

O-827-21

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK REGISTRATION NO. 2576287

IN THE NAME OF AWAD NABIL

FOR THE TRADE MARK

QATAR AIRWAYS

AND THE APPLICATION FOR CANCELLATION THEREOF

UNDER NO. 503302

BY

QATAR AIRWAYS GROUP (Q.C.S.C.)

Background and pleadings

1. Awad Nabil is the registered proprietor (“RP”) of the following UK trade mark

UK TM No. 2576287
Qatar Airways
Filing date: 24 March 2011 Registration date: 29 July 2011
<i>Class 18: Leather and imitations of leather, and goods made of these materials.</i>
<i>Class 25: Clothing, footwear, headgear.</i>
<i>Class 28: Games and playthings: playing cards; gymnastic and sporting articles; balls for use in sport, exercise or games; sporting articles, apparatus and equipment</i>

2. Qatar Airways Group (Q.C.S.C.) (“Q.C.S.C.”) seeks revocation of the registered trade mark, in full, on the grounds of non-use under Section 46(1)(a) of the Trade Marks Act 1994 (‘the Act’) in respect of the period 30 July 2011 to 29 July 2016 with an effective revocation date of 30 July 2016, and under section 46(1)(b) for the period 24 August 2015 to 23 August 2020, with an effective revocation date of 24 August 2020.

3. Mr Nabil filed a TM8N and counterstatement dated 20 October 2020 in which he denied the grounds for revocation but did not to file evidence of use at that date¹.

4. There were issues concerning the evidence eventually submitted by Mr Nabil by means of an amended TM8N in April 2021 which are set out in my previous decision,

¹ Section 9 TM8N

BL O/360/21, on these proceedings. I do not intend to revisit those issues in detail in this decision but will touch on them as necessary.

5. In these proceedings Mr Nabil has represented himself and Q.C.S.C. have been represented by Bird and Bird LLP.

6. A hearing was requested, and the matter was heard before me on 8 October 2021.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Preliminary issues

8. At 1.16am on the morning of the hearing, Mr Nabil emailed the Tribunal with an attachment of 35 pages stating this was “evidence files for my hearing case”. This was followed by a second email at 1.35am with another attachment of 35 pages. A third email was sent at 9.47am, after the hearing had started, with a website hyperlink.

9. Taking the details from the 1.16am email first, the attached material consisted of

- Correspondence from Mr Nabil to the IPO dated 5 April 2021 regarding an explanation of why his evidence was not filed by the given deadline.²
- Correspondence from Mr Nabil to the IPO dated 5 April 2021 regarding the cancellation proceedings³
- A copy of decision BL O-116-16 which related to 2016 cancellation proceedings brought under sections 5(3) and 3(6) of the Act for the mark QATAR FOUNDATION involving Mr Nabil and a different third-party, namely Qatar Foundation For Education, Sciences & Community Development.⁴

² Page 2 of the attachment

³ Page 3 of the attachment

⁴ Pages 4-13 of the attachment

12. In relation to the decision BL O-116-16, I have previously explained to Mr Nabil in other related proceedings concerning the present parties that I cannot take account of that decision because the cancellation action in that case related to a different trade mark and was brought on different grounds to the case before me here.

13. In regard to the website link which was emailed at 9.47am; again I have previously explained to Mr Nabil that neither the Tribunal nor the other party will look at website hyperlinks as evidence. Any information contained on a website needs to be printed as screenshots such as from an internet archive service which would give the necessary date information as to what information was on the website during the periods of alleged non-use.

14. Finally with regard to the photographic images attached to the emails, Q.C.S.C. submitted at the hearing that they should not be admitted as evidence and furthermore cast doubt on the authenticity of the photographs and suggested they were created for the purpose of the hearing.

15. There are a number of elements to unpick here. The issue of admissibility of late evidence was considered in the *TITANIC* case⁶ in which Mr Justice Carr stated the factors to be considered, viz:

“...the registrar should primarily consider the following factors when deciding on the admissibility of late evidence, although the weight to be attached to each of them will vary from case to case:

- (i) the materiality of the evidence in question to the issues that the registrar has to determine;
- (ii) the justice and fairness of subjecting the opposite party to the burden of the evidence in question at the stage that the registry proceedings have reached, including the reasons why the evidence was not filed earlier;
- (iii) whether the admission of the further evidence would prejudice the opposite party in ways that cannot be compensated for in costs (eg excessive delays); and

⁶ *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), paragraph 34

- (iv) the fairness to the applicant of excluding the evidence in question, including prejudice to the applicant if it is unable to rely on such evidence”.

