

O-220-18

TRADE MARKS ACT 1994  
IN THE MATTER OF  
APPLICATION NO. 3203607  
BY ZbTM INTERNATIONAL LTD  
TO REGISTER

**“Monsta Boy”**

AS A TRADE MARK

IN CLASS 41

AND

THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT

IN DEFENCE OF THAT APPLICATION

IN OPPOSITION PROCEEDINGS (NO. 408982)

LAUNCHED BY

MONSTER ENERGY COMPANY

## Background

1. On 21 December 2016, ZbTM International Ltd ('the Applicant') applied to register as a trade mark the words "Monsta Boy" for "entertainment" in class 41. The application was published in the Trade Marks Journal on 31 January 2017.
2. On 10 March 2017, Bird & Bird LLP filed a notice of threatened opposition (Form TM7A) on behalf of its client, Monster Energy Company ('the Opponent'), and on 11 April 2017 filed its notice of opposition (Form TM7), based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").
3. On 13 April 2017 the Trade Marks Registry<sup>1</sup> served the Form TM7 in a letter that stated that the Applicant had two months in which to file a Form TM8 (notice of defence) and counterstatement. Alternatively, if both parties agreed, a Form TM9C 'Request for a cooling off period' may be filed to extend, by a further seven months, the period for the filing of the Applicant's defence. The Registry's letter stated that if neither a Form TM8 nor TM9C were received on or before 13 June 2017, then in accordance with rule 18(2) of the Trade Marks Rules 2008, the application would be treated as abandoned in whole or part unless the registrar otherwise directed.
4. A Form TM9C, dated 5 June 2017 and signed by Mr David Edwards on behalf of the Applicant was duly filed. That form was acknowledged in a letter from the Registry dated 13 June 2017, which informed the parties that in view of the requested cooling off period, the deadline for filing the Form TM8 (or to request for a further extension) was set as **15 January 2018**. The letter similarly repeated the point that if no Form TM8 were filed by that deadline (or there were no request for a further extension) "the application shall, unless the Registrar otherwise directs, be treated as abandoned in whole or part, in accordance with Rule 18(2) of the Trade Marks Rules 2008."
5. On 30 January 2018, two weeks after the expiry of the deadline, the Registry wrote to the parties referring back to the content of the official letter of 13 June 2017 and stating that as no Form TM8 and counterstatement had been filed within the time period set,

---

<sup>1</sup> i.e. the Intellectual Property Office (IPO)

Rule 18(2) applied and that the Registry was minded to deem the application as abandoned. (That position is known as the Registry's "preliminary view.") The letter gave the Applicant two weeks in which to express any objection, requiring that if the Applicant disagreed with the preliminary view, it would need, by 13 February 2018, to request a hearing and to explain in a witness statement why the Form TM8 and counterstatement were to be filed outside of the prescribed period. If no response were received by 13 February 2018, the Registry would indeed proceed to deem the application abandoned.

6. On 12 February 2018, David Edwards on behalf of the Applicant sent to the Registry, with copy to the Opponent's legal representatives, an email enclosing a Form TM8 and counterstatement, responding to each of the three grounds of opposition. The email also referred to an enclosed witness statement, but none was in fact attached. The Registry wrote to Mr Edwards on 14 February 2018 confirming receipt of the Form TM8 and counterstatement, but noting the absence of the witness statement explaining the late filing. The Registry gave the Applicant a further seven days - until 21 February 2018 - to file a witness statement else the preliminary view would be confirmed and the application would be deemed abandoned.
7. In fact later that same day (14 February 2018) Mr Edwards sent a further email, apologising for the mistake and enclosing his witness statement, which took the form of a letter to the caseworker. I note that it does not contain a statement of truth normally required of a witness statement, but it does contain the name and address of Mr Edwards, describes itself as a Witness Statement, and is dated and signed by Mr Edwards. Mr Edwards also asked the Registry to let him know if it required the statement in another format. No comment was made by the Registry. The formality could be rectified if necessary, but the matter drew no objection and I consider the letter to serve as a witness statement and to stand as part of the proceedings.
8. The letter from Mr Edwards requested a hearing to explain why the TM8 and counterstatement were being filed outside of the prescribed period. The explanation given by Mr Edwards in his letter is extracted below:

As I have not undertaken anything like this before and I have been totally out of my depth dealing with this as an individual. I have received some limited assistance in relation to negotiations with the Opponent on a pro bono basis, and this has resulted in settlement discussions which are ongoing and promising.

Can I add I have been coming to terms with the bereavement of my dear mother, which may have added to my confusion and resulted in the missing the date to file the TM8 and counterstatement at the correct time. I had this marked in my diary as the 15<sup>th</sup> February 2018 and even quoted this date in correspondence to those advising me on the settlement discussions. I can but apologise and hope that you will sympathise with me on this occasion.

