

**TRADE MARKS ACT 1994**

**IN THE MATTER OF CROSS OPPOSITIONS INVOLVING APPLICATION NO.  
2424749 FOR THE TRADE MARK "RIG COOLING" IN THE NAME OF OPTIMA  
SOLUTIONS UK LIMITED AND OPPOSITION THERETO UNDER NO. 99708 BY  
RIGCOOL LTD**

**AND**

**APPLICATION NOS: 2445949 & 2466128 FOR THE TRADE MARKS "RIGCOOL LTD  
HEAT SUPPRESSION SAFETY SYSTEMS" & "RIGCOOL LTD – RIGCOOLING  
SOLUTIONS" AND CONSOLIDATED OPPOSITIONS THERETO UNDER  
NOS: 95388 & 96914**

## **BACKGROUND**

1. In these proceedings I have been asked to provide a statement of reasons for a matter on which I expressed a preliminary view at a Case Management Conference (“CMC”) held on 8 June 2010. At that CMC Optima Solutions UK Limited (“Optima”) were represented by Mr Douglas Thomson of Marks & Clerk (“MC”) and Rigcool Ltd (“RL”) were represented by Ms Joanna Lowther of Hindle Lowther (“HL”). However, in order to place both my preliminary view and my later decision into context, it is necessary first for me to explain the inter-relationship between the various proceedings together with the stages they had reached at the time of the CMC.

### **RL’s opposition to Optima’s application for RIG COOLING**

2. On 16 June 2006, Optima applied to register the trade mark RIG COOLING for a range of goods and services in classes 7, 11, 35, 37 and 42. The application was examined and objections raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 (“the Act”). Following discussions with the Trade Marks Registry (“TMR”) the application was accepted and published for opposition purposes on 31 July 2009 in Trade Marks Journal (“TMJ”) No. 6796 for the following services in classes 35 and 37:

“Personnel recruitment services; personnel recruitment agency services; personnel recruitment consultancy; advertising services relating to the recruitment of personnel; recruitment consultancy services; assistance relating to recruitment and placement of staff; advisory services relating to personnel recruitment; business recruitment consultancy; interviewing services [for personnel recruitment]; management advice relating to the recruitment of staff; professional recruitment services; recruitment consultants in the oil and gas industries; recruitment of temporary technical personnel; assistance relating to recruitment and placement of staff; employment placement services; placement of staff; placement of personnel skilled in the oil and gas industries; provision of offshore and onshore personnel; information, consultancy and advisory services in respect of the aforesaid services.”

“Application of fireproof materials; underwater construction and repair services; installation of fire detection systems.”

3. On 2 November 2009, HL on behalf of RL filed a Form TM7 to oppose the application. The opposition is based on sections 3(1)(b), (c) and (d) of the Act (on the basis that the words RIG COOLING describe the service of cooling oil and gas rigs) and section 3(3)(b) of the Act (on the basis that the services would be deceptive if they did not). On 3 December 2009, the TMR served the Form TM7 on MC allowing them until 3 February 2010 to file a Form TM8 (“Notice of defence and counterstatement”). On 3 February 2010, MC filed a Form TM8N (“Notice of defence and counterstatement for use in revocation on the grounds of non-use”) in which, I note, RL’s claims are denied. On 2 March 2010, the TMR wrote to MC (copied to HL). That letter read:

“Thank you for your letter dated 03 February 2010 in which the applicant submitted a Form TM8(N) and counter-statement.

Please note that the applicant has submitted the incorrect form, the correct form to use in opposition proceedings is a Form TM8. A copy of the Form TM8 is enclosed for your perusal.

In order to progress the matter a period of fourteen days that is on or before 16 March 2010, has been allowed for the applicant to submit the correct version of the Form TM8.

Upon receipt of the amended Form TM8 the Registry will commence the evidence rounds.”

4. On 8 March 2010 MC filed Form TM8. In an official letter dated 11 March 2010, the TMR served a copy of this Form on HL and set a timetable for the filing of evidence in which RL were allowed until 11 June 2010 to file their evidence in chief. In an official letter dated 20 April 2010, the TMR advised the parties that a CMC was to be held, by telephone conference, on 13 May 2010 (albeit at that time in relation to unrelated issues); the CMC was rescheduled to 8 June.

5. On 26 April 2010, HL wrote to the TMR in response to the official letters of 2 and 11 March 2010. In that letter they argued that the approach adopted by the Case Work Examiner (“CWE”) in the official letters mentioned above was inappropriate, the consequence of which was that Optima’s application for registration should be treated as abandoned because MC had filed a Form TM8(N) as opposed to a Form TM8; HL requested a hearing and asked for RL’s evidence period to be suspended until the issue was resolved. In an official letter dated 28 April 2010, the CWE advised the parties that the TM8 issue would be dealt with at the CMC; MC were allowed until 7 May 2010 to comment on the issue.

6. On 7 May 2010, MC responded arguing, inter alia, that the CWE had acted correctly. In a letter dated 4 June 2010, HL argued that the matter should not be dealt with at the CMC and requested a hearing in person in Glasgow. In an official letter dated 7 June 2010, the TMR responded indicating once again that the issue would be dealt with at the CMC.

