

O-0081-25

TRADE MARKS ACT 1994

SUPPLEMENTARY DECISION ON COSTS

**IN THE MATTER OF TRADE MARK REGISTRATION NOS. 915823991, 3185199,
2566730, 3023980, 3036230, 3039469, 3407316, 3546687, AND 918324246
IN THE NAME OF BIMS WALTHAMSTOW LIMITED OR BIMS AFRICAN FOOD
STORE LIMITED**

**AND IN THE MATTER OF THREE GROUPS OF CROSS CONSOLIDATED
INVALIDATION/REVOCAION PROCEEDINGS THERETO UNDER NOS. 505291,
504844, 505290, 503843, 504693, 504695, 504687, 504699, 504694, 504696,
504698, 504700, 504462, 504464 AND 504465 BY BIMS AFRICAN FOOD STORE
LIMITED OR BIMS WALTHAMSTOW LIMITED**

AND

**IN THE MATTER OF TRADE MARK REGISTRATION NOS. 3333445
IN THE NAME OF KARIM ZIGHECHE**

**AND IN THE MATTER OF INVALIDATION PROCEEDINGS THERETO UNDER
NO. 504463 BY BIMS AFRICAN FOOD STORE LIMITED**

1. On 18 November 2024, my decisions (BL O/1088/24, BL O/1089/24, BL O/1090/24 and BL O/1091/24) were issued regarding the above-mentioned proceedings. Supplementary decision BL O/1092/24 was issued on 19 November 2024 correcting a clerical error in decision BL O/1091/24. In these decisions, BIMS Walthamstow Ltd was identified as Party A, BIMS African Food Store Limited as Party B and Karim Zigheche as Party C. On the issue of costs, I stated the following in all four decisions:

“In light of the complexity of the proceedings that were subject to the hearing, I indicated that I would seek written submissions on costs after all four substantive decisions are issued covering all the proceedings that were the subject of the hearing. The parties are therefore directed to provide written submissions within 21 days of the date of this decision and these are to address each group of cases in turn. I will then issue a supplementary decision in respect of the costs award in each group of cases.”

2. I intend to consider the issue of costs in all four sets of proceedings in this single supplementary decision.

3. Party B filed submissions on costs on 19 December 2024. Party A/C were granted further time in order to respond to Party B’s submissions and provided its submissions on 16 December 2024 and on 19 December 2024 Party B filed submissions in reply.

4. Section 68 of the Trade Marks Act 1994 (“the Act”) states:

“68. - (1) 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.”

5. Rule 67 of the Trade Marks Rules 2008 enacts this:

“Costs of proceedings; section 68

67. 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.”

6. Tribunal Practice Notices (“TPN”) 2/2000 and 4/2007 are also relevant. Having referred to the leading case, *Rizla Ltd’s Application* [1993] RPC 365, TPN 2/2000 goes on to state:

“5. In the light of *Rizla*, the Office considers that the existing legislation provides the power to operate a nominal cost regime or a full cost recovery regime - or anything in between - and that no legislative change is necessary to put in hand any revision of that sort.”

7. I find it appropriate to consider each of the four groups in turn. In my original decisions, I named these four groups Group A (the subject of decision BL O/1088/24), Group B (the subject of decision BL O/1089/24), Group C (the subject of decision BL O/1090/24) and Group D (the subject of decision BL O/1091/24). I shall do so again here, beginning with Group B.

Group B: 504693/504695/504697/504699/504694/504696/504698/504700

8. This group consisted of Party B’s four applications for revocation and four applications for invalidation against four of Party A’s marks. Party B was wholly successful in all eight applications.

9. In its submissions, Party B appears to place its arguments regarding this group under the heading “Group A (BIMS Kitchen marks)” and its submissions in respect of Group A under the heading “Group B (BIMS Marks of BAFS)”. I will therefore consider what appears to me to be the correct submissions rather than those made under the heading “Group B...”.

