

BL O/1114/24

TRADE MARKS ACT 1994

DECISION ON COSTS

IN THE MATTER OF APPLICATION 3587268

BY

GLOBAL TRADEMARK SERVICES LIMITED

TO REGISTER THE TRADE MARK



IN CLASS 25

AND

THE OPPOSITION THERETO UNDER NO 436355

BY

THIERRY HENRY

1. This costs decision relates to an opposition filed against a trade mark that was subsequently withdrawn due to the applicant's failure to accept undertakings, following an assignment. This means that the validity of the contested trade mark has not been tested. However, following withdrawal of the trade mark (3587268 - shown on the cover page of this decision), the opponent requested costs above the usual scale, based on the conduct of the applicant throughout the proceedings and the additional work and time the opponent expended as a result. This decision deals with that request, which concerns, in particular, a case management conference (CMC) and a number of assignments made by the applicant.

2. There has been a high volume of correspondence filed by the applicant in this case. Much of it has been disparaging to tribunal staff and the opponent. Where possible, I have avoided including unnecessary reference to such material and have only included it where it is likely to inform this costs decision.

Background to the case management conference

3. On 29 January 2021, Global Trademark Services Limited (the applicant) applied to register the mark shown on the cover page of this decision. The application was made in respect of 'clothing' and 'headgear' in class 25 and was published on 17 June 2022.

4. On 17 August 2022, a TM7A form was filed in the name of Thierry Henry (the opponent), by his representative Marks and Clerk.¹ The filing of that form extended, by one month, the deadline to file his opposition – in this case the period was extended to 17 September 2022.

5. The 17 September 2022 was a Saturday. Also of note is the fact that Monday 19 September was a bank holiday.² The Intellectual Property Office (IPO) website is clear that the office is deemed closed on weekends, Good Friday, Christmas Day and all England and Wales bank holidays for all types of business, except for the filing of new

¹ Four other TM7As were also filed.

² An additional bank holiday for the State Funeral of Queen Elizabeth II.

applications not claiming priority. Any official time period that expires on a weekend or any other day on which the office is closed is extended to the next working day.³

6. Accordingly, taking account of weekends and bank holidays, the due date for the opposition was 20 September 2022. The opposition was filed on 20 September 2022.

7. Between 27 September 2022 and 10 October 2022 the tribunal received twelve items of correspondence from Jim Dear – the Director of Global Trademark Services Limited. In essence, Mr Dear submitted that Arsenal Football Club had filed the TM7A to extend the opposition period and so Thierry Henry could not file an opposition in the extended deadline, being the wrong legal entity. He further submitted that the TM7 filed on 20 September 2022 was filed out of time (seemingly relying on Tribunal Practice Notice (TPN) 4/2010).

8. On 10 October 2022 the tribunal wrote to Mr Dear informing him that he was notified on 18 August that five TM7A forms had been filed against his trade mark applications.

9. One of the five aforementioned TM7A forms was the form filed in the name of Thierry Henry by Marks and Clerk. A copy of that form was included in the tribunal letter, dated 10 October 2022, for reference. The letter also informed Mr Dear that the correct TPN for the calculation of opposition period deadlines was not TPN 4/2010, but was in fact TPN 1/2013, which shifted, to one day later, the time period for filing an opposition. Both TPNs are published on the IPO website and both notices clearly state that TPN 1/2013 replaces TPN 4/2010.

10. Following that letter, Mr Dear wrote to the tribunal asking for various members of IPO staff to be removed from dealing with his cases. I will not reiterate the accusations made or the language used by Mr Dear, other than to note that the head of tribunal administration wrote to Mr Dear on 20 October 2022 asking that he correspond with the tribunal ‘in a professional and respectful manner’.

³ In accordance with section 80 of the Trade Marks Act 1994 (the Act) and rule 80 of the Trade Marks Rules 2008 (the Rules) the Intellectual Property Office (IPO) may specify its hours of business and must publish them on its website.

11. In further correspondence, Mr Dear continued to raise the same points regarding the opposition filed by the opponent, Thierry Henry. On 22 November 2022 I held a CMC to resolve the outstanding issues and move the case forward. Suffice to say, Mr Dear's conduct was neither professional nor respectful.

12. At the CMC, I reiterated the same points as those included in earlier correspondence, particularly the status of TPN 4/2010 and its replacement with TPN 1/2013. The day following the CMC, Mr Dear wrote to the tribunal accepting that the opposition was validly filed.

Continuation of the proceedings

13. A defence was filed by the due deadline of 5 December 2022, but in non-standard form. Following correspondence, an acceptable defence was filed on 27 December 2022.

