

O-437-12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2530191
BY ARCHIBALD DUNCAN OGILVIE MCINTYRE TO REGISTER THE SERIES
OF TWO TRADE MARKS:**



IN CLASSES 9, 16 AND 41

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 100311
BY MARIE MONGAN**

SUPPLEMENTARY DECISION ON COSTS

DECISION ON COSTS

1) In my decision of 19 September 2012, in respect of proceedings relating to Opposition No. 100311 (Decision BL O-353-12), the applicant, Mr Archibald Duncan Ogilvie McIntyre was successful in defending his application from an opposition brought by Mrs Marie Mongan. Consequently, I found that Mr McIntyre was entitled to an award of costs. At paragraphs 59 and 60 of my decision, I stated the following:

“59) Mr McIntyre has been successful and is entitled to a contribution towards the cost of the time he has spent on these proceedings. In his written submissions of 10 October 2011, he requested that he is allowed an opportunity to make detailed submissions on costs at the end of the proceedings. I refer Mr McIntyre to Tribunal Practice Notice (TPN) 4/2007 where information is provided on the costs regime operated by the Registry. It is common practice to make an award of costs in the form of a contribution and not on a compensatory basis. The Hearing Officer is free to deviate from this practice if he feels it is appropriate. However, in these proceedings, there is nothing that strikes me as requiring consideration of costs other than in the normal way.

60) The Registrar usually operates on a published scale of costs as set out in the above TPN. However, since Mr McIntyre has not been professionally represented during the proceedings, an award made from the published scale might be larger than his actual expenditure. Consequently, Mr McIntyre 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 notice of opposition and completing the counterstatement, preparing his evidence and reviewing Mrs Mongan’s evidence and written submissions. This should be filed within 21 days of the date of this decision and should be copied to Mrs Mongan’s representatives, 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 sides availed themselves of the opportunity afforded to them with Parker Bullen Solicitors submitting an application for costs for Mr McIntyre on 11 October 2012, Silverman Sherliker LLP Solicitors providing written submissions on behalf of Mrs Mongan on 22 October 2012 and Mr McIntyre providing additional submissions in response, dated 25 October 2012. I confirm that I have fully considered these submissions when giving my decision.

3) Mr McIntyre made an application for costs totalling £45,287.91. In my decision, after drawing attention to the Tribunal Practice Notice (TPN) 4/2007, I went on to express the view that “there is nothing that strikes me as requiring consideration

of costs other than in the normal way”. Mr McIntyre appears to be making a request for an award of costs on a compensatory basis, although he does not expressly state this.

4) The submissions presented on behalf of Mrs Mongan, in essence, submitted that:

- No award of costs should be made outside the usual scale;
- The application for costs has been inflated and should not form the basis for any award of costs;
- Mr McIntyre has claimed costs on the basis that he was represented in the opposition, despite not being so;
- Mr McIntyre has ignored my comments (referred to in the paragraph above) and claimed costs off the usual scale.

5) I keep these submissions in mind. Before considering Mr McIntyre’s application for costs, I will comment on the final bullet point (above). Whilst I made such a comment in my decision, I do not interpret it as precluding Mr McIntyre from submitting that he is entitled to an award of costs that goes above and beyond the published scale. It merely reflected my view prior to submissions being made on the issue. I now have the benefit of the parties’ submissions and I will consider the award in taking account of these submissions.

6) I have a number of observations on Mr McIntyre’s application and these are detailed below:

- Mr McIntyre has included costs incurred, by himself and with others he approached, in respect of activities undertaken to prevent Mrs Mongan’s attempt to register the mark HYPNOBIRTHING in the UK. Such activity is not relevant to these proceedings and consequently, any award of costs cannot and should not reflect these costs;
- It transpires that Mr McIntyre did receive substantial professional assistance from Parker Bullen (amounting to costs of £11,529.91), despite not recording them as his representative. However, obtaining such professional assistance is not a reason for making a cost award outside of the normal scale (in fact, and as I alluded to in paragraph 60 of my substantive decision, the published scale presupposes professional representation and it is because Mr McIntyre appeared to have none that he was invited to provide his submissions);
- Notwithstanding my comments regarding the above point, Mr McIntyre claims costs for advice received from Parker Bullen in respect of Mrs Mongan’s application to register a mark of her own and also what Mr McIntyre calls “inter-related work” concerning the filing of observations, at OHIM, in respect of a further application by Mrs Mongan. Such costs were not incurred in the current proceedings and cannot, therefore, be taken into account;

7) I note these observations and I keep these in mind when commenting below, on what I perceive as being the pertinent issues to my consideration of costs.

