

O/047/19

SUPPLEMENTARY DECISION ON COSTS

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3217732 BY
CLINTON WILLIAM FRANK SLATER
TO REGISTER:**



AS A TRADE MARK IN CLASSES 35 & 41

AND

**OPPOSITION THERETO (UNDER NO. 409602) BY
OUTDOOR PHYSICAL TRAINING LTD**

1. On 28 August 2018, I issued a decision in these proceedings upholding an opposition brought by Outdoor Physical Training Ltd (“the opponent”) against the registration of a trade mark filed by Mr Clinton William Frank Slater. At the end of my decision I dealt with the matter of costs and I ordered Mr Slater to pay the opponent costs of £200; in relation to this I stated:

“28. At the end of the proceedings, the parties were sent a letter indicating that if they wanted to claim costs they should complete a costs pro-forma, setting out the hours expended in dealing with the proceedings, otherwise no costs (other than official fees) would be awarded. The opponent, who otherwise would have been entitled to a costs award, did not respond. Therefore, I make no costs award other than in respect of the opponent’s official opposition fee of £200.”

2. Thus, my decision on costs was factored upon the non-completion of the costs pro-forma.

3. After receiving my decision, the opponent contacted the Tribunal to advise that a costs pro-forma had in fact been submitted. In response, the Tribunal wrote to the parties advising that:

- a) The opponent’s costs pro-forma had been received but, due to an administrative error, had not been placed on the case-file.
- b) In view of the above, my decision on costs was to be set aside.
- c) The parties were given 14 days to request a hearing on the decision to set aside, if they wished to take issue with it.

4. The decision to set aside on such clear instance of procedural irregularity is predicated upon the basis of rule 74 of the Trade Marks Rules 2008. Neither party objected or requested a hearing. I now, therefore, issue a fresh decision on costs.

5. The opponent’s pro-forma identified a large number of hours expended in handling this case:

- 3 hours for completing the TM7.
- 4 hours for considering the TM8.
- A total of 63 hours for various tasks associated with preparing evidence/submissions and considering those of Mr Slater.
- 16 hours for reviewing correspondence and writing final submissions.

6. Claims are also made for £1.90 printing costs, £6.50 postage costs and £9040 for loss of membership income resulting from Mr Slater setting up his business “under the same name and brand”.

7. In relation to the claim for loss of membership income, this is not something I can countenance in my costs assessment. An award of costs before this Tribunal is intended as a contribution towards the costs of dealing with the proceedings. I have no power to award damages or an account of profits. I use the word “contribution” intentionally as such awards are, generally speaking, made on a contributory as opposed to a compensatory basis.

8. In terms of the hours claimed, whilst I have no reason to doubt the number of hours said to be have been expended by the opponent, some strike me as unexpectedly high for the tasks undertaken. Tackling this into account, and bearing in mind my earlier observations relating to the contributory nature of the award, I consider a costs award for the following number of hours to be reasonable:

- Completing the notice of opposition (TM7) and considering the counterstatement (TM8) – 5 hours.
- The various tasks associated with preparing evidence/submissions and considering those of Mr Slater – 35 hours
- Preparing final written submissions – 3 hours
- **Total 43 hours**

9. I will also allow the claim for printing and postage costs, equalling £8.40. The opponent is also entitled to costs covering the official fee of £200 for filing the opposition.

10. In relation to the hours expended, I note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour. I see no reason to award anything other than this. The breakdown is, therefore:

- Hourly rate (43 hours at £19 per hour) - £817
- Official fee - £200
- Other expenses - £8.40
- **Total: £1025.40**

11. I hereby order Mr Clinton William Frank Slater to pay Outdoor Physical Training Ltd the sum of £1025.40 within fourteen days of the expiry of the appeal period for this supplementary decision on costs, or, if this supplementary decision on costs is appealed, within fourteen days of the final determination of any appeal.

Dated this 24th day of January 2019

Oliver Morris

For the Registrar,

The Comptroller-General