

TRADE MARKS ACT 1994

IN THE MATTER OF:

INVALIDITY APPLICATION No. 500518 IN THE NAME OF ROBERT BOSCH GMBH

IN RELATION TO

TRADE MARK No. 2524239 REGISTERED IN THE NAME OF ROMAN KHAN

DECISION

1. On 29 July 2014, Robert Bosch GmbH ('the Applicant') applied under number 500518 for a declaration of invalidity in relation to Trade Mark No. 2524239 BOSCO registered in Classes 11 and 21 as of 20 August 2009 in the name of Roman Khan ('the Proprietor'). The application was made under sections 47(2)(a) and 47(2)(b), in combination with sections 5(2)(b), 5(3) and 5(4)(a), of the Trade Marks Act 1994 on the basis of earlier registered and unregistered rights claimed and asserted by the Applicant in relation to the trade mark BOSCH.
2. The application was made on Form TM26(I) (containing a statement of the grounds on which it was made) in accordance with the provisions of Rule 41(1) of the Trade Marks Rules 2008. An amended Form TM26(I) was filed on 21 August 2014 in response to a request for clarification raised by the Registry in an official letter of 1 August 2014. On 28 August 2014, a copy of the amended Form TM26(I) was sent to the Proprietor by the Registry in accordance with the provisions of Rule 41(5) of the 2008 Rules.

3. It then became necessary for the Proprietor to file a Form TM8 and counter-statement in answer to the invalidity application ‘within two months’ of the date on which the copy of the amended Form TM26(I) had been sent to him: Rule 41(6). This was not a ‘flexible time limit’: see Rule 77(6) and Schedule 1 to the 2008 Rules. The required Form TM8 and counter-statement could be filed after expiry of the period of two months allowed by Rule 41(6) ‘if, and only if’ the failure to file within that period was ‘attributable, wholly or in part, to a default, omission or other error by the registrar, the Office or the International Bureau’ and ‘it appears to the registrar that the irregularity should be rectified’ by re-setting the date for filing: Rule 77(5).

4. The Proprietor was warned of the consequences of not filing within two months (i.e. on or before 28 October 2014) in the official letter enclosing the amended Form TM26(I) that was sent to him on 28 August 2014:

Please find enclosed a copy of an amended Form TM26(I) filed against your registration. For convenience, a copy of the form, along with a copy of this letter, will also be sent to you by recorded delivery post.

If you wish to continue with your registration, you should complete a Form TM8 and counterstatement, which is available from the IPO website. This is in accordance with Rule 41(6) of the Trade Marks Rules 2008.

The Form TM8 and counterstatement should be received on or before **28 October 2014**.

If no Form TM8 and counter-statement are filed within this period, (**a period which cannot be extended**), the registration of the mark shall, unless the Registrar otherwise directs, be declared invalid in whole or in part. This is in accordance with Rule 41(6).

Before you decide whether to defend your registration, you may wish to refer to the guidance notes on invalidity proceedings and the scale of costs which are available from IPO website at www.ipo.gov.uk

5. The deadline of 28 October 2014 came and went without any filing (or other response) on the part of the Proprietor in answer to the application for invalidity. It then became necessary for the Registrar to consider whether the registration of the Proprietor's Trade Mark No. 2524239 should, as provided for in Rule 41(6), be declared invalid pursuant to the apparently unopposed application. To that end, the Registry sent an official letter to the Proprietor on 5 November 2014 stating as follows:

The Registry's letter dated **28 August 2014** informed you that if you wished to continue with the registration you should file TM8 and counterstatement on or before **28 October 2014**.

As no TM8 and counterstatement have been filed within the time period set, Rule 41(6) applies. Rule 41(6) states that:

"... otherwise the registrar may treat the proprietor as not opposing the application and registration of the mark shall, unless the registrar otherwise directs, be declared invalid."

The Registry is minded to treat the proprietor as not opposing the application for invalidation and declare the registration as invalid as no defence has been filed within the prescribed period.

If no response is received on or before **19 November 2014** the Registrar will proceed to issue a short decision on the issue of failure to comply with the Rules governing the filing of a defence.

6. The deadline of 19 November 2014 came and went without any response on the part of the Proprietor to the statement of position contained in the official letter of 5 November 2014. That deadline would quite readily have been extended to allow more time for a substantive response if a request for extension indicating a genuine desire to engage with the situation had been received from the Proprietor in the period following its expiry. However, the Registry heard nothing from him and so, on 2 December 2014, Mr Raoul Colombo acting on behalf of the Registrar issued a Decision under Rule 41(6) declaring the registration of Trade Mark No. 2524239 invalid upon the following basis:

By an application filed on 29 July 2014, Robert Bosch GmbH applied for a declaration of invalidity of this registration under the provision of Sections 47(2)(a) and 47(2)(b) of the Trade Marks Act 1994.

