

**O-619-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF A JOINT HEARING HELD IN RELATION TO  
REGISTRATION NO. 2377282  
IN THE NAME OF KARL ROBERT JOHNSON**

**AND**

**AN APPLICATION FOR REVOCATION UNDER NO. 501488  
BY GABRIEL CESAR ALVARADO**

## **Background**

1. These proceedings concern an application by Gabriel Cesar Alvarado to revoke trade mark registration number 2377282, in the name of Karl Robert Johnson. The trade mark is for the word **RESLOSOUND**. It was applied for on 4 November 2004 and registered on 23 September 2005. The mark stands registered for the following goods:

Class 9: Apparatus for recording, transmission or reproduction of sound or images; microphones; transducers; electro-acoustic transducer elements; electro- acoustic devices; electrical sound effects; audio signal processing; studio apparatus; reverberation and delay apparatus; amplifiers; loudspeakers; loudspeaker cabinets; audio mixers; none of the aforementioned goods being hearing aids or for use with hearing aids.

2. The application to revoke the trade mark (Form TM26(N)) was made on 9 December 2016. The application included in the form a statement that Mr Johnson had been notified on 18 November 2016 of Mr Alvarado's intention to file the revocation action. The application for revocation was based on sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 ("the Act") and was directed against all of the goods in the registration.

3. There were some difficulties with the application for revocation, which required repeated amendment and resulted in the s. 46(1)(b) ground being struck out. I note that all three letters regarding the amendment of the form (dated December 2016, January 2017 and February 2017) were copied to Mr Johnson. On 12 April 2017, the tribunal wrote to the parties and served the form TM26(N) on Mr Johnson. The letter gave a date of 12 June 2017 for Mr Johnson to file his form TM8(N). The letter also stated:

"In accordance with rule 38(6) if the TM8 (N) and counter-statement are not filed within this period, (a period which cannot be extended), the registration of the mark shall, unless the registrar otherwise directs, be revoked in whole or part".

The method of service was by recorded post to Mr Johnson's chosen address for service. The Royal Mail's online record for the tracking number indicates that delivery was attempted on 18 April 2017, after which the letter remained at the delivery office until it was collected on 17 June 2017. It is not clear why the letter was held at the delivery office rather than being returned to the tribunal.

4. On 21 April 2017, Mr Johnson emailed the IPO's information centre in response to an automated "Trademark Update Notification" he had received on 12 April. The update indicated that an application had been made to revoke the mark. Mr Johnson indicated that "there is no instructions [sic] as to why this has been lodged or how one may go about refuting it. I have had no written correspondence via the post".

5. On 3 May 2017, the tribunal responded to Mr Johnson by providing a further copy of the form TM26(N) and the accompanying letter. The letter of 3 May 2017 states that "[the] date for response remains as **12 June 2017**". A contemporaneous file note indicates that this correspondence was sent by ordinary post as well as to the email address which Mr Johnson had used in his email of 21 April.

6. On 20 June 2017, Mr Johnson filed a form TM8. He was advised by the tribunal on 14 July 2017 that, the form having been filed late, if he wished the tribunal to consider the late defence he should file the correct form (TM8(N)) along with a witness statement explaining the delay. A period until 28 July 2017 was allowed for his response. No response was received.

7. The tribunal wrote again to Mr Johnson on 22 August 2017, indicating that, as no response had been received to its letter of 14 July, the tribunal would treat Mr Johnson as not opposing the application for revocation and that the registration would shortly be revoked.

8. On 4 September 2017, Mr Johnson filed a form TM8(N) and a witness statement. He stated that:

"I suffer from chronic severe clinical depression and I take prescription medication to try and alleviate my symptoms. I am often left unable to

function properly and to undertake routine daily tasks, this includes collecting my post. This period of deterioration in my condition specifically affected the reason why I mistakenly completed the incorrect form and why there was a short delay in filing it.