#### **Optima’s oppositions to RL’s “Rigcool Ltd” applications**

7. On 7 February and 4 September 2007 respectively, RL applied to register the following trade marks:

No. 2445949

Rigcool Ltd Heat Suppression Safety Systems

And:

No. 2466128

### RigCool Ltd – RigCooling Solutions

8. Both applications were examined and accepted and were subsequently published for opposition purposes on 27 April 2007 in TMJ No. 6681 (2445949) and 8 February 2008 in TMJ 6722 (2466128) for identical specifications in class 9 which read:

“Safety apparatus [for the prevention of accident or injury]; apparatus for suppressing fires; apparatus for extinguishing fires; fire control equipment; fire fighting apparatus.”

9. Forms TM7 were filed by Kennedy’s Patent Agency Limited (“Kennedy’s”) on 27 July 2007 (opposition No.95388) and by MC on 21 April 2008 (opposition No. 96914); both were based on sections 3(6), 5(2)(b), 5(3) and 5(4)(a) of the Act (the 5(2)(b) and 5(3) claims relied upon application No. 2424749 i.e. the subject of Optima’s application for registration mentioned above and opposed by RL under opposition No. 99708).

10. The TMR served these forms on RL’s professional representatives at that time Lawdit Solicitors Limited (“Lawdit”) on 29 August 2007 and 28 April 2008 respectively, and Forms TM8 were filed by Lawdit on 29 November 2007 and 29 July 2008. In official letters dated 17 January and 6 August 2008, Optima were allowed until 17 April and 6 November 2008 respectively to file their evidence in chief. Following the filing of a number of requests for extensions of time by MC (who replaced Kennedy’s as Optima’s agents in opposition No. 95388 in April 2008), the TMR wrote to the parties on 15 October 2008 indicating that the proceedings would be consolidated. The time for Optima to file their evidence in the now consolidated proceedings was subsequently further extended to 6 February 2009. On 5 February 2009, MC filed the witness statements of James Oag (and 11 exhibits) and Peter Bartholomew (and 2 exhibits). In an official letter dated 12 February 2009, RL were allowed until 5 May 2009 to file their evidence in the consolidated proceedings; RL chose not to file any evidence.

11. In an official letter dated 8 July 2009 indicating that the evidential rounds were considered complete, the TMR queried the wording of exhibit JO7 to the statement of Mr Oag. It was, inter alia, this issue which led to the CMC. Although the TMR were unable to resolve this issue in correspondence, it was satisfactorily resolved at the CMC (see paragraph 13 below).

12. I note that in a letter dated 10 May 2010, HL advised the TMR that they had been appointed to act for RL in the consolidated proceedings.

## Conclusions reached at the CMC

13. My letter of 9 June 2010 addressed to Mr Thomson following the CMC read:

“The issues discussed at the CMC and the conclusions reached were as follows:

### **The witness statement of Curtis Wilie filed as part of Exhibit JO7 to the witness statement of James Oag**

At the CMC you agreed that the witness statements in this exhibit were first filed during the ex-parte examination of application No. 2424749. This led Mr Oag to refer in his witness statement of 14 January 2009 to “a different action”, which in turn led to the Trade Mark Registry’s request for clarification. In light of your explanation, I confirmed that Mr Oag’s witness statement and the original exhibit JO7 were acceptable and no further action on your part was necessary.

### **Rigcool’s request (i) that application No. 2424749 be treated as abandoned because the wrong style Form TM8 was filed, and (ii) the filing of additional evidence in consolidated proceedings 95388/96914**

Having heard the parties’ submissions at the CMC, I allowed Ms Lowther until 5pm on 15 June to confirm in writing if her client wishes to pursue these points. If they do, Ms Lowther should advise if they wish to attend a hearing and if so on what basis i.e. by telephone or video conference or with Ms Lowther in attendance in Newport. If a hearing is required, both parties agreed to make themselves available within 7 days of the above date i.e. no later than 22 June.

If Ms Lowther’s client wishes to pursue these points other than at a hearing i.e. by filing written submissions, these written submissions (which should be copied to you) must be received by the Trade Marks Registry in the timeframe mentioned above. You will then be allowed a further period of 7 days from the receipt of the written submissions by you to provide any comments you wish to make.

### **Optima’s application No. 2424749 and its basis as a ground of opposition under sections 5(2)(b) and 5(3) of the Act in consolidated proceedings 95388/96914**

At the CMC you confirmed that Optima would not be pursuing the ground based on section 5(2)(b) of the Act but wished to maintain their objection under section 5(3). Despite Ms Lowther’s submissions to the contrary, this letter is, in my view, sufficient to reflect that change; there is no need for a formal amendment to the notice of opposition or counterstatement.

### **Next steps and the further conduct of these proceedings**

I will issue further directions when the TM8/additional evidence points have been determined. However, the parties did agree that if opposition No. 99708 continues the consolidated opposition proceedings should be suspended to allow that opposition to catch up. It was also agreed that in those circumstances evidence periods of two months would be appropriate with a view to all of the proceedings being substantively determined at the same time i.e. by late 2010.”