Following an exchange of correspondence between the Registrar and the applicant, a copy of this application was served upon the registered proprietor on 28 August 2014.

The registered proprietor did not file a counterstatement within the two months specified by Rule 41(6) of the Trade Mark Rules 2008 and neither party requested a hearing or gave written submissions in respect of the official letter of 5 November 2014. Such circumstances are covered by Rule 41(6) which states

“... otherwise the registrar may treat him as not opposing the application.”

Under the provisions of the rule, the Registrar can exercise discretion. In this case, no reasons have been given why I should exercise this discretion in favour of the registered proprietor and I therefore decline to do so. Therefore, in accordance with Section 47(6) of the Act, the registration is declared invalid and I direct that it be removed from the register and deemed never to have been made.

7. The Proprietor took steps on receiving the Decision to instruct trade mark attorneys to act for him in relation to the invalidity application he had thus far failed to defend. He instructed the firm of attorneys who had been acting for him since at least early April 2014 in Opposition No. 401660 (in the name of Robert Bosch GmbH) to Application No. 3025218 (in the name of Roman Khan) for registration of the trade mark BOSCO in Classes 7 and 8. On his behalf they filed a Form TM55P and Grounds of Appeal together with a supporting witness statement directed essentially to the proposition that he should be granted relief from the sanction of the declaration of invalidity that had been made as a result of his failure to file a Form TM8 and counter-statement within the period of two months prescribed by Rule 41(6).

8. I pause at this juncture to observe that there is no general power to grant relief from sanctions in Registry proceedings under the 1994 Act and 2008 Rules. If a trade mark proprietor who is in default of compliance with the deadline imposed by Rule 41(6) wishes to avoid a declaration of invalidity under that Rule he must:
(i) seek to satisfy the Registrar that relief should be granted on the basis of procedural irregularity under Rule 77(5): see paragraph [3] above; and / or (ii) seek to satisfy the Registrar that the discretion available under Rule 41(6) should be exercised so as to allow the Registry proceedings to continue. After a decision has been made under Rule 41(6) declaring the registration of a trade mark to be invalid, it may be set aside if (within a period of 6 months beginning immediately after the date that the register was amended to reflect the declaration of invalidity) the proprietor of the trade mark successfully applies to the Registrar under Rule

43(1)(c) for an order to that effect. For that purpose the trade mark proprietor must demonstrate to the reasonable satisfaction of the Registrar that his failure to comply with Rule 41(6) ‘was due to a failure to receive’ the relevant Form TM26(I) and that the decision ought to be set aside in the exercise of the discretion conferred by that Rule.

9. The Registrar may, in appropriate circumstances, set aside a Registry decision (including a ‘final’ decision: see TWG Tea Company Pte Ltd v Mariage Freres SA; BL O-396-15 at paragraphs [17] to [19]) in the exercise of the discretionary power conferred upon him by Rule 74 to rectify an ‘irregularity in procedure ... connected with any proceeding or other matter before the registrar or the Office’. However, the power conferred by Rule 74 is expressly ‘subject to rule 77’. It therefore cannot be used in circumstances where Rule 77(5) could not be used to alter the operation or effect of the two month time limit set by Rule 41(6).
10. The Proprietor seeks by means of this appeal to an Appointed Person under section 76 of the 1994 Act to have the Decision below set aside and replaced with an order or direction enabling him to defend the application for invalidity on its merits. To that end, he maintains: (i) that the Registrar has a discretion under Rule 41(6) to allow the Registry proceedings to continue notwithstanding the Proprietor’s failure to comply with the filing requirements of that Rule; (ii) that this Tribunal should find that the facts and matters on which the Proprietor relies in aid of his appeal are sufficient to justify a determination that the Registry proceedings should continue in the exercise of the discretion conferred by Rule

41(6); and (iii) that there should accordingly be an order or direction of this Tribunal providing for the Registry proceedings to continue in the exercise of that discretion.