9. Ahead of the Joint Hearing, the Opponent provided skeleton arguments to the Registry and to the Applicant on 27 March 2018. The Applicant had no ongoing professional legal representation and was not required to provide written skeleton arguments ahead of the hearing.

### **The Hearing**

10. The hearing was to take place before me on 29 March 2018, to be conducted by telephone conference at 10:30. Mr Nick Boydell of Bird & Bird LLP attended as the legal representative of the Opponent. Although Mr Edwards had requested the hearing on behalf of the Applicant, the Registry received no reply to its notification of the hearing. The Registry attempted to contact Mr Edwards by email<sup>2</sup> and tried various telephone numbers in its attempts to reach Mr Edwards shortly before the time of the hearing on 29 March, but without success. In the absence of Mr Edwards, I had no information to amplify the points contained in his written statement; and taking into account the Opponent's skeleton arguments against the admission of the late filed Form TM8 I informed Mr Boydell at the hearing that I confirmed the preliminary view of the Registry with the consequence that the application was deemed abandoned. I have set out below an account of the factors behind my decision, along with matters of costs in these proceedings.

---

<sup>2</sup> It is noted that Mr Edwards replied to the email outside of office hours on 29 March 2018, acknowledging that he was unable to attend or to notify the Registry of his non-attendance. The bare outcome of the hearing has been communicated to Mr Edwards.

## The law

11. Rule 18 of the Trade Marks Rules 2008 ('the Rules') provides as follows:

“(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.”

12. 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.”

13. It is clear that in this instance there has been no irregularity in procedure. Accordingly, I need not consider rule 77(5). The only possible basis on which I may allow the Applicant to defend the opposition proceedings is provided by the words “*unless the registrar otherwise directs*” in rule 18(2).

14. In order to promote consistency and fairness the Registry must take account of relevant principles set out in previous decisions of appellate bodies such as the Appointed

Persons<sup>3</sup>. Sitting as the Appointed Person in *Kickz AG and Wicked Vision Limited* (BL-O-035-11) (*'Kickz'*) Mr Geoffrey Hobbs QC held that the discretion conferred by rule 18(2) can be exercised only if there are “*extenuating circumstances*”. And sitting as the Appointed Person in *Mark James Holland and Mercury Wealth Management Limited* (BL-O-050-12) (*'Mercury'*) Ms Amanda Michaels QC held that there must be “*compelling reasons*” to justify the Registrar exercising that discretion. In considering relevant factors, Ms Michaels 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 opposition proceedings, are as follows:

- i. The circumstances relating to the missing of the deadline, including reasons why it was missed and the extent to which it was missed;
  - ii. The nature of the opponent's allegations in its statement of grounds;
  - iii. The consequences of treating the applicant as opposing or not opposing the opposition;
  - iv. Any prejudice caused to the opponent by the delay;
  - v. Any other relevant considerations, such as the existence of related proceedings between the same parties.
15. I take account of all of the above factors in my decision below.

### **Relevant factors**

16. As to the **first of the *Music Choice* factors**, the Opponent states in its skeleton argument as follows:

---

<sup>3</sup> An “Appointed Person” is a senior lawyer expert in matters of trade mark law, who sits in an independent capacity to hear appeals from first instance decisions by the trade mark tribunal.

“the Applicant is a limited company, represented in the Applicant's witness statement by Mr David Edwards. Mr Edwards' stated lack of familiarity with trade mark opposition proceedings is not an extenuating circumstance, in particular where deadlines are clearly communicated by the UK IPO. The Applicant's lack of representation is not an extenuating factor, following the decision of Geoffrey Hobbs QC in BOSCO (O-399-15):

*"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 GH/Bosco doc -11- 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."*

13. In any event, as stated by Mr Edwards in his statement, the Applicant received some assistance on a pro bono basis.

14. Mr Edwards' bereavement, while regrettable, is not an extenuating circumstance such that the Registrar should exercise discretion in these proceedings. In any event, Mr Edward's statement that this 'may' have resulted in missing the deadline falls short of stating that this is the cause of missing the deadline.

15. Mr Edwards' statement suggests that he missed the deadline because he had marked it incorrectly in his diary as the 15 February 2018 (one month after the deadline). Mr Edwards does not suggest that he was incorrectly informed of the deadline. A lack of vigilance in recording a deadline correctly is not an extenuating circumstance such that the Registrar should exercise discretion.”