8) There are a number of submissions made by Mr McIntyre that require consideration in the context of whether it is appropriate to make an award of costs that goes over and above the normal scale.

9) Firstly, Mr McIntyre submits that “Silverman Sherliker prevaricated and time-wasted unreasonably, applying for extensions on the very last day at every single stage ... which made the case last for a great deal longer than it should have” and requests additional costs for this. By way of example, he directs me to the Registry letter addressed to him and dated 2 August 2011, where the case worker commented that she was “mindful of the unnecessary delay” and that “This is a matter which may be taken into account by the Hearing Officer in determining any costs award at the end of proceedings”. On that occasion, the chronology of events was as follows:

- Mr McIntyre filed amended evidence on 21 April 2011;
- The Registry wrote to Silverman Sherliker on 18 May 2011 stating that it should have now received a copy of the evidence and that it had until 21 June 2011 to provide any written submissions on the evidence;
- On 20 June 2011, Sherliker Silverman first called the Registry and then wrote (but failed to copy the letter to Mr McIntyre) to inform it that the evidence had not been received and asked the Registry to set a new timetable;
- In further correspondence it transpired that Mr McIntyre did send the evidence to Sherliker Silverman on 20 April 2012 (but it appears never to have been received);
- Mr McIntyre was then required by the Registry to re-send this evidence and confirm that it had been received by Silverman Sherliker. Mr McIntyre did so and furnished evidence of this (in the form of a “proof of posting receipt” and a “Royal Mail certificate of delivery”).

10) At the time of receipt of the Registry letter of 18 May 2011, Sherliker Silverman would have been aware that it had not received Mr McIntyre’s amended evidence. Consequently, it does appear somewhat odd that it then chose to wait until the day before its written submissions were due (21 June 2012) to draw to the Registry’s attention that it had not received Mr McIntyre’s evidence. There is nothing in the papers to indicate the reason for this, but I accept that it could merely have resulted from an oversight by Silverman Sherliker. Consequently, and contrary to Mr McIntyre’s submission, I cannot conclude that this was a deliberate attempt to delay proceedings. Whilst Mr McIntyre was put to the additional work of demonstrating, to the satisfaction of the Registry, that he did, in fact, send the evidence to Sherliker Silverman and was required to resend the evidence and produce both proof of sending and

proof of receipt, this cannot be blamed upon Sherliker Silverman (who, for whatever reason, may never have received the original package). Consequently, it would not be appropriate to make an award of costs on this point, against Mrs Mongan. Further, whilst Sherliker Silverman were responsible for a delay of just over one month (from when it was alerted on 18 May 2011 that it should have already received Mr McIntyre's evidence to 20 June 2011, when it finally wrote to the Registry saying it had not received it), it is not clear that the delay alone resulted in any additional costs to Mr McIntyre. Accordingly, I decline to award any additional costs to Mr McIntyre for this delay.

11) I also comment upon Mr McIntyre's allegation that as a result of Sherliker Silverman's "time wasting", the case has taken a good deal longer than it should have, taking nearly three years. This allegation is somewhat a mischaracterisation of the facts. Firstly, the proceedings have taken less about thirty months from when the parties were joined (when Mr McIntyre filed his counterstatement on 18 May 2010) and of the two deadlines extended, one was to allow Mr McIntyre to submit his evidence in the correct format. I do not consider it accurate to identify Sherliker Silverman's actions as the only reason for the slow progress of the case.