14. HL wrote to the TMR in a letter dated 15 June 2010. As this letter forms the basis of their arguments as to why Optima’s application No. 2424749 should be treated as abandoned, I will return to it in more detail later. That said, I note that the opening paragraph reads:

“During the CMC, the Hearing Officer was not willing to agree to an in-person Hearing in Glasgow despite the fact that both parties are based in Scotland, and **he also suggested that the requirement to use a TM8 should be satisfied by the filing of the Form TM8(N) as it contained the same information as a TM8 would have.** As the costs that would be involved in attending a hearing in Newport would be relatively high, and that the prospect of UK application No. 2424749 be treated as abandoned at any such Hearing would, in the light of the Hearing Officer’s comments appear low, Rigcool have decided at this stage to pursue this matter by way of written arguments.” (my emphasis)

15. In a letter dated 25 June 2010, MC wrote to the TMR. They said:

“I have not responded to the letter from opposing counsel. The reason for this is that all the points which I had wished to make are already on file or were raised at the Case Management Conference.”

### **Conclusions reached following RL’s written submissions:**

16. Having considered HL’s written submissions the CWE (at my direction) responded to HL in an official letter dated 7 July 2010. This read:

“Your letter of 15 June and Mr Thomson’s response of 25 June have now been considered by Mr Salthouse.

**Rigcool’s request that application No. 2424749 be treated as abandoned because the wrong style Form TM8 was filed**

In relation to the above, and essentially for the reasons he gave at the CMC, Mr Salthouse remains of the view that as, inter alia, the Form TM8N filed by Optima contained all the necessary information, the approach adopted in the official letter of 2 March was correct. The consequence of that decision is that the application will not be treated as abandoned and opposition proceedings No. 99708 will

continue. Should you require a fuller explanation of the reasons for this decision you should file a Form TM5 requesting a statement of reasons, together with the required fee (£100) within one month of the date of this letter.

### **Evidential periods in opposition No. 99708**

As agreed at the CMC, **Rigcool are now allowed a period of 2 months from the date of this letter to file any evidence they consider appropriate.** Further evidential periods of 2 months i.e. for Optima's evidence and Rigcool's reply will follow.

### **The filing of additional evidence in consolidated proceedings 95388/96914**

Further to the discussions at the CMC, **Rigcool are now allowed a period of 2 months from the date of this letter to consider filing evidence in the above proceedings.** Should they chose to file evidence, Optima will on receipt of that evidence be allowed a period of 2 months to file any evidence-in-reply they consider appropriate. When the evidence rounds in these proceedings are complete, the proceedings will, as agreed at the CMC, be suspended to await the completion of the evidence rounds in opposition No. 99708."

17. On 6 August 2010, HL filed a Form TM5 requesting a statement of reasons for my decision not to treat Optima's application No. 2424749 the subject of opposition No. 99708 as abandoned, notwithstanding the erroneous filing by MC of a Form TM8(N).

## **DECISION**

### **The Law**

18. Opposition proceedings are governed by section 38 of the Act and by rules 17 and 18 of the Trade Marks Rules 2008. The relevant parts read as follows:

### **The Act**

"38. - (1) When an application for registration has been accepted, the registrar shall cause the application to be published in the prescribed manner.

(2) Any person may, within the prescribed time from the date of the publication of the application, give notice to the registrar of opposition to the registration.

The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition."

## The Rules

“17.—(1) Any notice to the registrar of opposition to the registration, including the statement of the grounds of opposition, shall be filed on Form TM7.

(2) Unless paragraph (3) applies, the time prescribed for the purposes of section 38(2) shall be the period of two months beginning with the date on which the application was published.

(3) This paragraph applies where a request for an extension of time for the filing of Form TM7 has been made on Form TM7A, before the expiry of the period referred to in paragraph (2) and where this paragraph applies, the time prescribed for the purposes of section 38(2) in relation to any person having filed a Form TM7A (or, in the case of a company, any subsidiary or holding company of that company or any other subsidiary of that holding company) shall be the period of three months beginning with the date on which the application was published.

(4) Where a person makes a request for an extension of time under paragraph (3), Form TM7A shall be filed electronically using the filing system provided on the Office website or by such other means as the registrar may permit.

(5)...

(6)...

(7)...

(8) The registrar shall send a copy of Form TM7 to the applicant and the date upon which this is sent shall, for the purposes of rule 18, be the “notification date”.

(9)...

18.—(1) The applicant shall, within the relevant period, file a Form TM8, which shall include a counter-statement.

(2) Where the applicant fails to file a Form TM8 or counter-statement within the relevant period, the application for registration, insofar as it relates to the goods and services in respect of which the opposition is directed, shall, unless the registrar otherwise directs, be treated as abandoned.

(3) Unless either paragraph (4), (5) or (6) applies, the relevant period shall begin on the notification date and end two months after that date.

(4)...

(5)...

(6)...



(7) The registrar shall send a copy of Form TM8 to the person opposing the registration.”