16. Taking the above factors into account, I find that firstly the material provided by Mr Nabil in this instance does not assist me in making my decision. The images are undated so I cannot determine when the goods were purported to be on sale. Indeed the images have no context at all. They lack even the most basic of sales information such as pricing, availability or sizing. They are simply images.

17. In relation to the second factor, Q.C.S.C. were emailed by Mr Nabil at the same time as the Tribunal so they were at the very least able to review the material shortly before the hearing began and were able to make brief oral submissions on the matter. The question remains however as to why this material was not submitted in the correct evidential format at a much earlier point in the proceedings. Mr Nabil has not provided an answer to that question beyond the following verbatim oral submission made at the hearing⁷

“In regards of the circumstances of submitting the evidence, maybe I have not submitted it correctly but I still here confirm in myself and in my statement that I use my trade mark. I am not a big lawyer who can know the law exactly and submit everything exactly. I am still a student who is trying to bring the business together to present my case to you as the IPO”.

18. Notwithstanding these comments, there is information available on the IPO website, which was signposted to Mr Nabil in the Tribunal letters dated 26 November 2020 and 15 March 2021, concerning the nature of when and how to provide evidence in support of cancellation proceedings and suggestions of what material is particularly important to show. In cancellation cases concerning non-use this should be material which is adequately dated and the other side need to have seen it well in advance of the hearing to properly consider it.

⁷ Hearing Transcript page 10

19. As for the third factor, Q.C.S.C did not identify any specific prejudice but have already indicated in its skeleton argument that it seeks off-scale costs for what it identifies as issues around Mr Nabil's conduct in these proceedings⁸.

20. Finally in relation to the fourth factor, I do not find that there can be any prejudice caused to Mr Nabil as the material as presented does not assist his case for the very reason set out above in paragraph 16.

21. Therefore I find this additional material should not be admitted as evidence to the proceedings.

Registered Proprietor's evidence

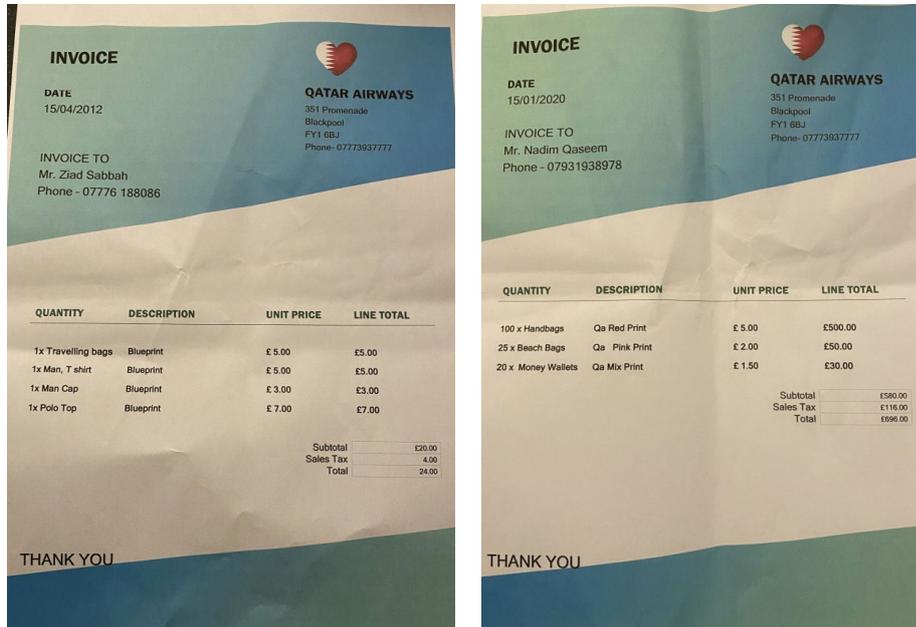
22. Now I turn to Mr Nabil's evidence which was admitted to the proceedings in May 2021. The detail of this admission of evidence was set out in my previous decision, namely BL O/360/21, following the CMC between the parties on 5 May 2021. I do not need to revisit that my decision in detail here but it suffices to say that I admitted the evidence on the basis of the amended TM8N which contained the statement of truth.

