

O-727-19

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTERED TRADE MARK NO.3202272

STANDING IN THE NAME OF EDWIN OBI-OKOYE

FOR THE FOLLOWING SERIES OF THREE MARKS



AND THE LATE FORM TM8 AND COUNTERSTATEMENT

FILED IN DEFENCE OF THAT REGISTRATION

IN INVALIDATION PROCEEDINGS (UNDER NO.502700)

LAUNCHED BY RINGDALE UK LIMITED

Background

1. The registered trade mark set out below stands in the name of Edwin Obi-Okoye.

UK TM No. 3202272	Classes
 <p>(series of 3)</p> <p>Filing date: 14 December 2016</p> <p>Registration date: 10 March 2017</p>	<p>35: Advertising; business management; business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; organisation of trade fairs; opinion polling; data processing; provision of business information; retail services connected with the sale of Grade A phones and mobile phone accessories.</p> <p>38: Telecommunications services; chat room services; telecommunication portal services; e-mail services; providing user access to the Internet; radio and television broadcasting.</p>

2. By an application dated 2 July 2019, Ringdale UK Limited ('Ringdale') applied to invalidate the registered trade mark in full under section 5(2)(b) of the Trade Marks Act 1994 ('the Act').

3. The application for invalidation, Form TM26(1), was served on Mr Obi-Okoye on 11 July 2019 setting a deadline of 11 September 2019 for the filing of a defence via a Form TM8 and counterstatement.

4. No Form TM8 and counterstatement were received on or before 11 September 2019. Subsequently the Tribunal wrote to Mr Obi-Okoye on 19 September 2019 in the following form:

“As no TM8 and counterstatement have been filed within the time period set, Rule 41(6) applies. Rule 41(6) states that:

“...otherwise the registrar may treat the proprietor as not opposing the application and registration of the mark shall, unless the registrar otherwise directs, be declared invalid.”

The Registry is minded to treat the proprietor as not opposing the application for invalidation and declare the registration as invalid as no defence has been filed within the prescribed period.

If you disagree with the preliminary view you **must** provide full written reasons and request a hearing on, or before, **3 October 2019**. This **must** be accompanied by a Witness Statement setting out the reasons as to why the TM8 and counterstatement are being filed outside of the prescribed period.”

5. On 29 September 2019, the Tribunal received a Form TM8 from Mr Obi-Okoye. This was not accompanied by a witness statement. The Tribunal wrote to Mr Obi-Okoye on 3 October requesting a witness statement by 17 October 2019. Mr Obi-Okoye subsequently telephoned the Tribunal regarding the witness statement. In a letter dated 7 October 2019, he was sent a template witness statement as a guide to the information required. In the same letter, the Tribunal also included information regarding deficiencies in the Form TM8. The deadline of 17 October was reinstated. Mr Obi-Okoye filed a witness statement and amended Form TM8 on 16 October. However, there were still deficiencies with the Form TM8 and Mr Obi-Okoye was allowed until 5 November 2019 to file an amended version. Mr Obi-Okoye filed an admissible Form TM8 on 25 October and also requested to be heard on the matter of the late filed Form TM8.

Hearing

6. The hearing took place before me on 25 November 2019 by telephone conference. Mr Obi-Okoye represented himself and Ms Kate Cruse, of Forresters IP LLP, represented Ringdale. Ms Cruse provided a skeleton argument in advance of the hearing. Ms Cruse also asked at the outset of the hearing whether Mr Obi-Okoye had filed a skeleton argument. I confirmed that he had not, and Mr Obi-Okoye replied that he had been informed by the Tribunal that he did not have to file a skeleton argument.

7. Mr Obi-Okoye was very apologetic and explained that firstly he was not aware that his registered trade mark could be attacked and that secondly, he had not previously experienced any tribunal proceedings although he owns a number of trade marks and was confused by the procedures and timescales involved. This confusion was amplified by a letter he had received in May 2019 from the Trade Marks Examination section notifying him of Ringdale's trade mark application for UK TM No.3395052. Mr Obi-Okoye filed a threatened opposition, via a Form TM7A, on that case on 1 July 2019 (although ultimately did not oppose it) and did not realise that these invalidation proceedings were an entirely separate matter. He further explained that he has mostly been working in Kenya for the past 2 to 3 years and had been working there for the last few months. Whilst in Kenya, he frequently works in rural areas with limited telecommunications coverage so does not have regular contact with the UK.

8. We discussed the series of events in relation to the invalidation proceedings. Mr Obi-Okoye accepted that the Tribunal letter dated 11 July 2019 serving the notice of invalidation had been received at his registered address and had been signed for by a tenant, but the letter had not been opened or forwarded to Mr Obi-Okoye in Kenya. Moreover, he also accepted that he had received the Tribunal's emails but that these emails had gone to one of a number of email addresses Mr Obi-Okoye uses. This particular email address received a great deal of spam mail, so the Tribunal's email had gone unnoticed by Mr Obi-Okoye.

9. Ms Cruse contended that if a proprietor was out of the country on a regular basis then a representative could have been appointed to deal with correspondence.

Further Ms Cruse contended that failure to deal with correspondence related to trade marks matters in a timely manner did not amount to “extenuating circumstances”¹ nor “compelling reasons”². She also pointed out that Mr Obi-Okoye had been able to file a Form TM7A in relation to Ringdale’s trade mark application no. 3395052 on 1 July 2019 so should have been able to file a Form TM8 in these proceedings in time. In addition, Ms Cruse also stated that the failure to file an admissible Form TM8 had already gone on for several months and the delay was detrimental to her clients.

