

O-549-20

TRADE MARKS ACT 1994

**IN THE MATTER OF A JOINT HEARING HELD IN RELATION TO
APPLICATION NO. 3437626
IN THE NAME OF ANETA KELLER-SAUBA**

AND

**OPPOSITION THERETO UNDER NO. 420607 BY
TASTY BAKING COMPANY**

BACKGROUND

1. On 18 October 2019, Aneta Keller-Sauba (“the applicant”) sought registration of the trade mark **kakes** for the goods in class 30 shown in the Annex to this decision. The application, which was accorded no. 3437626, was published for opposition purposes on 3 January 2020.

2. On 28 February 2020, CSY London (“CSY”) filed a Form TM7A (Notice of threatened opposition) on behalf of Flowers Bakeries Brands, LLC (“FBB”). The effect of filing Form TM7A was to extend the opposition period in which FBB could file opposition until 3 April 2020. On 3 April 2020, CSY filed a Form TM7 (Notice of opposition and statement of grounds); the opponent is identified as Tasty Baking Company (“TBC”).

3. In its Statement of Grounds accompanying its Form TM7, it states that TBC “is a wholly owned subsidiary of [FBB].” Rule 17(3) of The Trade Marks Rules 2008 (“the rules”) reads:

“This paragraph applies where a request for an extension of time for the filing of Form TM7 has been made on Form TM7A, before the expiry of the period referred to in paragraph (2) and where this paragraph applies, the time prescribed for the purposes of section 38(2) in relation to any person having filed a Form TM7A (or, in the case of a company, any subsidiary or holding company of that company or any other subsidiary of that holding company) shall be the period of three months beginning immediately after the date on which the application was published.”

The Form TM7 filed on 3 April 2020 in the name of TBC is, therefore, acceptable.

4. The opposition, which is directed against all of the goods in the application, is based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”), with the opponent relying upon a United Kingdom Trade Mark and International Registration designating the European Union Trade Mark (“IREU”) i.e. UK no.

2634341 and IREU no. 1349564 for the trade marks “TASTYKAKE” and



for “bakery products” in class 30.

5. On 1 July 2020, the tribunal served the Form TM7 on the applicant. That letter contained the following:

“If you wish to continue with your application, you need to file a notice of defence and counterstatement by completing Form TM8 - please note the important deadline below. You will find a blank Form TM8 on the IPO website, together with brief guidance on what happens after it is filed: <https://www.gov.uk/government/publications/trade-mark-forms-and-fees/trademark-forms-and-fees>

Rule 18(1) and 18(3) of the Trade Marks Rules 2008 require that you must file your notice of defence and counterstatement (Form TM8) within **two months** from the date of this letter. Alternatively, if both parties wish to negotiate to resolve the dispute, they may request a “cooling off period” by filing a Form TM9c, which will extend the 2 month period in which to file a Form TM8 by up to a further seven months. Form TM9c is also available on the IPO website (above). Please note both parties must agree to enter into cooling off.

IMPORTANT DEADLINE: A completed Form TM8 (or Form TM9c) MUST be received on or before 1 September 2020.

Rule 18(2) of the Trade Marks Rules 2008 states that “*where an applicant fails to file a Form TM8 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.*”

It is important to understand that if the deadline date is missed, then in almost all circumstances, the application will be treated as abandoned.”

6. The official record shows that on 16 September 2020, a Casework Examiner spoke to the applicant by telephone. Given the use of the word “him” on the official record, this is more likely to be a reference to Mr Sauba (see below). On the same day, the tribunal received a Form TM8 completed by Oumaduth Sauba (who describes himself as the applicant’s “representative”). In the Form, TM8 Mr Sauba states:

“I denied that the opponent trademark number 3437626 is identical and/or similar...”

7. Attached to the Form TM8 is a witness statement from Mr Sauba which reads as follows:

“I spoken with [the Casework Examiner] at the IPO and I was told to contact the opponent of the opposition to discuss the opposition against the above Trade Mark application. I emailed the representative of the opponent on 17 August 2020 regarding the opposition and find a resolution. Danielle Jeeves wrote back on 18 August 2020 stating:

“We have been discussing this matter with our client and we will be in touch as soon as possible”.

