

O-068-14

TRADE MARKS ACT 1994

TRADE MARK APPLICATION 2575617

BY HESKETH RACING LIMITED

AND

OPPOSITION 102295

BY

LORD THOMAS ALEXANDER FORMOR-HESKETH

Decision on costs

1. In a decision dated 17 December 2013, I rejected an opposition brought by Lord Thomas Alexander Formor-Hesketh against an application by Hesketh Racing Limited to register a trade mark in class 25.

2. With regard to costs I stated that:

Costs

62. The opposition having failed the applicant is entitled to a contribution towards its costs. The Registrar normally awards costs on the basis that such awards make a contribution towards the successful party's costs (as opposed to covering the full cost). If the applicant had been legally represented I would have ordered the opponent to pay the applicant £1800 made up of:

- i) £300 for considering the notice of opposition and preparing a counterstatement.
- ii) £500 for considering the opponent's evidence and filing evidence in reply.
- iii) £1000 for preparing for and attending the hearing.

63. However, parties without legal representation usually have lower costs and it is necessary to ensure that awards do not exceed the amounts actually spent on the proceedings. Therefore I invite the applicant to provide, within 28 days of the date of this decision, a schedule setting out the costs incurred in these proceedings having particular regard to the headings set out above. This may include an estimate of the number of business hours spent on this matter and the hourly rate(s) at which these costs have been incurred. In this connection, it should be noted that the Registrar will not normally award costs to unrepresented parties at a rate higher than £18 per hour.

64. The applicant should copy its schedule and any covering documents to the opponent's representatives.

65. The opponent will have 21 days from the date of receiving any such schedule in which to submit any written comments it wishes to have taken into account.

3. I received submissions from the Hesketh Racing Ltd indicating that:

- i) 25 hours were spent considering the notice of opposition, researching the matter, and preparing a counterstatement.
- ii) 20 hours were spent considering the opponent's evidence and preparing the applicant's evidence.
- iii) 12 hours were spent preparing for and attending the hearing.
- iv) £210 was spent on legal advice from Borneo, Martell, Turner, Coulston, solicitors.

4. An invoice was providing substantiating the last point.

5. I also received submissions from the opponent to the effect that:

- i) The 25 hours at £18 per hour the applicant claims for considering the notice of opposition and filing a counterstatement amounts to £450, which exceeds the £300 I indicated in the main decision that I would have awarded if the applicant had been legally represented.
- ii) The applicant's claim includes £210 in legal costs, contrary to my directions in the main decision.
- iii) The applicant's claim for 20 hours to consider the opponent's evidence and to prepare its own is excessive. Ten hours would be a reasonable "and in line with the length of time these things ought to take."
- iv) The opponent does not contest the costs claimed for the hearing.

6. At £18 per hour, the amount claimed by the applicant on account of its own efforts is £1026. With £210 spent on legal advice that amounts to £1236. This is well within scale costs.

7. There is no doubt that the Registrar has the power to award reasonable costs. Rule 67 of the Trade Mark Rules 2008 provides follows:

Costs of proceedings; section 68

67. 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.

8. The Registrar normally awards costs on a contribution basis within the limits set out in the published scale. The latest version of the scale is included in Tribunal Practice Notice 4/2007.

9. The opponent objects to some of the applicant's claims. I do not accept that there is anything in these objections. Firstly, as regards the time spent on items 3(i) and 3(ii) above, it is obvious why a self represented party would spend a lot longer than a legal specialist would take to consider a notice of opposition and evidence, and prepare a counterstatement and evidence. The applicant's claim has to be compared to scale costs overall, rather than item by item or the number of hours spent on particular tasks. Secondly, as regards the inclusion of legal costs, I did not cover them in my earlier direction because it was not apparent to me that the applicant had incurred legal costs. My assumption is not a proper basis to prevent the applicant from claiming for any of its legal costs.

10. As I have noted, scale costs are intended to make a contribution to the successful parties' costs of proceedings, not to recover the full cost. I see no reason why this principle should be set aside because a party has chosen to act in person. I will therefore award Hesketh Racing Limited £900 as a reasonable contribution towards the costs it incurred.

11. I order Lord Thomas Alexander Formor-Hesketh to pay Hesketh Racing Limited £900 within 21 days of the date of this decision, subject to any appeal.

Dated this 10th day of February 2014

**Allan James
For the Registrar**