O/0932/25

TRADE MARKS ACT 1994

SUPPLEMENTARY DECISION ON COSTS

IN THE MATTER OF APPLICATION NO. UK00003924385
IN THE NAME OF AARON ROSS
IN CLASS 33

AND OPPOSITION THERETO UNDER NO. 443927
BY THE WEST HIGHLAND WOODLANDS

AND IN THE MATTER OF REGISTRATION NOS. UK00003427527 AND UK00003919382 IN THE NAME OF THE WEST HIGHLAND WOODLANDS

AND APPLICATIONS FOR DECLARATIONS OF INVALIDITY THERETO UNDER NOS. 506900 AND 506899
BY AARON ROSS

BACKGROUND

1. On 13 August 2025, I issued a decision in the above identified proceedings, the outcome of which was in favour of The West Highland Woodlands ("WHW"). In relation to costs, I stated:

> "111. WHW has been successful in both the applications for invalidation and the opposition. They have requested costs off the scale.
>
> 112. I therefore direct WHW to file full written reasons for their request for costs off the scale, along with details of those costs within 14 days.
>
> 113. Mr Ross will then have a period of 14 days in which to reply.
>
> 114. A subsequent decision on costs will then be issued."

2. WHW filed submissions on 26 August 2025.

3. Mr Ross did not file any submissions in response.

4. I will now give a supplementary decision on costs.

DECISION

Should off-scale costs be awarded?

5. Having been successful in the proceedings, WHW would normally be entitled to a contribution towards its costs based on the Registrar's published scale of contributory costs. However, as explained above, WHW claims that the applicant has acted unreasonably during the course of these proceedings and that this should have a bearing on costs.

6. The submissions filed by WHW are somewhat confused; they firstly request costs off the scale (as requested at the substantive hearing before me) and then request costs at the higher end of the scale. No breakdown of actual costs incurred has been provided, as would be required to support a claim for off scale costs. As such, the most that can be awarded is costs at the higher end of the scale.

The reasons for the claim

7. WHW makes various allegations against Mr Ross, which it claims should impact the award of costs made.

8. Firstly, WHW states that Mr Ross was well aware that none of the parties concerned had commenced use of the FASSFERN mark at the time of filing the contested marks and, consequently, that no goodwill can have been accrued to form the basis of a passing off claim under section 5(4)(a). In addition to this, WHW notes that in the first Form TM26(I) that was filed, no date of first use was particularised.

9. The fact that there were issues with the first version of the Form TM26(I) filed by Mr Ross is not, in my view, a basis for awarding higher costs. Whilst it is far from preferable that a form filed by a professional representative was incomplete, it is not uncommon. Indeed, the Form TM7 filed by WHW in the opposition proceedings was inadmissible and required re-filing. As such, this does not, in my view, justify an award of higher costs.

10. In relation to the claim that Mr Ross knew that there was no goodwill, by the time of filing UKTM no. 3919382 ("the 382 Mark") on 6 June 2023, there was clearly trade ongoing as I explained in my decision; the issue for Mr Ross was the lack of evidence to substantiate the scale of this use. As such, I was unable to determine whether there was a small (but protectable) goodwill or a trivial (and, therefore, not protectable) goodwill. WHW's position cannot, therefore, succeed in relation to the application for invalidation against the 382 Mark.

11. However, I agree that Mr Ross must have known that there were no commercial activities ongoing at the time of filing UKTM no. 3427527 ("the 527 Mark"). This mark

was filed on 10 September 2019, at which time the parties were in discussions for the establishment of a distillery. Having been so heavily involved in the preparations that were ongoing at the time, it seems to me that he must have known (given that he was professionally represented and had the benefit of legal advice) that there could be no goodwill at the relevant date.

12. Secondly, WHW claims that Mr Ross was well aware that the application for the marks in issue had been made in good faith with Mr Ross's consent and that WHW had acquired the registration in good faith with Mr Ross's knowledge and consent. As such, WHW claims that Mr Ross knew that there was no bad faith on WHW's part. In this regard, WHW notes that Mr Ross has been found to have acted in bad faith. For the avoidance of doubt, I do not consider the mere fact that Mr Ross has been found to act in bad faith to be a basis to award costs at the higher end of the scale. However, I do accept that Mr Ross seems to have accepted that, at the time of filing, the party that applied for the 527 Mark was doing so with his consent. As such, he must have known (given that he was professionally represented and had the benefit of legal advice) that there was no basis for a bad faith claim. I do not consider that the same is true in respect of the 382 Mark, which was filed by WHW after the relationship had broken down.

13. Thirdly, WHW states that Mr Ross knew that there was no distillery in operation and could not, therefore, rely upon The Scotch Whisky Regulations 2009 ("TSWR 2009"). Further, he relied upon sections of TSWR 2009 which did not relate to trade origin. I have no evidence before me regarding whether or not a distillery has or is being operated by Mr Ross. As such, I have been unable to make a finding either way. Consequently, this line of argument cannot succeed.

14. Finally, WHW states that Mr Ross should have known that his claim that FASSFERN was descriptive was not a successful ground of invalidation, particularly given that he had himself applied for a mark which contained FASSFERN, the purpose of which was to prevent third party use. Mr Ross had applied for a figurative mark which included the word FASSFERN and a device. It seems to me that he was attempting to protect that form of the mark, rather than the word FASSFERN itself. I do not, therefore, consider it to be contradictory to his position under section 3(1)(c). I

do acknowledge that the name FASSFERN appears to have been Mr Ross's idea. However, I have no evidence as to whether Mr Ross was professionally advised at that time that he came up with the name and, in any event, I noted in my substantive decision that there were factors pointing in favour of both parties under this ground. As such, whilst I ultimately found against Mr Ross, I do not consider that it can be said that this ground was without reasonable prospect of success.

The Costs Award

15. Taking all of the above into account, as well as the complexity of the case, I am prepared to award costs at the higher (but not highest) end of the scale. With that in mind, I award WHW the sum of **£4,050**, calculated as follows:

Preparing statements and considering Mr Ross's statements	£650
Preparing evidence and considering and commenting upon Mr Ross's evidence	£2,000
Preparing for and attending the hearing	£1,200
Official fee for opposition	£200
Total	**£4,050**

16. I therefore order Aaron Ross to pay West Highland Woodlands the sum of **£4,050.** This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

The Appeal Period

17. The appeal period for both this supplementary decision on costs, and my substantive decision dated 13 August 2025, will begin to run from the date of this costs decision.

Dated this 1st day of October 2025

S WILSON

For the Registrar