

SUPPLEMENTARY DECISION

**IN THE CONSOLIDATED MATTERS OF
TRADE MARK REGISTRATION No. 2575691
STANDING IN THE NAME OF AGILITISE LIMITED
AND A REQUEST FOR A DECLARATION
OF INVALIDITY THERETO UNDER No.500015
BY PREMIER EVENTS AND LEISURE COMPANY LIMITED**

AND

**IN THE MATTER OF APPLICATION Nos. 2640199 & 3008660
BY PREMIER EVENTS AND LEISURE COMPANY LIMITED
TO REGISTER A DEVICE MARK AND A SERIES OF TWO WORD AND DEVICE
MARKS BOTH IN CLASSES 35, 41 & 43
AND IN THE MATTER OF OPPOSITIONS
THERETO UNDER Nos. 400221 AND 400934 BY AGILITISE LIMITED**

- 1) On 2 December 2014 I issued decision O-511-14 in which I found in favour of Premier Events and Leisure Company Ltd (PEL). At the hearing it was agreed that the decision would be issued and that both parties would then have the opportunity to provide written submissions on costs.
- 2) Both sides have provided comments which I shall refer to as and when necessary.
- 3) In its submissions, Agilitise Ltd (AL) contend that PEL should not receive any costs despite my finding in favour of them in all three cases. AL states:

“4. We contacted Premier’s Attorneys on behalf of AL on 3 April 2013 to attempt to negotiate a settlement between the parties, prior to the filing of the invalidation application and prior to the filing of either opposition. Upon discussing the matter with Premier’s Attorneys, we were advised by the Attorneys that they did not feel they could recommend to their client that an amicable agreement should be reached between the parties. We enclose a copy of Premier’s Attorney’s letter of May 2013, confirming that the settlement proposal put forward on behalf of Agilitise is not of interest to Premier and that Premier is not comfortable with the idea of co-existence. We also enclose a copy of a letter received from Premier’s Attorney’s on 27 September 2013 advising that Premier is not interested in negotiating a Co-existence agreement with Agilitise.

5. We indicated to Premier’s Attorneys throughout the proceedings that Agilitise remained willing to explore the possibility of reaching an amicable settlement. Premier’s Attorneys subsequently suggested the possibility of negotiating a settlement in July 2014. If the parties had commenced settlement discussions earlier, the prolonged costs and time of the proceedings and the hearing could

have been avoided if a settlement had been reached, as this would have reduced costs for both parties in particular.

6. Audra Smith of Agilitise contacted Mr Crowley directly in December 2013 in connection with negotiating a settlement; however, she received no response. This was confirmed in Gerald Crowley's third witness statement dated 24 January 2014 (at paragraph 14).

7. We believe Premier's refusal to enter into settlement discussions in 2013 is tantamount to refusing to mediate. It is in the interests of good administration of the trade mark system, and in particular the Tribunal Section of the UK Intellectual Property Office for parties to explore settlement properly (subject to the application of the criteria set down in *Halsey v Milton Keynes General NHS Trust* [2004] EWCA Civ 576) and for them to state their case appropriately.

8. Premier's Attorneys filed a large volume of evidence on behalf of Premier; however, the majority of the evidence was undated and some parts of the evidence were inconsistent in terms of the dates indicated. We requested cross-examination of Mr Gerald Crowley at the hearing due to the fact that a number of inconsistencies in his evidence necessitated questioning. It was only at the hearing during cross-examination that Mr Crowley detailed the different parts of Premier's business. Premier requested cross-examination of Audra Smith at the hearing. We are not aware of the reason behind such a request, nor are we aware that Premier gained anything from the cross examination. It seems therefore that Premier requested cross examination purely as part of a "tit for tat" exercise.

9. Mr Crowley sought to introduce fresh evidence at the hearing, in particular in terms of referring to his qualifications. Although we still are unable to identify which particular services Premier relied upon in the above consolidated proceedings, we believe cross-examination of Mr Crowley was necessary in order to obtain some information concerning Premier's business. We requested this on several occasions from Premier's Attorneys but received nothing of substance."

AND:

"11. Finally, we suggested to Premier's Attorneys that Agilitise would amend the specification of services covered by UK trade mark registration No. 2575691 by inserting a limitation. We enclose copies of our correspondence of 29 April 2013, 9 July 2014 and 22 August 2014 to Premier's Attorneys in connection with this point. The limitation suggestion put forward on behalf of Agilitise was rejected by Premier. Upon enquiring with Premier's Attorneys which particular wording Premier would accept, we were advised that it was not up to Premier to tell us which wording the company would accept. We raised the question because it was unclear from the evidence filed by Premier which services in particular were of interest to the company.

12. We therefore request that no costs are made in Premier's favour, but that they are made in Agilitise's favour, due to the fact that the costs of the proceedings and the hearing could have been avoided had the parties negotiated a settlement in 2013 when we attempted to do so on behalf of Agilitise. In addition, cross examination of Mr Crowley was necessary in order to clarify the poor quality evidence filed by Premier."

4) AL's submissions stated that copies of correspondence between the two sets of agents were attached but there were no attachments to the submissions. However, attached to the submissions of PEL were copies of the correspondence between the parties.

5) AL have made a number of allegations regarding the evidence of PEL and the cross examinations. I accept some of the criticism regarding the evidence of PEL but this would also relate to the evidence of AL, and indeed most cases before the Registry. There were a couple of minor inconsistencies in dates which were easily explained by the witness. The issue of the total business of PEL was addressed in cross examination but Mr Crowley made it clear that his written evidence related only to that under the mark in suit not services provided under other marks. As to his seeking to provide evidence at the hearing, this was in response to Mr Woods questioning if any training or development took place at all. Mr Crowley merely mentioned that he was a qualified Belbin practitioner and later mentioned some of the theories they use at team building days to provide team development in a fun and social setting. The services offered by PEL were set out in their evidence quite clearly. Inevitably in any cross examination there is a certain amount of light shed onto the evidence filed, but this applies equally to Ms Smith's evidence.

6) Moving onto the negotiations between the parties, it would appear from the correspondence that PEL's position was consistent throughout. They believed that confusion would occur if AL continued to use the device element. They made a series of offers to pay for the partial rebranding that AL would face in removing the device element from its leaflets, website etc. These ranged from £2,000 to £7,500 and were all rejected by AL who in turn reduced its demands from £25,000 to £10,000. The fact that PEL refused to negotiate a co-existence agreement does not equate to a refusal to mediate, it simply reflects a consistent view regarding the damage to its business caused by AL continuing to use the device element.

7) In its submissions, PEL does not seek additional costs on the initial parts of setting the case in motion as it regards these as being "normal" events in such undertakings. They make certain criticisms of AL's evidence such as the repetition whereby statements and attached submissions which were almost identical were provided but the alterations were such that the whole document had to be studied to be certain that nothing additional had been included. They also criticise the manner that AL approached the action and the fact that the hearing had to be moved.

8) I accept that AL's behaviour in this case has been, at best, pernicky, I do not believe that it warrants costs off the scale. I will therefore remain within the Registry scale of costs in making my award.

COSTS

Preparing statements and considering the other side's statements x3	£900
Preparing evidence and considering the evidence of the other side	£1,600
Expenses	£200
Preparing for and attending the final hearing	£1500
Cross examination expenses	£186.50
TOTAL	£4,386.50

9) I order Agilitise Ltd to pay Premier Events and Leisure Company Ltd the sum of £4,386.50. This sum 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 this 27th day of January 2015

**George W Salthouse
For the Registrar,
the Comptroller-General**