

BL O/0392/25

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3978032 BY LUMI GLO LIMITED TO REGISTER



AS A TRADE MARK IN CLASSES 3 & 35

AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. OP600003167 BY KAREN WOOD

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF A COOPER DATED 13 NOVEMBER 2024.

DECISION

Introduction

1. In decision O/1071/24 dated 13 November 2024 ("**Decision**"), Arran Cooper for the Registry held that Karen Wood's ("**Respondent**") opposition to Lumi Glo Limited's ("**Appellant**") application No. 3978032 for the trade mark shown below for goods and services in classes 3 and 35 ("**Application**") was successful in full.



2. On 2 January 2025 the Appellant filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994. On the same day, the Appellant filed Form TM26(l) to declare the mark relied upon by the Respondent in the opposition (Registration No. 3815929) invalid under ss. 3(6), 5(3) and 5(4)(a) of the 1994 Act. That application proceeded under No. 508267 ("**Invalidity Proceedings**"). The Form TM55 Notice to Appeal requested a stay of the appeal pending the outcome of the Invalidity Proceedings, but did not set out the grounds

of the appeal itself. Following a request by the Appointed Persons Secretariat on 7 January 2025, the Appellant filed its Grounds of Appeal on 31 January 2025.

3. The Appellant was notified on 16 January 2025 that its Form TM26(I) did not contain all the required information. An amended TM26(I) was filed by the Appellant on 6 February 2025.
4. In [O/0147/25](#), I dealt with the Appellant's application for a stay, and a cross-application by the Respondent for security for costs. I made the following orders ("**Preliminary Decision**"):
 - a) The appeal was stayed pending the outcome of the Invalidity Proceedings;
 - b) The period for filing of the Respondent's notice was extended to 21 days after the stay is lifted;
 - c) Each party has permission to apply to lift the stay;
 - d) The Appellant shall provide security for the costs of the appeal in the sum of £3,000. That sum should be paid into the Registry account no later than 4.30 pm on the day 21 days after the stay is lifted; and
 - e) In the event of failure by the Appellant to comply with the above order for security for costs, the appeal shall, without further order, be treated as having been withdrawn.

Events since the Preliminary Decision

5. On 20 February 2025, the Registry informed the Appellant that its amended TM26(I) was still deficient. The Appellant was given a further opportunity to file a compliant TM26(I).
6. No further TM26(I) having been filed, the Registry wrote to the parties on 12 March 2025 stating its preliminary view that there was insufficient information for the Invalidity Action to proceed, and it accordingly intended to strike out the Invalidity Action in its entirety. The parties were given the opportunity to request a hearing by 19 March 2025.
7. On 27 March 2025, the Registry wrote to the parties noting that the Appellant had not requested the appointment of a hearing to discuss the Registry's preliminary view to strike out the Invalidity Action. The Appellant's cancellation action was accordingly struck out.
8. On the same day, the Appointed Persons Secretariat Manager wrote to the parties on my behalf informing them that i) the stay is lifted; ii) the Appellant must, by 4.30 pm on 7 April 2025, pay £3,000 into the Registry account by way of security for costs, failing which the appeal will be treated as withdrawn; and iii) the Respondent may file any Respondent's Notice on or before 7 April 2025.
9. The Appellant failed to provide the security for costs I ordered, and accordingly the parties were informed on 28 April 2025 that the appeal was treated as withdrawn.
10. On 29 April 2025 the Respondent requested an order for costs in its favour in the sum of £1,600.

Costs

11. In the Preliminary Decision, I reserved the costs of the Appellant's application for a stay of the appeal, and the Respondent's application for security for costs, pending the outcome of the appeal. Now that the appeal has been withdrawn, it is necessary for me to consider both the costs of the Preliminary Decision and of the appeal itself.

12. The Respondent was clearly the successful party in the Preliminary Decision, as it successfully resisted the Appellant's application for a stay, and was also successful in its own application. It is right, therefore, that the Appellant should pay the Respondent's costs of the Preliminary Decision. Furthermore, given that the appeal has been deemed withdrawn because of the Appellant's default, the Appellant should pay the Respondent's costs of dealing with the substantive appeal itself.
13. Costs of hearings before the Appointed Person are usually awarded on a contributory, rather than actual, basis, in accordance with a scale, published as Tribunal Practice Notice 1/2023. Whereas costs can, in appropriate circumstances, be ordered off the scale, the Respondent has not suggested that any such off-scale award might be requested, and nothing in the documents I have seen gives any obvious indication that an off-scale award might be appropriate.
14. TPN 1/2023 envisages an award of £350 to £650 for preparation of submissions, depending on their substance, if there is no oral hearing. In my view, an award of £600 is appropriate in respect of the Preliminary Decision. The appeal itself was at an early stage when it was withdrawn, but the Respondent will undoubtedly have incurred costs in considering it and deciding how best to respond. In my view, a further £600 is an appropriate award.
15. As for the costs of the hearings below, I reiterate the Hearing Officer's awards below in the total sum of £1,400.

Conclusion

16. The appeal is treated as withdrawn. The Appellant must pay the Respondent, by 21 May 2025, the total sum of £2,600, comprising £600 in relation to the Preliminary Decision, £600 in relation to the appeal, and £1,400 in relation to the costs below.

Dr. Brian Whitehead

30 April 2025

Representation

GCS Europe Limited for the Appellant

Cloch Solicitors Limited for the Respondent