14. The opponent filed evidence by the required deadline. This was in the form of a witness statement by Thierry Henry with twenty-six exhibits and a witness statement by Nick Leech with twelve exhibits.

15. The applicant filed a TM21B to add a limitation to its trade mark specification.⁴ The amendment was made and the opponent confirmed its intention to continue with the opposition. The tribunal wrote to the parties notifying them that the opposition case would continue, the opponent's evidence was acceptable and the applicant had until 12 June 2023 to file its evidence.

16. The applicant did not file evidence within the specified period. Mr Dear filed an email, dated 21 May 2023, which included the following:

"...IP solicitors filing an opposition in the full knowledge their client has no goodwill (significant UK sales) is the filing of Sham and Vexatious case.

⁴ Dated 24 April 2023.

Also, in a reasonably recent ruling by the High Court that the filing of a trademark application, any application, can be an instrument of fraud.

Having made my opponent aware that I am aware of these rulings my opponent will of course now have to discuss the situation with their client. Should my opponent then still wish to proceed it will then potentially be a conspiracy on either or both Sham & Vexatious filing and an Instrument of Fraud by my opponent and their legal representative.”

17. On 3 July 2023, letters were sent to the parties confirming the conclusion of evidence rounds. That letter included a period in which the parties could file written submissions and/or request a hearing to determine the substantive case. Mr Dear responded on 20 July 2023. His response included the following:

“The IPO broke it's legal requirement to be impartial at all times and in doing so ceased to be independent and impartial.

While the IPO most definitely cannot have any further involvement with these two trademark applications it is possible the IPO should be excluded from any actions on any further applications filed by my company.”

17. Neither side requested a hearing, the opponent filed submissions in lieu of a hearing on 31 July 2023. Mr Dear wrote to the tribunal on 11 August 2023, in essence refusing the IPO's jurisdiction in reaching a decision in this case. Within that letter Mr Dear included the following:

“I have made it clear on many occasions with the IPO I have 3 companies, Global Trademark Services Limited and Signed Security Limited who will hold trademarks and lease them to my 3rd company Fasanta Fashion Limited...”

18. On 2 August 2023, the case was listed for a decision to be taken from the papers.

19. On 3 December, Mr Dear again wrote to the tribunal refusing the IPO's jurisdiction in reaching a decision in this case.

The assignments

20. Following the listing of this case for a decision to be written, a series of assignments were made by the applicant.

Assignment 1

21. On 8 November 2023, the HENRY trademark was assigned by the applicant, Global Trademark Services Limited, to Signed Security Limited. As Mr Dear had already submitted, these are both his companies.⁵

22. The tribunal wrote to the applicant on 12 December asking the new applicant to confirm it had seen the relevant papers, was going to stand by the statements made in the proceedings so far and that it accepted the liability for costs for the whole proceedings, (if necessary). On 13 December the applicant was reminded:

“Please note that failure to agree to the undertakings, i.e. to stand by the statements made in the counterstatement, will result in there being no defence, and the application being deemed abandoned.

You are reminded that the deadline to respond to the matter of undertakings is 27 December 2023.”

23. On 8 January 2024, the tribunal wrote to Signed Security Limited stating that, as no response had been received, the registry intended to deem the contested trade mark abandoned. The applicant was notified that any challenge to that view must be made at a hearing. The applicant had until 22 January 2024 to request one.

24. A lengthy response was received. It included the following:

⁵ See paragraph 17, above.

“...I propose the IPO apologises for this lapse and whithdraws [sic] it's threat to void my trademark applications. A review of which Officer takes these cases forward is undertaken.

If the IPO is not prepared to listen to reason and forces my trademark applications to a Hearing I will commence the process for filing Misconduct in Public Office with Gwent Police. To be clear if the IPO does not listen to reason I request a Hearing on all three oppositions/trademark applications.”

Assignment 2

25. On 11 January 2024, the tribunal received an assignment request to re-assign the HENRY trade mark from Signed Securities Limited to Global Trade Mark Services Limited. The same two companies a⁶re owned by Mr Dear.

26. The tribunal wrote to Global Trademark Services Limited on 9 February 2024 informing them that the assignment back into their ownership (being the original applicant) removed the need for a CMC and the case would, again, be sent for a substantive decision to be written.

Assignment 3

27. On 8 April 2024, the HENRY trademark was again assigned by the applicant, Global Trademark Services Limited to Signed Security Limited. The same two companies owned by Mr Dear.

28. The tribunal wrote to Signed Security Limited on 18 April asking the new applicant to confirm it had seen the relevant papers, was going to stand by the statements made and that it accepted the liability for costs for the whole proceedings (if necessary). The applicant was given until 2 May 2024 to respond.