### **The rules relating to extensions of time**

19. These can be found in, inter alia, rules 77(1) and (5) and in Schedule 1 (which I note refers to rule 18(1) i.e. filing of a counterstatement in opposition proceedings). The relevant rules read:

“77—(1) Subject to paragraphs (4) and (5), the registrar may, at the request of the person or party concerned or at the registrar’s own initiative extend a time or period prescribed by these Rules or a time or period specified by the registrar for doing any act and any extension under this paragraph shall be made subject to such conditions as the registrar may direct.

(5) A time limit listed in Schedule 1 (whether it has already expired or not) may be extended under paragraph (1) if, and only if—

(a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the registrar, the Office or the International Bureau; and

(b) it appears to the registrar that the irregularity should be rectified.”

20. Section 66 and Rule 3 which relate to the use of forms are also relevant and read:

### **The Act**

“66. - (1) The registrar may require the use of such forms as he may direct for any purpose relating to the registration of a trade mark or any other proceeding before him under this Act.

(2) The forms, and any directions of the registrar with respect to their use, shall be published in the prescribed manner.”

### **The Rules**

“3-(1) Any forms required by the registrar to be used for the purpose of registration of a trade mark or any other proceedings before the registrar under the Act pursuant to section 66 and any directions with respect to their use shall be published on the Office website and any amendment or modification of a form or of the directions with respect to its use shall also be published on the Office website.

(2) Except in relation to Forms TM6 and TM7A a requirement under this rule to use a form as published is satisfied by the use either of a replica of that form or of a form which is acceptable to the registrar and contains the information required by the form as published and complies with any directions as to the use of such a form.”

### **The factual background**

21. As I mentioned above, application No. 2424749 was published for opposition purposes on 31 July 2009. On 30 September 2009, HL filed (under the provisions of rule 17(2)) a Form TM7a which (under the provisions of rule 17(3)) extended the period for them to file the Form TM7 until 31 October 2009. As 31 October 2009 fell on a Saturday which is not a business day, section 80 of the Act is relevant. It reads:

“80. - (1) The registrar may give directions specifying the hours of business of the Patent Office for the purpose of the transaction by the public of business under this Act, and the days which are business days for that purpose.

(2) Business done on any day after the specified hours of business, or on a day which is not a business day, shall be deemed to have been done on the next business day; and where the time for doing anything under this Act expires on a day which is not a business day, that time shall be extended to the next business day.

(3) Directions under this section may make different provision for different classes of business and shall be published in the prescribed manner.”

22. On 2 November 2009 (the following Monday and the next business day), HL filed a Form TM7 together with the appropriate fee; the filing on this later date was acceptable under the provisions of section 80(2) of the Act.

23. Under the provisions of rules 18(1) and 18(3), the TMR served the Form TM7 on MC on 3 December 2009 allowing them until 3 February 2010 to file Form TM8. On 3 February 2010, MC filed a Form TM8(N) which as I have mentioned above is the form a registered proprietor should file when defending itself against an application for revocation on the grounds of non-use; the correct form is Form TM8. In an official letter dated 2 March 2010, the TMR gave MC an opportunity to correct their error; the correct form was filed by MC on 8 March 2010. HL say that the TMR's approach was wrong, and what the TMR should have done was to treat Optima's application as abandoned under the provisions of rule 18(2).

## **RL's arguments**

### **Their letter of 26 April 2010**

24. As I mentioned earlier, the official letter of 2 March 2010 advising MC that they had filed the wrong Form TM8 was copied to HL, as was the official letter of 11 March 2010 which served the replacement Form TM8 on them and set the period for them to file RL's evidence in chief. However, it was not until 26 April 2010 that HL chose to respond to either of those official letters. In their letter HL say, inter alia:

"The applicant did not submit a Form TM8 within the relevant period. Nor did they submit a replica of that form. Instead they submitted a different form which looks quite different and which requests different information to a Form TM8, and which the Registry direct should be used for completely different proceedings namely, revocation actions on the grounds of non-use. Accordingly, we submit that the requirements of Rule 18(1) were not met, and that under Rule 18(2) [the application] must be treated as abandoned unless the registrar otherwise directs. However, we would also submit that under the Trade Marks Act and the Rules, it is not open to the registrar to direct otherwise."

And:

"Any direction by the registrar to allow the applicant to file a TM8 outside the relevant period would in substance amount to granting an extension of time to the deadline for filing a Form TM8...Therefore we would submit that it was not appropriate for the Case Work Examiner to allow the applicant further time in which to file a Form TM8 and that, accordingly, [the application] should have been treated as being abandoned."

## **MC's arguments**

### **Their letter of 7 May 2010 in response to the above**

25. In that letter MC say inter alia:

"...that the Case Work Examiner has acted properly and, secondly, that Form TM8 which we filed on 8 March should be admitted into these proceedings,"

"Looking at my file, it is clear that Form TM8(N) was erroneously submitted on 3 February. I hold that the filing of that Form was clearly an administrative oversight as the cover letter specifically refers to the filing of the Form TM8 not TM8(N)."

