

O-124-10

TRADE MARKS ACT 1994

SUPPLEMENTARY DECISION ON COSTS

IN CONSOLIDATED PROCEEDINGS IN THE MATTER OF:

- 1) MR JOHN PEPIN'S OPPOSITIONS (NOS 95351A & 98132) TO TWO
TRADE MARK APPLICATIONS (2446109A & 2487699)
BY FREEMANTLEMEDIA LIMITED & SIMCO LIMITED
TO REGISTER THE TRADE MARKS:**



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BRITAIN'S GOT TALENT

AND

- 2) FREEMANTLEMEDIA LIMITED & SIMCO LIMITED'S OPPOSITION (NO
98973) TO TRADE MARK APPLICATION 2506974
BY MR JOHN PEPIN TO REGISTER THE TRADE MARKS**

Britains Got Talent

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Background

1. On 11 March 2010 I issued a decision in relation to these consolidated proceedings. In summary, Mr Pepin's opposition to Freemantlemedia Limited's & Simco Limited's trade mark applications (2446109A & 2487699) failed whereas Freemantlemedia Limited's & Simco Limited's opposition to Mr Pepin's trade mark application (2506974) succeeded. In relation to costs, I stated at paragraph 100 of my decision:

“At the hearing Mr Pepin wanted to refer me to correspondence that had been marked as “without prejudice save as to costs”. I declined to consider this prior to issuing this decision as to do otherwise would have meant that I had had sight of without prejudice material before coming to a conclusion on the substantive matters. Nevertheless, I agreed with both parties that such material would be considered and taken into account after the substantive decision had been issued. I agreed that both parties could make their submissions on costs in writing. I will allow a period of 28 days from the date of this decision in order for them to do so. I will then issue a supplementary decision dealing with costs. The appeal period for this substantive decision will run concurrently with the appeal period for my decision on costs.”

2. Freemantlemedia Limited & Simco Limited made written submissions. The submissions focused on the registrar's published scale of costs and made no mention of the correspondence marked “without prejudice save as to costs”. In terms of the published scale, Freemantlemedia Limited & Simco Limited requested costs at its higher end to reflect the “considerable evidence” lodged and, also, its representation by Counsel at the hearing.

3. Mr Pepin also filed written submissions. He asked that costs be kept to a minimum given that he is a sole trader and that he tried to resolve the matter without the need for the oppositions to be progressed. The information on file marked “without prejudice save as to costs” contains a number of letters which, essentially, show Mr Pepin offering to withdraw his opposition if Freemantlemedia Limited & Simco Limited provide certain undertakings, such as to not interfere with his business under his domain name. In a covering written submission to these letters, Mr Pepin highlights these letters and his contact with a representative of the other side (Ms Brender). Mr Pepin further highlights that it was Freemantlemedia Limited & Simco Limited who asked for the hearing, Mr Pepin would have been content for a decision to be reached from the papers. He also states that a vast number of unnecessary documents were put into evidence (by Freemantlemedia Limited & Simco Limited) and that this should be taken into account when determining costs.

4. The fact that Mr Pepin is a sole trader is not a reason to reduce the costs that I should award to Freemantlemedia Limited & Simco Limited. Furthermore, the

attempts to settle the various proceedings are, similarly, not relevant. The fact that Freemantlemedia Limited & Simco Limited did not wish to settle the dispute on the terms set out by Mr Pepin (or on any terms at all) and that they wished the proceedings to be determined on their merits is a perfectly reasonable course of action. This also applies to the request to be heard which, for the record, I found to be helpful in determining the various issues before me. The registrar has a wide discretion on costs¹. That being said, I see nothing in the case before me to depart from the registrar's published scale of costs. I therefore intend to make a fair and reasonable assessment against the published scale².

5. In terms of my assessment, I bear in mind, of course, that the cases were consolidated and that this would have resulted in some cost savings. In terms of "Preparing a statement and considering the other side's statement" the statements and counterstatements were filed prior to case consolidation, nevertheless, similar issues and contents were contained. I consider it reasonable that a total sum of £600 be awarded for this aspect.

6. In terms of "Preparing evidence and considering and commenting on the other side's evidence", I consider that a fair amount of evidence was filed by Freemantlemedia Limited & Simco Limited and that it also had to consider a fair amount of evidence filed by Mr Pepin (Mr Pepin filed five witness statements) even if some of it was duplicative. I do not, despite Mr Pepin's claim, consider that any of Freemantlemedia Limited's & Simco Limited's evidence was unnecessary. I consider a sum of £1000 to be reasonable.

7. In relation to "Preparing for and attending a hearing" the scale is up to £1500 per day of hearing but capped at £3000 (presumably for multi-day hearings). The hearing was more of a half day affair. I consider the sum of £700 to be reasonable.

8. In terms of expenses, Freemantlemedia Limited & Simco Limited had to pay a £200 opposition fee when it lodged opposition to Mr Pepin's application. This is a relevant expense to consider. My overall assessment is:

Preparing a statement and considering the other side's statement	£600
Preparing evidence and considering and commenting on the other side's evidence	£1000
Preparing for and attending a hearing	£700

¹ *Rizla Ltd's Application* [1993] RPC 365.

² The scale was first published in TPN 4/2007 and repeated in TPN 6/2008. I note that Mr Pepin's oppositions were filed before the publication of this scale (a previous scale was in force at this point), but that Freemantlemedia Limited's & Simco Limited's opposition was filed after the scale's publication. I have borne this in mind in my assessment and the overall sums I have come to reflect this fact.

Expenses	£200
Total	£2500

9. I hereby order Mr John Pepin to pay Freemantlemedia Limited & Simco Limited the sum of £2500. The appeal period for the substantive decision and this supplementary decision is to run concurrently from the date given below. The above 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 (or the substantive decision) is unsuccessful.

Dated this 22 day of April 2010

**Oliver Morris
For the Registrar
The Comptroller-General**