In connection with the above I did not initially receive your letter that was sent by Royal Mail Signed For as expected. An unsuccessful attempt to deliver was made on 18<sup>th</sup> April 2017, it was subsequently left at my local delivery office until a further attempt was made on 13<sup>th</sup> June 2017. After taking delivery of the letter I sincerely tried to make sure that the correct form was completed and returned to you as soon as possible”.

9. The tribunal responded on 10 October 2017. It indicated that it had taken into account the relevant case law but that “the circumstances as set out in your witness statement do not provide sufficient reasons to allow the admittance of the TM8(N)”. It gave the preliminary view that the TM8(N) could not be admitted into proceedings. It added:

“The facts are that the letter serving the notice of revocation was correctly served to the address for service provided and the registered proprietor has admitted having received the Form TM26(N). A further copy was also sent to the registered proprietor by post and by e-mail on 3 May 2017. The failure to file a defence in time in response to the revocation papers was because of a failure to act on the registered proprietor’s part”.

10. Mr Johnson objected to the preliminary view and requested to be heard on the point.

### **Additional evidence**

11. Prior to the hearing, Mr Johnson filed a second witness statement, along with a letter from his GP and a copy of the recorded delivery envelope. The witness statement is not signed and the attachments not identified as exhibits. However, the statement essentially repeats the content of his first statement, while the doctor’s letter confirms

that Mr Johnson suffers from depression but goes no further: it does not, for example, explain the severity of Mr Johnson's condition during the two-month period for filing the TM8(N). Consequently, none of the additional documents would materially assist Mr Johnson, even if the statement had been properly formatted and executed.

### **The hearing**

12. The matter came to be heard before me on 29 November 2017. Mr Johnson represented himself, while the applicant was represented by Antony Yerasimou for Trade Marks Wizards.

13. At the hearing, Mr Johnson explained that he is a sole trader and that he does everything himself. He explained that he has found it to be a struggle dealing with the legal matters concerning his trade mark and that he has found it very difficult to know which forms to fill out. To his credit, Mr Johnson admits that missing the deadline was his mistake.

14. Mr Johnson explained that he has been suffering from clinical depression for 10 years and that his condition fluctuates. He has been on medication but, despite that, he suffered a deterioration in his mental health in the period April-June of this year. He said that, in that period, he could not function properly in his personal life, let alone in dealing with legal proceedings. He said that he was not reading certain emails and not opening his post at all, so that he didn't realise the deadline to file his TM8(N) was looming. He asserted that he was practically housebound in that period and unable to cope with anything in his life. He said that his mental ill health was exacerbated by caring for his grandfather, who had Alzheimer's, and whose funeral was the cause of his request that the hearing be postponed from its original date. He said he had given his doctor permission to explain his condition but the doctor considered it appropriate to write a 'to whom it may concern' letter without going into detail, which he thought was for privacy reasons.

15. In respect of the email of 21 April, Mr Johnson said that his depression is a day-to-day condition and that he could write an email one day and deteriorate the next. His ability to send the email does not, he argued, mean he was capable of filling out forms.

Mr Johnson repeatedly said that his life was “out of control” and that in the period April-June he could not operate at all.

16. Mr Yerasimou contended that the reasons provided by Mr Johnson do not constitute extenuating circumstances. He pointed to the decision in *Mercury* and the need for documentation to support a claim of extenuating circumstances. He complains that the doctor’s note provided by Mr Johnson does not confirm that Mr Johnson’s health deteriorated in the relevant period or that it stopped him from performing routine tasks. The fact that Mr Johnson emailed the IPO on 21 April, he said, showed that Mr Johnson had the ability to function. Mr Yerasimou also pointed out that Mr Johnson has subsequently missed deadlines, in particular the deadline set in the official letter of 14 July 2017. Mr Johnson, according to the applicant, failed to file his TM8(N) in time because he did not diligently monitor the deadline.

17. At the hearing, I reserved my decision. In making my decision, I have reviewed and taken into account all of the papers on file and both parties’ skeleton arguments and submissions.