12) Having conducted a thorough review of the papers on file, the only other delay instigated by Silverman Sherliker was the request, received on 27 August 2010 (the day Mrs Mongan's evidence-in-chief was due), for an extension of time. An additional eight weeks were requested, expiring on 22 October 2010. On that date, a further extension of time was requested with the evidence finally being submitted on 28 October 2011. Consequently, proceedings were delayed by a shade over two months. Mr McIntyre challenged the reasons for the extension, producing an e-mail posted by Mrs Mongan "on her forum" on 28 October 2010 that suggested she was working from her office whilst attending medical appointments three times a week. This, he claimed, contradicts the reason for the extension request being that Mrs Mongan was travelling on business and therefore, not available to sign her statement. I am not persuaded by this. Whilst there may appear to be some tension between the two parties' perception of Mrs Mongan's movements, Mr McIntyre's comments were not considered persuasive by the case worker at the time and he chose not to challenge the case worker's view by requesting a hearing. Consequently, Silverman Sherliker did not need to provide any substantiation of its version of the situation and of course, there may have been a straight forward explanation for the apparent tension. In summary, I do not consider it appropriate that Mr McIntyre is entitled to any enhanced costs resulting from this applied for, and granted, extension of time.

13) I should say at this point, that the filing of documents on the last day of the permitted period, whilst not desirable, is something that Silverman Sherliker was fully entitled to do. They either complied with the dates set by the Registry or applied for an extension of time in the appropriate way. I do not see these actions

to be such as to lead to an enhanced award of costs. There are no further instances of delays arising from the actions of Mrs Mongan or her representative and I conclude that these issues do not result in a case for making any award of costs over and above a normal award based upon the published scale.

14) It is clear from Mr McIntyre's application for costs that, contrary to my assumption, he did receive some support from Parker Bullen Solicitors, despite the fact that they were only formally recorded as his representative between 29 November 2010 and 2 February 2011 (as actioned by the form TM33s filed on those dates, the first appointing Parker Bullen, the second to confirm that Mr McIntyre was, once again, representing himself). Nevertheless, upon close analysis of these invoices, much of the work undertaken by Parker Bullen relates to issues other than these current proceedings. For example, the invoices variously relate to work undertaken in respect to proceedings before OHIM, preparing an assignment and use of the term HYPNOBIRTHING in the title of a book by Mr McIntyre.

15) Three items appear relevant to these proceedings. Firstly, the invoices of 3 and 8 December 2010, from Parker Bullen, relate to advice given to Mr McIntyre on the issue of challenging an extension of time request made by Mrs Mongan. As Mr McIntyre was ultimately unsuccessful in this challenge, as is normal in such a situation, he is not entitled to an award of costs in respect of any work in producing the challenge.

16) Secondly, Parker Bullen's invoice of 29 November 2011 relates to (among other work not relevant) advice given in respect of a letter from Silverman Sherliker. It is not clear, nor is it explained what letter this is and whether it related to the progress of these proceedings, or whether it related to another matter between the parties (such as the dispute at the Community Trade Mark Office). Consequently, I disregard the costs (that were, at any rate, not itemised in the invoice) associated with this action.

17) Thirdly, Parker Bullen's invoice of 11 October 2011 is in respect of work carried out in respect of Mr McIntyre's application for costs. The application has been roundly criticised by Silverman Sherliker. It is true that Mr McIntyre's application for costs appears to be an attempt to reclaim costs not only related to these proceedings but other actions and activities relating more generally to the phrase HYPNOBIRTHING and Mrs Mongan's own UK and Community trade marks. Whilst Mr McIntyre would normally be permitted a contribution to compiling his costs, on this occasion, because of the number of unrelated costs that have been claimed and the additional work undertaken by Silverman Sherliker in preparing its submissions on this, I conclude that Mr McIntyre should not receive any additional award of costs for this element of his claim.

18) Mr McIntyre also submits five invoices merely headed with an address in Wiltshire. As Silverman Sherliker notes in its submissions, made on behalf of Mrs

Mongan, these appear to originate from Katherine Graves. This was subsequently confirmed by Mr McIntyre. Silverman Sherliker submits that Ms Graves has no legal standing in these proceedings. She is neither a party in the proceedings nor has she provided legal advice to Mr McIntyre. I agree with Silverman Sherliker that it is not appropriate to award costs to a person or entity who is not a party to the proceedings and where that party did not provide legal advice.

