

**TRADE MARKS ACT 1994 IN THE MATTER OF TRADE MARK NO. 3053633 IN
THE NAME OF RVT MANAGEMENT LIMITED**

**AND IN THE MATTER OF AN APPLICATION FOR A DECLARATION OF
INVALIDITY BY JAMES CHARLES LINDSAY**

DECISION AS TO COSTS

1. This was an appeal against the decision of Raoul Colombo on behalf of the Registrar dated 24 November 2015.
2. An application was filed on 12 August 2015 by James Charles Lindsay (“*Mr Lindsay*”) for a declaration of invalidity of Trade Mark Registration No. 3053633 (“*the Registration*”) pursuant to Section 47(2)(b) of the Trade Marks Act 1994 (“*the 1994 Act*”).
3. A copy of the application was sent to RVT Management Limited (“*the Proprietor*”) on 14 August 2015. In the accompanying official letter the time for filing a notice of defence and counterstatement was set for 14 October 2015.
4. No counterstatement was filed by or on behalf of the Proprietor. Neither party requested a hearing or supplied written submissions in respect of the official letter dated 22 October 2015.
5. Accordingly, pursuant to Rule 46(1) of the Trade Marks Rules 2008 (“*the Rules*”), the Hearing Officer declared that the Registration was invalid and directed that it be removed from the Register and deemed never to have been made.
6. On the 24 November 2015 a Notice of Appeal was filed on behalf of Proprietor. No Respondent’s Notice was filed.
7. By letter dated 18 January 2016 Notice of the Hearing of the Appeal on 5 February 2016 was given under Section 76 of the 1994 Act. In addition, on 1 February 2016 the Decision of Mr Geoffrey Hobbs QC in BOSCO Trade Mark (O-339-15) was drawn to the attention of the parties to the appeal.
8. On the 3 February 2016 a skeleton of argument on behalf of Mr Lindsay was filed. On 4 February 2016 an email was sent on behalf of the Proprietor indicating that he wished the appeal to be withdrawn. The Hearing of the Appeal was accordingly withdrawn from the list.

9. On 5 February 2016 an email was sent on behalf of Mr Lindsay indicating, *inter alia*, as follows:

Our client has incurred cost with this firm and with Anna Edwards-Stuart of Counsel and we would be grateful if you would make a costs award in our client's favour.

We attach to this email a signed Statement of Costs for Summary Assessment.

10. Later on the same day an email was sent drawing to the attention of the parties to the Decision As to Costs of Mr Geoffrey Hobbs QC in EDGE Trade Mark (O-295-14) and in particular to paragraphs 12 to 13 of that Decision.
11. Directions were then given as to the future conduct of the application for costs as follows:
- (1) On or before 4 pm on Friday 12 February 2016 [Mr Lindsay] must confirm in writing whether or not he is claiming costs other than on the standard scale.
 - (2) In the event that [Mr Lindsay] confirms that he intends to seek an order for off scale costs then on or before 4 pm on the 19 February 2016 [Mr Lindsay] must: (a) confirm that the signed statement of costs that was provided as an attachment to the email timed at 11:25 on 5 February 2016 is the bill itemising the actual costs upon which he intends to rely for that purpose and if not provide such a bill; and (b) provide a reasoned statement in support of his request for costs to be awarded to him on an off scale basis.
 - (3) On or before 4 pm on Friday 4 March 2016 the [Proprietor] should provide any written submissions that he would wish to make in response to [Mr Lindsay's] application for costs.
12. No confirmation was received from or on behalf of Mr Lindsay in accordance with the direction set out in sub-paragraph 11(1) above. A Default Notice was issued on 23 February 2016. By letter, sent on behalf of Mr Lindsay, dated 24 February 2016 it was confirmed that Mr Lindsay would limit his '*costs recovery to costs on the scale*'. No other submissions were made on behalf of Mr Lindsay.
13. As a result of the lateness of the confirmation, the time limit for the Proprietor to provide any written submissions as set out in sub-paragraph 11(3) above was extended until 9 March 2016. No submissions were received on behalf of the Proprietor.

14. I must therefore consider the application by Mr Lindsay for an order for the costs that he had incurred in relation to the appeal prior to it being withdrawn.
15. The general position in relation to costs is set out in Section 68(1) of the 1994 Act which states:

Provision may be made by rules empowering the registrar, in any proceedings before him under this Act –

- (a) to award any party such costs as he may consider reasonable, and
- (b) to direct how and by what parties they are to be paid.

Rule 67 of the Trade Mark Rules accordingly provides that:

The registrar may, in any proceedings under the Act or these Rules, by order award to any party such costs as the registrar may consider reasonable, and direct how and by what parties they are to be paid.

16. As stated in the Decision As to Costs of Mr Geoffrey Hobbs QC in EDGE Trade Mark (O-295-14) at paragraph [10]:

The long established practice in Registry proceedings is to require payment of a contribution to the costs of a successful party, with the amount of the contribution being determined by reference to published scale figures. The scale figures are treated as norms to be applied or departed from with greater or lesser willingness according to the nature and circumstances of the case. The Appointed Persons normally draw upon this approach when awarding costs in relation to appeals brought under section 76 of the 1994 Act.

17. This approach to the assessment of costs has been retained for the reasons explained in Tribunal Practice Notice TPN 2/2000 updated and supplemented by Tribunal Practice Notices TPN 4/2007 and TPN 6/2008.
18. As noted above Mr Lindsay has requested an award of costs on the basis of the current scale.
19. It seems to me that having regard to the papers before me, and in particular the matters set out above, that it would be fair and proportionate to award Mr Lindsay £500 as a contribution towards the costs of considering the Notice of Appeal and the preparation of the written submissions that were filed prior to the appeal being withdrawn.

20. I will therefore order that RVT Management Limited, pay Mr James Charles Lindsay £500 within 21 days of this Decision as to Costs.

EMMA HIMSWORTH Q.C.

Appointed Person

8 April 2016