

O-014-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION 1332605
IN THE NAME OF SHENZHEN SHANLING DIGITAL TECHNOLOGY DEV. CO.
LIMITED
IN RESPECT OF THE TRADE MARK:**

ONIX

IN CLASS 9

AND

**AN APPLICATION TO RECTIFY THE REGISTER (UNDER NO. 84215) BY
ADAM WILLIAM JOHN WORSFOLD**

SUPPLEMENTARY DECISION ON COSTS

1) In my decision of 20 November 2014, in respect of rectification proceedings relating to the ownership of registration 1332605 (Decision BL O-497-14), the application for rectification, Mr Worsfold, succeeded in his attempt to have the register amended to record himself as the registered proprietor.

2) I found that Mr Worsfold was entitled to an award of costs and in my decision, I commented, as follows, on the issue:

“52) The applicant for rectification has been successful and is entitled to a contribution towards his costs, according to the published scale in Tribunal Practice Notice 4/2007.

53) At the hearing, Mr Groves submitted that “Mr Worsfold has been forking out legal fees for a considerable period of time and a considerable amount of money”. The hearing had been postponed three times and he claimed that whilst the hearing had not been fully prepared for on each occasion, steps had been taken to prepare for it and legal costs had been incurred. Further, he cited the proprietor’s representatives removing themselves from the record at the last minute and claiming that this had caused the applicant a great deal of inconvenience and expense. He submitted that this warranted an award off the scale.

54) I have reviewed the file and, generally, the impression I take is that the delays in progressing the case lay with the actions of both sides. There are two situations that I comment on specifically. Firstly, the first case management conference was postponed four times (leading to a two month delay), but upon reviewing the reasons, I believe that the proprietor was not wholly to blame and should not be penalised by way of costs for these postponements. One of the reasons for these postponements was that the applicant identified that the proprietor’s representative was subject to a conflict of interest and consequently it withdrew from the proceedings. The proprietor acted quickly in appointing new representatives.

55) A delay of four months in the proceedings being heard resulted from two postponements, the first as a result of Mr O’Brien’s wife’s medical treatment preventing his attendance and the second time because of the proprietor’s representative withdrawing from the proceedings just three days before the hearing. In my opinion, it is only the latter of these reasons that may have placed an unnecessary and unacceptable cost burden upon the applicant. That said, this cost burden would not have been great. The applicant’s preparation for the hearing could have been picked up from the stage it had reached previously, but I accept further time will have been required to deal with the uncertainties that were created by the situation and I note that it required a number of email exchanges with the Registry. However, I do not believe that an off-scale award is appropriate. Rather, an award of £300 is sufficient to reflect the additional work involved in communicating with the Registry as the uncertainties were unraveled.

56) I will keep the above comments in mind, however, I will not award costs at this stage because any costs order should also reflect any reasonable travel and accommodation expenses incurred by Mr Worsfold in attending the hearing for cross-examination. Such information, together with any supporting documents (such as a hotel receipt, travel tickets etc), should be sent for my consideration within 28 days of the date of this decision. I will then issue a supplementary decision on costs.”

3) Mr Worsfold provided his representative with a breakdown of his costs as follows:

“Expenses for Nov 5 2014-12-23

Direct Costs

| | |
|-----------------------------------|-------|
| Fuel | 20.00 |
| Travel card Peak time x 2 | 35.80 |
| Parking | |
| 8.90 | |
| Travel From Asia (Thailand) x 1 | |
| 2450.00 | |
| Accommodation not claimed | |

Total 2514.70”

and

“Expenses from Before Nov 5 (Last min Change of Hearing)

| | |
|---------------------------------------------|--|
| Travel From Asia (Singapore) | |
| 2750.00 | |
| Hotels for 10 days (Travel Lodge @ 65 Pn) | |
| 650.00 | |

Total 3400.00”

4) These were provided to the Registry by email on the 23 December 2014 but with no corroboratory receipts or invoices. This was five days after the deadline set in paragraph 56 of my decision. Further, the email states that “Mr Worsfold has unfortunately had to go overseas again” and that plane tickets and hotel bills “can [...] be provided in support when he is back in this country”. I am prepared to consider these costs despite being filed late, but in the absence of any corroboratory documents, it is not appropriate for me to critically assess the level of costs claimed.

5) For the hearing on 5 November, Mr Worsfold claims £2450 for flights from and to Thailand. The other side, in its email submissions of 31 December, suggests that this price corresponds to business class flights. Indeed it appears that return economy flights from Bangkok, Thailand to London are available for about £600 or less, and I award this amount for the flights. Mr Worsfold claims no accommodation but fuel of £20, parking for £8.90 and two travel cards totaling £35.80. It is not explained why two travel cards were required. I award costs in respect of the parking, fuel and one travel card, amounting to £46.80.

6) In regard to the costs claimed as a result of the cancelled hearing, I note that the cost of travel from Singapore is claimed as is accommodation for ten nights. Once again, the cost of £2750 for the flights appears excessive with economy return flights between London and Singapore appearing to be in the region of £450. I also consider it appropriate to award accommodation costs for one night, amounting to £65.

7) Taking all of the above into account, I make an award of costs in favour of the applicant for rectification, on the following basis:

| | |
|----------------------------------------------------------------------------------------|-----------------|
| Preparing statement of grounds and considering counterstatement | £300 |
| Preparing evidence and considering other side's evidence | £800 |
| Preparing and attending hearing | £800 |
| Additional work resulting from withdrawal of proprietor's representative | £300 |
| Witness' costs in respect of the late cancelled hearing and attendance at the hearing: | |
| Attending hearing: | £646.80 |
| Travel/accommodation associated with cancelled hearing: | £515 |
| Total: | £3361.80 |

8) I order Shenzhen Shanling Digital Technology Dev. Co. Limited to pay Adam William John Worsfold the sum of £3361.80 which, in the absence of an appeal, should be paid within seven days of the expiry of the appeal period.

Dated this 13th day of January 2015

**Mark Bryant
For the Registrar
The Comptroller-General**