

O-0928-25

TRADE MARKS ACT 1994

SUPPLEMENTARY DECISION ON COSTS

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3865957
BY PHOTO-IMAGE LTD. IN RESPECT OF THE SERIES OF TWO TRADE MARKS**



AND



IN CLASS 9

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 441893 BY
HOYA CORPORATION**

1. In my decision issued under BL number O-638-25, dated 14 July 2025, Hoya Corporation (“the opponent”) was wholly successful in its opposition to the registration of trade mark application number 3865957. At the hearing, Mr Sam Carter, for the opponent, sought costs above the published scale because, he submitted, its costs in the proceedings have far exceeded those of a normal opposition. He cited the manner in which the applicant conducted the proceedings and stated that the request reflects the unusually high costs accrued by the opponent as a result. At the hearing, I commented as follows:

“I think the way I will proceed with costs is that I will consider the substantive issues and issue my decision. If I am for the opponent, I will also consider if I think off-scale costs are appropriate. If I do, I will then invite them to file a schedule of costs.”

2. In my decision, having found for the opponent and, in line with my comments at the hearing, I stated:

“64. The opponent has been successful and is entitled to a contribution towards its costs. At the hearing, the opponent sought off-scale costs citing the applicant’s manner of conducting the proceedings and that this has required multiple CMCs to debate unmeritorious points. Further, it was pointed out that the opponent had to deal with a near-constant barrage of aggressive and irrelevant correspondence. I agree that the costs associated with these proceedings are likely to have been significantly higher because of the way the applicant conducted these proceedings. Consequently, I direct that the opponent provide, within 21 days of the date of this decision, written submissions (not more than 3 pages) and a schedule of costs identifying any additional costs arising from the applicant’s unreasonable behaviour. The applicant should provide any submissions in reply within a further 21 days. These should also be limited to 3 pages. I will consider the parties’ comments and then issue a supplementary decision on costs.”

3. Despite Mr Carter’s indication at the hearing, that the opponent was seeking off-scale costs, no written submissions were forthcoming. Consequently, I have no

information to base an off-scale costs award. In light of this, I consider costs, where possible, on the published scale of costs.¹

4. Section 68 of the Trade Marks Act 1994 (“the Act”) states:

“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.”

5. Rule 67 of the Trade Marks Rules 2008 enacts this:

“Costs of proceedings; section 68

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.”

6. Tribunal Practice Notices (“TPN”) 2/2000 and 4/2007 are also relevant. Having referred to the leading case, *Rizla Ltd’s Application* [1993] RPC 365, TPN 2/2000 goes on to state:

“5. In the light of *Rizla*, the Office considers that the existing legislation provides the power to operate a nominal cost regime or a full cost recovery regime - or anything in between - and that no legislative change is necessary to put in hand any revision of that sort.”

7. At the hearing, Mr Senna, for Photo-Image Ltd (“the applicant”) disputed that off-scale costs are appropriate and referred to what he considered to be misconduct on behalf of the opponent and that this led to a “hostile situation” and sought costs on

¹ See Tribunal Practice Notice 1/2023

an indemnity basis. He also expressed the view that there was “nothing I have said or done that was not totally necessary.” These allegations are not supported by the facts before me (and referred to in my substantive decision and in the two letters issued subsequent to the CMCs). Whilst the applicant strongly believes otherwise, it is my view that in the most part, the opponent conducted its case in a professional and focused way. It is clear that Mr Senna perceived the opponent’s initial reliance upon the existence of a spent conviction to contribute to his perception of a “hostile situation”. However, despite a previous hearing officer allowing the opponent’s reliance upon this spent conviction, following further information provided by Mr Senna, the opponent voluntarily removed all references to it in its submissions and evidence. Further, as the successful party, it is the opponent and not the applicant who is entitled to an award of costs.

8. As I have already stated in the substantive decision, Mr Senna’s behaviour was often challenging, and there were two case management conferences held at the request of Mr Senna both of which resulted in findings regarding numerous complaints made by the applicant being resolved in favour of the opponent. In addition, it is also relevant to the issue of costs, that Mr Senna regularly emailed the Registry vociferously complaining about the content of the other sides evidence or submissions, restating arguments regarding issues already decided and, on numerous occasions, demanding that the proceedings be transferred to the High Court (despite being informed that this was not possible). Such communications, whilst often directed at the Registry, will have required review by the opponent that would have added to their costs unnecessarily. Consequently, I consider it appropriate make an award to also reflect this additional work.

9. Taking all of the above into account, I award costs, in favour of the opponent, as follows:

Preparing and filing statement of case and considering applicant’s statements	£300
Officials fee	£200
Preparing for and attending CMCs x 2	£1000
Preparing evidence and considering applicant’s evidence:	£1800

Considering (and where necessary responding) to multiple communications from the applicant:	£1000
Preparing for, and attending hearing:	£1000
Total:	£5300

10. I, therefore, order Photo-Image Ltd to pay Hoya Corporation the sum of **£5300**. 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.

11. In addition, the appeal period for the substantive decision, issued on 14 July 2025, begins with the date of this decision on costs,

Dated this 30th day of September 2025

For the Registrar,

The Comptroller-General