

O-276-16

TRADE MARKS ACT 1994

**APPLICATION Nos. 3055444 AND 3077984
BY ALPHA-TEK ASSOCIATES LTD
TO REGISTER THE TRADE MARKS**

CEM 11+
CEM 11 plus
(a series of two marks)

AND



**OPPOSITIONS Nos. 402725 AND 403772
BY THE UNIVERSITY OF DURHAM**

AND

**APPLICATION Nos. 3057993 AND 3057994
BY THE UNIVERSITY OF DURHAM
TO REGISTER THE TRADE MARKS**

CEM 11 plus

AND

CEM 11+

**AND OPPOSITIONS Nos. 402965 AND 402964
BY ALPHA-TEK ASSOCIATES LTD**

AND

APPLICATION No. 500438 BY AMIT MATALIA FOR TRADE MARK No. 2654219

CEM

**OWNED BY THE UNIVERSITY OF DURHAM
TO BE DECLARED INVALID**

Background

1. On 4th April 2016 I issued a decision on behalf of the registrar in these consolidated opposition proceedings between, on the one hand, Mr Amit Matalia and Alpha-Tek Associates Ltd (“Alpha”) and, on the other hand, the University of Durham (“the University”).

Overall outcome

2. I described the overall outcome of the consolidated proceedings as follows:

“i) Mr Matalia’s invalidation action fails. The University’s trade mark registration 2654219 remains registered.

ii) Alpha’s oppositions to the University’s applications 3057993 and 3057994 fail. These applications are to proceed to registration.

iii) The University’s oppositions to Alpha’s applications 3055444 and 3077984 succeed. These applications are refused.”

Costs

3. As to costs, I noted that the University had been successful in all five actions and was entitled to a contribution towards its costs calculated on the basis of the published scale¹. I found that if it had employed legal representatives, the University would have been entitled to an award of costs of £4100 made up of:

£600 for considering Mr Matalia’s and Alpha’s application for invalidation and oppositions and filing defences

£450 for filing notices of opposition to Alpha’s applications

£400 for the official fees for two oppositions

£2000 for filing evidence and considering Mr Matalia/Alpha’s evidence

£150 for attending a CMC

£500 for filing written submissions

4. There was no question that the University was entitled to a costs award of £400 to cover the filing fees for its oppositions. However, I bore in mind that the University represented itself, so would not have had the expense of professional representatives’ fees. I noted that it was important that the costs awarded to a party do not exceed its actual costs. I therefore invited the University to submit a breakdown of its actual costs, including accurate estimates (if necessary) of the number of hours spent on each of the matters listed in paragraph 3 above and an hourly rate for the person or persons who undertook the work.

¹ Tribunal Practice Notice 4/2007.

5. I made it clear that the registrar will not usually award such costs on an hourly rate of more than £20 per hour. Further, that the scale costs shown above would act as a ceiling for costs, as they would do if the University had used an external legal representative. This means that costs above the specified amounts would not be recoverable.

6. I directed that the required breakdown of costs should be filed within 21 days of the date of this decision and copied to Mr Matalia. Mr Matalia/Alpha would have 14 days from the date of receipt of the University's breakdown of its costs in which to file written submissions (if so desired) on the reasonableness of the claim. I subsequently received a breakdown of costs from the University as follows.

CONSIDERING MR MATALIA'S AND ALPHA'S APPLICATION FOR INVALIDATION AND OPPOSITION AND FILING DEFENCES			
Chief Operating Officer	Review, approval and signature	2 hours	£40
Head of Legal Support	Review and approval	2 hours	£40
Legal Support Officer	Preparation, research, drafting and administration	15 hours	£300
Director of CEM	Instructions, review and approval	2 hours	£40
TOTAL		21 hours	£420

