

O/1177/25

TRADE MARKS ACT 1994

SUPPLEMENTARY DECISION ON COSTS

**IN THE MATTER OF UK REGISTRATION NOS. 910767093,
915524069, 916347502 & 905480298**

IN THE NAME OF

ENNISMORE INTERNATIONAL MANAGEMENT LIMITED

AND

**THE APPLICATIONS FOR DECLARATIONS OF THE INVALIDITY
THEREOF UNDER NOS. 506280, 506326, 506328 & 506865**

BY

SION O'CONNOR

BACKGROUND

1. On 29 September 2025, I issued a decision in these proceedings (BL O/0908/25). Mr Sion O'Connor ("the applicant") had applied for declarations of invalidity against four trade marks owned by Ennismore International Management Limited ("the registered proprietor"). The registered proprietor was wholly successful. At paragraph 78 I said:

"At the hearing, I indicated that I would invite the parties to make submissions on costs once I had issued my decision on the substantive matters. As the registered proprietor has been successful, it has 14 days from the date of this decision to file submissions on costs. The applicant will have 14 days from receipt of those submissions to make its own submissions on costs."

2. The registered proprietor filed written submissions on 10 October 2025. The applicant filed written submissions in response on 24 October 2025.

3. Section 68(1) of the Trade Marks Act 1994 ("the Act") is as follows:

"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."

4. Rule 67 of the Trade Marks Rules 2008, SI 2008 No. 1797, states that:

"The registrar may, in any proceedings under the Act or these Rules, by order award to any such party such costs as the registrar may consider reasonable, and direct how and by what parties they are to be paid."

5. Costs awards in this Tribunal are intended to be contributory, rather than compensatory. (This does not mean that, in appropriate circumstances, awards may not be made that approach full compensation. However, I note that the registered proprietor has not made such a request in the present case.) In order to preserve the contributory nature of any costs awards, represented and unrepresented parties are

subject to slightly different procedures. An unrepresented party is sent a costs proforma, in which it is invited to record the amount of time spent on the proceedings. This information is considered by the hearing officer and, if they are persuaded that it is reasonable, becomes the basis for calculating an award of costs, using the same sum per hour set out in the Civil Procedure Rules, Part 46. Unrepresented parties are informed that, if no costs proforma is returned, no costs award will be made, except in relation to official fees (not including fees for extension of time requests).

6. Awards of costs made to represented parties are usually based on a scale, set out in a series of Tribunal Practice Notices (“TPNs”). This scale is periodically updated and the one applying to these proceedings can be found in TPN 1/2023.¹ Therefore, I do not agree with the applicant’s submission that the registered proprietor has failed to follow the appropriate procedure by not filing a proforma.

7. The registered proprietor submits that the applicant’s conduct of the proceedings would warrant an award of costs greater than the standard scale, but it considered that the costs of making such a request might have proved disproportionate. It therefore seeks an award at the upper end of the relevant scale, amounting to £9,400. The applicant disagrees and submits that £2,500 would be fair and reasonable. I shall take account of both parties’ detailed submissions in the decision that follows.

Preparing a statement and considering the other side’s statement

8. The invalidation applications were filed on 10 July 2023 (CA 506280), 18 July 2023 (CA506326 and CA506328) and 27 December 2023 (CA506865). The first three were consolidated on 14 February 2024 and suspended. The fourth application was added to the group on 9 April 2024 and the evidence rounds set. The reason for the consolidation was the considerable overlap in the proceedings, and the registered proprietor accepts that this overlap meant that it was possible to reduce some of the costs of preparing documents.² However, it submits that:

“3.1. ... this still meant considerably more work than if there had been a single set of proceedings in relation to one mark. It was still necessary to

¹ <https://www.gov.uk/government/publications/tribunal-practice-notice-tpn-12023-costs-in-proceedings-before-the-comptroller>.

² Submissions, paragraph 3.1.

consider each separate invalidity filing and to respond to each. ... the costs of this process was [sic] exacerbated by the numerous grounds of attack included by Mr O'Connor in each case. This all increased the costs and complexity involved in drafting counterstatements."