17. I consider the above to be a reasonable account of the circumstances and I also take note of the limited extent to which allowances may be made for litigants in person. The Applicant received clear and express notification(s) of the need to file a timely defence and of the consequences of failing to do so. The Registry's letter of 13 June 2017 identified the deadline date (of 15 January 2018) on three occasions within its text, each time presenting the date in bold print. Mr Edwards has stated that he marked the date in his diary as 15<sup>th</sup> February 2018. While I naturally have sympathy in respect of Mr Edwards' bereavement, it is not clear from the information he provided why or at what stage Mr Edwards made the mistake in noting the deadline date.

18. With regard to the **second factor**, the Opponent states in its skeleton argument that “there is nothing in the Opponent's allegations in its statement of grounds which suggests that the filing of a TM8 and counterstatement is unnecessary.” I note that the opposition is based on grounds under sub-sections 5(2)(b), 5(3) and 5(4)(a) of the Act and it is not the case that the merits of the opposition could simply be dismissed. For example, to determine the outcome of the opposition on the basis of the 5(2)(b) ground would require a careful multifactorial assessment as to whether the parties' marks are similar and are for goods or services that are identical with or similar to one another such that it is likely to confuse a notional average consumer. Notwithstanding the lay status of the Applicant, it has not been suggested that it encountered any difficulty in



understanding and responding to the claims, and clearly in this case, the cooling off period extended the time available to consider the Opponent's statement of grounds.

19. Proceeding to the **third factor**, the consequence for the Applicant were the discretion not exercised in its favour would be that this particular application for a trade mark would be treated as abandoned; contrastingly, if the discretion were exercised the case would proceed to be determined on its merits. In its skeleton argument, the Opponent points out that to deem the application abandoned would be in accordance with the Rules, resulting from a failure to file a timely defence in circumstances where "there are no extenuating circumstances to suggest that this is not an appropriate course of action, in particular where the Applicant has failed to exercise vigilance in recording the correct deadline." As to the **fourth factor** the Opponent has argued that it "has an interest in the Opposition being dealt with efficiently and expeditiously, and this has been prejudiced by the failure of the Applicant to meet the deadline." (I shall briefly return to the third and fourth factors below.)
20. As to the **fifth factor**, the Opponent has stated that "there no other related proceedings between the same parties or any other compelling reason under the fifth factor such that the Registrar should exercise its discretion."

## Decision

21. Having been alerted to the missed deadline by the Registry's letter of 30 January 2018, the Applicant in this case acted reasonably promptly to file the Form TM8. A mishap in noting diary entries may be commonplace in daily life and I have no reason to doubt that it was in this case simply an error. There is plainly prejudice to the Applicant in not being able to defend the opposition and there is no evidence that a short delay in proceeding with the opposition would have caused specific prejudice to the Opponent. However, in line with the view of the Appointed Person in *Mercury*, I find that these points are not sufficient to counterbalance the absence of a compelling reason<sup>4</sup> for the Applicant to be treated as defending the opposition where it has failed to comply with

---

<sup>4</sup> See paragraph 65 of *Music Choice*, Mr Vos QC sitting as a Deputy High Court Judge.

the time limit in Rule 18. That time limit is inextensible and the Registrar's discretion to admit a late filed defence is narrow.

22. It is clear from *Mercury* that it is incumbent on someone seeking an extension under Rule 18(2) to give full and detailed reasons for the request and to set out in proper detail any extenuating circumstances relied upon. Since Mr Edwards did not attend the hearing, I have only a bare expression of the possibility that the loss of his mother may have added to his confusion. It may be unduly callous to anticipate the provision of evidence in such circumstances, but a fuller explanation of the timings would have been relevant and helpful. I reiterate my condolences, but it is not possible to exercise a discretion to admit the Form TM8 filed after the expiry of the deadline, merely on the strength of the Applicant having mis-noted the date, without further explanation, despite clear forewarnings of the consequence and the very clear specification of the date in official correspondence from the Registry.
23. The guidance from the decisions of Appointed Persons, as I have referenced in this decision, leads me to find that there are in this case no compelling reasons or extenuating circumstances sufficient to enable the exercise of the narrow discretion in the Applicant's favour. Consequently, the trade mark application is treated as abandoned under rule 18(2).

## **COSTS**

24. As my decision concludes the proceedings, I must consider the matter of costs. Using the guidance set out in Tribunal Practice Notice 2/2016, and taking account of the straightforward nature of the issue and short duration of the hearing, I award the Opponent costs as follows:

Official fee (TM7)	£200
Preparing the notice of opposition	£200
Preparation for joint hearing (incl. consideration of TM8 and witness statement), preparing a skeleton argument and attending the (curtailed) hearing	£200
<b>Total:</b>	<b>£600</b>

25. I order **ZbTM International Ltd** to pay **Monster Energy Company** the sum of **£600** (six hundred pounds). 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 06<sup>th</sup> day of April 2018**

**Matthew Williams**  
**For the Registrar,**  
**the Comptroller-General**

---