

O-641-17

SUPPLEMENTARY DECISION ON COSTS

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION 2432117
BY IN THE NAME OF GORDON ALLAN MARK SIMMONDS
IN RESPECT OF THE TRADE MARK**

X-Pression

IN CLASS 26

AND

**AN APPLICATION TO RECTIFY THE REGISTER (UNDER NO. 84771)
BY FEME LIMITED**

1) In my decision issued on 1 November 2017 under the BL number O-551-17, my comments on costs were as follows:

“38) Ms Reid submitted that it was appropriate for Feme to receive enhanced costs because the proceedings were required only because there was a dishonest attempt to claim ownership of the registration, that it was necessary to file an increased amount of evidence and because, as a result of Mr Khan failing to attend the hearing without giving notice, Mr Ghani’s trip from Yorkshire was unnecessary. I concur with these submissions and I invite Feme to provide a schedule of costs associated with the proceedings for my consideration. These should be provided within 14 days of the date of this decision. Mr Khan is permitted a further 14 days to provide any submissions on costs that he wishes to make. I will then issue a supplementary decision setting out the costs award. ”

2) My comments were made in the context that:

- I found that the chain of title of the contested mark, as claimed by Mr Khan, was supported by several assignment documents that were prepared contemporaneously for the purposes of these proceedings;
- Mr Khan withdrew from the proceedings, without giving notice to the Registry or the other side. Mr Khan’s non-attendance at the subsequent hearing was the first time that his withdrawal became apparent;
- Cross examination of Mr Khan’s witness, Mr Hussain had been agreed and prepared for by the other side, but Mr Hussain failed to attend without Mr Khan giving notice of this;
- Feme’s witness, Mr Ghani travelled from Leeds to London to attend the hearing to be cross examined by Mr Khan (or his representative). His attendance was in vein in light of Mr Khan’s non-attendance.

3) Feme’s representative, Briffa, responded on 14 November 2017 by providing a statement of costs together with a separate full break down of all costs incurred. No

submissions were received from Mr Khan. The statement of costs can be summarised as follows:

Reason	Time	Cost (£)
Attendances on Feme (including Personal Attendances, letters out/emails, telephone)	25.4 hours	5,878
Attendances on Mr Khan via his representatives (Personal Attendances, letters out/emails)	1.8 hours	447
Attendances on others (UKIPO, witnesses, counsel, counsel's clerk (including letters out/emails, telephone)	23.4 hours	5,559
Work done on documents (searches, witness statements, instructions to counsel, skeletons and bundles)	49.8 hours	10,605
Attendance at Hearing	8 hours	1,200
Disbursements (Counsel's fees, courier fees, private investigator's fees)		12,647
Total (ex VAT)		36,336
VAT		7,267
TOTAL		43,603

4) I only consider costs accrued during the prosecution of the proceedings. The current proceedings began when the parties were joined on 21 February 2017 when Mr Khan's counterstatement was served. I note that the breakdown of costs includes activities undertaken before this date, often many months before. I decline to award costs for these activities, with one exception. On 20 December 2016, I conducted a case management conference ("CMC") that Feme was invited to attend. With this in mind and from considering the breakdown of costs, I calculate that the costs being claimed regarding activities before the 21 February 2017 amount to £10,484 + VAT (a total of £12,580.80). Of this, £396 + VAT (a total of £475.20) is attributed to attendance at the CMC and to follow-up activities. Consequently I reduce the amount claimed by £12,105.60.

5) Neither do I consider it appropriate to award costs in respect of activities that took place after the hearing. In this respect there is a claim of £325 + VAT (a total of

£390) in respect of various emails and telephone communications with Feme regarding a draft settlement agreement.

6) In addition, I decline to award costs in respect of attendance at the hearing by two Briffa representatives because counsel was instructed to make submissions and to conduct cross examination and the Briffa representatives played no part. The amount attributed to Briffa's attendance is £1,200 + VAT (a total of £1,440) and I also reduce the claim to reflect this.

7) In summary, with the exception of the points discussed above, I accept the statement as a realistic reflection of the costs resulting from the proceedings. Therefore, I award costs in favour of Feme Limited, as set out in the statement of costs, reduced as set out below:

Amount claimed in statement of costs	£43,603.20
Reduction: Pre-proceedings activities	(£12,105.60)
Reduction: Post-hearing activities	(£390.00)
Reduction: Representatives attendance at hearing	(£1,440.00)
Total:	£29,667.60

6) I order Asif Raza Khan to pay Feme Limited the sum of £29,667.60 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

Dated this 13th day of December 2017

Mark Bryant
For the Registrar
The Comptroller-General