I was waiting for a reply before putting a TM8 form. I had no reply as of today, 16 September 2020.

Unfortunately, the deadline has passed, and I spoke to IPO regarding the late submission of TM8 form. I was told I can still submit TM8 and hopefully the tribunal will accept it.

I am writing this witness statement as part of my TM8 form.”

Although signed by Mr Sauba, I note that the witness statement does not contain a statement of truth.

8. In an official letter dated 29 September 2020, the tribunal stated:

“I acknowledge receipt of the TM8 and witness statement which were received on 16 September 2020. It is the registrar’s preliminary view that no compelling reasons or extenuating circumstances have been given to allow the admittance of the late TM8.

The official letter dated 1 July 2020 invited the applicant to file a TM8 and counterstatement on or before **1 September 2020**.

As no TM8 and counterstatement has been filed *within the time period set*, Rule 18(2) applies. Rule 18(2) states that the application:

“.....shall, unless the registrar otherwise directs, be treated as abandoned.”

The registry is minded to deem the application as abandoned 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, **13 October 2020**. If no response is received within the time allowed, the preliminary view will automatically become final immediately after that date and the application will be confirmed as deemed abandoned.

Before requesting a hearing to challenge a preliminary view, you should bear in mind the following points:

the deadline for filing a counter-statement on Form TM8 is not a flexible time limit (see Trade Mark Rule 77(6) and Schedule 1 to those rules);

the legal constraints on the exercise of discretion by the Registrar in these circumstances; and

that in the event that the hearing officer upholds the preliminary view, there may be costs implications arising from the hearing against the party who requested the hearing.

The above information is not intended to dissuade you from requesting a hearing, but merely to inform you of the potential consequences should you be unsuccessful in overturning the preliminary view.”

9. On 13 October 2020, Mr Sauba requested a hearing. In his email he states:

“I was waiting for Cleveland Scott York to get back to me regarding their objection (see attached email).”

10. Attached to the mail is an email dated 17 August 2020 from Oumesh Sauba to Ms Jeeves at CSY which reads:

“I wrote to you in July regarding our the above trade mark. I would be grateful if you would kindly call me on 07XXXXXXXXXX to discuss your appeal.”

11. Also attached is an email dated 18 August 2020 to Mr Sauba from Ms Jeeves which reads:

“Thank you for your email, and apologies for the delay in responding.

We have been discussing this matter with our client and we will be in touch as soon as possible.”

12. On 19 October 2020, the tribunal wrote to the parties, that letter contained the following:

“I refer to the joint hearing scheduled to take place by telephone conference at 10.30am on 29 October 2020.

In reaching a conclusion, the Hearing Officer will be guided by, inter alia, the decisions of the Appointed Person in *Kickz AG v Wicked Vision Limited* (BL-O-035-11) and *Mark James Holland v Mercury Wealth Management Limited* (BL-O-050-12). Links to these decisions are shown below:

<https://www.ipo.gov.uk/t-challenge-decision-results/o03511.pdf>

<https://www.ipo.gov.uk/t-challenge-decision-results/o05012.pdf>

It would be helpful if, prior to the hearing, the parties could familiarise themselves with these decisions. “

The joint hearing

Representation

13. The joint hearing took place before me, by telephone, on 29 October 2020. At the hearing, the applicant was represented by Oumesh Sauba (who confirmed that Oumaduth/Oumesh both referred to him); the opponent was represented by Jonathan Clegg of CSY London. Both parties filed skeleton arguments in advance of the hearing.

The skeleton arguments

14. In his skeleton argument, Mr Sauba stated:

“3. The Applicant’s representative was late to file the TM8 as he was waiting for the Opponent representative to email back regarding the next step of the trademark application.

5. We were wating (sic) to see if this matter can be resolved between ourselves rather than going to Tribunal to decide. Hence, I was waiting for a response from the Opponent’s representative before sending the TM8 form.

