

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATIONS NOS 3 172 551 & 3 212 726

IN THE NAME OF 5678 MEDIA GROUP LLC

& OPPOSITION THERETO IN THE NAME OF TALPA CONTENT BV

**DECISION ON COSTS
FOLLOWING WITHDRAWAL OF APPEAL**

1. This was to have been an appeal against the decision dated 11 September 2018 of the Hearing Officer, Louise White, allowing an opposition against the registration of two marks utilising the words DANCE UK DANCE based upon earlier DANCE DANCE DANCE registrations in the name of the Opponent/Respondent, Talpa Content BV.
2. The appeal was due to be heard on Monday 4 February 2019. At 10.55am on 30 January 2019, that is the previous Wednesday, the Applicant/Appellant, 5678 Media Group LLC, wrote to the UKIPO to request withdrawal of the appeal and vacation of the forthcoming hearing.
3. After some correspondence between the parties and the Government Legal Department to clarify the position, it became apparent that this request was made unilaterally, and not as part of some negotiated settlement between the parties. It was nevertheless agreed that the hearing should be vacated and I invited submissions on the question of costs.
4. The Opponent/Respondent submitted as follows:

“We confirm that we consent to the withdrawal of the appeal. However, in relation to the award of costs, we had already instructed counsel to act on behalf of the Opponent and to prepare skeleton arguments for the appeal. Counsel had already prepared the skeleton arguments before we received notification of the Applicant’s request to withdraw the appeal. On this basis, we request that an additional award of costs be made in the Opponent’s favour for preparing the skeleton arguments.”
5. The Opponent/Respondent followed this up by explaining that the costs incurred in instructing counsel to prepare a skeleton argument were £750 excluding VAT and

that other legal fees incurred as a result of the appeal were approximately £1,200 excluding VAT.

6. The Applicant/Appellant was invited to respond on the issue of costs but declined to do so.

7. As set out in Tribunal Practice Note 1/2016: Skeleton arguments and attendance in trade mark proceedings:

3. Requirements

Skeleton arguments

(i) Parties with legal representation are required to provide skeleton arguments by 2pm two working days prior to Hearings (other than CMC), regardless of the start time of the Hearing. By way of example, for any Hearing due to take place on a Thursday, whether starting at 9.30am or 2pm, we should receive skeleton arguments by 2pm the Tuesday before.

8. On this basis skeletons were due to be exchanged and sent to me by 2pm on Thursday 31 January.

9. In the light of this I consider it entirely reasonable for the Opponent/Respondent to have incurred the cost of instructing counsel to prepare a skeleton argument by the time the Applicant/Appellant first indicated that it wished to withdraw its appeal. It would be surprising had this not been the case.

10. Equally, I consider that it is unreasonable for the Applicant/Appellant to give notice so late in relation to its intention to withdraw the appeal, yet not to acknowledge that in doing so it had caused the Opponent/Respondent to incur additional costs unnecessarily. I am not aware of the circumstances in which the appeal came to be withdrawn. It may be that it was only withdrawn after careful consideration of advice from Counsel following preparation of the Applicant/Appellant's own skeleton argument. Alternatively it may be that preparation of the appeal was left to the last minute and the decision to withdraw was made as a pragmatic alternative to the incurring of costs on the appeal. Either way, the decision was made too late to allow the Opponent/Respondent to save costs in its own preparation of a skeleton for the appeal.

11. For the avoidance of doubt, the Registry and the Appointed Persons will always encourage parties to compromise or withdraw disputes where possible. If an application, opposition or appeal is compromised or withdrawn then this not only benefits the parties in terms of saved time and expense, but it also benefits other

users of the trade mark system because the resources available can be directed to resolution of other outstanding disputes. Further, the sooner a matter is removed from the hearings list, the greater the procedural efficiency for all involved.

12. Therefore in the present case I have to balance the unnecessary costs incurred by the Opponent/Respondent in preparing for the hearing against the saving of costs of the hearing itself. I consider that the Opponent/Respondent is entitled to an award of costs in relation to preparation for the hearing of the withdrawn appeal, but not to the same extent as had the hearing taken place with the same outcome.
13. Annex A to Tribunal practice notice (2/2016): Costs in proceedings before the Comptroller states as follows:

Annex A

Scale of costs applicable in proceedings commenced on or after 1st July 2016

Task	Cost
Preparing a statement and considering the other side's statement	From £200 to £650 depending on the nature of the statements, for example their complexity and relevance.
Preparing evidence and considering and commenting on the other side's evidence	From £500 if the evidence is light to £2200 if the evidence is substantial. The award could go above this range in exceptionally large cases but will be cut down if the successful party had filed a significant amount of unnecessary evidence.
Preparing for and attending a hearing	Up to £1600 per day of hearing, capped at £3300 for the full hearing unless one side has behaved unreasonably. From £300 to £550 for preparation of submissions, depending on their substance, if there is no oral hearing.
Expenses	(a) Official fees arising from the action and paid by the successful party (other than fees for extensions of time). (b) The reasonable travel and accommodation expenses for any witnesses of the successful party required to attend a hearing for cross examination.

14. Doing the best I can with the material before me, I make an award of costs of £1000 in respect of this appeal to account for the Opponent/Respondent's costs incurred in considering the Grounds of Appeal and preparation of a skeleton for the hearing. I make no award in relation to attendance at the hearing, which did not take place.
15. This sum needs to be added to the sum of £1850 already awarded by the Hearing Officer to the Opponent/Respondent.
16. The total sum of £2850 should be paid by the Applicant/Appellant within 14 days of the date of the order which follows this decision.

Thomas Mitcheson QC
The Appointed Person

The Applicant/Appellant was represented by Trade Mark Wizards Limited

The Opponent/Respondent was represented by Lewis Silkin LLP

The Registrar took no part in the Appeal.