29. On 11 June 2024, the tribunal wrote to Signed Security Limited stating that as no response had been received the registry intended to deem the contested trade mark

⁶ See paragraph 17, above.

abandoned. The applicant was notified that any challenge to that view must be made at a hearing. The applicant had until 25 June 2024 to request one.

30. No response was received and on 11 June the tribunal wrote to the applicant confirming that the HENRY trade mark would be withdrawn. The applicant was given until 25 June 2024 by which to request to be heard, if it disagreed with that view. No response was received and on the 1 July 2024 the tribunal wrote to the applicant confirming that the application had been withdrawn.

Request for costs

31. On 30 July 2024, the opponent requested costs above the usual scale in respect of these proceedings. On 27 September 2024, it filed a detailed breakdown, as follows:

“...these proceedings were subject to several unjustifiable delays, including a CMC and the other party failing to meet deadlines on several occasions, as well as filing assignments to transfer rights between companies (all related to, or owned by James Dear). It is respectfully submitted that this behaviour was, at best completely unacceptable according to standards of the Tribunal or, at worst, designed to delay the matter from progressing to a decision and to increase the cost and burden on the Opponent (and the UKIPO). Our understanding is that the UKIPO have this information on file already, and have had sight of the extensive evidence filed by the Opponent in support of this matter...

...attached at Annex A is an itemised breakdown of the costs incurred by the Opponent in relation to this matter.”

32. Annex A is as follows:

Task	Cost
Preparing and filing Notice of Threatened Opposition	£438
Preparing Notice of Opposition and accompanying Statement of Grounds	£1,860
Preparation for and attendance at CMC	£1,195.50
Considering other party's defence to the same and reviewing and responding to intervening correspondence received from other party throughout the proceedings, including reviewing and responding to various trade mark assignments / ownership changes of the other party mark and various miscellaneous submissions submitted by other party.	£1,760
Work completed on preparing and submitting Evidence in Chief, (2 x Witness Statements and a large evidence bundle and submissions relating to claims of bad faith and passing off).	£6,542.50
Preparation and submission of final submissions in support of this matter.	£2,765.5

GRAND TOTAL: £14,561.5

33. The applicant was given the opportunity to file comments regarding appropriate costs. No comments were received by the deadline of 16 October 2024. I note that the only comment on file from the applicant regarding costs was contained in an email of 19 August 2024. The relevant part reads:

“Signed Security Limited is a dormant company and has no assests [sic] or monies and even if it did the IPO having improperly withdrawn these applications should bear any costs.”

34. Rule 67 of the Rules states:

“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.”

35. Section 68 of the Act and Rule 67 of the Trade Mark Rules 2008 give the registrar wide discretion to award costs. As Anthony Watson Q.C. stated in *Rizla Ltd.’s*

Application when considering a very similar provision under the Patents Act 1977:⁷ “The wording of section 107 could not in my view be clearer and confers on the Comptroller a very wide discretion with no fetter other than the overriding one that he must act judicially.”

36. Although the courts have endorsed the registrar’s power to award compensatory costs in cases of unreasonable behaviour, it does not follow that compensatory costs must be awarded whenever there is any unreasonable behaviour. As stated in *Rizla Ltd.’s Application*, the question is whether “*the behaviour in question constituted such exceptional circumstances that a standard award of costs would be unreasonable.*”

37. The volume and nature of correspondence in this case is exceptional, particularly the number of documents filed before receipt of a defence. Much of this has been generated by or in response to Mr Dear. The volume itself does not lead one to consider costs above the usual scale, in this case it is the volume as well as the tone of that correspondence coupled with the fact that most of it was entirely unnecessary.

38. In Mr Dear’s email filed the day after the CMC to discuss the opposition filing date, he described himself as a lay litigant, but variously also describes himself as having extensive knowledge and experience with regard to trade mark matters.⁸ Irrespective, nothing turns on this. Mr Dear opted to represent his companies and chose how to handle his case.

39. The tribunal has clearly borne the brunt of Mr Dear’s plethora of unprofessional correspondence, but this has also put an additional burden on the opponent, having to read and consider every letter and email, often multiple emails in a single day. Large numbers of these letters and emails are unpleasant to read and were irrelevant to these proceedings. Even when the opponent did not need to respond to the applicant’s correspondence, it needed to keep up with the issues being raised and the responses from the tribunal.

⁷ [1993] RPC 365 at 377.

⁸ For example, see Mr Dear’s email correspondence dated 28 September 2022 and letter dated 11 October 2022.

