

O-691-18

TRADE MARKS ACT 1994

SUPPLEMENTARY DECISION

**IN THE MATTER OF A JOINT HEARING HELD IN RELATION TO
INTERNATIONAL REGISTRATION NO. 1374609
IN THE NAME OF ASAS JAPAN INC.**

AND

**OPPOSITION THERETO UNDER NO. 412067
BY BEIJING SMASHING E-COMMERCE CO. LTD**

1. On 1 October 2018 and following a hearing, I issued a decision (O-616-18) in which I refused to admit a late Form TM8 and counterstatement filed in defence of the application identified on the cover page of this decision.

2. Following the hearing before me, I directed the applicant to provide an explanation of the legal basis on which it had filed an invalidity action at the EUIPO against EUTM 15270549 owned by the opponent and relied upon in the subject opposition proceedings (paragraphs 12 and 13 of the decision). I noted in my subsequent decision that the applicant did not reply, however, it has now come to light that a procedural error occurred at the IPO because the applicant had in fact replied but its response had not made its way to me.

3. The applicant's response was sent by fax on 20 October 2018 and was as follows:

“UKIPO has no legal basis, and to do so goes beyond its powers, to request that the Applicant effectively provide it with a summary of its case and copy this to the representative for the Opponent. Such a request would be prejudicial to the Applicant's case as, before it is finalised, we would be providing information to the other party. Further, the invalidity proceedings are being heard before the EUIPO and the UKIPO is not in a position to assess the merits of the case.

The Applicant takes exception to the mere suggestion by an Officer of the UKIPO that its application for invalidity could be prima facie meritless. Such a suggestion could be prejudicial to the Applicant, the proceedings before the UKIPO and EUIPO. The Applicant requests that the statement contained in the letter of 6 September 2018 be struck from the public record.”

4. Whilst, belatedly, I note the above, as no further information about the invalidation proceedings have been provided, the applicant's submissions do not alter my previous decision, which, therefore stands. As regards my direction, I have already explained why I considered it appropriate to make so no further comment is required.

5. Given the uncertainty that the missing response has caused, the appeal period will be reset and will now start from the date of this supplementary decision.

Dated this 2nd day of November 2018

Teresa Perks

For the Registrar

The Comptroller General