

O/354/21

TRADE MARKS ACT 1994

TRADE MARK REGISTRATION No. 2631680

IN THE NAME OF BIO-SYNERGY LTD

AND

APPLICATION No. 502463 BY SPARTAN RACE, INC.

FOR THE REVOCATION OF THE TRADEMARK

ON GROUNDS OF NON-USE

AND

DECISION ON COSTS

Background

1. On 10th March 2021, I issued a decision revoking trade mark 2631680 for non-use. I found that the proprietor's behaviour during the proceedings was unreasonable. I explained why I was minded to award the applicant the full reasonable cost of dealing with the proprietor's unreasonable behaviour during its defence of the application, which the applicant had assessed as £12,672.96.

2. I directed that:

“(i) That within 21 days of this decision, the applicant provides a breakdown of the £12,672.96 spent on these proceedings;

(ii) This breakdown should include an estimate (at least) of the number of hours spent on the various stages and/or issues that have arisen, and should also include the time spent preparing the required breakdown;

(iii) The breakdown should be copied to the proprietor;

(iv) The proprietor has 21 days from the receipt of this breakdown to provide any comments (in writing) it has on the applicant's request for off-scale costs and the reasonableness of the costs claimed.

I indicated that I would then issue a final decision on costs.

Subsequent events

3. The applicant subsequently provided me with a breakdown of the costs associated with the application. I was informed that the original claim for £12,672.96 included some pre-action matters not exclusively or directly related to the cancellation action. The request for costs was revised accordingly to £11,038.18.

4. The applicant sent a copy of the breakdown of costs to the proprietor's representative.

5. The proprietor does not appear to have commented on the applicant's claim. The period allowed for doing so has now expired.

6. The proprietor has, however, filed an appeal against my substantive decision to revoke the trade mark registration for non-use.

7. I have considered whether to issue this decision before the substantive appeal has been determined. This is because the outcome of the appeal could have a bearing on the appropriateness of awarding substantial costs to the applicant. On the other hand, the quantum of costs cannot be challenged through an appeal until I have issued a decision on that matter. I have therefore decided that the proper course is to issue a decision on the quantum of costs, which can be challenged through appeal. However, to avoid the potential unfairness of requiring the proprietor to pay these costs before its appeal against my first decision is decided, I will direct that the costs should be paid within 21 days of the determination of the appeal already filed or, if that appeal is withdrawn, within 21 days of that event. If this decision on costs is also appealed, the appellate tribunal will, of course, have the power to set aside this decision and decide the costs due to the applicant differently, even if my substantive decision is upheld.

Decision on costs

8. I have been through the proprietor's breakdown of costs. It appears that £1109 of the costs claimed arose before the 23rd April 2019 when the proprietor's representative sent an email (but only to the tribunal) explaining why it had not filed the counterstatement on time, i.e. before the case started going off the rails. I will not award compensatory costs in respect of these 'normal' actions. I will, however, award the applicant £200 towards the official fee for filing the revocation application and £300 scale costs for preparing the application.

9. I have also noted that £323 of the cost claimed result from two activities undertaken on 4th and 24th September 2020, which appear to relate to a possible settlement. I will not award costs in respect of these matters.

10. This leaves £9606.18 that the applicant reasonably spent dealing with the consequences of the proprietor's unreasonable behaviour in these proceedings. Adding the £500 due as normal scale costs for filing the application brings the total to £10106.18.

11. I therefore order Bio-Synergy Ltd to pay Spartan Race, Inc. the sum of £10106.18.

12. Subject to an appeal against this decision and any order made by the appellate tribunal, the costs specified above should be paid within 21 days of the determination of the appeal already filed, or if that appeal is withdrawn, within 21 days of that event.

Status of this decision

13. For the avoidance of doubt, this is a final decision on costs. The period for appeal runs from the date shown below.

Dated 11th day of May 2021

Allan James

For the Registrar