

# SUPPLEMENTARY DECISION

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION No. 3231633**

**STANDING IN THE NAME OF**

**LAURELLE LONDON LIMITED**

**AND**

**IN THE MATTER OF A REQUEST FOR A DECLARATION**

**OF INVALIDITY THERETO UNDER No.502604**

**BY KATHLEEN DEAYTON**

## **BACKGROUND**

1) It has been drawn to my attention that the decision issued in this matter on 1 April 2021 contained two typographical errors. Specifically, paragraph 5 of the decision which stated that only Laurelle London Ltd (hereinafter LL) provided evidence, when I clearly summarised Ms Deayton's (hereinafter KD) evidence at paragraph 26 of my decision. Paragraph 5 should therefore have started "Both parties provided evidence". Also, paragraph 30 stated:

"30) The invalidity action under sections 5(2)(b) and 3(6) failed and trade mark 3231633 will remain on the register."

When it should have stated:

"30) The invalidity action under sections 5(1), 5(2)(a) and 3(6) failed and trade mark 3231633 will remain on the register."

2) These errors are plainly an irregularity in procedure and capable of being corrected under Rule 74. Consequently, I give the parties notice that paragraphs 5 and 30 of the decision will be amended as stated above and apply as though that paragraph had appeared in the original version of the decision.

3) In my decision I set out some of the submissions made by LL regarding an award of costs off the scale. I gave both parties an opportunity to comment further in written submissions. On the 8<sup>th</sup> April

2021 Mr Aikens on behalf of LL provided his submissions. I allowed KD seven days to reply. A response was received on 15 April which contained the following:

“We have received the email of the 8th April from the Agents for the Proprietor and the accompanying Submission on Costs.

We do not accept the allegation regarding "the Applicant's poor and unreasonable behaviour" and consider that the Proprietor's fall back position is excessive. It would be much more appropriate to reduce the claimed costs by a further 50%.

The Proprietor has, we believe, achieved significant sales of their "CHOSEN" perfume, whereas the sales achieved by the Applicant have been minimal.”

4) The following day, outside the seven-day limit, a further letter regarding costs was received. This focussed almost entirely upon the CMC costs. The letter read:

“Further to my letter of 15 April 2021, I confirm again that we do not accept the allegation of "the Applicant's poor and unreasonable behaviour".

The Applicant has requested that, regardless of the outcome, off the scale costs be awarded to her in relation to the endless times she had to amend her TM26(1) because of the Proprietor's unreasonable objections.

The Applicant was perfectly entitled to request that an extra ground be added in to her TM26(1), which the Registry in their preliminary view allowed. It was the Proprietor who requested a CMC to get the 3(6) ground struck out. The Applicant adhered to the Hearing Officer's request to amend her TM26(1) in relation to the Proprietor's objections and when she did so, he objected to that and wanted that struck out.

This poor and unreasonable behaviour went on, causing a nearly 9 month delay in getting a substantive hearing, at substantial time and costs to the Applicant. The Proprietor's representative, Mr Aikens, after confirming he would attend the final CMC on the date given by the Hearing Officer, then said, about a week later, that he could not make that date and postponed it to another date suitable for him and the Hearing Officer delaying it a further 2

weeks, which we did not deem as "exceptional reasons" as the Proprietor could have found alternative representation.

After Mr Aikens delayed the final CMC to determine whether or not the Applicant's Without Prejudice evidence could be admitted into a substantive hearing and how they would support bad faith, he then decided that it was not worth him attending the final CMC, which he had requested 9 months earlier.

We agree that Mr Aikens is entitled to a contribution towards his inflated excessive costs but that the time and costs to the Applicant also need to be taken into consideration because of their unreasonable objections, for which the Applicant requested an off the scale award, regardless of the outcome.

We believe that costs should be awarded to the Applicant for the Proprietor's unreasonable objections and behaviour and should be taken into consideration."

5) Attached to this was a six-page letter dated 20 July 2020 which also related to the costs associated with the 2<sup>nd</sup> abandoned CMC. In my earlier decision at paragraph 32 I stated regarding KD's submission for the main hearing:

"32) I also note that much of the thirty-nine pages of written submissions consisted of a rehash of the evidence, with additional material being included. Additional evidence was submitted on both the day before the hearing and the morning of the hearing, and further written submissions filed 30 minutes prior to the start of the hearing. Much of this was not copied to the other party."

6) There is no question in my mind that the grounds included in the invalidity could and indeed should have been raised in the initial opposition. I accept the views expressed by Mr Aikin at paragraph 9 of his submissions where he sets out his main points for requesting an award of costs off the scale. These are:

"9) Third, if the Hearing Officer is not of the view that the Applicant should pay all of the Proprietor's costs on the basis that these whole proceedings were vexatious, the Proprietor seeks an off-scale costs award to reflect the Applicant's general poor and unreasonable behaviour leading to significant wasted costs on the Proprietor's side. In support, the Proprietor relies on the following in particular:

(a) The Applicant has filed four different versions of the TM26(1), constantly changing her pleading and failing to set out clearly and concisely what is, as is clear from the decision, in essence a relatively straightforward case.

(b) The Applicant has on numerous occasions failed to follow clear directions given by the Hearing Officer, including:

- (1) failing to delete references to without prejudice communications from her pleading; and
- (ii) failing to restore her original pleading on proper reasons for non-use after the 1st CMC and instead introducing new irrelevant material.

(c) Filing multiple different versions of her first witness statement as a result of failing to comply with the Hearing Officer's directions.

(d) Filing highly repetitive evidence, including duplicating the content of previous statements and duplicating previously filed exhibits.

(e) Unreasonably insisting on referring to without prejudice communications in her pleadings and evidence, in the face of the Proprietor's reasonable objections.

(f) Filing 39 pages of written submissions the day before the hearing and an additional three pages on the morning of the hearing, much of which was a rehash of the Applicant's evidence which by that stage had been set out in four materially identical witness statements over two sets of proceedings. The later 3-page submission was not even sent to the Proprietor."

7) Bearing in mind that KD was professionally represented, the case has been, in my view, poorly handled resulting in significantly more work for LL and its representatives. To my mind, this does rise to the level of unreasonable behaviour and I therefore award costs off the scale. In addition to the £2,601 awarded in relation to the first CMC, LL sought a further £25,603.67. They also offered a fall-back position of half these fees (£2,601 + £12,801.84). I believe that a figure between these is the more correct result.

8) I order Kathleen Deayton to pay Laurelle London Limited the sum of £21,800 (which includes the CMC costs). This sum to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 11th day of May 2021**

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