respectively:

“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.”

17. As pointed out by the Applicant, the relevant guidance in these sets of proceedings is that set out in Tribunal Practice Notice (“TPN”) 1/2023 and the scale set out at Annex A thereto, which applies to proceedings commenced on or after 1 February 2023. I will refer to the relevant parts of the TPN as and when appropriate.

18. The guidance on the UK Government website, within the Tribunal section of the Trade Marks Manual, is also relevant. Section 5 provides for costs, and section 5.8 in particular is relevant here:

“However, if the applicant files a counter-statement this will be taken as an intention to defend the attack. If the application is then withdrawn or the registration is voluntarily cancelled a deduction will not usually be made to any costs award.”

19. Section 5.9 is also relevant:

“If the proceedings were consolidated before any evidence had been filed, the cost calculation should normally award the amount for each stage of the evidence as if it was a single set of proceedings.”

20. I note the Applicant’s submissions on the point of attempting to avoid the proceedings, specifically that it offered to undertake to withdraw its applications if the OfS refused the name change, in return for the Opponent not taking any action against the applications until the OfS’ decision was issued. However, as explained in my paragraph 11, neither party approached the Tribunal with regards to suspending the proceedings.

21. Regardless, it is not persuasive when considering the matter of costs that the Opponent rejected the Applicant’s proposed undertakings. There is nothing inappropriate in the Opponent choosing to oppose, within the prescribed time period, trade mark applications which it objected to; much like, whilst it was open to the Applicant, in the interest of saving time and costs, to file its trade mark applications once the OfS had issued its decision, it was not inappropriate for the Applicant to choose to secure the trade marks it intended to use.

22. Whilst there were options available to the parties to avoid the time and costs expended in these proceedings, neither party has acted unreasonably and so I proceed to calculate an award of costs in line with the scale set out in the TPN. On the basis that the Applicant withdrew its applications after defending the oppositions, it is the Opponent that I consider to be entitled to an award of costs, which will be contributory, not compensatory.²

23. I will take the tasks listed in the Annex to the TPN in turn, addressing the parties’ submissions where relevant.

² Paragraph 2 of TPN 1/2023.

24. The costs associated with the Form TM7s and TM8s are considered together as per the Annex. I have considered the content of those forms in all 42 sets of proceedings and agree with the Applicant that there is considerable repetition. I do not consider it to be proportionate to award even the scale minima for all 42 sets of forms; instead, I will decide an appropriate sum based on the complexity of the statements and make a reduction for the repetition accordingly.

25. Turning to the preparation of evidence (in group 7 only), which was filed with the Tribunal and sent to the Applicant prior to the Applicant withdrawing its applications, I am persuaded to some extent by both parties' submissions. The timing of the Applicant's withdrawals meant that the Opponent had already prepared and filed its evidence and is entitled to an award in this regard. Further, whilst the Applicant has made observations on the volume and complexity of the Opponent's evidence, what was filed totalled 300 pages of evidence, the upper limit set by the Tribunal for evidence in chief. The evidence was substantial, and I will make an award accordingly, in line with the scale. I do, however, agree with the Applicant that the award should take account of the consolidation and be made as if group 7 was a single set of proceedings.

AWARD

26. Taking the above considerations into account, I award costs to the Opponent on the following basis:

Task	Calculation	Amount
Official fees	£200 x 42	£8,400
Preparing a statement and considering the other side's statement	£350 x 42 - 50% =	£14,700 - £7,350 £7,350
Preparing evidence	£1,200	£1,200
Total		£16,950

27. I therefore order the University of Bolton³ to pay the University of Manchester the sum of £16,950. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings. The appeal period will commence from the date of this decision.

Dated this 7th day of August 2025

MRS E FISHER
For the Registrar

³ I note the Applicant's name change since its withdrawals and so this order applies equally to the University of Greater Manchester.