26. Having focused on what MC refer to as rule 77(1)(b) (which I assume is meant to be a reference to rule 77(5)(b)) which is not relevant, MC go on to say:

“Returning now to the administrative oversight which led to the filing of Form TM8(N), we observe that counterstatement on each form was the same. We conclude from this that the applicant’s defence was fully set out in the form attached to our letter dated 3 February although we accept that the correct form was not used. The opponent has, we conclude, not suffered any real disadvantage by the erroneous filing of the Form TM8(N).”

**RL’s written submissions of 15 June 2010 in lieu of attendance at a hearing**

27. Give that this represents RL’s substantive submissions in relation to the issue that is before me, the relevant parts are reproduced in full below. Having reproduced the text of rules 3(1) and (2) RL say:

“Firstly, we submit that the Form TM8(N) submitted by Optima’s agents, [MC], is not a replica of the Form TM8. The Form TM8(N) is intended for and refers to different proceedings...looks quite different to a Form TM8, and asks a number of questions not included on a TM8 and omits some questions asked on the TM8.

We would also submit that the Form TM8(N) filed by [MC] did not contain the information required by the Form TM8 as published. For example, question 9 on the Form TM8 states: “Do you want a Preliminary Indication on section 5(1) and/or (2) grounds to be issued? Unlike in relation to question 5, which relates to proof of use, there is no indication in the notes at the bottom of the Form TM8 that question 9 should only be answered where an application has been opposed on Section 5(1) and/or (2) grounds.

Further, even if it were held that the Form TM8(N) is acceptable to the registrar and if it were held that the Form TM8(N) contains the information required by the Form TM8 as published, we would argue that the filing of a Form TM8(N) does not comply with directions as to the use of such a form.

As can be seen from the enclosed documents which have been downloaded from the Office’s website, it is clear that the office directs that a Form TM8(N) should only be used in relation to revocation proceedings on grounds of non-use and it is a Form TM8 which should be used in relation to opposition proceedings.

We also submit that the reference in Rule 3(2) to a replica of a form, or a form which is acceptable to the registrar was intended to allow electronic filing or the provision of forms output from databases which correspond in content but not in layout and graphical presentation, subject to suitable directions, and was not intended to encompass the submission of a wrong form which simply has similar numbering.

Accordingly, we submit that the requirements to use a Form TM8, (Rule 18(1)), was not satisfied by the use of the Form TM8(N)...we submit that as the

applicant, Optima, did not submit a Form TM8 within the relevant period [the application] must be treated as abandoned.

In their letter of 7 May 2010, the applicant sought to draw attention to Rule 77(1)(b). However, the Trade Marks Rules 2008 do not contain a Rule 77(1)(b). If the applicant was intending to refer to Rule 77(5), including 77(5)(b), we submit that this section cannot be relied upon to effectively extend the time limit for submitting a TM8 since it is only intended to cover circumstances where an irregularity or prospective irregularity is attributable wholly or in part to the Registrar, the Office, or the International Bureau, which is not the case here.

Although on the face of it, it may appear unfortunate if [the application] is treated as abandoned because the applicant's agents submitted an incorrect form, we would submit that the Registrar is not entitled to adopt procedures which are in direct contradiction to the express provisions of the Trade Marks Act and Rules. We refer to the comments of Pumfrey J in *Pharmedica GmbH's Application* [2000] RPC 526 in which he stated at page 514 that:

*"Notwithstanding the fact that the registrar is, like the county court, a tribunal which is established by statute, I have no doubt that the registrar has the power to regulate the procedures before her in such a way that she neither creates a substantive jurisdiction where none existed nor exercises that power in a manner inconsistent with the express provisions conferring jurisdiction upon her."*

We also refer to the comment of the Geoffrey Hobbs QC in Opposition No. 90599 in the name of Uniter SpA to Application No. 2199661A, in the name of KML Invest AB (O-084-04) when he states in paragraph 15:

*"I regret that I am unable to grant the Applicant relief or dispensation. I would have allowed it to rely on the Form TM8 which it sent to the Registry on 25th September 2002 if I could have found a way of enabling it to do so in accordance with the Act and the Rules. However, the provisions of Rules 13(3), 13(6), 68(1) and 68(3) are too stringent and explicit to be denied their full meaning and effect."*

Accordingly, on the basis of the above, and our arguments set out in our letter of 26 April 2010, we submit that [the application] should be treated as abandoned."

28. There is no dispute that having been set a deadline of 3 February 2010 by which to file Form TM8 and counterstatement, that on 3 February 2010 MC incorrectly filed a Form TM8(N) (a copy of the TM8(N) filed by MC is at Annex 1 to this decision). However, as the Form TM8(N) filed by MC was identified by the TMR as referring to the current proceedings, the error made by MC when they filed the wrong style Form TM8 clearly did not engage the concerns referred to by the Appointed Person in the *KML Invest* case mentioned above namely:

“In Re M’s Application [1985] RPC 249 the importance of insisting upon the use of prescribed forms was explained by Falconer J. at p.260 in the following terms:

“..... it means that the Office knows at once how to process a document coming in. If there were not prescribed forms for the very many steps which have to be taken, an application or a step in an application might be taken in any form at all and, as it was put, the Office could not as a practical matter operate and the only sensible system is to have prescribed forms for the various steps which have to be taken, as a matter of practicality and, indeed, workability. However that may be, under the statute it is mandatory that the prescribed form shall be used, and it is mandatory that you pay the prescribed fee; and I cannot regard mandatory requirements under the statute as being matters of form and not of substance.”

