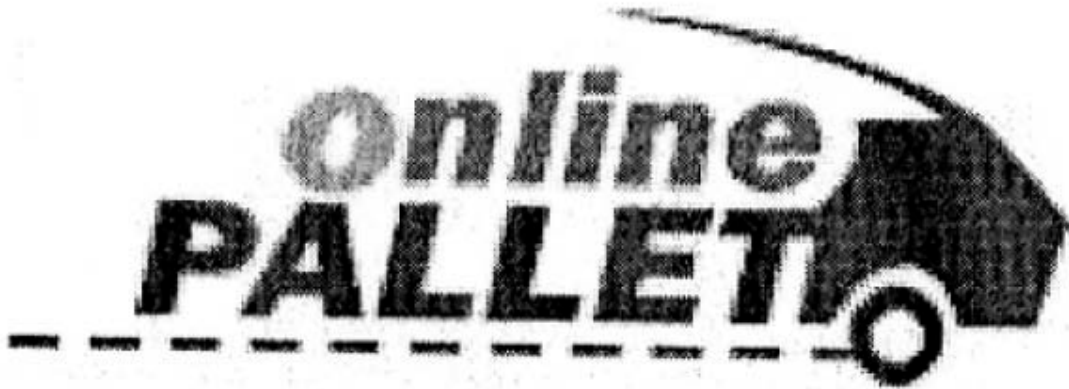


O/148/12

SUPPLEMENTARY DECISION ON COSTS

**IN THE MATTER OF REGISTRATION NO. 2512671
IN THE NAME OF BENJAMIN OLIVER SPENCER
OF THE TRADE MARK**



IN CLASSES 20 AND 39

AND

**AN APPLICATION FOR
A DECLARATION OF INVALIDITY THERETO
UNDER NO. 83707
BY PASS J HOLDINGS LIMITED**

SUPPLEMENTARY DECISION ON COSTS

1. On 15 February 2012, I issued a substantive decision in these proceedings in which Mr Spencer, the registered proprietor, was wholly successful in defeating an application for a declaration of invalidity against his trade mark. In relation to costs, I said:

“52. Mr Spencer has been successful and is entitled to a contribution towards the cost of the time he has spent on these proceedings. The Registrar usually operates on a published scale of costs¹. However, since Mr Spencer has not been professionally represented for some of the time during the proceedings, an award made from the published scale might be larger than his actual expenditure. In BL O/160/08 *South Beck*, Mr Richard Arnold QC, sitting as the appointed person, stated:

“32. Secondly, counsel for the opponent submitted that, if CPR r. 48.6 was applicable, the hearing officer had misapplied it. In support of this submission he pointed out that CPR r. 48.6(4) provides:

The amount of costs to be allowed to the litigant in person for any item of work claimed shall be-

(a) where the litigant can prove financial loss, the amount that he can prove he has lost for time reasonably spent on doing the work; or

(b) where the litigant cannot prove financial loss, an amount for the time reasonably spent on doing the work at the rate set out in the practice direction.

The Part 48 Practice Direction provides at paragraph 52.4 that the amount which may be allowed to a litigant in person under rule 46.8(4) is £9.25 per hour. Counsel submitted that the hearing officer appeared to have awarded the applicant two-thirds of the scale figure which he would have awarded a represented party, and that this could not be justified since the opponent had not proved any financial loss and was very unlikely to have spent over 160 hours on the matter.....

36. In my judgment the approach which should be adopted when the Registrar is asked to make an award of costs in favour of a litigant in person is as follows. The hearing officer should direct the litigant in person pursuant to r. 57 of the 2000 Rules to file a brief schedule or statement setting out (i) any disbursements which the litigant claimed he has incurred, (ii) any other financial losses claimed by the litigant and (iii) a statement of the time spent by the litigant in dealing with the proceedings. The hearing officer should then make an assessment of the costs to be awarded applying by analogy the principles applicable under r. 48.6, but with a fairly broad brush. The objective should be to

¹ Tribunal Practice Notice 4/2007.

ensure that litigants in person are neither disadvantaged nor overcompensated by comparison with professionally represented litigants.”