11. Proposition (i) is correct. It underpins rather than undermines the Decision under appeal. The discretion conferred by Rule 41(6) is exercisable by the Registrar in the first instance. The Registrar decided at first instance in the present case not to allow the Registry proceedings to continue in the exercise of the discretion available to him under that Rule. On turning to propositions (ii) and (iii), it appears to me that the Proprietor is effectively asking this Tribunal to act de novo with regard to the exercise of the discretionary power reserved to the Registrar in the first instance. That could only be done by impermissibly collapsing the two tiers of decision taking involved in an appeal under section 76 of the Act into a single tier of decision taking at the appellate level. In keeping with its role as an appellate tribunal, this Tribunal should not interfere with the decisions of the Registrar unless, to put it broadly, they appear to have been deprived of legitimacy by error or irregularity. That, broadly speaking, is the perspective from which I propose to consider the criticisms and concerns raised by the Proprietor in relation to the Decision under appeal.
12. The Registrar was criticised for failing to infer from the fact that the Proprietor was concerned to contest Opposition No. 401660 to his Application No. 3025218 for registration of the trade mark BOSCO in Classes 7 and 8 that he was likewise concerned to contest the application for invalidity brought by the Applicant in

relation to his Trade Mark No. 2524239 BOSCO registered in Classes 11 and 21; for failing to take account of the presumption of validity contained in section 72 of the Act; for allowing the application for invalidity to succeed without proof of use from the Applicant under Rule 42(3); for allowing the application for invalidity to succeed without providing the Proprietor with an opportunity to file evidence under Rule 42(5); and generally for failing to determine whether the application for invalidity should be regarded as well-founded.

13. I can see no substance in any of these criticisms. The Registrar was not required to conduct an investigation into the Proprietor's attitude or approach to the opposition proceedings relating to his application to register the trade mark BOSCO in order to try and work out what his subjective intentions might or might not be with regard to the present application for invalidity of his registered trade mark BOSCO. The Proprietor was placed by statute in much the same position as if he had written to the Registrar saying: 'I have not filed a Form TM8 and counter-statement under Rule 41(6) because I am not opposing the application for invalidity made in the Form TM26(I) sent to me under Rule 41(5)'. Consistently with that being the position, it was open to the Registrar to treat the presumption of validity in Section 72 of the Act as inapplicable to the case at hand and allow the apparently unopposed application for invalidity to succeed without making any independent determination of his own to the effect that the application should be regarded as well-founded. The provisions of Rules 42(3) and 42(5) did not prevent the Registrar from allowing the apparently unopposed application for invalidity to succeed under Rule 41(6): if they did it would be practically impossible for the

Registrar to make a declaration of invalidity under Rule 41(6); they operate downstream of Rule 41(6) and take effect only as part of the regime prescribed by Rule 42 for the filing of evidence in relation to contested applications for invalidity while they remain ongoing. The Registrar decided not to allow the Registry proceedings to continue in the exercise of the discretionary power conferred upon him by Rule 41(6). It was plainly open to him to do so in circumstances where the Proprietor had provided no information, evidence or submissions upon which a decision in his favour allowing the Registry proceedings to continue might possibly have been based.

14. The Applicant's trade mark attorneys were criticised for filing the invalidity application without notice: '... the attorneys acting for the other side had been in contact regularly with Trade Mark Direct at the time they filed the invalidation action. Indeed, they had just finished discussing a without prejudice offer, but no notice of the invalidation proceedings was communicated or even mentioned to the registered proprietor's attorneys despite those respective attorneys having been in correspondence. It just seems like they were trying to slip it under the net almost. They filed it directly on the owner rather than telling us anything about it.' (Transcript p.43, line 21 to p.44, line 6). And that was said to have led to '... a premature decision based on a stroke of luck and a technical knock-out': Skeleton of Argument for the Proprietor, paragraph 23.
15. These criticisms are misconceived. When filing the application for invalidity, the Applicant's attorneys did everything they were required to do by the Act and the

Rules – no more and no less. They were under no duty or obligation to assist the Proprietor (or any trade mark attorneys he might instruct) to defend his registered trade mark from attack. The Proprietor was responsible for protecting his own interests and doing whatever needed to be done in that connection. There is no reason to suppose that the Applicant’s attorneys foresaw that the Proprietor would either fail to bring the invalidity application to the attention of his own trade mark attorneys or fail to take any steps to comply with the requirements of Rule 41 as notified to him in the official letters he received from Registry at his address for service. These failings on his part were not attributable to any act or omission (let alone any blameworthy act or omission) on their part.