In the same case on appeal, Oliver LJ observed at p.271:

“The whole rationale of prescribing forms for time-critical documents is that they have to be received and filed, as a matter of ordinary Office administration, by staff who have neither the time nor the qualification to read, digest and reply to letters. Thus substantially all the time limits which are laid down by the Rules are related to the filing of forms or documents, rather than correspondence. Mr. Laddie has submitted that this is really what underlies the whole system.

29. There is also no dispute that following the official letter of 2 March 2010, that on 8 March 2010 MC filed the correct version of the Form TM8 (a copy of which is at Annex 2 to this decision). That said, I agree with HL that the Form TM8(N) filed by MC on 3 February cannot be considered to be a replica of the Form TM8 nor can it be considered to be a form which contains the information required by the form as published and complies with any directions as to the use of such a form. I say this because as HL says, it is clear that the TMR directs that a Form TM8(N) is only to be used to defend a registered trade mark in revocation proceedings on the grounds of non-use.

30. I also agree with HL that the combined effect of rules 77(1), 77(5) and schedule 1, mean that the time limit specified in rule 18(3) is not extendable other than in the circumstances specifically identified in rules 77(5)(a) and (b), which clearly do not apply in these proceedings.

31. However, that is not an end of the matter. The wording of rule 18(2) includes the following:

“...shall, unless the registrar otherwise directs, be treated as abandoned.”

32. The use of the word “may” in the rule clearly provides the registrar, in appropriate circumstances, with the discretion not to treat an application for registration as abandoned in circumstances where the applicant fails to file a Form TM8 within the relevant period. The question of course is how this discretion should be exercised. HL have reminded me of the comments of Mr Justice Pumfrey in *Pharmedica*. I am also aware of the comments of Mr Geoffrey Vos QC sitting as a Deputy High Court Judge in *Music Choice Limited and Target Brands, Inc* (CH/2005/APP 0423/0749). Although his comments related to how the words: “otherwise the registrar may treat him as not opposing the application” should be interpreted in revocation and invalidation proceedings under the Trade Marks Rules 2000 (Tribunal Practice Notice 1 of 2006 refers), it provides, in my view, useful guidance on how a discretionary power of the type provided by rule 18(2) should be approached in these current proceedings. In *Music Choice* Mr Vos said:

“65. Having decided that there is a general discretion in the registrar, it would be inappropriate to set out factors which would circumscribe the exercise of that discretion. Plainly, however, the discretion must be exercised on the premise that the time limit in Rule 33(6) is inextensible, and that there must be compelling reasons for the proprietor to be treated as opposing the application, notwithstanding his failure to comply with an inextensible time limit.

67. The factors that are, in my judgement relevant to the exercise of the discretion in this case include:

1. The circumstances relating to the missing of the deadline including reasons why it was missed and the extent to which it was missed.
2. The nature of the applicant’s allegations in its statement of grounds.
3. The consequences of treating the proprietor as opposing or not opposing the application.
4. Any prejudice to the applicant by the delay.
5. Any other relevant considerations, such as the existence of related proceedings between the same parties.”

33. If one compares the Form TM8 at Annex 2 with the Form TM8(N) at Annex 1, one can see that all of the important information required by the Form TM8 (other than the opposition number) was included in the erroneously filed Form TM8(N). For the sake of completeness I will compare the forms box-by-box using the Form TM8 as the basis for comparison.

Box 1 – “Trade mark number” – as box 1 of Form TM8(N);

Box 2 – “Full name of the applicant or registered proprietor” – although the wording of the question differs (the Form TM8(N) only referring to the registered proprietor) both boxes contain the name Optima Solutions UK Limited;

Box 3 – “Opposition, invalidation, revocation or rectification number”, this has been completed by insertion of the number 99708 whereas Box 3 of the Form TM8(N) which only refers to the Revocation number was left blank;

Box 4 – “Name and address (including postcode) of the agent (if any) – as box 4 of Form TM8(N);

Box 5/6 – reads “Do you want the opponent to provide proof of use? and “If you answered “yes” to question five, please state for which goods and services you require proof”. These questions do not appear on the Form TM8(N) but as the opposition only relates to absolute grounds they are, as MC note, “Not relevant.”

Box 7 – “Counterstatement” – as box 7 of Form TM8(N);

Box 8 – reads “Are there any related proceedings currently with the Registry or Courts? If so, please provide details”. This box is identical to box 6 on the Form TM8(N) and the wording contained in both is identical;

Box 9 – reads “Do you want a Preliminary Indication on section 5(1) and/or (2) grounds to be issued?” An equivalent box does not appear on the Form TM8(N), but as only absolute grounds are involved, MC have noted on the Form TM8 that this box is “Not relevant”;

Box 10 – “Declaration/Your signature” – the signature detail (save for the date) are identical to those completed in box 8 on Form TM8(N);

Box 11 – “Name and daytime telephone number/Your reference” – are identical to the details completed in box 9 on Form TM8(N).

