

O-383-18

TRADE MARKS ACT 1994

**IN THE MATTER OF A JOINT HEARING HELD IN RELATION TO
APPLICATION NOS. 3254825, 3254842 AND 3254806
IN THE NAME OF
SYNERGY OFFICE SOLUTIONS LLP, SYNERGY OFFICE TECHNOLOGIES LLP
AND SYNERGY OFFICE (UK) LTD, RESPECTIVELY**

AND

**OPPOSITIONS THERETO UNDER NO. 411169, 411171 AND 411172
LAUNCHED BY TOTAL SYNERGY PTY LIMITED**

BACKGROUND

1. This decision concerns a procedural issue relating to the late filing of three Forms TM8 and counterstatements in response to three separate oppositions filed against the following three applications:

i) UK3254825



ii) UK 3254842



iii) UK 3254806



2. In each case the specifications are the same and cover services in classes 37, 38 and 42.

3. The applications were filed on 6 September 2017 by Synergy Office Solutions LLP, Synergy Office Technologies LLP and Synergy Office (UK) LTD respectively (“the applicants”). Though the applicants are separate legal entities, they are all related by virtue of being owned by the same group of companies.

4. On 27 December 2017, ip21 Ltd, on behalf of its client, Total Synergy Pty Limited (the “Opponent”) filed three separate notices of opposition (Forms TM7) against the applications. The oppositions, which are directed against all of the services in the applications, are based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

5. In each case, a copy of the opposition was served on the applicant on 19 January 2018. The accompanying letters advised that a period of time to **19 March 2018** was allowed for the applicants to file a Form TM8 and counterstatement or, alternatively, for the parties to request a cooling-off period by filing a Form TM9C. Each of the letters contained the following paragraphs:

“If you wish to continue with your application, you must in accordance with rule 18(1) and 18(3) of the Trade Mark Rules 2008, complete Form TM8 and counterstatement (please see Glossary) and return it within two months from the date of this letter.

If the parties wish to seek a negotiated settlement and avoid the cost of preparing and submitting evidence or submissions, a Form TM9C ‘Request for a cooling off period’ (no fee required), which will extend the period for the filing of the applicant’s defence for a further seven months, must be filed. Both parties must agree to enter into cooling off.

The TM8 and counterstatement, or TM9C must be received on or before 19 March 2018.

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 unless the registrar otherwise directs.”

6. Although one of the copies was returned, it was reissued by ordinary post on 25 January 2018 and it is not disputed that the forms were correctly served.

7. On 30 January 2018 the applicants filed Forms TM21B requesting amendment of the class 42 specification on each of the three applications.

8. By way of letters of 23 February 2018, the Registry refused the requests because, it explained, the proposed amendment appeared to broaden the scope of the specification. The parties were reminded of the existing deadline of **19 March 2018**.

9. On 23 March 2018, the applicants wrote to the Registry requesting the withdrawal of the class 42 specification of the three applications. They also resent the Forms TM21B without any amendment.

10. By way of letters of 16 April 2018, the Registry confirmed, in each case, that the request to amend the application had not been considered because the applicant had failed to file the Form TM8 within the deadline of 19 March 2018 and that the application would be deemed abandoned. The applicants were given until 30 April 2018 to request a hearing if they wished to challenge this course of action and to provide an explanation in the form of a witness statement as to why no defence was filed within the prescribed period.

11. On 27 April 2018, Forms TM8 and counterstatements were filed in each of the three applications. These were supported by separate but identical letters, one signed by Mr Leon Penny, on behalf of the applicants, the other signed by Mr Raymond Holt, who identifies himself as "Finance Director (Witness)". The letters included the following statements:

"There was a misunderstanding with our application. Us [...] and the opponent (Total Synergy Pty Ltd) have come to an agreement that we delete class 42 from our application and reapply to outline that our services aren't aimed at architects, engineers and the construction industry.

I am writing to outline reasons as to why form TM8 have been filed outside of the prescribed period.

- We are not experts in trademarks and have been receiving advice from Jackie Tolson, the opposition's lawyer and the IPO;
- Although we received letters from the IPO outlining to fill in TM8, we had been seeking advice and have been told to fill in form TM21 B. Never had we received advice on filling in form TM8;

- We thought we had been doing everything we needed to do to come to a reasonable resolution.

We would like to continue to come up with a solution that makes both parties happy, therefore we request for a hearing in the hope to come up with a resolution.”

12. On 2 May 2018, Jackie Tolson, on behalf of the opponent, wrote to the Registry essentially clarifying that she never represented the applicants in the opposition proceedings at issue and that any correspondence between the parties related to an undertaking that the applicants had signed with the opponent to amend their applications. She requested the applications be deemed abandoned.

13. In a letter dated 21 May 2018, the Registry issued a preliminary view in which it indicated that it did not consider that the reasons provided constituted “extenuating circumstances” sufficient for the Registrar to exercise its discretion and refused to admit the late-filed Forms TM8. It stated:

“Having reviewed the submissions, the registry’s preliminary view is that the reasons provided are not compelling and do not constitute extenuating circumstances and are therefore not sufficient to necessitate the exercise of the Registrar’s discretion to allow the late TM8s into proceedings. The facts of the case show that the serving letter sent to the applicant by email and recorded delivery on 19 January 2018 clearly set out the deadline for filing form TM8 or TM9C and explained the consequences of non-adherence. As the hard copy of the correspondence was returned, the letter was reissued on 25 January 2018 and the consequences were reiterated. In the official letter of 23 February 2018, the applicant was reminded again of their existing deadline (of 19 March 2018). The failure to meet the deadline was wholly on the part of the applicant.

