

**O-329-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF A JOINT HEARING HELD IN RELATION TO  
APPLICATION NO. 3254228  
IN THE NAME OF FRANK KENNEDY**

**AND**

**OPPOSITION THERETO UNDER NO. 411089 BY  
F AND M MEDIA GROUP LIMITED**

## BACKGROUND

1. Application No. 3254228 is for a series of four trade marks i.e.



It was applied for on 4 September 2017 in relation to goods and services in classes 9, 35 and 41, stands in the name of Frank Kennedy and was published in the *Trade Marks Journal* on 22 September 2017.

2. On 18 December 2017, Sheridans Solicitors (“Sheridans”), filed a Form TM7 (Notice of opposition and statement of grounds) on behalf of its client F And M Media

Group Limited (“F&M”). The opposition, which is directed against all of the goods and services in the application, is based upon sections 3(6) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. On 11 January 2018, the Tribunal served the Form TM7 on Mr Kennedy by both e-mail (his stated preference) and by Royal Mail “Signed For”. Mr Kennedy was advised that he had until 12 March 2018 to file either a Form TM8 and counterstatement or Form TM9C (to request cooling-off). The letter contained the following paragraph:

“If you choose not to file a TM8, or a TM9C your application shall, in accordance with rule 18(2) of the Trade Marks Rules 2008, be treated as abandoned in whole or part unless the registrar otherwise directs.”

4. The official record indicates that on 14 March 2018, Mr Kennedy contacted the Tribunal by telephone. The annotation on the official record reads as follows:

“I received a call from the applicant asking for advice as his TM8 deadline expires on 21st March, or so he thought. The deadline actually expired in 12 March, not the 21st. I advised that, in this circumstance, he would need to file the TM8, along with a W/S advising why the deadline was missed. As he was unsure what a Witness Statement was, I sent him an example of a W/S by email.”

5. On the same date, the Tribunal received a Form TM8 (accompanied by a number of attachments) and a witness statement from Mr Kennedy. The operative part of that statement appears in paragraph 11 below.

6. On 28 March 2018, the Tribunal wrote to Mr Kennedy indicating that as the reasons provided for the late filing of the Form TM8 did not constitute “extenuating circumstances” nor “compelling reasons”, its preliminary view was that the request to have the late filed Form TM8 admitted into the proceedings should be refused. Mr Kennedy was allowed until 11 April 2018 to request a hearing and on that date he did so.

## **The joint hearing**

7. A joint hearing took place before me, by telephone conference, on 8 May 2018. At the hearing, Mr Kennedy represented himself; F&M was represented by Dan Head of Sheridans, who provided a skeleton argument in advance of the hearing.

## **DECISION**

### **Statutory provisions**

8. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by rule 18 of the Trade Marks Rules 2008 (“the rules”). The relevant parts read as follows:

“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.”

9. 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.”

10. At the hearing, Mr Kennedy indicated that he had received the official letter of 11 January 2018. As a consequence, there has been no irregularity in procedure and the only basis on which he may be allowed to defend the opposition proceedings is if I exercise the discretion afforded to me by the use of the words “*unless the registrar otherwise directs*” in rule 18(2) in his favour.

#### **Mr Kennedy’s witness statement**

11. The relevant paragraph reads as follows:

“5. I have suffered with stress and due to my stress I have had a serious case of gout in both my feet which has lead me to not able to walk, also a lot of personal problems occurring within my business structure and family that has not had me be 100% focused to the point I entrusted my secretary at the time to prepare the above application form to be submitted on time. She assumed the closing off date was 21<sup>st</sup> March 2018 instead of 12<sup>nd</sup> March 2018. It was only till I took it upon myself to contact Chris Benny at IPO that it was brought to my attention the closing date was in fact 12<sup>nd</sup> March. I confirm this was a purely clerical error, and that ownership of the applicant trademark has not changed during the course of this application.”

12. Mr Kennedy also provided a document from his clinician in support of the above. I shall keep the contents of that document in mind but do not intend to refer to it in any detail in this decision.