6. The argument on the TM8 form has always been that UK00003437626 is not similar to the applicant (sic) trademark.”

15. In his skeleton argument, Mr Clegg stated:

“11. In any event, the question of correspondence – whether open or ‘without prejudice’ - between the parties is in principle irrelevant to the Applicant’s failure to file its Form TM8 and counterstatement. It is of course open to the parties to communicate with each other at the same time as the procedural periods of an opposition are running. Equally, however, it is each party’s own responsibility to meet its deadlines in opposition proceedings, irrespective of whether one party is waiting for a response from the other in related correspondence.”

Hearing discussion

16. At the hearing, it emerged that the applicant is Mr Sauba’s wife. Although he is not formally recorded as her official representative, it was he that filed and signed the Form TM8 and Witness Statement on 16 September 2020. It is, therefore, clear that the applicant has delegated the responsibilities for dealing with the opposition to him. In those circumstances, it is Mr Sauba’s actions upon which I must focus.

17. Following the filing of the Form TM7A on 28 February 2020, at the hearing, the parties agreed that there was an exchange of correspondence between them. Mr Clegg argued that such correspondence was not relevant to the issue before me and even if it was, while the opponent was not averse to negotiations, in his view, the correspondence received from Mr Sauba offered no realistic way forward.

18. At the hearing, Mr Sauba explained that although he was fully aware of the deadline in which to file the Form TM8, the matter had “slipped his mind.” That was, he further explained, because of the disruption caused by the Covid pandemic, in particular, the impact it had on his working arrangements, the knock-on effect on his family responsibilities and what he explained were difficulties in contacting the opponent. Insofar as the latter is concerned, Mr Clegg strongly denied that there

were any such difficulties. Finally, in response to a comment from Mr Clegg in relation to the Interrupted Days period instituted by the IPO during the height of the pandemic, Mr Sauba drew my attention to similar measures implemented by Companies House to mitigate the effects of the pandemic and asked me to bear such mitigation in mind in reaching a conclusion.

19. At the conclusion of the hearing, I reserved my decision to give me an opportunity to reflect on the additional reasons relied upon by Mr Sauba which were not foreshadowed in either his witness statement or skeleton argument.

DECISION

Statutory provisions

20. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by rule 18 of 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 is the period of two months beginning immediately after the notification date.

(4) This paragraph applies where—

(a) the applicant and the person opposing the registration agree to an extension of time for the filing of Form TM8;

(b) within the period of two months beginning immediately after the notification date, either party files Form TM9c requesting an extension of time for the filing of Form TM8; and

(c) during the period beginning on the date Form TM9c was filed and ending nine months after the notification date, no notice to continue on Form TM9t is filed by the person opposing the registration and no request for a further extension of time for the filing of Form TM8 is filed on Form TM9e,

and where this paragraph applies the relevant period is the period of nine months beginning immediately after the notification date.

(5)...

(6)...

(7),...".

21. The combined effect of rules 77(1), 77(5) and Schedule 1 of the rules mean 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 rule 77(5) 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.”

22. As there has been no default, omission or error on the part of the office, the only way the applicant may be allowed to defend her trade mark application, is if I

exercise the discretion provided to me by the use of the words “unless the registrar otherwise directs” in rule 18(2) in her favour.

23. Although the document filed by Mr Sauba on 16 September 2020 is signed and headed “Witness Statement”, it does not contain a statement of truth. However, it is clear that the underlying facts upon which he relies upon are supported by the email chain he provided as an attachment to his email of 13 October 2020.

How should the discretion be approached?

24. As foreshadowed in the official letter of 19 October 2020, in approaching how to exercise discretion in these circumstances, the tribunal takes into account the decisions of the Appointed Person (“AP”) in *Kickz AG v Wicked Vision Limited* (BL-O-035-11) and *Mark James Holland v Mercury Wealth Management Limited* (BL-O-050-12) i.e. the tribunal has to be satisfied that there are extenuating circumstances/compelling reasons which justify the exercise of the discretion in the applicant’s favour. At the hearing, Mr Sauba confirmed he had read those decisions.