23. The admitted evidence consists of nine invoices in total. The invoices in each case set out a sub total from the orders plus a sales tax. I set out below the dates and sub totals of the orders contained therein.

- 15 January 2020 for a total of £580
- 18 May 2019 for a total of £350
- 18 September 2018 for a total of £200
- 15 August 2017 for a total of £300
- 11 February 2016 for a total of £250
- 4 March 2015 for a total of £350
- 12 June 2014 for a total of £200
- 15 May 2013 for a total of £200
- 15 April 2012 for a total of £20

⁸ Skeleton Argument dated 6 October 2021, paragraph 40

24. The invoices amount to a total value of £2450, excluding the sales tax element. All the invoices submitted were in the following format. I have used the 2012 and 2020 invoices by means of an illustration.



25. The words QATAR AIRWAYS appear in the top right of the invoices. On the three invoices dated from 2020, 2019 and 2018, the letters “Qa” appears in the product description column but no explanation is given as to what those letters mean. Otherwise the description column consists of a colour and the word “print”. The goods appearing on the invoices are bags, t-shirts, caps, polo shirts, golf balls, beach balls, mini balls, footballs, sand balls, wallets, beach bags and handbags.

26. Mr Nabil gave no further information in his TM8N of April 2021 as to other sales, turnover or advertising expenditure emanating from the goods provided under the registered trade mark.

Legislation

27. Section 46 of the Act states:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as in referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”.

28. Section 6A(1) applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

29. Section 100 of the Act is as follows:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.

30. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch);

“114. *The law with respect to genuine use.* The CJEU has considered what amounts to ‘genuine use’ of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeviliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816] [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as

a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76];

Leno at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. As such there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].

Sufficiency of use

31. I am guided by the following case law in assessing evidence. In *Awareness Limited v Plymouth City Council*⁹, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and

⁹ BL O/236/13

fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

32. I also note Mr Alexander’s comments in *Guccio Gucci SpA v Gerry Weber International AG*¹⁰, where he stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round- or lose it” “ [original emphasis].

33. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*¹¹, Mr Geoffrey Hobbs Q.C. also sitting as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in

¹⁰ BL O/424/14

¹¹ BL O/404/13

the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

Decision

34. It is clear from the guidance given above that I must consider a number of factors when assessing whether genuine use of the mark has been shown from the evidence. In cases of non-use, the onus is on the Registered Proprietor to provide ‘sufficiently solid’ evidence to refute the claims made. In this case there are a number of particular deficiencies within the evidence provided.

35. Q.C.S.C. extensively criticized Mr Nabil’s evidence in its skeleton argument which it then reiterated in its oral submissions at the hearing, viz

“24. At the outset, the authenticity of these documents should be put into question. There are several details that must appear in a valid invoice in the UK, as can be clearly seen in guidance provided by Her Majesty’s Revenue and Customs (HMRC), which states that the following details must be included in a valid invoice:

- a unique identification number

- the company name, address and contact information - in the case of a sole trader issuing the invoice, it must include the actual name of the sole trader, in addition of any business name.
- the company name and address of the customer that is being invoiced
- a clear description of what you're charging for
- the date the goods or service were provided (supply date)
- the date of the invoice
- the amount(s) being charged
- VAT amount if applicable
- the total amount owed

25. The purported invoices provided by the Registered Proprietor do not feature several of those details - in particular, they do not have a unique identification number, the company (or sole trader) name, which needs to be provided in addition to any business name (such as QATAR AIRWAYS in this case) and the address of the customer that is being invoiced.

26. All the missing details are requirements for any invoice to be valid, as established by the HMRC, and in the absence of these details, the documents submitted as purported invoices cannot be considered as such and do not have any probatory value.

27. There is a single purported invoice for each year during the period 2012 – 2020, all of which are made out to individuals. Mobile phone numbers are provided for each of these individuals, but no addresses or other information. It is also noted that the invoices do not contain invoice numbers, order numbers or other identifiers. Furthermore, given the lack of address provided, it is not clear where these products purport to have been sent. They could have been sent anywhere in the world (if indeed any products were actually sent at all), for example, and not in the UK. The orders may not have been fulfilled and/or the products could have been returned to sender.

28. Most importantly, given the lack of supporting evidence (such as photographs of the products, product catalogues, price lists, etc which would have been extremely easy for the Registered Proprietor to produce had it existed) it is entirely unclear whether any of the products mentioned in the invoices bore the Qatar Airways mark in the requisite trade mark sense (i.e. as a badge of origin) or even at all. The description of the products provided certainly does not make any reference to the trade mark.”