10. Party B proposed an award of costs as follows:

- £650 for preparing statements
- £2,200 for preparing evidence
- £1600 for preparing for, and attending hearing
- £1600 (8 x £200 official fees)
- TOTAL: £6050

11. Party A states that it is prepared to accept these figures but argues that the amounts claimed in respect of the “Group B” (I take this as relating to “Group A” as per my comment at [8], above) and Group D are excessive and duplicated. I keep this in mind when considering the costs associated with the Group A and Group D cases.

12. I generally agree with the level of costs proposed by Party B but consider the approach relating to the preparation for and attending the hearing should be based on a slightly different analysis. The standard published scale of costs¹ lists a sum of “Up to £1600 per day of hearing, capped at £3300...” in respect of preparing for and attending a hearing. In the current case, the hearing lasted one and a half days. In light of the number of proceedings covered by the hearing and the detailed issues that arose, I consider that the full daily amount of £1600 should be scaled up at the same rate so that for the 1.5 days hearing the total amount should be £2400. The four sets of proceedings involved a total of sixteen cases. Group B involved half of these cases and I apportion half the total amount to this case, namely £1200.

13. Taking account of my conclusion regarding costs relating to the hearing and the fact that I concur with Party B’s proposal in other respects, I award costs, in favour of Party B, as follows:

Preparing and filing statements of case (x8) and considering Party A’s statements	£650
Officials fees x 8	£1600

¹ Contained in Tribunal Practice Notice 2/2016

Preparing evidence and considering other party's evidence:	£2200
Preparing for, and attending hearing:	£1200
Total:	£5650

Group A: 505291/504844/505290/503843

14. I remind myself that Party A was partially successful in respect of its two applications for revocation (based on non-use) but failed in its two applications for invalidation.

15. Party B draws attention to the fact that Party A abandoned its applications for revocation at the hearing, to the same extent that Party B claimed use in its counterstatement (Form TM8). Party B also points out that it received no warning prior to the filing of the applications for revocation and claims that it "surrendered the revoked goods at the earliest possible opportunity". This statement is not strictly accurate because there has been no surrender filed by Party B. More accurately it did not defend the revocation in respect of the goods where no use was claimed. It was, therefore, clear from the time that Party A received Party B's defence that it was aware of the scope of Party B's use claim and that such a claim was not objectionable to Party A. I keep this in mind as I consider the level of costs for this group.

16. In addition to these two revocations, I keep in mind that Party A's two applications for invalidation failed in their entirety. Taking this into account, Party B is entitled to costs in its favour in respect of these two applications.

17. Party B proposed an award of costs as follows:

- £650 for preparing defence statements
- £2200 for preparing evidence
- £1000 for preparing for, and attending hearing
- TOTAL: £3850

18. Party A indicated that it would accept:

- £650 for preparing statements
- £1000 for preparing evidence
- £0 in respect of the hearing
- TOTAL: £1650

19. In light of my earlier comments in respect of the distribution of costs arising from the hearing, this group consisted of four of the sixteen cases being heard and, consequently, I award a quarter of the total hearing costs i.e. £600.

20. As referred to earlier, Party A submits that the amount claimed for the preparation of evidence and preparation for the hearing is excessive and involved duplication of work conducted in respect of the Group B cases. I agree in part with Party A's submissions. One of the two witness statements provided on behalf of Party B included a history of Party B and its predecessor's business dating back to 1993 and has notable overlap with its evidence-in-chief provided in the Group B proceedings. Party B's evidence served a dual purpose, namely, to demonstrate genuine use in support of its defence in the revocation proceedings and also to demonstrate an earlier goodwill in support of its defence in the applications for invalidity. Therefore, the evidence was equally relevant to both Party A's revocation actions and invalidation actions. Regardless of whether the evidence was unnecessary or not in respect of the former, its preparation was still relied upon in the latter. Consequently, I disagree with Party B's submission that an earlier concession from Party A would have reduced the evidential burden for Party B. Taking all of this into account, I consider the £1000 suggested by Party A to be an appropriate award of costs in respect of preparing evidence.