25. In *Mercury* (by reference to the comments of Mr Geoffrey Vos Q.C sitting as a deputy judge of the High Court in *Music Choice Ltd’s Trade Mark* [2006] RPC 13), the AP indicated that a consideration of the factors (shown below in bold) 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;

26. The Form TM8 was due by 1 September 2020; it was received by the tribunal on 16 September 2020. Although Mr Sauba confirmed he was fully aware of the official deadline, the Form TM8 was not filed on time because: (i) he was awaiting a response to the follow-up email he sent to CSY on 17 August 2020, and (ii) the Covid related difficulties he was experiencing.

The nature of the opponent’s allegations in its statement of grounds;

27. The opponent relies upon grounds under sections 5(2)(b) and 5(3) of the Act. There is nothing to suggest that the opposition is without merit.

The consequences of treating the applicant as defending or not defending the opposition;

28. If the applicant is allowed to defend her application, the proceedings will continue to the evidence rounds. If she is not allowed to defend, the application will be treated as abandoned.

Any prejudice caused to the opponent by the delay;

29. At the hearing, Mr Clegg very fairly submitted there was no “special” prejudice beyond the delay which has already occurred and the additional costs that have resulted.

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

30. At the hearing, Mr Clegg confirmed that these are the only proceedings in which the parties are involved. Also at the hearing, Mr Sauba asked me to keep in mind the approach adopted by Companies House during the height of the pandemic. In this regard, I note that the IPO adopted a similar approach during the height of the pandemic declaring the period 24 March 2020 to 29 July 2020 as Interrupted Days. During that period statutory deadlines relating to the filing of, for example, a Form TM8 which fell within the Interrupted Days period were extended to 30 July 2020.

Considerations

31. The official letter of 1 July 2020 served the Form TM7 on the applicant and allowed her until 1 September 2020 to file a Form TM8. Although the Form TM7 was served during the Interrupted Days period, the deadline set for the Form TM8 to be filed was

not. The fact that the Interrupted Days period came to an end on 29 July 2020, is, in my view, recognition of the fact that relief from observing official time limits was no longer considered necessary. As a consequence, this is not a factor that assists the applicant. The letter of 1 July 2020 (paragraph 5 above refers) contained four different mentions of the need for the Form TM8 to be filed by the deadline set and the consequences of failing to do so i.e. “please note the important deadline below”, “you must file your notice of defence...(Form TM8) within **two months** from the date of this letter”, **“IMPORTANT DEADLINE...MUST be received on or before 1 September 2020”** and **“if the deadline is missed, then in almost all circumstances, the application will be treated as abandoned”** (original emphasis).

32. As I mentioned earlier, Mr Sauba confirmed he was fully aware of the deadline. However, despite having written to CSY at an unspecified date in July 2020 and on 17 August 2020 emailed CSY again in an attempt to resolve the dispute (to which a holding response was received by him on 18 August 2020), the deadline of 1 September 2020 “slipped his mind” for the reasons mentioned in paragraph 26 above. However, even if Mr Sauba is correct and he had difficulties contacting CSY by telephone to discuss the matter, as of 18 August 2020 when Ms Jeeves responded to him indicating that CSY were “discussing this matter with our client and will be in touch as soon as possible”, the onus remained on him to monitor the deadline and to proceed accordingly. He either had to contact CSY ahead of the deadline to, for example, ascertain if the opponent would agree to enter cooling-off, or he had to file a Form TM8 to protect the applicant’s position while he awaited the opponent’s response. In the event, he did neither, but instead waited until 16 September 2020 to contact the tribunal seeking guidance.

33. In reaching a conclusion, it is clear from the decisions mentioned above, that for me to exercise the narrow discretion provided in rule 18(2) in the applicant’s failure, there must be extenuating circumstances/compelling reasons to justify such an approach. I have no doubt that Mr Sauba’s reliance on his awaiting the opponent’s response does not, as Mr Clegg put it, meet that “high-bar”.

