

O-476-17

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO 3211119
IN THE NAME OF SHOPTAGON LTD
TO REGISTER



AS A TRADE MARK IN CLASS 35
AND
THE LATE FORM TM8 AND COUNTERSTATEMENT
FILED IN DEFENCE OF THAT APPLICATION
IN OPPOSITION PROCEEDINGS (UNDER NO. 409313)
LAUNCHED BY
ZUFFA LLC

BACKGROUND

1. On 6 February 2017, Shoptagon Ltd ('the applicant') applied to register the mark below in class 35 for **retail services in relation to sporting equipment**.



2. The application was published on 17 February 2017. Further to the filing of Form TM7a (Notice of threatened opposition) on 12 April 2017, Form TM7 (Notice of opposition) was subsequently filed on 17 May 2017 by Zuffa LLC ('the opponent') on the grounds of Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act').

3. The form TM7 was served on the applicant on 13 June 2017 setting a deadline of 14 August 2017 for the filing of a form TM8 and counterstatement. As no defence was received on or before 14 August 2017, the Tribunal wrote to the applicant on 22 August 2017 in the following terms:

“...As no TM8 and counterstatement has been filed within the time period set, Rule 18(2) applies. Rule 18(2) states that the application:

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

The registry is minded to deem the application as abandoned as no defence has been filed within the prescribed period.

If you disagree with the preliminary view you must provide a TM8, full written reasons, and request a hearing on or before 5 September 2017. This must be accompanied by a Witness Statement setting out the reasons as to why the TM8 and counterstatement are being filed outside of the prescribed period.

If no response is received the registry will proceed to deem the application abandoned.”

4. On 4 September 2017, the Tribunal received an emailed letter from Mr Brian Conroy of Rennick Solicitors responding to the official letter of 22 August 2017. Attached to the email were a form TM33 appointing Mr Conroy as the representative for the applicant and the form TM8 and counterstatement.

5. In his email letter of 4 September 2017, Mr Conroy explained that he had wrongly diaried the case for 14 September 2017 instead of 14 August. He attributed this to ‘human error’ and asked that his letter be considered as a witness statement and requested a hearing on the matter.

6. The Tribunal replied to Mr Conroy giving a preliminary view that the late TM8 could not be admitted and setting a hearing date of 21 September 2017. That hearing was subsequently rescheduled for 25 September following a request from Marks & Clark LLP, the representatives for the opponent.

7. On the date the skeleton arguments were due to be filed, namely Friday 22 September, there was some confusion regarding the representation for the applicant. When the Tribunal contacted Rennick Solicitors, it transpired that Mr Conroy had left their employment. Mr Conroy subsequently contacted the Tribunal explaining that he was now employed by Lemman Solicitors but that the applicant remained his client. Mr Conroy also requested that the hearing was adjourned for a further two weeks. I refused this request as the hearing had already been rescheduled once. Mr Conroy has subsequently filed a skeleton argument by means of an email and a form TM33 containing his new details on 25 September 2017 prior to the hearing.

HEARING

8. The hearing took place before me on 25 September 2017 by telephone conference. Mr Conroy, now of Lemman Solicitors, represented the applicant and Mr

Ferdinand of Marks & Clark represented the opponent. I received skeleton arguments from both sides.

9. Mr Conroy began by outlining the circumstances around the late filing of the TM8. The applicant currently has an ongoing opposition in the Republic of Ireland with the same opponent. Mr Conroy was advising the applicant in dealing with this matter. However whilst he was aware that the applicant had made a UK trade mark application, he had not been formally instructed to represent the applicant with regard to the UK case. Nevertheless Mr Conroy had noted in his diary system that a TM8 and counterstatement were due in relation to the UK case. Unfortunately the diary date had been set for a month too late, i.e. 14 September 2017 instead of 14 August 2017. The error was brought to Mr Conroy's attention when the applicant received the Tribunal letter dated 22 August stating that no TM8 or counterstatement had been received. Mr Conroy states that a 'breakdown of communication' had occurred as the applicant had wrongly assumed that Mr Conroy was acting for the UK case in addition to the ROI case. Mr Conroy informed the Tribunal on 4 September 2017 of his representation and also filed the defence at the same time.

10. Mr Conroy conceded that the statutory time period for filing a defence and counterstatement was not extensible and that the deadline in this case for filing such a defence had been missed. He also acknowledged that the Registrar's discretion, as per Rule 18(2), to allow the late admission of the form TM8 was narrow. However he referred me to the test set out by Mr Vos QC in *Music Choice* (CH/2005/APP0423/0749) in his skeleton argument, which I will refer to later in this decision. Mr Conroy also stated the applicant's intention to re-file the application in the event that the TM8 was not admitted

11. Mr Ferdinand in reply stated that in addition to the points made in his skeleton argument, he did not regard the omission of a robust diary management system as a reason for allowing the late defence. Neither did he find that the issue of parallel proceedings in the ROI Patent Office 'displaced the burden on the applicant to ensure that UK deadlines were met on time'.