19) Turning to Mr McIntyre's direct expenses (i.e. those attributed solely to his time in preparing his case), he provides a schedule of activities and allocates an hourly rate of £100 for 195 hours of work and 38 hours of travel. He submits that this hourly rate is reasonable and he should not be expected to attribute a lower rate than what he receives for providing his hypnotherapy services. I note this, but in the absence of specific guidance on this in the Trade Mark Rules, 2008, it is appropriate for me to take account of the guidance provided in the Civil Procedure Rules ("the CPR"). In particular, I refer to Paragraph 52(4) of The Costs Practice Direction supplementing Parts 43 to 48 of the CPR that sets out that a litigant in person is allowed £18 an hour.

20) Even taking account of the justifiable criticisms of Mr McIntyre's application for costs, it is clear that his true costs (relating solely to the conduct of these proceedings) are, by some comfortable way, above what would normally be awarded based upon the published scale, even applying an hourly rate of £18. Consequently, my concerns expressed in paragraph 60 of the substantive decision, that a costs award may be higher than his actual expenditure, have proved to be unfounded and it is clear that his costs in these proceedings will clearly exceed any award based upon the published scale.

21) In summary, having considered Mr McIntyre's application for costs, it does not change my initial view that there is nothing that strikes me as requiring me to make an order for compensatory costs. I conclude that an award is appropriate on a contributory basis and based upon the published scale (as set out in Tribunal Practice Notice 4/2007 and shown below).

Task	Cost
Preparing a statement and considering the other side's statement	From £200 to £600 depending on the nature of the statements, for example their complexity and relevance.
Preparing evidence and considering and commenting on the other side's evidence	From £500 if the evidence is light to £2000 if the evidence is substantial. The award could go above this range in exceptionally large cases but will be cut down if the successful party had filed a significant amount of unnecessary evidence.
Preparing for and attending a hearing	Up to £1500 per day of hearing, capped at £3000 for the full hearing unless one side has behaved unreasonably. From £300 to £500 for preparation of submissions, depending on their substance, if there is no oral hearing.
Expenses	(a) Official fees arising from the action and paid by the successful party (other than fees for extensions of time).

Task	Cost
	(b) The reasonable travel and accommodation expenses for any witnesses of the successful party required to attend a hearing for cross examination.

22) Silverman Sherliker submit that Mr McIntyre has behaved unreasonably during the proceedings by flouting rules and deadlines, with “many long and detailed letters being provided ... both outside his own deadlines, and without copies being sent” (to the Opponent). It recognises that such actions “may be excused for a litigant in person” but claim that “it is dramatically compounded by the Application for Costs which has been submitted under professional advisement and which is entirely improper”. It concludes by submitting that Mr McIntyre should not be allowed any contribution to the costs of proceedings.

23) It is true that, in part, Mr McIntyre’s application for costs appears to be an attempt to reclaim costs related to issues outside the scope of these proceedings and I decline to award any costs for this part of the claim. However, I dismiss Siverman Sherliker’s submission that Mr McIntyre should not be allowed any contribution to the costs of these proceedings. Whilst Mr McIntyre has provided detailed written submissions at every procedural landmark in the proceedings, none of this appears unreasonable to me. With legal representation, such submissions may have been made more briefly, but Mr McIntyre did no more than attempt to defend his position.

24) In summary, balancing all the relevant facts, it is my view that the costs award in favour of Mr McIntyre should reflect the published scale. I take account of the fact that no hearing took place but that both parties provided evidence and written submissions. Finally, I also keep in mind that the CPR, at Rule 48.6(2) states that costs awards to litigants in person should not exceed two thirds of the amount which would have been allowed if the litigant had been legally represented. I award costs on the following basis:

Considering Notice of Opposition and preparing counterstatement:	£300
Preparing and filing evidence and considering Mrs Mongan’s evidence:	
	£800
Preparing written submissions:	£300
TOTAL:	£1400

25) I order Marie Mongan to pay Archibald Duncan Ogilvie McIntyre the sum of £1400. 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.

26) The appeal period for both the substantive decision BL O-353-12 and the issue of costs begins with the date of issue of this supplementary decision.

Dated this xx day of November 2012

**Mark Bryant
For the Registrar,
the Comptroller-General**