

O-410-20

SUPPLEMENTARY DECISION ON COSTS

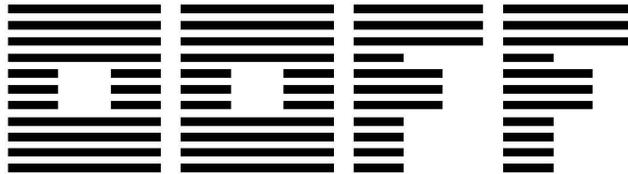
TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3364245

BY

JACK CLARK

TO REGISTER:



AS A TRADE MARK IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 415752

BY

OFF-WHITE LLC

BACKGROUND & PLEADINGS

1. On 25 February 2020, I issued a decision in these proceedings (BL-O-118-20 refers), in which I found for the applicant, Jack Clark. In that decision I stated:

“Costs

74. As the applicant has been successful, he is, in principle, entitled to a contribution towards his costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016.

75. Although the official record shows that the applicant has been represented by Mr Andrew Clark, I note that Mr Andrew Clark has the same address as the applicant. As there is nothing to suggest that Mr Andrew Clark is a professional representative, at the conclusion of the evidence rounds, the tribunal wrote to Mr Andrew Clark. In that letter, dated 8 November 2019, the tribunal stated:

“If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party...

If there is to be a “decision from the papers” this should be provided by **6 December 2019**.

If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded...”

76. The applicant did not respond to that invitation either by the deadline set or by the date of the issuing of this decision. As the applicant has not incurred any official fees in the defence of his application, I make no order as to costs.”

2. The parties were allowed until 24 March 2020 to consider appealing against that decision.

3. On 28 February 2020, the tribunal received an email from Andrew Clark which read:

“Can you help please. I have received communication from you to say that our application has been accepted and that the case brought by Off White (the opponent) has failed.

It says in the concluding paragraphs that we had made no submission as to costs --however this was filed with you and our opponents as below.

Can you please clarify?”

4. Attached to that email was a further email from Andrew Clarke dated 6 December 2019 which had been sent to tribunalsection@ipo.gov.uk and copied to the opponent’s agents. That email read:

“I attach a request for costs form in relation to the case of opposition No. 415752.”

Also attached was a completed copy of the Tribunal Cost Pro Forma sent by the tribunal to the applicant at the conclusion of the evidence rounds.

5. In a letter to Mr Clarke dated 16 March 2020 and copied to the opponent, the tribunal stated:

“Thank you for your recent emails addressed to the Tribunalsection@ipo.gov.uk which as the Tribunals Hearings Manager have been brought to my attention.

I have investigated this matter and I would first like to apologise for the failure to bring your submission for costs received at the IPO, on 6 December 2019, to the Hearing Officer's attention, before he issued his substantive decision dated 25 February 2020. I propose to rectify this procedural irregularity by invoking rule 74 'Correction of irregularities in procedure' of the Trade Marks Rules 2008 and ask the Hearing Officer to now consider your submission on costs, and issue a supplementary decision dealing solely with the cost request.

If no request to be heard is received within 14 days from the date of this letter, the Hearing Officer will be asked to address the request for costs.

Please note that the appeal period in respect of the substantive decision as set out in the Registrar's letter dated 25 February 2020 remains. Any appeal to the Hearing Officer's substantive decision must be filed on or before 24 March 2020. Once again, please accept my apologies for any inconvenience caused."

6. As both deadlines mentioned above fell within the "interrupted days" period implemented by the Intellectual Property Office as a result of the disruption caused by the Covid outbreak, the period allowed in which to both appeal the substantive decision and for the opponent to comment on the approach adopted in the official letter of 16 March expired on 30 July 2020. No appeal was filed and the opponent elected not to comment on the official letter.

Costs assessment

7. The Cost Pro Forma requires those completing it to indicate the amount of time they have spent during the proceedings by reference to various categories of work, for example, "Notice of defence", "Considering forms filed by the other party", "Preparing evidence/written submissions/considering and commenting on the other sides' evidence/written submissions". However, the completed Cost Pro Forma provided

simply indicates that in total 30 hours had been spent by the applicant during the proceedings. This was split as follows: 20 hours in relation to “opposition documents”, 6 hours in relation to “defence documents” and 4 hours in relation to “external legal advice”.

8. In approaching the request for costs, I have assumed that the reference to “opposition documents” refers to reviewing the Notice of Opposition and the opponent’s evidence and “defence documents” refers to the preparation of a counterstatement and the filing of written submissions. The four hours spent in relation to “external legal advice” is, I assume, the time spent seeking legal advice.

9. As I mentioned in my original decision, there is nothing to suggest that Andrew Clarke is representing Jack Clark in a professional capacity. Proceeding on that basis, it would, I have little doubt, have taken some time for Andrew Clarke to familiarise himself with the legal basis of the opposition, particularly the passing-off claim. Insofar as the opponent’s evidence is concerned, this consisted of a thirteen-page witness statement and twenty-six exhibits amounting to 354 pages. Having reviewed this evidence myself, I have absolutely no doubt that would have been a very time-consuming task for Andrew Clarke to undertake.

10. Having familiarised himself with the basis of the opposition, the completion of the initial and amended counterstatement would have been less onerous, as would the preparation of the various written submissions. As the law of trade marks is fairly complex, the four hours spent seeking legal advice seems entirely reasonable.

11. Although the time spent in dealing with specific parts of the opposition have not been attributed in the manner requested, taking a “rough and ready” view of the matter in light of the basis of the opposition, the evidence filed in support and the applicant’s defence, a total of 30 hours dealing with the totality of the opposition does not appear to me to be unreasonable. The official letter of 8 November 2019 contained the following:

“If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded. You must include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed and any travel costs. Please 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.”

12. Applying the guidance in the above letter, 30 hours @ £19 per hour amounts to £570. I therefore order Off-White LLC to pay Jack Clark the sum of **£570**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of August 2020

C J BOWEN
For the Registrar