### **The statutory provisions**

18. There is no need for me to set out all of the provisions governing revocation proceedings before the tribunal. For the purposes of this decision, it suffices to note that the period allowed to the proprietor to file a form TM8(N) by rule 38(3) is an inextensible period, governed by Schedule 1 to the Trade Marks Rules 2008 (“the Rules”). Nevertheless, the registrar has discretion to admit a late-filed TM8(N) if he considers it appropriate to do so. This discretion is contained in rule 38(6), which reads:

“38(6) Where the proprietor fails to file a Form TM8(N) within the period specified in paragraph (3) the registration of the mark shall, unless the registrar directs otherwise, be revoked”.

## Decision

19. Mr Johnson accepts that it was his fault that he missed the deadline, though he submits that extenuating circumstances caused him to do so. That means that the only matter for me to consider is the discretion afforded to me under rule 38(6). In approaching the discretion provided in that rule by the use of the words “unless the registrar directs otherwise”, I take into account the decisions of the Appointed Person (“AP”) in *Kickz AG v Wicked Vision Limited* (O/035/11) and *Mark James Holland v Mercury Wealth Management Limited* (O/050/12). Although those decisions concerned opposition rather than revocation proceedings, the same principles are relevant. Bearing those decisions in mind, I must be satisfied that there are extenuating circumstances or compelling reasons to exercise the registrar’s discretion in favour of Mr Johnson.

20. There is no dispute that the TM26(N) was properly served. The TM8 was filed eight days late and without further prompting from the tribunal, apparently as a result of Mr Johnson collecting the letter of 12 April 2017 from the Royal Mail delivery office. Mr Johnson stated in his (signed) witness statement that he suffers from chronic severe clinical depression. I accept that evidence. Mr Johnson elaborated on his condition at the hearing, saying that he was unable to function in the relevant period, which included his being unable to collect and open post. I have considerable sympathy for Mr Johnson’s position and have no doubt that mental illness can be debilitating. However, a more detailed description of Mr Johnson’s condition and its impact at the relevant time, particularly from his GP, would have assisted. I also bear in mind that, notwithstanding the claimed deterioration in his condition at the time, Mr Johnson himself contacted the IPO to ask how to defend his mark against the attack. I acknowledge that Mr Johnson stated that his condition fluctuates but that cuts both ways, and the tribunal’s response was sent with over five weeks of the period for filing the TM26(N) left to run. Whilst I might accept that he was not capable of actually going to the delivery office, or that post might be left unopened, its significance not realised, I have more difficulty in accepting that Mr Johnson was incapable of opening and reading an email response to his own enquiry. That is even more the case given that the revocation action had been filed some four months previously and that he must

have been aware that the application for revocation may be admitted into proceedings at any time.

21. In terms of the prejudice to the parties, Mr Yerasimou did not identify any prejudice arising from the eight-day delay in filing the form TM8. There would, clearly, be serious consequences for Mr Johnson if his defence is not admitted, as his mark will be revoked. However, that is always the case where the tribunal makes an adverse decision because of a failure to file a defence in time. Mr Johnson also spoke of the emotional impact revocation of his mark would have, describing it as “devastating”.

22. After careful consideration of the competing written and oral submissions in light of the relevant case law, my decision is that the reasons for the failure to file the TM8(N) on time do not constitute exceptional circumstances such to allow the exercise of the registrar’s narrow discretion. My decision is not to exercise the discretion available under rule 38(6) in Mr Johnson’s favour. Subject to appeal, the registration will be revoked in full under s. 46(1)(a) with effect from 27 May 2011.

### **Costs**

23. As my decision terminates the proceedings, I must consider the matter of costs. At the hearing, both parties agreed that any costs award should be based on the scale of costs (which is contained in TPN 2/2016). I award costs to the applicant on the following basis:

Revocation fee:	£200
Preparing the TM26(N)	£200
Reviewing the late-filed TM8(N) and witness statement, and attending the hearing	£200
<b>Total:</b>	<b>£600</b>



24. I order Karl Robert Johnson to pay to Gabriel Cesar Alvarado 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 5<sup>th</sup> day of December 2017**

**Heather Harrison**

**For the Registrar**

**The Comptroller-General**