36. I agree with the points raised by Q.C.S.C. In assessing the evidence, I find that a single invoice provided each year from 2012 is insufficient proof that the mark was in genuine use as per the requirements set out by caselaw. Although the words QATAR AIRWAYS appear on the invoices, there is nothing to indicate that this mark was in use on the goods at that given date. Mr Nabil needed to show examples of what goods he used the trade mark on during these periods, not simply show an invoice bearing the contested mark. In terms of the total sales made of £2450, this is a very low level of turnover for 9-year period between 2012 and 2020. Breaking this down to the two alleged periods of non-use, this equates to £1020 during the first revocation period and £1430 during the second revocation period. Whilst the use of a trade mark does not have to be quantitatively significant to be genuine, it is somewhat unfortunate that in his oral submissions Mr Nabil states

“Who said this was my income? I only send you samples. You are not my taxman or my accountant for me to send you and show you exactly how much I made. I have only sent you a small sample of the lowest amount of what we have sold, one each year”¹²

37. If Mr Nabil has not provided evidence of more sales and higher turnover when he states that he has them then he has not made out his best case in the first instance. However if that evidence of higher sales simply consists of more invoices of the sort provided so far then they would not be of any assistance as it has been established that invoices lack the information required to prove use of the marks on the goods during the period of alleged non-use. The lack of dated information concerning the mark as applied to the goods is the greatest barrier in a case concerning non-use.

¹² Hearing transcript page 9

38. In terms of the criticism that there is no customer information beyond a name and mobile telephone number, I agree that there is simply not enough information provided to show where the customer base lies or the geographical extent of the trade mark use. In his oral submissions Mr Nabil said he runs a print on demand service used by Amazon and Redbubble and he gets a commission from them. In addition, he stated that some customers phone in orders and pick them up personally so that he does not involve himself in shipping arrangements¹³. As a consequence, there is no evidence provided to show where the goods are sold in the UK or overseas or where his customers are based.

39. Taking all of the above into account, in my view Mr Nabil has failed to discharge the burden placed on him to provide sufficient evidence of genuine use in respect of the goods for which the trade marks are registered. Simply stating “if I do not use my trade mark then I would say that I don’t need it “¹⁴ is not enough nor is the act of renewing the registered trade mark. A registered proprietor must show sufficiently solid and dated evidence during the periods of alleged non-use and that has not been done in this case.

Conclusion

40. The application for revocation on the grounds of non-use succeeds under sections 46(1)(a) and (b). Consequently, UK trade mark no. 2576287 is revoked in its entirety, the effective date of revocation being the earlier of the two effective revocation dates, namely, 30 July 2016.

Costs

41. As Q.C.S.C has been successful, it is entitled to an award of costs. Ordinarily awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. However in its skeleton argument and at the hearing Q.C.S.C requested costs off the published scale. I allowed Q.C.S.C one week from the date of the hearing to put

¹³ Hearing transcript page 11

¹⁴ Hearing transcript page 11

their detailed reasons for off scale costs in writing. This was received by the Tribunal on 14 October 2021.

42. Q.C.S.C.'s email contained the following reasons for an off-scale costs award to be made

- “Mr Nabil did not meet the IPO’s formality requirements on numerous occasions. In particular, he submitted a total of four different defence forms and counterstatements, which did not comply with the requirements set up by the UKIPO:

a) On 2 October 2020, he submitted his initial handwritten TM8. However, he used a TM8 form, rather than a form TM8(N), and this had to be returned to him to be corrected.

b) 21 October 2020: Mr Nabil submitted the correct form TM8(N); however, as his counterstatement was insufficient, the examiner asked Mr Nabil to submit another corrected form.

c) 24 October 2020: Mr Nabil submitted a third form with an updated counterstatement, which was accepted by the examiner.

d) 9 March 2021: Mr Nabil submitted a fourth form, with a different counterstatement, in light of deficiencies with his evidence. We estimate the additional time spent reviewing and reconciling the various forms and counterstatements amounted to 2.9 billable hours, or £1,112.07. This is additional to the cost that would normally have been incurred for such a task.