DECISION

12. With regard to the late filing of a form TM8, I must refer to Rule 18 of the Trade Marks Rules 2008 which states:

“(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.” (my emphasis)

13. The combined effect of Rules 77(1), 77(5) and Schedule 1 of the Rules means that the time limit in rule 18, which sets the period in which the defence must be filed, is non-extensible other than in the circumstances identified in rules 77(5)(a) and (b) which states:

“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.”

14. As there has been no error on the part of the registrar or the office, rule 77(5) is not relevant. In *Kickz*, Mr Hobbs QC sitting as the Appointed Person held that the discretion conferred by rule 18(2) is a narrow one and can be exercised only if there are “extenuating circumstances”. In *Mercury*, Ms Amanda Michaels, sitting as the Appointed Person, in considering the factors the Registrar should take into account in exercising the discretion under rule 18(2), held that there must be “compelling reasons”. She also referred to the criteria established in *Music Choice Ltd’s Trade*

Mark [2006] R.P.C. 13 ('*Music Choice*'), which provides guidance, applicable by analogy, when exercising the discretion under rule 18(2). Such factors (adapted for an opposition case) are:

- (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 opponent's allegations in its statement of grounds;
- (3) The consequences of treating the applicant as opposing or not opposing the opposition;
- (4) Any prejudice caused to the opponent by the delay;
- (5) Any other relevant considerations, such as the existence of related proceedings between the same parties.

15. Insofar as the first *Music Choice* factor is concerned, I note that the deadline was missed by 21 days and I must bear in mind the circumstances which led to the delay in filing the defence. There was evidently some confusion on the part of the applicant as to whether Mr Conroy was acting on his behalf in relation to the UK case. There also appears to have been a communications issue around who needed to act and when. However Mr Conroy has stated that he was aware that opposition had been filed against this case and was also aware that a defence needed to be filed if matters were to be progressed to formal proceedings. In this case the recordal of an incorrect diary deadline is unfortunate but does not amount to either an extenuating circumstance or compelling reason in my view.

16. In terms of the second *Music Choice* factor, the grounds of opposition are based on section 5(2)(b), 5(3) and 5(4)(a) of the Act, as the opponent alleges the marks are confusingly similar.

17. Turning to the third *Music Choice* factor, the consequences for the applicant if discretion is not exercised in their favour are serious as their trade mark application

would be deemed abandoned for want of a defence. By contrast, if discretion is exercised in their favour, then they would have the opportunity to defend the trade mark and a decision would be made on the merits of the case.

18. In terms of the fourth *Music Choice* factor, the opponent has not commented on any specific prejudice caused by the delay.

19. As regards the fifth *Music Choice* factor, I have been made aware that there are parallel opposition proceedings between the same parties at the Irish Patent Office. Further, Mr Conroy indicated that if the subject application is deemed abandoned the applicant would file a new UK application for the subject trademark and would likely face the same grounds of opposition from the opponent in due course. This would evidently cause more delay and costs for both parties.

20. Having addressed each of the relevant factors in *Music Choice*, I must now decide whether there are sufficient extenuating circumstances to enable me to exercise my discretion. After careful consideration, my decision is that the necessary extenuating circumstances or compelling reasons have not been made out. I bear in mind that the consequences for the applicant are that it will lose its application and it intends to refile it if treated as abandoned. I also keep in mind that the opponent has not identified any specific prejudice that has been caused to it and I note the proceedings ongoing in the Irish Patent Office. However, I do not consider that these factors counterbalance the far from compelling reason as to why the deadline was missed. Both the applicant itself and Mr Conroy were clearly aware of the deadline. The lack of clear communication between them and the dairying error simply indicates that, in the words of Mr Hobbs in *Kickz*, there has been a failure to exercise the 'minimal degree of vigilance' required to meet the deadline. **The late Form TM8 and counterstatement is not admitted into the proceedings. The application is treated as abandoned.**

COSTS

21. As my decision terminates the proceedings, I must consider the matter of costs. Using the guidance set out in Tribunal Practice Notice 2/2016, I award the opponent costs on the following basis:

Official fee for the Notice of Opposition	£200
Preparing the Notice of Opposition	£200
Preparing for & attending the hearing	£200
Total	£600

22. I order Shoptagon Ltd to pay Zuffa LLC the sum of £600. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 04th Day of October 2017

June Ralph

For the Registrar,

The Comptroller-General