9. The scale for this part of the proceedings ranges from £250 to £750 "*depending on the nature of the statements, for example their complexity and relevance*". The registered proprietor submits that an appropriate award would be £2,000 (4 x £500) "*i.e. not the maximum allowable but not the minimum either, to reflect the complexity, multiplicity of grounds and the fact that there were 4 sets of proceedings*".³

10. Some of the grounds brought in the first three applications were struck out. By the time the registered proprietor had to file its defence, the grounds had been reduced to sections 3(1)(b), 3(1)(c), 3(1)(d), 3(3)(b) and 3(6). The pleadings were largely identical across all four applications, the main difference being additional claims concerning the stylisation of UKTM Nos. 905480298, 915524069 and 916347502. Furthermore, the claims made under both sections 3(1)(b) and 3(1)(c) centred on the alleged descriptiveness of the registered proprietor's marks, and so were dealt with together in the counterstatement. The counterstatements themselves were also largely identical. I accept that the registered proprietor will have had to go through each of the application forms, but the pleadings are concise so it should not have taken a particularly long time to identify the commonalities between them. I consider that a fair award for this part of the proceedings would be £500 for the considering the first TM7 and preparing the first TM8, with £250 for each of the subsequent applications, amounting to £1,250.

Preparing evidence and considering and commenting on the other side's evidence

11. The registered proprietor submits that the applicant filed a large amount of evidence, which needed to be considered. It also argues that it had to file evidence to demonstrate that its marks had acquired distinctiveness, in case the applicant was successful in its arguments under section 3(1). However, it is not uncommon for parties defending their marks against such an attack to file evidence of use.

³ Paragraph 3.3.

Permission was given for the registered proprietor to rely on evidence filed in the parallel revocation proceedings, although I accept that the registered proprietor will have had to review this evidence for relevance to the present case.

12. It goes on to submit that the top of the scale (i.e. £2,600) should be regarded as a starting point and quotes the TPN as saying that “*The award could go over this range in exceptionally large cases but will be cut down if the successful party had filed a significant amount of unnecessary evidence.*” I agree with the registered proprietor that the fact that I did not consider the evidence going to acquired distinctiveness does not mean that it was unnecessary. Had I found that the marks were inherently descriptive, I would have needed to address it, and it was an appropriate precaution on the part of the registered proprietor to file it.

13. The applicant submits that the evidence filed in the present proceedings was largely identical to the evidence it filed in the revocations. It also retained an identical Exhibit numbering system for both sets of proceedings. I accept that the applicant believed that this would reduce the burden for the Registry and the proprietor. The registered proprietor has not raised this point in its submissions, so I shall not take it into account in calculating my award for this stage of the proceedings. However, I do note here that the approach made handling the evidence more difficult, as indicated by errors that crept into the consolidated indices used for the bundles. A sequential numbering system, following the structure of the witness statement, makes it easier to navigate one’s way through the evidence, particularly where, as here, it is fairly lengthy.

14. I agree that this is not a case where the evidence was light. However, I do not consider that this is a case where the evidence is exceptionally large to warrant an award higher than the top end of the scale. The applicant’s evidence in chief was not significantly over 300 pages. While the registered proprietor had to prepare some evidence specifically for this matter, it was also able to use evidence that had been prepared for previous proceedings. I do not think it appropriate to award an additional sum to reflect the fact that these were consolidated proceedings. The purpose of consolidation is greater efficiency in proceedings, including reduced costs. I consider that a fair award for this stage is £2,600.

Preparing for and attending a hearing (including procedural hearings) or submissions in lieu

15. The registered proprietor seeks costs in relation to a joint hearing on 27 September 2023 and a Case Management Conference (“CMC”) held on 9 September 2024, in addition to costs in relation to the main hearing. I shall consider each in turn.

The joint hearing of 27 September 2023

16. On 18 August 2023, the Registry issued a preliminary view to strike out the section 3(1)(a) and 5(4)(a) grounds relied upon in Cancellation Numbers 506280, 506326 and 506328. The applicant objected to the preliminary view and requested to be heard. Both parties attended and made their submissions. The decision was reserved. On 4 October 2023, the Registry wrote to the parties upholding the preliminary view.

17. The registered proprietor submits that it incurred significant costs in preparing for and attending the hearing and that it should be awarded costs of not less than £1,000. The applicant has made no submissions specifically relating to this joint hearing. This is what he has to say on the matter:

“3.5 Procedural Hearings: Mutual Litigation and Proportionality of Costs

The Proprietor seeks to recover £2,000 for two interim hearings – one on 27 September 2023 and the other on 9 September 2024 – asserting that they were ‘largely unsuccessful’ and therefore responsible for increasing costs [cite: Proprietor’s Submissions on Costs, Paragraph 2.6]. This oversimplifies the procedural history and ignores the Proprietor’s own actions which contributed to the length and cost of the proceedings.”

18. The applicant does not explain how he considers that the submissions relating to the joint hearing of 27 September 2023 oversimplify the procedural history. He makes comments elsewhere about the behaviour of the registered proprietor, using such terms as “trade mark bullying” and “misusing its trade marks”. These comments appear to be straying into the substantive matters, in particular, the claim of bad faith,

which I advised the applicant, who is a litigant in person, were not to be the subject of the submissions on costs. I shall therefore say no more about these submissions.

