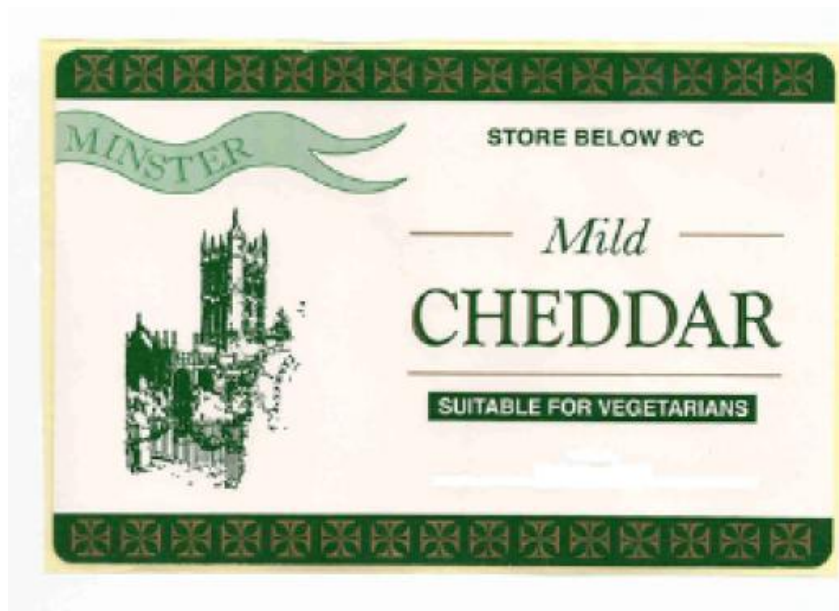


O-060-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 2571522  
IN THE NAME OF  
THE DAIRY KOMPANY LTD  
IN RESPECT OF THE TRADE MARK**



**AND**

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO  
UNDER NO 84292 BY  
FAYREFIELD FOODS LIMITED**

## Background

1. On 26 November 2012 my decision in these proceedings (BL O-467-12) was issued. In that decision I said:

### “Conclusion

**36. As a consequence of my decision above, FFL’s request to invalidate Dairy’s trade mark fails.**

### Costs

37. Dairy has been successful and is entitled to a contribution towards the cost of the time it has spent on these proceedings. The Registrar usually operates on a published scale of costs. However, since Dairy has not been professionally represented during the proceedings, an award made from the published scale might be larger than its actual expenditure. In BL O/160/08 *South Beck*, Mr Richard Arnold QC, sitting as the appointed person, stated:

“32. Secondly, counsel for the opponent submitted that, if CPR r. 48.6 was applicable, the hearing officer had misapplied it. In support of this submission he pointed out that CPR r. 48.6(4) provides:

The amount of costs to be allowed to the litigant in person for any item of work claimed shall be-

(a) where the litigant can prove financial loss, the amount that he can prove he has lost for time reasonably spent on doing the work; or

(b) where the litigant cannot prove financial loss, an amount for the time reasonably spent on doing the work at the rate set out in the practice direction.

The Part 48 Practice Direction provides at paragraph 52.4 that the amount which may be allowed to a litigant in person under rule 46.8(4) is £9.25 per hour. Counsel submitted that the hearing officer appeared to have awarded the applicant two-thirds of the scale figure which he would have awarded a represented party, and that this could not be justified since the opponent had not proved any financial loss and was very unlikely to have spent over 160 hours on the matter.....

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.”

Under the current practice direction, the amount allowed to a litigant in person is £18 per hour.

38. Consequently, Dairy should produce an estimate of its costs, including the number of hours spent on these proceedings, broken down by category of activity, i.e. reviewing the application for invalidation, completing its counterstatement and reviewing FFL’s evidence. **This estimate should be filed within 21 days of the date of this decision and should be copied to FFL who will have 14 days from receipt of the estimate to provide written submissions.** I will then issue a supplementary decision covering the costs of these proceedings.

**39. The period for any appeal against this decision will run concurrently with the appeal period for the supplementary decision on costs and so will not commence until the supplementary decision is issued.**

2. In a letter dated 11 December 2012, Dairy responded to paragraph 38 of my decision. In a telephone conversation with the Trade Marks Registry (“TMR”) on 1 February 2013, FFL confirmed that it would not be filing any submissions. In its letter Dairy said:

“There were 2 staff involved in the preparation of the defence both directors of the company. They are paid an hourly rate of £35.

The total number of hours expended by staff of the company on this defence was 32 hours...at total cost of £1120.

The total defence was conducted by staff of the company without direct legal support.”

3. Dairy’s breakdown of its time spent on the application is as follows:

- Investigating the basis of FFL’s objection and familiarising itself with how to file a defence – **12 hours**;
- Preparing and filing a defence – **8 hours**;
- Reviewing FFL’s evidence – **6 hours**;
- Liaising with the TMR and making a decision not to file evidence – **4 hours**;
- Reviewing the decision of 26 November 2012 – **2 hours**.

4. As Dairy have not claimed that it incurred any disbursements or that it has suffered any financial loss as a result of its defence of its registration, I have only the time reasonably time spent by it on these proceedings to consider. Given that Dairy had to familiarise itself with the basis of FFL's application and how to go about defending its registration, I do not think it was unreasonable for it to have allocated two of its officers to deal with the matter. However, even with that in mind, it should not reasonably have taken the 12 man hours Dairy claim for this aspect of the work. Similarly, I do not think it ought reasonably to have taken 8 man hours to prepare and file a counterstatement consisting of 2 pages and 8 short paragraphs or 6 man hours to evaluate FFL's evidence which consisted of a 1 page witness statement, 4 relatively light exhibits and 2 pages of written submissions. While I am prepared to accept that Dairy's officers had to discuss and determine whether to file evidence in response to FFL's evidence and that this may have required one of its officers to discuss the matter with the TMR, once again I do not think that this ought reasonably to have taken 4 man hours to achieve. Finally, I do accept that it was necessary for Dairy to review my 17 page decision and (if it was pursuing an award of costs) to provide the breakdown mentioned in my decision.

5. In view of my comments above, I am prepared to accept that the following time was reasonably spent by Dairy in defence of its registration:

Investigating the basis of FFL's objection and familiarising itself with how to file a defence – **6 hours**;

Preparing and filing a defence – **4 hours**;

Reviewing FFL's evidence – **4 hours**;

Liaising with the TMR and making a decision not to file evidence – **3 hours**;

Reviewing the decision of 26 November 2012 – **2 hours**.

6. That amounts to a total of 19 hours. At the rate allowed to a litigant in person specified in the practice direction mentioned above i.e. £18 per hour, Dairy are entitled to a contribution towards its costs in the amount of £342.

7. I order Fayrefield Foods Limited to pay The Dairy Kompany Ltd the sum of **£342** as a contribution towards the costs incurred by it 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.

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

**Dated this 6th day of February 2013**

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