34. From the above one can see that of all the relevant information required by the Form TM8 (other than the opposition number) were included in the timely (albeit erroneously filed) Form TM8(N). This was an important factor when I indicated at the CMC that, if required, I was minded to exercise the discretion available to me in Optima's favour. It is also clear that neither the TMR nor HL (the latter of which did nothing for a little under eight weeks) had any difficulty in determining that Optima had defended their application and the basis of that defence.



35. Nothing I have seen in RL's written submissions changes my view of the matter. In reaching the conclusion I have, it appears to me that the failure to file the correct form was nothing more than a technical failure on the part of MC (I note for example that their letter of 3 February 2010 which accompanied the erroneously filed Form TM8(N) actually refers to "Form TM8"). In addition, the filing of the incorrect version of the form did not impact significantly upon the processing of the form by the TMR who were able to identify the proceedings and proceed accordingly. Finally, and perhaps most important of all, the erroneously filed Form TM8(N) contained all the important information required by the Form TM8.

36. In addition, I am also conscious that the opposition to application No. 2424749 is but one of a related set of proceedings between the parties and that this application forms the basis of Optima's 5(3) ground in relation to both of RL's applications. I note that box 8 of the Form TM8 (box 6 of the Form TM8(N)) contains the following:

"There are no related proceedings concerning this trade mark within the Registry or Courts although there are similar proceedings in Australia. Also, the parties are in dispute in relation to other items of intellectual property."

From the above it is clear that the parties are known to one another and the filing of a defence in opposition No. 99708 would not have come as a surprise to RL.

## **Conclusion**

37. Having considered the oral submissions at the CMC and having carefully reviewed the parties' written submissions, I have chosen for the reasons indicated above to exercise the discretion available to me by the use of the words "unless the registrar otherwise directs" in rule 18(2) in Optima's favour. I do so because, in my view, the failure of MC to file the correct version of the Form TM8 on Optima's behalf was (given that all the important information was included in the erroneously filed Form TM8(N)) nothing more than a technical failure on their part which ought not to prevent Optima from defending its application for registration. Whilst there are a number of differences between the two forms in terms of their layout, the information provided on them is almost identical (the absence of the proof of use and Preliminary Indication information not being relevant to the circumstances of these proceedings). The TMR takes a purposive approach to the acceptance of forms, the purpose of a TM8 and TM8(N) is to set out the extent of the filer's defence and thus enable the parties to establish the issues which are in dispute; the Form TM8(N) as filed did this. Given that the parties are known to one another combined with the inter-related nature of these cross-oppositions, it should not, in my view, result in RL succeeding on a "technical knock-out" as opposed to having the basis of their opposition determined on its merits.

## **Costs**

38. I made no costs order in respect of this discrete interlocutory issue. However, I am aware of RL's views on costs contained in their written submissions of 15 June 2010, and will bear their comments in mind when I determine the proceedings substantively.

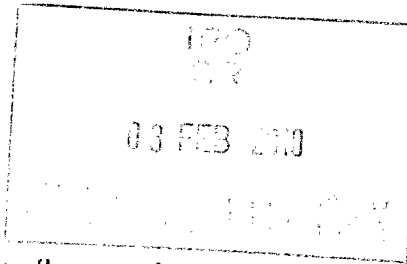
**39. The consequence of my decision is that Optima's application will not be treated as abandoned and opposition No. 99708 will continue on the basis mentioned in paragraph 16 above.**

**Dated this 22 Day of September 2010**

**G W SALTHOUSE  
For the Registrar  
The Comptroller-General**



**INTELLECTUAL**  
PROPERTY OFFICE



**Form TM8(N)**  
**Nil Fee**

**Notice of defence and counterstatement for the use in  
revocation on the grounds of non-use**

Trade Marks Registry  
Concept House  
Cardiff Road  
Newport  
South Wales  
NP10 8QQ

*Please read the guidance notes on the next page before filling in this form.*

1. Trade mark number.	2424749
2. Full name of the registered proprietor.	Optima Solutions UK Limited <span style="float: right;">35</span>
3. Revocation number.	
4. Name and address (including postcode) of your agent (if any).	Marks & Clerk LLP Aurora 120 Bothwell Street Glasgow G2 7JS United Kingdom
5. Please specify in relation to which goods and/or services of the registration you are submitting this notice of defence.	All services
6. Are there any related proceedings currently with the Registry or the courts? If so, please provide details.	There are no related proceedings concerning this trade mark with the Registry or Courts although there are similar proceedings in Australia. Also, the parties are in dispute in relation to other items of intellectual property.
7. Counterstatement	

The applicant denies each of the grounds of opposition listed by the opponent and puts the opponent to proof that the allegations are true.

The applicant's position is that the trade mark RIG COOLING is distinctive. The trade mark does not describe any characteristics of the services covered by this application and it has not become customary in the current language or practices of the trade. The trade mark allows the relevant public to identify the origin of the applicant's services. Lastly, the trade mark RIG COOLING was adopted by the applicant and has been used without any deceptive intent. The applicant is unaware of any deception amongst the relevant public.