19. The applicant was the unsuccessful party in this joint hearing. I accept that the registered proprietor will have needed to prepare for it. The TPN gives the scale for preparation for and attendance at hearings as *“Up to £1900 per day of hearing, capped at £3900 for the full hearing unless one side has behaved unreasonably.”* This means that the award for a hearing that lasts a day could go up to £1,900. In this context, I consider that £1,000 is rather high for a joint hearing that lasted less than half a day. In my view, £500 would be a fair award for the joint hearing.

The CMC of 9 September 2024

20. The CMC had been called to discuss the applicant’s evidence in chief, the volume of which was, in the Registry’s preliminary view, excessive and a request from the registered proprietor to strike out at least some of the grounds pleaded by the applicant. By the time the CMC was held, the applicant had filed amended evidence and requested that the Tribunal should issue a summary judgment in its favour. The outcome of the CMC was that the section 3(6) claim was struck out in two of the actions, but the remaining claims were to proceed, and the applicant’s request for summary judgment was not successful. Therefore, I consider that it is fair to make an award for the CMC that is slightly lower than the award for the joint hearing, to reflect the balance of success. I award the sum of £350.

The main hearing of 14 May 2025

21. The registered proprietor seeks an award of £1,900 *“to reflect the fact that all of the surviving grounds of invalidity were pursued in full by Mr O’Connor – and all failed”*.⁴ I do not consider that the fact that the losing party pursued, and failed in, all the grounds is in itself a reason to award costs at the top end of the scale. The individual circumstances of the case must be taken into account.

22. I am invited by the registered proprietor to note that the applicant filed further correspondence on 11 May 2025 and 12 May 2025 before the final hearing, and that the applicant’s “final submissions” ran to 67 pages. The applicant states that the

⁴ Written submissions, paragraph 5.11.

correspondence of 11 May 2025 was not a late submission, but rather a correction to the reissued consolidated indices. With regards to the submissions of 12 May 2025, the applicant refers me to the letter of 11 February 2025 from the Registry setting the date for the hearing. It said:

“Should you wish to provide the Hearing Officer with written submissions, please send them for the urgent attention of the Hearings Clerk in word or PDF format to tribunalhearings@ipo.gov.uk. Any submissions should be received by **14.00, 2** working days before the hearing **Monday 12 May 2025** and copied to the other side; late submissions will not be taken into account if they do not reach the Hearing Officer in time for the hearing.”

23. He also submits that the claim that the final submissions amounted to 67 pages is misleading, as 31 pages were taken by the written submissions of 4 December 2024. The applicant explains that these had been attached to the final submissions so that there was a single reference document that could be used at the hearing.

24. I shall deal with the submissions of 12 May 2025 first. The letter from the Registry makes it clear that the applicant was entitled to file such submissions. I agree that they were quite long (36 pages). Litigants in person do not have to file skeleton arguments ahead of a hearing, unlike represented parties. In my view, if they do file written submissions, it is more helpful than unhelpful, as it gives the other party notice of the points that will be argued orally. While I accept that 36 pages is on the lengthy side, and the total amounted to 67 pages, it is not unknown for submissions filed earlier in the proceedings to be attached to represented parties' skeleton arguments (which can also sometimes be quite long), so I do not think that this should be held against the applicant.

25. Turning to the email of 11 May 2025, I consider that this would not have required much time from the registered proprietor. As the applicant says, it notifies the Registry and the other party of three errors in the consolidated indices. The documents not listed would have been seen earlier in the proceedings by the registered proprietor. Admittedly, it was filed fairly late in the day, as the revised version of the consolidated indices had been sent to the parties on 27 March 2025. However, the registered proprietor has not explained in detail how much further review was needed.

26. The hearing lasted the allotted 3 hours. I accept that there was a significant amount of evidence and submissions from the applicant with which Counsel for the registered proprietor needed to familiarise himself. I consider that a fair award for the main hearing is £1,300.

Costs award

27. I make an award to the registered proprietor of £6,000, which is calculated as follows:

£1,250 for preparing statements and considering the other side's statements;
£2,600 for preparing evidence and considering and commenting on the other side's evidence;
£500 for preparing for and attending the joint hearing of 27 September 2023;
£350 for preparing for and attending the CMC of 9 September 2024;
£1,300 for preparing for and attending the main hearing.
£6,000 in total

28. I order Sion O'Connor to pay Ennismore International Management Limited the sum of £6,000. This sum is to be paid within twenty-one days of the expiry of the appeal period, which I hereby set to begin on the date of this supplementary decision, or within twenty-one days of the final determination of this case if any appeal against my decision is unsuccessful.

Dated this 17th day of December 2025

Clare Boucher
For the Registrar,
Comptroller-General