10. Mr Obi-Okoye responded by saying he was a sole trader and could not afford legal representatives. The delay was caused by a lack of understanding on his part regarding Tribunal procedures, he has invested a great deal of time and money in his business under his registered trade mark and he did not treat trade mark matters lightly. Ms Cruse clarified that she meant that a representative did not have to be a legal representative but just someone who could receive and open correspondence in relation to trade mark matters and pass on all relevant information to him.

Decision

11. With regard to the late filing of a Form TM8, I refer to Rule 41(6) of the Trade Marks Rules 2008 which states:

“The proprietor shall, within two months of the date on which a copy of Form TM26(l) and the statement was sent by the registrar, file a Form TM8, which shall include a counter-statement, otherwise the registrar may treat the proprietor as not opposing the application and registration of the mark shall, unless the registrar otherwise directs, be declared invalid”.

12. The combined effect of Rules 77(1), 77(5) and Schedule 1 of the Rules means that the time limit in Rule 41(6), 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—

¹ Kickz AG v Wicked Vision Limited O-035-11

² Mark Holland v Mercury Wealth Management Limited O-050-12

(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 has been established that the serving letter from the Tribunal dated 11 July 2019 was received at the address supplied by Mr Obi-Okoye and I find there has been no error on the part of the Tribunal meaning that rule 77(5) is not relevant. That leaves rule 41(6) to be considered. As referred to above, in the *Kix* decision, Mr Geoffrey Hobbs QC sitting as the Appointed Person held that the discretion conferred by rule 18(2), applicable by analogy to Rule 41(6) in invalidity proceedings, is a narrow one and can be exercised only if there are “extenuating circumstances”. In *Mercury*, Ms Amanda Michaels, also sitting as the Appointed Person, in considering the factors the Registrar should take into account in exercising the discretion under rule 18(2), again applicable by analogy to Rule 41(6) in invalidity proceedings, held that there must be “compelling reasons”. Ms Michaels also referred to the criteria which was established in *Music Choice Ltd’s Trade Mark* [2006] R.P.C. 13 (*‘Music Choice’*), which provides guidance when exercising discretion in invalidation proceedings. The criteria are set out below:

- (1) The circumstances relating to the missing of the deadline including reasons why it was missed and the extent to which it was missed;
- (2) The nature of the applicant’s allegations in its statement of grounds;
- (3) The consequences of treating the registered proprietor as opposing or not opposing the application for cancellation;
- (4) Any prejudice caused to the applicant by the delay;
- (5) Any other relevant considerations, such as the existence of related proceedings between the same parties.

14. With regard to the first *Music Choice* factor, I note that the deadline was missed by 44 calendar days. The error occurred as the Tribunal letter setting the deadline for the Form TM8 was received at the address supplied by Mr Obi-Okoye but was neither opened nor forwarded to him. His witness statement states that he only

became aware of the invalidity action on 25 September 2019 following sight of a Tribunal email. Although Mr Obi-Okoye filed several versions of the Form TM8 during October 2019, the only acceptable and therefore admissible version was filed on 25 October 2019.

15. Regarding the second *Music Choice* factor, Ringdale has made an application to invalidate the registered trade mark under section 5(2)(b) on the basis that the registered trade mark is similar to its earlier marks, has similar services and there exists a likelihood of confusion.

16. Turning to the third *Music Choice* factor, the consequences for Mr Obi-Okoye if discretion is not exercised in his favour are very serious as his trade mark would be invalidated and he would lose his registered rights in that trade mark.

17. In respect of the fourth *Music Choice* factor, Ms Cruse stated that Ringdale had been prejudiced by the lengthy delay between the original deadline for filing the Form TM8, namely 11 September and the eventual filing on 25 October as well as the additional delay caused by the appointment of a hearing.

18. Finally concerning the fifth *Music Choice* factor, there are no other related proceedings between these parties.

19. Having addressed each of the relevant factors in *Music Choice*, I must now decide whether there are sufficient extenuating circumstances or compelling reasons to enable me to exercise my discretion to admit the late filed Form TM8 and counterstatement in to these proceedings.

20. After careful consideration, I do not find that there are sufficient extenuating circumstances or compelling reasons which justify me exercising the discretion provided by rule 41(6) in Mr Obi-Okoye's favour. In this case, the letter serving the Form TM261 was received and the subsequent Tribunal emails were received. Both methods of correspondence were sent to addresses provided to the IPO by Mr Obi-Okoye. As such the onus is on him to deal with any correspondence sent to those addresses. Whilst I understand the reasons Mr Obi-Okoye has given in terms of his

absence, and I am mindful of the serious consequences for him in that he will lose his registered trade mark, this does not counterbalance the importance of dealing promptly with matters pertaining to his trade mark which he said during the hearing was an integral part of his business. I bear in mind that Mr Obi-Okoye is not familiar with trade mark procedure and is legally represented but case law makes clear that being a litigant in person is not of itself a good reason for failing to comply with the rules and deadlines clearly set out in official correspondence. The approach of Mr Obi-Okoye in this matter indicates that, in the words of Mr Hobbs in *Kix*, he has been 'the author of his own misfortune'.

21. The late filed Form TM8 and counterstatement will not be admitted into the proceedings and subject to any successful appeal, the registered trade mark is to be invalidated in full.

Costs

22. As my decision terminates the proceedings, I must consider the matter of costs. Ringdale are entitled to a contribution towards the cost of proceedings. Awards of costs are set out in Tribunal Practice Notice 2/2016. Using that guidance, I award Ringdale the following costs:

Official fee – TM26(l)	£200
Preparing for & attending the hearing	£300
Total	£500

23. I order Edwin Obi-Okoye to pay Ringdale UK Limited the sum of £500. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 03rd day of December 2019

June Ralph

For the Registrar,

The Comptroller-General