

O-330-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION 2552097  
IN THE NAME OF TARIQ YOUNIS  
IN RESPECT OF THE TRADE MARK:**

**kilimanjaro**

**IN CLASS 43**

**AND**

**AN APPLICATION TO RECTIFY THE REGISTER (UNDER NO. 84697) BY  
APOLLO APOLLINAIRE OUEDRAOGO**

**SUPPLEMENTARY DECISION ON COSTS**

1) In my decision of 5 June 2014, in respect of rectification proceedings relating to the ownership of registration 2552097 (Decision BL O-254-14), the applicant for rectification, Mr Apollo Apollinaire Ourdraogo was successful. The registered proprietor, Mr Tariq Younis, was found to have transferred the registration into his own name without the consent or knowledge of Mr Ouedraogo, the previous recorded registered proprietor.

2) In my decision, I commented as follows:

“40) At the hearing, Mr Moss submitted that Mr Ouedraogo should be entitled to his full costs. He argued that if I was to find that the key signatures present in the key documents in the proceedings had been forged, then the rectification would not have been required. He made reference to a schedule of costs that had been provided to the Registry. This has not been received. However, I concur with Mr Moss that this is a clear case where it is appropriate to depart from the published scale of costs. I have found that both the Form TM16 and the hand-written receipt carried forged signatures. In the absence of these documents, the proceedings would not have been required. Mr Younis’ actions are a clear attempt to defraud Mr Ouedraogo of his mark.

41) In light of this, I invite Mr Ouedraogo to submit a schedule of costs. He should provide this within 14 days of the date of this decision. Mr Younis will then be permitted a further 14 days to submit his own comments on the issue of costs. I will then issue a further decision on costs.”

3) Subsequent to the hearing, Mr Ouedraogo’s representative submitted the schedule of costs. Mr Younis did not provide any comments.

4) Section 68(1) of the Act establishes that:

“Provision may be made by rules empowering the registrar, in any proceedings before him under this Act –

(a) to award any party such costs as he may consider reasonable, and

(b) to direct how and by what parties they are to be paid.”

Rule 67 of the Trade Marks Rules 2008 accordingly provides that

“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.”

5) Under Rule 67 it is open to me to depart from the scale of costs in the exercise of the power to award such costs as I consider reasonable. In this respect, Tribunal Practice Note TPN 4/2007 is relevant. Its general comments regarding off-scale costs are relevant:

## “Off scale costs

5. TPN 2/2000 recognises that it is vital that the Comptroller has the ability to award costs off the scale, approaching full compensation, to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour. Whilst TPN 2/2000 provides some examples of unreasonable behaviour, which could lead to an off scale award of costs, it acknowledges that it would be impossible to indicate all the circumstances in which a Hearing Officer could or should depart from the published scale of costs. The overriding factor was and remains that the Hearing Officer should act judicially in all the facts of a case. It is worth clarifying that just because a party has lost, this in itself is not indicative of unreasonable behaviour.

6. TPN 2/2000 gives no guidance as to the basis on which the amount would be assessed to deal proportionately with unreasonable behaviour. In several cases since the publication of TPN 2/2000 Hearing Officers have stated that the amount should be commensurate with the extra expenditure a party has incurred as the result of unreasonable behaviour on the part of the other side. This “extra costs” principle is one which Hearing Officers will take into account in assessing costs in the face of unreasonable behaviour.

7. Any claim for cost approaching full compensation or for “extra costs” will need to be supported by a bill itemising the actual costs incurred.”

6) The schedule of costs submitted on behalf of Mr Ouedraogo is reproduced, in full, below:

Work carried out by Robin Winskell, Consultant at the rate of £250 per hour plus VAT

Activity	Time Spent	Charge (£)
Preparation	8 hours 36 minutes	2,150.00
Attendance	2 hours 12 minutes	550.00
Telephone attendances	36 minutes	150.00
Letters sent	12 minutes	<u>50.00</u>
Total:	11 hours 36 minutes	2,900.00

Work carried out by Malana Jarvis, Paralegal at the rate of £120 per hour plus VAT

Activity	Time Spent	Charge (£)
Preparation	2 hours 54 minutes	348.00
Attendance	42 minutes	84.00
Letters sent	2 hours 54 minutes	348.00

Activity	Time Spent	Charge (£)
Telephone attendances	1 hour 42 minutes	<u>204.00</u>
Total:	8 hours 12 minutes	984.00

**SUMMARY**

Work carried out by:

Robin Winskell	2,900.00	
Malana Jarvis	<u>984.00</u>	3,884.00
VAT thereon at 20%		<u>776.80</u>
Sub-total		4,660.80
Add disbursements:		
Kate Strzelczyk – Handwriting Expert	975.00	
Mr Jonathan Moss	2,250.00	
VAT thereon:	<u>450.00</u>	<u>3,675.00</u>
<b>GRAND TOTAL:</b>		<b><u>£8,335.80</u></b>

7) Mr Ouedraogo's representative was required to prepare his evidence, consider and respond to Mr Younis' evidence, prepare for, and attend a case management conference on 6 December 2013, locate and instruct an expert witness (and liaise with Mr Younis who first said he would financially contribute to the costs of an expert witness and then changed his mind), and prepare for and attend the hearing. Whilst I acknowledge that the evidence filed by both parties was light and that the work required of Mr Ouedraogo's representative would not have been time consuming in this respect, nevertheless, a total time of less than twenty hours strikes me as a reasonable assessment of the time required for the prosecution of the case.

8) I do note that, at the case management conference, I directed that the cost of the expert witness should not exceed £600 + VAT, i.e. £720. However, the schedule lists £975 + VAT, i.e. £1,170. Whilst subsequent to the case management conference, I agreed a higher amount, this was based on a perceived need at the time for the expert witness to travel to the Intellectual Property Office to inspect the documents. This was ultimately not necessary. Therefore, my direction is still appropriate. I consider it fair and right to award the full costs detailed in the schedule, but reduced by £450 to reflect the difference between the amount agreed for the expert witness and the amount actually claimed.

9) In light of the above, I award costs of £7885.80.

£

10) I order Tariq Younis to pay Apollo Apollinaire Ouedraogo the sum of £7885.80. This sum is to be paid within seven days of the expiry of the appeal period (in respect of this supplementary decision) or within seven days of the final determination in respect of this supplementary decision if any appeal against it is unsuccessful.

**Dated this 30th day of July 2014**

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