

O/300/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2553346
BY SIMON LAWTHER TO REGISTER THE
TRADE MARK**



IN CLASS 7

AND

**APPLICATION No. 2553366
BY RUBY MASON ENGINEERING TO REGISTER THE
TRADE MARK**

Powerspark

IN CLASS 7

AND:

**CONSOLIDATED OPPOSITIONS THERETO
UNDER NOS. 101135 & 101425 BY THOMAS IBBOTSON**

1. On 22 June 2012, the substantive decision in these proceedings was issued. In that decision, I said:

“41. SL has been successful and is entitled to a contribution towards the cost of the time he has spent on these proceedings. The Registrar usually operates on a published scale of costs – Tribunal Practice Notice 4 of 2007 refers. However, since SL has not been professionally represented during the proceedings, an award made from the published scale might be larger than his actual expenditure...”

43. Consequently, SL should produce an estimate of his costs, including the number of hours that he has spent on these proceedings, broken down by category of activity, i.e. reviewing the notices of opposition and completing the counterstatements, preparing his evidence and reviewing TI’s evidence and written submissions. This should be filed within 21 days of the date of this decision and should be copied to TI who will have 10 days from receipt of the estimate to provide written submissions on costs (and only on costs). I will then issue a supplementary decision covering the costs of these proceedings. “

2. Both parties responded to this direction; SL in a letter dated 29 June 2012 and TI in a letter dated 11 July 2012. In his letter SL said:

“...I now supply an analysis of costs relating to my defence of the opposition (number 101135) to my original application number 2553346.

I did not employ anyone to represent me or prepare paperwork for this case however all submissions were made in consultation with and upon the advice of the finance manager of Powerspark Ignition Ltd. As this person does not live locally to me this has involved posting correspondence, also telephone calls, e-mails etc and at least two separate face to face meetings. I have not claimed separately for this employee’s time, merely my own time. However, there were expenses in connection with travelling to the meeting which I have included. On that basis I consider that preparing evidence and considering and commenting on the other side’s evidence took a total of 65 hours work...”

3. In reaching a conclusion, I am guided by the comments of the appointed person, Mr Richard Arnold QC in BL O/160/08 *South Beck*, when he said:

“36. In my judgment the approach which should be adopted when the Registrar is asked to make an award of costs in favour of a litigant in person is as follows. The hearing officer should direct the litigant in person pursuant to r. 57 of the 2000 Rules to file a brief schedule or statement setting out (i) any disbursements which the litigant claimed he has incurred, (ii) any other financial losses claimed by the litigant and (iii) a statement of the time spent by the litigant in dealing with the proceedings. The hearing officer should then make an assessment of the costs to be awarded applying by analogy the principles applicable under r. 48.6,

but with a fairly broad brush. The objective should be to ensure that litigants in person are neither disadvantaged nor overcompensated by comparison with professionally represented litigants.”

4. SL’s break down of the time spent and costs incurred by him are as follows:

- Reviewing TI’s notice of opposition in no. 101135 - 5 hours;
- Preparation of SL’s counterstatement in no. 101135 – 2 hours;
- Reviewing TI’s evidence and preparing evidence in response – 21 hours;
- Submission of form TM9 to put SL’s evidence into the correct format – 4 hours;
- Reviewing TI’s evidence in reply – 10 hours;
- Preparing evidence in response to TI’s evidence in reply – 15 hours;
- Travelling to consultation meetings with his finance manager and web consultant – 4 hours;
- Mail costs, telephone calls, photocopying, printing, stationery, fuel for travelling to meetings - £105;
- 2 hours consultation and research re web archiving etc with the company dealing with technical administration of SL’s website - £130.

5. In his letter TI said, inter alia:

“I have received [SL’s] estimate for costs. On reading through his claim for costs I can only say that it is totally unrealistic. In fact, the bill is so ludicrous that it is difficult to comment.

He is claiming that he spent every hour of every day for two weeks reviewing the case i.e. 65 hours – this simply cannot be true. I shouldn’t think he spent any more time on it than I did. I spent about 8-10 hours in total.

He is claiming various other costs including £35 for fuel going to meetings – equivalent to driving 250+ miles.”

6. In approaching this matter, I must keep in mind that TI’s oppositions were based upon bad faith and passing-off. These are complex grounds which, by their very nature, are heavily evidence dependent and relate to concepts with which an unrepresented applicant, such as SL, is likely to have taken time to familiarise himself. While in his letter, mentioned above, SL appears to indicate that the time spent only relates to one of his trade mark applications, as these proceedings were ultimately consolidated

(following the filing of TI's evidence in chief), I have inferred that the time spent actually refers to both applications.

7. In approaching the reasonableness or otherwise of the time SL estimates he spent on dealing with the various phases of what I infer is the consolidated oppositions, I note that in relation to the filing of a form TM9 (which became necessary because of a default on SL's part and for which no contribution is appropriate in any case), SL claims he spent 4 hours completing the form, a copy of which is shown as an annex to this decision. Given the very simple nature of this form, SL's claim of 4 hours is, in my view, excessive to say the least, and has, as a consequence (and bearing in mind the comments of TI), caused me to approach the other figures provided by SL with a degree of caution.

8. Bearing in mind the nature of the pleaded grounds and defence, and the nature and extent of the evidence provided by both parties, applying the "broad brush" approach mentioned above, I award costs to SL on the following basis:

Considering TI's statements and preparing statements in reply:	£100
Reviewing TI's evidence and preparing evidence in response:	£500
Disbursements/travelling/meeting:	£150
Total:	£750

9. The period for appeal against the substantive decision runs concurrently with the period for appeal against this supplementary decision.

10. I order Mr Thomas Ibbotson to pay Mr Simon Lawther the sum of **£750** as a contribution towards the costs incurred Mr Lawther in dealing with these proceedings. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated 6th of August 2012

**C J BOWEN
For the Registrar
The Comptroller-General**

ANNEX



INTELLECTUAL PROPERTY OFFICE

05045017 0001 390534 TRD
0900711 100-00 TRIPLE

Form TM9
Fee £100

M1-IPD-NEWPORT
07/OCT/2011

Trade Marks Registry
Concept House
Cardiff Road
Newport
South Wales
NP23 5UG

Request for an extension of time (See note 1)
Please read the notes below before filling in this form.

1. Trade mark number. (Please put an 'M' in front of Madrid marks.)	(Lowest) Class 2553346 / 2553336
2. When does (or did) the time period expire?	September 1 st 2011
3. If the request is in respect of a published mark which is in dispute, what is the opposition, invalidation, revocation, or rectification number? (See note 2.)	101135 + 101425
4. How much more time do you want from the date stated at 2 above?	5 weeks
5. Why do you want more time? (Use a separate blank sheet if there is not enough space for your answer.)	Format of evidence was incorrect on initial submission
6. Full name of the person or company making this request.	Simon Lawther
7. Your name and address (including postcode) or your agent's name and address, if you have one.	16 Swaledale Close, Bronsgrove B60 3PY
8. Your signature.	
Your name in BLOCK CAPITALS	SIMON LAWTHOR
Date.	3 rd October 2011
9. Name and daytime phone number of the person we should contact in case of query.	01527 889453 S Lawther
Your reference no.	Powerspark
Number of sheets attached to this form.	This is sheet 1 of 1

Notes

- This form is for use where the request is being made for any of the following reasons:
Extension to the period for resolving filing deficiencies;
Extension of time after publication;
Any request for a retrospective extension;
All other requests (including those following an ex-parte hearing) should be made by letter without payment of a fee.
- If the request is for a trade mark which is in dispute, you must send a copy of this request to everyone else involved in the case.