21. Both parties are in agreement in respect of the level of costs to be awarded in respect of preparation of statements and I also agree with their suggestion, namely £650.

22. In respect of the official fees, Party A is entitled to 2 x £200 in respect of its partially successful applications for revocation and I discount the award to Party B by £400.

23. In light of the above, the level of scale costs in favour of Party B and in respect of this group of cases is as follows:

Preparing and filing statements of case (x2) and considering Party A's statements	£650
Preparing evidence and considering other party's evidence:	£1000
Preparing for, and attending hearing:	£600
Discount (Party A's official fees r.e. revocations)	(£400)
Total:	£1850

Group C: 504462/504464/504465

24. This group consisted of Party B's three applications for invalidation of three of Party A's marks. Party B was partially successful to in respect of two of the applications for invalidation but failed in its entirety in the third.

25. Party B submits that a "fair outcome" would be for each party to bear their own costs. Party C disagrees and categorises the outcome of the proceedings as Party A having "won substantially". I do not agree with this characterisation. As pointed out by Party B in its reply submissions, it was substantially successful in two of the proceedings, failing in respect of only two terms in the list of goods and services of each of Party A's registrations. This, together with the total success for Party B in the third of these proceedings makes me believe that Party B's submission is a fair one and that each party should bear its own costs.

Group D

26. Party B's single application for invalidation of Party C's registration succeeded in its entirety and is, therefore, entitled to a contribution towards its costs.

27. Party B submit that the following costs should be awarded in its favour:

- £650 for preparation of statement
- £2200 for preparing evidence
- £1000 in respect of the hearing
- £200 for the official fee
- Total £4050

28. Party C indicates that it would accept:

- £650 for preparing statement
- £1000 for evidence
- £0 in respect of the hearing
- £200 for the official fee

29. Despite the parties agreeing in respect of the amount to award in respect of Party B's preparation of the statement of case, I consider the amount (that equates to the maximum of the scale) to be excessive. Whilst the statement of case detailed three grounds, I do not consider that this application for invalidation was of the highest level of complexity and consider that £400 would be a proportionate amount.

30. Similarly, I do not consider that the evidence burden upon Party B merits a maximum of the scale. The level suggested by Party C is far more reasonable and I award £1000 in respect of this.

31. Consistent with my earlier comments regarding the apportionment of costs in respect to the hearing, this Group D case was only one of sixteen cases heard on the day. I award that proportion of the total £2400, namely, £150 in respect of the hearing.

32. In light of my considerations, I award the following costs in favour of Party B:

Preparing and filing statement of case

£400

Official fee	£200
Preparing evidence and considering other party's evidence:	£1000
Preparing for, and attending hearing:	£150
Total:	£1750

Summary

33. Taking all of the above into account and recognising that Mr Zigheche is a different legal entity than his company, BIMS Walthamstow Limited, I make two costs award, both in favour of BIMS African Food Store Limited.

First Award

34. Firstly, I award BIMS African Food Store Limited a contribution towards the costs of the Group A, Group B and Group C proceedings, the sums of which have been calculated as shown earlier in respect to each group, and amount to:

Group A: £1850
Group B: £5650
Group C: none
TOTAL: £7500

35. I therefore order BIMS Walthamstow Ltd to pay BIMS African Food Store Limited the sum of **£7500**. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Second Award

36. Secondly, I award BIMS African Foodstore Limited a contribution towards the costs of the proceedings in respect of the Group D case, the sum of which have been calculated as shown at paragraph 31, above, and totals £1750.

37. I therefore order Karim Zigheche to pay BIMS African Food Store Limited the sum of **£1750**. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 29th day of January 2025

Mark Bryant
For the Registrar