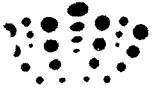
The applicant requests that the opposition be dismissed and that an award of costs is made in favour of the applicant.

<p>8. Declaration</p> <p>Your signature.</p>	<p>I believe that the facts stated in this notice of defence and counterstatement are true.</p> <p><i>Marks &amp; Clerk LLP</i></p>
<p>Your name in BLOCK CAPITALS</p>	<p>MARKS &amp; CLERK LLP</p>
<p>Date.</p>	<p>3 February 2009</p>
<p>9. Name and daytime phone number of the person we should contact in case of query.</p>	<p>Douglas C. Thomson 0141.221.5767</p>
<p>Your reference.</p>	<p>DCT/LF/XG423718GBAA</p>
<p>Number of sheets attached to this form</p>	

**Notes** If a "proper reasons for non-use" defence is being mounted, then this should be clearly set out in the Counterstatement at box 7

If you need more space for your counterstatement you may attach separate sheets. Number each one and say in question 9 how many sheets you have used.

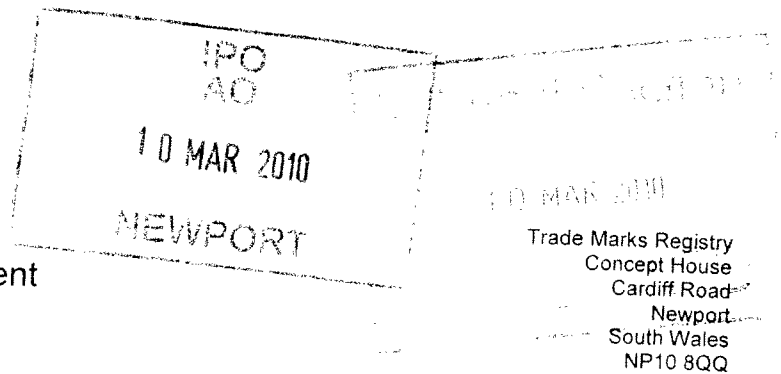
Boxes 2 and 4: At least one of these should be located in the European Economic Area (EEA) or the Channel Islands.



**INTELLECTUAL  
PROPERTY OFFICE**

**Form TM8**

**Nil Fee**



**Notice of defence and counterstatement**

*Please read the guidance notes on the next page before filling in this form.*

1. Trade mark number.	2424749
2. Full name of the applicant or registered proprietor.	Optima Solutions UK Limited
3. Opposition, invalidation, revocation or rectification number.	99708
4. Name and address (including postcode) of the agent (if any).	Marks & Clerk LLP Aurora 120 Bothwell Street Glasgow G2 7JS United Kingdom
5. Do you want the opponent to provide proof of use? (see note)	Not relevant
6. If you answered "yes" to question five, please state for which goods and services you require proof.	

**7. Counterstatement**

The applicant denies each of the grounds of opposition listed by the opponent and puts the opponent to proof that the allegations are true.

The applicant's position is that the trade mark RIG COOLING is distinctive. The trade mark does not describe any characteristics of the services covered by this application and it has not become customary in the current language or practices of the trade. The trade mark allows the relevant public to identify the origin of the applicant's services. Lastly, the trade mark RIG COOLING was adopted by the applicant and has been used without any deceptive intent. The applicant is unaware of any deception amongst the relevant public.

The applicant requests that the opposition be dismissed and that an award of costs is made in favour of the applicant.

Counterstatement (continued from previous sheet)

<p>8. Are there any related proceedings currently with the Registry or Courts? If so, please provide details.</p>	<p>There are no related proceedings concerning this trade mark with the Registry or Courts although there are similar proceedings in Australia. Also, the parties are in dispute in relation to other items of intellectual property.</p>
<p>9. Do you want a Preliminary Indication on section 5(1) and/or (2) grounds to be issued?</p>	<p>Not relevant</p>
<p>10. Declaration</p> <p>Your signature.</p>	<p>I believe that the facts stated in this notice of defence and counterstatement are true.</p> <p><i>Marks &amp; Clerk LLP</i></p>
<p>Your name in BLOCK CAPITALS.</p>	<p>Marks &amp; Clerk LLP</p>
<p>Date.</p>	<p>8 March 2010</p>
<p>11. Name and daytime phone number of the person we should contact in case of query.</p>	<p>Douglas C. Thomson 0141.221.5767</p>
<p>Your reference.</p>	<p>DCT/LF/XG423718GBAA</p>
<p>Number of sheets attached to this form.</p>	<p></p>

**Notes** If you need more space for your counterstatement you may attach separate sheets. Number each one and say in question 11 how many sheets you have used.

Boxes 2 and 4: At least one of these should be located in the European Economic Area (EEA) or the Channel Islands

Box 5: Only applies in opposition, or similarly in the case of invalidation proceedings, where the person opposing or invalidating your mark may have provided a statement of use and only applies to grounds of opposition or invalidation raised under sections 5(1) and 5(2) and 5(3) of the Trade Marks Act. If more than one trade mark is being relied upon, please indicate in respect of which trade mark you would like the opponent to provide proof of use.