Under the current practice direction, the amount allowed to a litigant in person is £18 per hour.

53. Consequently, Mr Spencer 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, e.g. preparing evidence, and giving details of the parts of the proceedings where he was professionally represented. This should be filed within 21 days of the date of this decision and should be copied to the other side’s professional representatives, who will have 10 days from receipt of the estimate to provide written submissions. I will then issue a supplementary decision covering the costs of these proceedings.

54. The period for any appeal against this decision will run concurrently with the appeal period for the supplementary decision on costs and so will not commence until the supplementary decision is issued.”

2. The applicant did not file any written submissions in response to Mr Spencer’s written submissions, filed on 7 March 2012, in which he gives the legal bill total for the time he was represented, prior to the commencement of the evidence rounds, and an estimate of the amount of hours he spent on the proceedings when he was unrepresented. The latter is broken down as:

Preparing evidence and considering and commenting upon the other side’s evidence: 30 hours;

Preparing for the first substantive hearing: 12 hours;

Attending the first substantive hearing: 4 hours.

3. Mr Spencer also asks for an award above the published scale in respect of the consideration of the applicant’s statement and his own counterstatement (at this time he was professionally represented). He requests payment of his full legal costs (£1,503.00, excluding VAT) because he says that the applicant did not particularise its case with sufficient clarity and relied upon an excessive number of grounds.

4. The applicant relied upon four earlier rights in respect of its grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994. It set out these grounds in customary fashion. The counterstatement, prepared by Mr Spencer’s professional representatives, responded to each mark and ground separately, in eight pages. Parts of the counterstatement relied, *mutatis mutandis*, upon the defence pleaded against the first of the four earlier marks. That is not to say, however, that Mr Spencer and his attorney only had to consider the first of the four marks; simply that there is a degree of repetition through the counterstatement in relation to the section 5(3) and 5(4) grounds.

5. Taking all of this into account, I decline to award Mr Spencer his actual legal costs in respect of the beginning of the proceedings (application and counterstatement stage). I will, however, make an award towards the top end of the Registrar's published scale of costs, as set out in Tribunal Practice Notice 4/2007, for the consideration of the other side's statement and the preparation of the counterstatement. Each earlier mark pleaded required separate consideration, which Mr Spencer met, notwithstanding the element of repetition in relation to sections 5(3) and 5(4)(a).

6. In relation to consideration of the applicant's evidence (which included the proof of use element) and the preparation of his own evidence, Mr Spencer's estimate of thirty hours appears to me to be reasonable, bearing in mind that it is appropriate to allow a litigant in person more time for a particular task than a professional adviser would be allowed². In relation to the claim of twelve hours for preparing for the first substantive hearing, Mr Spencer represented himself at that hearing. His preparation would have included reviewing the applicant's skeleton argument (prepared by its trade mark attorney). The transcript from that hearing indicates to me that Mr Spencer had done some research into points of trade mark law which were reflected in his oral submissions. Mr Spencer's estimate of twelve hours appears reasonable. Finally, I have no concerns about Mr Spencer's estimate of four hours for the hearing itself.

7. I award Mr Spencer costs on the following basis, applying the hourly figure of £18 by analogy with *South Beck*:

Consideration of the applicant's statement and preparation of a counterstatement	£500
Preparing evidence and considering and commenting upon the other side's evidence (30 hours @ £18 per hour):	£540
Preparing for and attending the first substantive hearing (12 + 4 hours @ £18 per hour):	£288
Total:	£1328

² As per Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person in *Bluebird*, BL O/020/12.

8. I hereby order Pass J Holdings Limited to pay Benjamin Oliver Spencer the sum of £1328. This sum should 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. The appeal period in relation to this supplementary decision will run concurrently with my earlier substantive decision.

Dated this 4th day of April 2012

**Judi Pike
For the Registrar,
the Comptroller-General**