OFFICIAL FEES FOR TWO OPPOSITIONS			£400
FILING NOTICES OF OPPOSITION TO ALPHA'S APPLICATION			
Chief Operating Officer	Review, approval and signature	2 hours	£40
Head of Legal Support	Review and approval	3 hours	£60
Legal Support Officer	Preparation, research, drafting and	10 hours	£200

	administration		
Director of CEM	Instructions, review and approval	2 hours	£40
TOTAL		17 hours	£340
FILING EVIDENCE AND CONSIDERING MR MATALIA/ALPHA'S EVIDENCE			
Chief Operating Officer	Preparation of witness statements, review of all other evidence compiled. Final approval and signature.	8 hours	£160
Head of Legal Support	Review and approval of all documents filed.	4 hours	£80
Legal Support Officer	Research, consideration of all evidence supplied by Mr Matalia, preparation of University evidence, drafting and administration.	40 hours	£800
Director of CEM	Research, supplying evidential documentation to Legal Support.	6 hours	£120
Head of Assessment Development CEM	Research, supplying evidential documentation to Legal Support.	2 hours	£40
Business Operations Manager CEM	Research, supplying evidential documentation to Legal Support.	2 hours	£40
TOTAL		62 hours	£1240
ATTENDING A CASE MANAGEMENT CONFERENCE			
Head of Legal Support	Preparation and attendance	2 hours	£40
Legal Support Officer	Preparation and attendance	3 hours	£60
TOTAL		5 hours	£100

FILING WRITTEN SUBMISSIONS			
Chief Operating Officer	Review, approval and signature	1 hours	£20
Head of Legal Support	Review and approval.	2 hours	£40
Legal Support Officer	Preparation, research, drafting and administration.	16 hours	£320
TOTAL		19 hours	£380
TOTAL COSTS CLAIMED			£2880

7. I was informed that the hourly rate to the University for all the University staff involved exceeded £20 per hour. Further, that these costs represented only a small proportion of the University's costs.

8. Mr Matalia filed written submissions in which he submitted that:

- i) The time taken by the University does not properly take into account that much of the same material was relied on for the different types of proceedings, and is generally inflated.
- ii) A qualified legal person would only have taken a quarter of the time claimed by the University.
- iii) There was unreasonable duplication and triplication of time spent checking and rechecking the work of other University staff.
- iv) Some of the time spent on preparing evidence was because it was not filed in an acceptable form to begin with.
- v) The University should not be able for claim for the cost of 2 people to attend the case management conference when only one could speak.
- vi) It would be reasonable to award the University £1000 in costs.

9. There is no doubt that the Registrar has the power to award reasonable costs. Rule 67 of the Trade Marks Rules 2008 provides as follows:

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.

10. Mr Matalia objects to the University's claims. I do not accept that there is anything in these objections. A party without legal representation is bound to take

longer than a party with legal representation because of their lack of familiarity with the subject matter and the process. That is not a reason to deny reasonable costs. Similarly, one would expect an approval process so having one or two more people sign off the work, usually including the client. This is not unreasonable. I see nothing unreasonable about the time claimed for any of the activities. I note that the largest single cost to the University was the time spent reviewing Mr Matalia's lengthy evidence.

11. However, costs awarded by the registrar are not intended to permit parties to recover their full costs. The published scale is intended to yield a reasonable contribution to the actual costs. In the case of a litigant in person, this is sometimes achieved by reducing scale costs by 50%. I find that the University is entitled to recover the official opposition fees of £400. On top of that, I will award 50% of the usual scale costs as a contribution towards the cost of the University's time. This comes to £1850, which brings the total award to £2250. This is an appropriate contribution towards the University's actual recoverable costs of £2880.

12. I therefore order Mr Amit Matalia and Alpha-Tek Associates Ltd to pay the University of Durham £2250. Mr Matalia and Alpha shall be jointly and severally liable to pay these costs.

13. My decision of 4th April is the subject of an appeal to the Appointed Person. This decision on costs should not therefore take effect until the appeal against decisions on the substantive issues is concluded. Subject to any different directions by the Appointed Person, I therefore order that the costs specified in paragraph 11 above be paid within 14 days of the conclusion of the appeal proceedings.

Dated this 6th day of June 2016

**Allan James
For the Registrar**