16. The case for the Proprietor ultimately rested upon the proposition that this Tribunal should not allow the Registrar’s Decision to stand because it would be unjust to do so in the light of the explanation he had provided, for the first time on appeal, as to why he had done nothing in response to the Form TM26(I) and official letters he had received. His explanation was that he ‘wrongly assumed’ that the Form TM26(I) and official letters he had received related to Opposition No. 401660 in which he had instructed trade mark attorneys to act on his behalf and that they were documents which had ‘simply been copied to him’ by the Registry ‘for information purposes only’: Skeleton of Argument for the Proprietor, paragraph 14. It was submitted that for lack of understanding on his part there had, in effect, been ‘a failure to receive’ the Form TM26(I) and official letters which should (consistently with the provisions of Rule 43) be taken to provide a basis for setting aside the declaration of invalidity made by the Registrar

under Rule 41(6). It was suggested in paragraph 16 of the Skeleton of Argument for the Proprietor that he had ‘limited ability to read and understand English, being of Afghan origin, his first language being Pashto’. However, it was confirmed on behalf of the Proprietor at the hearing of the appeal that this was not being put forward as a matter of any independent significance: Transcript p.36, line 13 to p.37, line 1; p.40, line 20 to p.41, line 17.

17. I shall assume without deciding (and also without pursuing the implications of the point that this Tribunal cannot purport to exercise a general power to grant relief from sanctions under Rule 41(6) which, as noted in paragraphs [8] and [9] above the Registrar does not possess) that it would be open to me to set aside the Decision under appeal if I was satisfied that it was rendered unjust by the explanation provided.
18. It continues to be the position in civil proceedings in the High Court that: ‘... if proceedings are not to become a free-for-all, the court must insist on litigants of all kinds following the rules. In my view, therefore, being a litigant in person with no previous experience of legal proceedings is not a good reason for failing to comply with the rules’: R (Hysaj) v Secretary of State for the Home Department [2014] EWCA Civ. 1633 at paragraph [46] per Moore-Bick LJ, Vice-President of the Court of Appeal, with whom Tomlinson LJ and King LJ agreed. In the same vein, it was observed in Nata Lee Ltd v Abid [2014] EWCA Civ. 1652 at paragraph [53] per Briggs LJ with whom Moore-Bick LJ, Vice-President of the Court of Appeal, and Underhill LJ agreed, that: ‘... the fact that a party (whether an individual or a

corporate body) is not professionally represented is not of itself a reason for the disapplication of rules, orders and directions, or for the disapplication of the overriding objective which now places great value on the requirement that they be obeyed by litigants. In short, the CPR do not, at least at present, make specific or separate provision for litigants in person. There may be cases in which the fact that a party is a litigant in person has some consequence in the determination of applications for relief from sanctions, but this is likely to operate at the margins’.

19. The same approach should, in my view, be adopted in relation to the need for compliance with rules, orders and directions in Registry proceedings under the 1994 Act and the 2008 Rules. And on considering the matter from that perspective, I am satisfied that the Decision under appeal cannot properly be regarded as unjust in the light of the Proprietor’s explanation for ignoring the Form TM26(I) and official letters he had received. It was evidently a conscious decision on his part to do nothing in response to those communications. His decision to that effect was based on an erroneous ‘assumption’ that the Registry was copying him into correspondence relating to Opposition No. 401660. That erroneous ‘assumption’ seems to have been unilaterally made and persisted in by him from the beginning (28 August 2014 letter) to the end (Decision dated 2 December 2014) of the sequence of relevant communications. However, the relevant communications were clearly not what the Proprietor says he ‘assumed’ them to be. And a party to Registry proceedings who actually considered the notifications provided by those communications could not have understood them to be what the Proprietor says he ‘assumed’ them to be. That being so, I attribute

the Proprietor's erroneous 'assumption' and 'lack of understanding' to the absence of any actual consideration of the notifications addressed to him. The absence of such consideration does not, in my view, render the notifications any the less valid and effective for the purposes of the Decision under appeal or provide the Proprietor with any legitimate basis for characterising the Decision as unjust. There was no 'failure to receive', only a 'failure to consider', the Form TM26(I) and official letters. The Proprietor's case on appeal gains no support from the provisions of Rule 43.

20. For the reasons I have given the Proprietor's appeal is dismissed. The Applicant should receive an award of costs under Rules 67 and 73(4) in relation to the unsuccessful appeal. I consider that £875. is a fair and proportionate sum to order the Proprietor to pay to the Applicant by way of contribution towards its costs. That sum is to be paid within 21 days of the date of this decision.

Geoffrey Hobbs QC

21 August 2015

Ms Kate McCormick of Trade Mark Direct appeared on behalf of the Proprietor.

Mr Graeme Murray of WP Thompson appeared on behalf of the Applicant.

The Registrar was not represented and took no part in the appeal.