- Mr Nabil did not copy Bird & Bird into relevant correspondence. As a result, Bird & Bird was required to contact the UKIPO for clarification on several occasions.
- Mr Nabil missed several deadlines. In particular, he was set a deadline of 26 January 2021 to submit his evidence-in-chief in defence of his registration but failed to do so. Mr Nabil submitted evidence on 9 March 2021, over a month after his initial evidence deadline had passed, and the evidence he did submit was in the incorrect evidential format.

- As a result of the deficiencies with Mr Nabil's evidence, a CMC took place, as you know. This CMC could have been avoided had Mr Nabil complied with the IPO practice. According to our records, around 9 billable hours were spent preparing for and attending the CMC, and for related actions thereafter, totalling £3,173.74 in costs for our client. Mr Nabil's unreasonable conduct as regards his evidence continued right until the end of the proceedings: as you know, he submitted evidence at 2am on the day 2 of the hearing; although we are not claiming costs in relation to that particular instance, it is reflective of the general pattern of Mr Nabil's conduct throughout.

For the above reasons, the Cancellation Applicant incurred costs above and beyond a 'normal' non-use action. We estimate that at least £4,285.81 was incurred on top of the expected costs for this action, and as such we ask that Mr Nabil make a contribution to those additional costs off the usual scale. The total costs incurred by our client were significantly greater than this figure, although we must stress that we are only claiming additional costs that were incurred due to Mr Nabil's conduct mentioned above, e.g. the multiple missed deadlines that led to many client calls and updates that would have been avoided if he had acted reasonably."

43. In terms of awarding off scale costs, the Trade Marks Manual states that the Tribunal can award costs off the scale and approaching full compensation for wider breaches of rules, delaying tactics or other unreasonable behaviour. I would add that according to the leading authority, Rizla Ltd's Application¹⁵, the conduct complained about must be sufficiently unreasonable as to justify off-scale costs.

44. Reviewing the case history of these proceedings, it is clear that Mr Nabil has consistently struggled to meet the deadlines set out by Tribunal in the conduct of the case. In addition to Q.C.S.C.'s summary above, I detail these instances in my decision BL O/360/21 which was taken following the CMC held on these proceedings on 5 May 2021. Neither has Mr Nabil consistently followed the Tribunal guidance that all parties must be copied in on any correspondence. In some instances, during

¹⁵ [1993] RPC 365

the course of these proceedings, Mr Nabil emailed only the Tribunal and not Q.C.S.C. via its agents Bird & Bird. At other times Mr Nabil emailed only Bird & Bird and not the Tribunal. This has led to unnecessary time and administrative effort spent on the forwarding and exchanging of correspondence so that all parties have sight of all information relating to the proceedings.

45. I accept that Mr Nabil is a litigant in person and as such is dealing with tribunal proceedings without the benefit of professional legal advice. However these are serious legal proceedings and indeed the second set of proceedings in which these parties have been engaged in the last year, (the other being opposition proceedings in case no. 600001489¹⁶) and Mr Nabil has been made aware on multiple occasions of the necessity of adhering to the correct tribunal procedures. Simply being a litigant in person does not exempt any party from non-compliance with the requirements set out by the Tribunal to ensure the smooth running of a case. There is nothing before me to suggest that Mr Nabil has acted in this manner deliberately but not complying with deadlines and other Tribunal requirements, even when given the guidance on how to do so by Tribunal staff, has impacted on these proceedings by means of delays and additional administrative effort. However, during the resolution of the TM8N situation, the correspondence was between Mr Nabil and the Tribunal and did not require intervention from Q.C.S.C. I accept that during the Case Management Conference, Q.C.S.C. had to forward Mr Nabil's emails to the Tribunal. However I should point out that they were ultimately unsuccessful at the CMC so I do not find it is appropriate to award costs for it. I also accept whilst Mr Nabil's late filed evidence was ultimately not admitted, Q.C.S.C. still needed to consider it at very short notice on the morning of the hearing. This was undoubtedly an inconvenience to the other side, however I do not find it has caused significant detriment and does not merit an off-scale award. Notwithstanding I find it does merit a higher scale cost award.

46. Taking the above into account I award the following costs:

¹⁶ My decision BL O/181/21 refers.

£200	Official fee for the TM26N
£500	Preparing the statement of grounds and considering other side's statement
£500	Considering other side's evidence
£1300	Preparing for the hearing
£2500	Total

47. I order Mr Awad Nabil to pay Qatar Airways Group (Q.C.S.C.) the sum of £2500. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 10th day of November 2021

June Ralph

For the Registrar