### **How should the discretion be approached?**

13. As foreshadowed in Mr Head's skeleton argument and as I explained to Mr Kennedy at the hearing, in approaching how to exercise discretion in these circumstances, the Tribunal takes into account the decisions of the Appointed Person ("AP") in *Kickz AG and Wicked Vision Limited* (BL-O-035-11) and *Mark James Holland and Mercury Wealth Management Limited* (BL-O-050-12) i.e. the Tribunal has to be satisfied that there are extenuating circumstances which justify the exercise of the discretion in Mr Kennedy's favour.

14. In *Mercury*, the AP indicated that a consideration of the following factors is likely to be of assistance in reaching a conclusion as to whether or not discretion should be exercised in favour of a party in default. That is the approach I intend to adopt referring to the written and oral submissions to the extent that I consider it necessary to do so.

### **The circumstances relating to the missing of the deadline including reasons why it was missed and the extent to which it was missed;**

15. At the hearing, Mr Kennedy provided further details of the circumstances leading to the missing of the deadline. These included references to various medical issues he had been experiencing for some time (references which are supported by the document from the clinician mentioned above). These issues led him to delegate the responsibility for the completion of the Form TM8 to what he describes in his witness statement as "my secretary". However, at the hearing, it transpired that the person referred to as his "secretary" was, if I understood him correctly, an individual participating in a music workshop in which he was also involved (and whom he explained was undergoing management training involving dealing with correspondence and "admin" work). He explained that he passed the responsibility to this individual on or around 9 March 2018 (i.e. the Friday before the Monday on which the Form TM8 was due). Although Mr Kennedy states that "she assumed the closing off date was 21<sup>st</sup> March instead of 12<sup>nd</sup> March", at the hearing, he explained that this was because she was "not herself", adding that the individual concerned had become seriously unwell and it was not until he returned to the workshop on 14 March 2018 that he became aware of this fact. It was on that date he contacted the

Casework Examiner, learnt the deadline had already expired and filed the Form TM8 and witness statement i.e. the Form TM8 and counterstatement was two days late.

**The nature of F&M's allegations in its statement of grounds;**

16. The opponent's allegations relate to bad faith and passing off, both of which require the filing of cogent evidence if the opponent is to succeed.

**The consequences of treating Mr Kennedy as defending or not defending the opposition;**

17. If Mr Kennedy is not allowed to defend the opposition, his application will be deemed abandoned (leading to a loss of priority) and may, in due course, result in the filing of another application on much the same basis. If he is allowed to defend his application, the proceedings will move to the next stage and the opposition will be determined on its merits.

**Any prejudice caused to F&M by the delay;**

18. Other than the additional time and costs in dealing with the matter, Mr Head did not identify any specific prejudice to the opponent by the delay in these proceedings. He did, however, comment upon it in relation to "other" proceedings, to which I will now turn.

**Any other relevant considerations such as the existence of related proceedings between the parties.**

19. At the hearing, I asked Mr Head to comment upon what might (in due course) become related proceedings between the parties. In this regard, I noted that on 4 September 2017 (i.e. the same date Mr Kennedy filed his application), F&M filed an application to register the trade mark shown below for services in class 41:

F R A N K I N C E N S E & M Y R R H

20. The application was accorded no. 3254411 and was published for opposition purposes on 22 September 2017. On 27 September 2017, a Form TM7A (Notice of threatened opposition) was filed and on 22 December 2017, a Form TM7 was filed. On the Form TM7, the opponent is identified as Frank Kennedy. Following amendment, Mr Kennedy seeks to oppose the application in full on the same legal basis as his application is opposed i.e. sections 3(6) and 5(4)(a) of the Act.

21. At the time of the hearing, however, there was an unresolved discrepancy between the name of the opponent appearing on the Form TM7A and that shown on the Form TM7, with Mr Kennedy allowed until 17 May 2018 to address this issue. I explained that it appeared to me that if that discrepancy is resolved in Mr Kennedy's favour, there may in the very near future be related proceedings (under No. 411167) between the same parties, in relation to, inter alia, services in class 41 and trade marks all of which include the words "FRANKINCENSE & MYRRH". Mr Head explained that as his firm had only recently been appointed to deal with those proceedings, he was unable to comment on what course of action the applicant might adopt should Mr Kennedy satisfactorily address the discrepancy mentioned above. However, even if Mr Kennedy did, it was not, in his view, sufficient to justify the exercise of discretion in Mr Kennedy's favour.