As requested in your letter, the case has been passed to the hearings team. As a formalities requirement, the applicant must ensure that a witness statement setting out the reasons for failing to file the TM8 within the prescribed period is submitted in the appropriate format in advance of the hearing.

No witness statement has been received to date.”

14. A hearing in respect of all three applications took place before me, by telephone, on 12 June 2018. Mr Penny and Ms Irene Acosta-Chavez appeared on behalf of the applicants. Ms Tolson attended as the legal representative of the opponent. Neither party filed a skeleton argument.

15. At the hearing Ms Acosta-Chavez conceded that she had confused the forms and had filed forms TM21B in place of filing Forms TM8.

THE LAW

16. Rule 18 of the Trade Marks Rules 2008 (“the Rules”) provides:

“(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.”

17. The period for filing a Form TM8 and counterstatement appears in Schedule 1 of the Rules and may only be extended under the following conditions, set out in Rule 77(5):

“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.”

18. In this case it is not disputed that the Forms TM7 were served correctly. Ms Acosta-Chavez has admitted that the failure to submit the Forms TM8 and counterstatements on time was due to an oversight on her part. Accordingly, Rule 77(5) does not apply and the only relevant consideration in this matter is whether the discretion conferred by the wording of Rule 18(2) should be exercised in the applicants' favour.

19. In *Kickz AG and Wicked Vision Limited*, BL-O-035-11, Mr Hobbs QC sitting as the Appointed Person held that the discretion conferred by Rule 18(2) is narrow and can be exercised only if there are “extenuating circumstances”. In *Mark James Holland and Mercury Wealth Management Limited*, BL-O-050-12, 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, which provides guidance applicable by analogy when exercising the discretion under Rule 18(2). The factors identified in *Music Choice*, which I take account in my decision 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

20. As accepted by Ms Acosta-Chavez at the hearing, the applicants failed to file the Forms TM8 through their own error. Further, notwithstanding the Registry's request, the applicants failed to file witness statements in appropriate format in advance of the hearing. Some information was provided by Ms Acosta-Chavez on the day of the hearing, however, bearing in mind the reasons she gave, even if the information had been provided in evidential format, it would not have made any difference.

21. Looking at the applicants' conduct of their cases, it seems to me that they made no serious efforts to understand (and comply with) the Registry's directions. The fact that the applicants are not professionally represented cannot amount to "extenuating circumstances" and it is not, in itself, a good reason for failing to comply with a non-extensible deadline¹. If the applicants felt they were not versed in trade mark matters, it was their responsibility to appoint a trade mark agent.

2. The nature of the opponent's allegations in its statements of grounds

22. Though it is not appropriate for me to comment on the particulars of the oppositions, it does not seem to me that they are wholly without merit.

3. The consequences of treating the applicants as opposing or not opposing the oppositions

23. If the applicants are not allowed to defend the oppositions they will lose their applications. The prejudice to the applicants is obvious. Whilst I take this prejudice into account, there is no evidence of how this will impact on the applicants' current business and the applicants have made no specific submissions on the point.

4. Any prejudice caused to the opponent by the delay

24. The opponent did not identify any specific prejudice resulting from the delay in filing the Forms TM8, nor can I see any material prejudice to the opponent resulting from the delay.

5. Any other relevant considerations, such as the existence of related proceedings between the same parties

25. The three oppositions at issue have not been consolidated because the applications were filed by different companies. Though the proceedings are connected to the extent that the corporate entity behind all of the applications is the same, there

¹ See *BOSCO*, BL 399-15

appear to be no extant proceedings between the parties before this office, the court or the European Union Intellectual Property Office (EUIPO).

Considerations

26. I am satisfied that the delay which occurred between the expiry of the relevant deadlines, i.e. 19 March 2018, and the filing of the Forms TM8, i.e. 27 April 2018, is unlikely to have prejudiced the opponent to any material extent. This is a point in the applicants' favour. As to the reasons for the delay in meeting the deadline of 19 March 2018, the applicants' mistakes do not constitute "extenuating circumstances" and/or "compelling reasons"; that to my mind is a serious factor, which tip heavily in favour of the opponent. Finally, the fact that the applicants had no previous experience of trade mark matters does not provide an excuse for their failure to file a defence within the relevant deadline. Balancing all these factors, I consider that even though there is an obvious prejudice to the applicants, it is not sufficient to counterbalance the absence of any compelling reasons to allow the applicants to defend their applications. My decision is therefore not to exercise the discretion available under Rule 18(2) in the applicants' favour. Since these are total oppositions, the applications, subject to any successful appeal, will be deemed abandoned.

Costs

27. As my decision terminates the proceedings, I will now consider the matter of costs. The opponent has been successful and is entitled to a contribution towards the costs it incurred in preparing and filing its oppositions. Although the opponent attended the hearing, it lasted only 10 minutes and neither party filed skeleton arguments so I will make no award of costs in relation to it. I see no reason why the award should not be on the usual scale. Awards of costs are dealt with in Tribunal Practice Notice (TPN) 2 of 2016. Bearing the guidance in that TPN in mind and taking into account the fact that the oppositions have not been consolidated, I award costs to the opponent on the following basis in relation to each opposition:

Official fees	£100
Preparing a notice of opposition:	£200
Total:	£300

28. I order Synergy Office Solutions LLP, Synergy Office Technologies LLP and Synergy Office (UK) LTD to pay Total Synergy Pty Limited the sum of £300 each as a contribution towards its costs. 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 22nd day of June 2018

Teresa Perks
For the Registrar
The Comptroller General