34. As to Mr Sauba’s reliance on the difficulties caused by the pandemic, Mr Clegg accepted that it has caused complications, but pointed to, inter alia, the

straightforward nature of the Form TM8. I too accept that the pandemic has been challenging for individuals and businesses alike. However, the sorts of issues to which Mr Sauba refers i.e. home working and family responsibilities have been experienced by many in this country during the pandemic and, in my experience, deadlines before this tribunal have, for the most part, continued to be met. While I have some sympathy with the position in which Mr Sauba found himself, without more, that does not, in my view, amount to extenuating circumstances/compelling reasons and, as such, is not sufficient to justify me exercising the very limited discretion provided in rule 18(2) in the applicant's favour.

Outcome

35. The consequence of my decision in paragraph 34 above is that subject to any successful appeal, the application will be treated as abandoned.

Costs

36. As my decision terminates the proceedings, I must also consider the matter of costs. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. At the hearing, Mr Clegg indicated that, if successful, the opponent sought an award of costs on the scale for the work associated with the hearing. As foreshadowed in the official letter of 29 September 2020, I agree such an award is appropriate. Having applied the guidance in the TPN and bearing in mind the length of the hearing (30 minutes), the complexity of the issue and the nature of the opponent's skeleton argument, I award costs to the opponent on the following basis:

Preparing the Notice of Opposition:	£300
Official fee:	£200
Preparation for and attendance at the hearing:	£200

Total:

£700

37. I order Aneta Keller-Sauba to pay Tasty Baking Company the sum of **£700**. 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 5th day of November 2020

C J BOWEN

For the Registrar

Annex

Acanthopanax tea (Ogapicha); Achar pachranga (fruit pickle); Acid drops [confectionery]; Adlay flour for food; Aerated beverages [with coffee, cocoa or chocolate base]; Aerated chocolate; Aerated drinks [with coffee, cocoa or chocolate base]; Agave syrup for use as a natural sweetener; Agave syrup [natural sweetener]; Aioli; Alimentary pasta; Alimentary paste [dough]; Alimentary seasonings; Allspice; Almond cake; Almond confectionery; Almond cookies; Almond flavorings, other than essential oils; Almond flour; Almond paste; Almond pastries; Almonds covered in chocolate; Angelica; Aniseed; Aniseeds for use as a seasoning; Aperitif biscuits; Apple cider vinegar; Apple flavoured tea [other than for medicinal use]; Apple fritters; Apple pies; Apple sauce [condiment]; Apple tarts; Aromatic preparations for cakes; Aromatic preparations for candies; Aromatic preparations for food; Aromatic preparations for ice-creams; Aromatic preparations for making non-medicated infusions; Aromatic preparations for making non-medicated tisanes; Aromatic preparations for pastries; Aromatic teas [other than for medicinal use]; Artichoke sauce; Artificial coffee; Artificial rice [uncooked]; Artificial tea; Artificial tea [other than for medicinal use]; Asian apricot tea (maesilcha); Asian noodles; Bacon buns; Bagels; Baguettes; Bakery goods; Baking powder; Baking powders; Baking soda; Baking soda [bicarbonate of soda for baking purposes]; Baking soda [bicarbonate of soda for cooking purposes]; Baking spices; Baking-powder; Baklava; Balsamic vinegar; Banana fritters; Baozi ; Baozi [stuffed buns]; Baps; Barbecue sauce; Barley (Crushed -); Barley flakes; Barley flour [for food]; Barley flour for food; Barley for use as a coffee substitute; Barley (Husked -); Barley meal; Barley prepared for human consumption; Barley tea; Barley-leaf tea; Barm cakes; Bars based on wheat; Bars of sweet jellied bean paste (Yohkan); Bases for making milk shakes [flavourings]; Basil, dried; Batter for making crepes; Batter for making pancakes; Batter mixes; Batter mixes for Japanese-style pancakes (Okonomiyaki); Batter mixes for okonomiyaki [Japanese savory pancakes]; Batter mixes for okonomiyaki [Japanese savoury pancakes]; Bavarian creams; Bean jam buns; Bean meal; Bean paste; Bean-jam filled wafers (monaka); Bean-starch noodles (harusame, uncooked); Bee glue; Beer vinegar; Beverages based on chocolate; Beverages based on coffee; Beverages based on coffee substitutes; Beverages based on tea; Beverages (Chocolate-based -); Beverages (Cocoa-based -).