40. This is particularly evident when considering the CMC (taken in November 2023), which was only necessary due to Mr Dear's refusal to accept legal reasoning (relating to well-established procedural matters) and his confusion concerning applicable law.

41. In short, the way in which Mr Dear dealt with this case has pushed the opponent's costs beyond those that would have been envisaged by the usual tribunal scale.

42. I have been through the applicant's schedule of costs, which totals £14,561.50. Some of the work undertaken by the opponent relates to 'normal' work that would be required in opposition proceedings, such as the preparation and filing of evidence. This should be awarded on the appropriate scale.⁹ Other work, such as that required for the CMC, was entirely unnecessary and only occurred due to the actions of Mr Dear.

43. The opponent has made its cost request under a number of headings, broadly similar to those contained in the standard scale. I will do the same, with reasoning as to the quantum in each case.

Preparing and filing the notice of threatened opposition (£438 claimed)

44. The TM7A is a short online form that parties complete to extend the opposition period by one month. I do not intend to make a separate award for this. The opponent could have filed its opposition within the initial two-month window. The applicant's actions have no bearing on this part of the proceedings.

Preparing the Notice of Opposition and statement of grounds (£1,860 claimed)

45. On the standard costs scale this work is combined with considering the other side's defence and has a maximum value of £650. The opponent has separated the consideration of the applicant's defence and related correspondence from the preparation and filing of its opposition (see paragraphs 49 and 50 below). I find that to be appropriate in this case, given the volume of correspondence generated by the

⁹ TPN 2/2016.

applicant in the period between the opposition being filed and the defence being filed. I find it appropriate to award scale costs for the preparation and filing of the opposition.

46. For preparing and filing the opposition, an appropriate award on the standard scale of costs is £350.

Preparation for and attendance at the CMC (£1,195.50 claimed)

47. Based on the hourly rates provided, this amounts to 3–4 hours work. I find this to be a reasonable amount of time to spend on this issue, for all the reasons I have already given. I also bear in mind that the CMC was completely unnecessary.

48. For preparation and attendance at the CMC, I award the opponent actual costs of £1,195.50.

Considering other party's defence, correspondence, trade mark assignments, ownership changes and various miscellaneous submissions (£1,760 claimed)

49. The opponent has provided hourly rates for a partner and a senior associate. The amount claimed would be approximately 4–5 hours work at the lower hourly rate and I find this to be reasonable. Whilst the opponent did not have to respond to every letter sent to the tribunal by the applicant, it did have to monitor and consider each and every email and letter and keep on top of the changing landscape of ownership of the contested trademark. For all the reasons already given, off-scale costs are appropriate for this work and the claim is a reasonable one.

50. For considering other party's defence, correspondence, trade mark assignments, ownership changes and submissions, I award £1760.

Preparing and filing evidence in chief

51. I do not intend to award the opponent costs above the usual scale for the preparation and filing of its evidence. It selected the grounds to pursue and filed the

evidence it considered appropriate to make its case. I also bear in mind that the applicant did not file evidence; consequently, no response was required.

52. For preparing and filing its evidence, I award the opponent £1000 based on the standard scale of costs.

Preparing and submitting final submissions in support of costs (£2,765.50)

53. The opponent's cost submission is a single page letter and the annex reproduced above at paragraph 31. The assessment and preparation of costs requests is a normal part of engaging in proceedings, although on this occasion, the behaviour of the applicant has necessitated a request for costs above the usual scale. This would have required additional work, including a review of the file and its excessive material. However, the amount claimed is equivalent to approximately 7 hours work at the lower rate. I find this to be excessive, given the time claimed in respect of the CMC, which would have required considerable preparation. I find it reasonable to award one hour at the lower hourly rate.

54. For preparing and submitting final submissions in support of costs I award £365.

55. Taking all of this into account, the cost award is as follows:

Preparing and filing the notice of threatened opposition	£0
Preparing the Notice of Opposition and statement of grounds	£350
Preparation for and attendance at the CMC	£1,195.50
Considering the defence, correspondence, assignments, ownership changes and submissions	£1760
Preparing and filing evidence in chief	£1000
Preparing and submitting costs submissions	£365
Total	£4670.50

56. I order Global Trade Mark Services to pay Thierry Henry the sum of £4670.50. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Status of this decision

57. I note that the tribunal letter of 11 June 2024 gave the applicant a period in which to request a hearing, prior to the final withdrawal of its trade mark 3587268. This decision allows the applicant an appeal period in respect of the tribunal decision to withdraw its trade mark, as well as a period in which to appeal this costs decision.

Dated this 21st day of November 2024

Al Skilton

For the Registrar,

The Comptroller-General