22. Having reviewed the official record of this potentially related case, I note that the name of the opponent entered in Box 3 of the Form TM7A is "Tarandeep Chowdhry, 144 Langland Crescent, Stanmore, Middlesex, HA7 1NH", whereas the name of the opponent recorded on the Form TM7 is Frank Kennedy. In an official letter dated 11 January 2018, the tribunal noted this discrepancy and stated:

"Before the opposition can be admitted, you must explain the discrepancy between the name of the opponents provided on the Form TM7 and Form TM7a, whilst also confirming to the Registry the name of the opponent in these proceedings."

23. Mr Kennedy was allowed until 1 February 2018 to address, inter alia, the above issue. That period was further extended to 6 April 2018. Although on 23



March 2018, Mr Kennedy filed an amended Form TM7, he did not address the issue mentioned above. In an official letter dated 10 April 2018, this oversight was brought to his attention and he was allowed a further period expiring on 24 April 2018 to address the issue. In an email dated 24 April 2018, Mr Kennedy stated:

“Attached is a copy of my statement regarding my TM7a Form against (UK00003254411) and the opponent known as Taradeep Chowdhry (Teeezyc) of 144 Langland Crescent Stanmore Middlesex HA7 1NH who is the same person who runs "F AND M MEDIA GROUP LIMITED", Rapid Formations Ltd (71 - 75) Shelton Street London WC2H 9JQ. (IP website will not let me download the form again to resubmit so attached are all the evidence and statements to support my TM7a Form).”

24. Attached to that email are a number of attachments including letters from Mr Kennedy to Mr Chowdhry (at the address mentioned above) dated 17 April and 22 July 2015, and a further letter to Mr Head at Sheridans dated 6 November 2017 (in response to a letter from Mr Head dated 25 October 2017). In an official letter dated 3 May 2018, the tribunal stated:

“The Registry is in receipt of your email dated 24 April 2018 which claims to also contain a statement regarding the Form TM7a filed.

Upon examination of the documents filed, the statement referred to in your email appears to consist of correspondence between Tarandeep Chowdhry and Frank “Mulla” Kennedy.

In between copies of the correspondence you have provided, page 11 of the documents you have filed contains what appears to be a statement, however, that statement begins as follows:

***‘The opponent real name is Taradeep Chowdhry (Teeezyc) of 144 Langland Crescent Stanmore Middlesex HA7 1NH who is the same person who runs “F AND M MEDIA GROUP LIMITED”, Rapid Formations Ltd (71-75) Shelton Street London WC2H 9JQ’***

Please note, the details you have provided appear to be the details of the **applicant**, not the opponent, therefore, you do not appear to have confirmed the name of the opponent as requested by the Registry in the letter dated 10 April 2018.

A period of 14 days from the date of this letter, which is up to and including **17 May 2018**, is now given for the discrepancy between the name of the opponent given on the Form TM7a and Form TM7 to be provided.

**As well as this, you must also confirm the name of the opponent in these proceedings.”**

25. On 16 May 2018, Mr Kennedy wrote to the Tribunal stating:

“As requested, I am providing you with amended details of the opponent for the from TM7a as followed:

3. Name and address (including postcode) of the opponent threatening to oppose the above application: Frank Kennedy, Unit 19, The Arches, Grant Road, London SW11 2NU

The correct name of the opponent is FRANK KENNEDY which is originally on the form TM7”

26. In an official letter dated 21 May 2018, the Tribunal responded to that email. The operative part of that letter states:

“I acknowledge receipt of your email dated 16 May 2018 which advised the Registry of the correct details which should have been contained in box 3 of the Notice of threatened opposition (Form TM7a), also confirming the correct name of the opponent, Frank Kennedy.

Following this information, now the opponent in these proceedings has been confirmed, it is the preliminary view of the Registry to admit the opposition.”

27. In that letter, F&M is allowed until 23 July 2018 to file a Form TM8 and until 4 June 2018 to request a hearing if it disagreed with the preliminary view.

28. Mr Kennedy confirms that he received the official letter of 11 January 2018 which served the Form TM7 upon him. That letter made it clear that he had until 12 March 2018 to file a Form TM8 and counterstatement. Although I accept his various medical, business and personal issues are likely to have distracted him to a certain extent, it was not until three days before the expiry of the official deadline that he elected to delegate the responsibility for completing the Form TM8 to someone else. Notwithstanding that delay, as the official record shows, when Mr Kennedy contacted the Tribunal on 14 March 2018, he was under the mistaken impression that the deadline was actually 21 March 2018. It is not clear how that misunderstanding originally occurred. Although referred to in his witness statement as his “secretary”, the person delegated the responsibility to complete the Form TM8 was, it appears, an individual (undergoing management training) with whom Mr Kennedy was acquainted through his participation in a music workshop.

29. Whether Mr Kennedy was aware of the correct deadline or not when he delegated the responsibility for the completion of the Form TM8 to his “secretary”, his decision to leave the completion of the Form TM8 to so late in the day and his selection of the individual he tasked to complete the Form TM8 on his behalf are both, in my view, highly questionable. Although Mr Head argued there is nothing to suggest that having delegated the matter Mr Kennedy did anything to monitor the position during the relevant period, he was clearly monitoring the position, because as soon as he became aware that the individual tasked with completing the Form TM8 was not in a position to do so, he contacted the Tribunal to seek guidance (at that point he was, of course, under the mistaken impression the deadline was 21 March 2018). Regardless, there is no escaping the fact the deadline was missed because of either an error on Mr Kennedy’s part or on the part of the person to whom he delegated the task; he is, as Mr Hobbs Q.C. described the position in *Kickz*, “the author of his own misfortune.” That is, however, only one part of the multi-factorial assessment I am required to carry out.

30. I have already commented upon, inter alia, the potential prejudice to Mr Kennedy if he is not allowed to defend the opposition and to that which may be suffered by F&M if the proceedings continue. The final point I need to consider is the existence of potentially related proceedings between the parties, the details of which I have outlined above.

31. There is no doubt that the parties to these disputes are known to one another. Given the Tribunal's decision in similar circumstances (see, for example, BL-O-237-09 – referred to as the “*Saga*” decision), the preliminary view of 21 May 2018 in relation to Opposition no. 411167 is unlikely to be controversial. Assuming F&M files a defence in those proceedings (which Mr Head indicated was probable), there would at that point be extant proceedings between the same parties, on the same legal basis in relation to, inter alia, services in class 41 and in respect of trade marks which contain the words FRANKINCENSE & MYRRH. Finally, in response to a reference contained in Mr Head's skeleton argument in relation to a previous decision of this Tribunal in BL-O220-18 (“*Monsta Boy*”), I note that the existence of related proceedings was not a factor in the Tribunal's decision in those proceedings.

32. I accept that Mr Kennedy was clearly at fault in not recording and monitoring the correct deadline. However, in reaching a conclusion, I must also keep in mind the very short delay which occurred in filing the Form TM8 (i.e. two days), the nature of F&M's allegations in its Notice of opposition (both of which are evidential in nature), the serious consequences for Mr Kennedy if he is not allowed to defend the opposition, the lack of what I regard as any significant prejudice to F&M as a result of the delay which occurred and, most importantly in my view, the existence of the closely related proceedings between the same parties I have already described.

33. I must now weigh those factors, including the desirability for all concerned (including this Tribunal) in dealing with matters as quickly, efficiently and at as low a cost as possible. Having done so, I am satisfied that, collectively, they constitute extenuating circumstances sufficient for me to exercise the discretion provided by rule 18(2) in Mr Kennedy's favour and in so doing allow his late filed Form TM8 to be admitted in to the proceedings and formally served upon the opponent. There is clearly a serious issue to be determined between the parties and taking all matters into

account, it seems to me that it is appropriate that this be determined on the basis of evidence rather than on the basis of what would otherwise be a “technical knock out”.

### **Next steps**

34. These proceedings will be suspended until it is known if F&M file a defence in opposition no. 411167. If they do, these proceedings will be consolidated with opposition no. 411167 and a timetable set for the filing of evidence. If F&M do not file a defence in opposition no. 411167, a period will be set for the filing of F&M's evidence in these proceedings.

**Dated this 25th day of May 2018**

**C J BOWEN**

**For the Registrar**

**The Comptroller-General**