

**O/1003/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NO. UK00003694874  
BY PARABOLICA LTD  
TO REGISTER:**

**TESLA**

**AS A TRADE MARK  
IN CLASSES 12, 25 AND 28**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 432487  
BY TESLA, INC.**

1. On 14 September 2021, Parabolica Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The applicant has applied to register the mark for goods in classes 12, 25 and 28 which can be seen in the **Annex** to this decision.

2. On 7 October 2022, Bird & Bird LLP filed a Form TM7 (notice of opposition and statement of grounds) on behalf of Tesla, Inc. (“the opponent”) on the basis of section 3(6) of the Trade Marks Act 1994 (“the Act”).

3. On 28 April 2022, the Registry served the Form TM7 on the applicant. The deadline for the applicant to file its Form TM8 (Notice of defence and counterstatement) was 28 June 2022, communicated by the Registry in the serving letter. The Registry’s 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/trade-mark-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 28 June 2022.**

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.**”

(original emphasis)

4. The applicant did not file a TM8 by 28 June 2022. The applicant, represented by Erich Auer in his position as director of Parabolica Ltd, contacted the Registry on 29 June 2022 and 30 June 2022. Mr Auer advised the Registry that he had been unable to meet the deadline due to illness and sought guidance from the Registry on the next steps that would be required to follow to file the applicant’s late TM8. I will discuss the detail of these conversations later in the decision.

5. Mr Auer contacted the Registry in an email dated 13 July 2022, which reads as follows:

“ regarding the deadline: 28.6.2022.

I can not reach you via phone right now.

I have a medical certificate which certifies that I was sick beyond 28.6.2022. Due to the illness, I was unable to meet the deadline.

As far as I understand this, I will be given the opportunity to bring this forward and prove it and submit the TM8 form.”

6. In an official letter dated 17 August 2022, sent to both parties, the Registry stated:

“The official letter dated **28 April 2022** invited the applicant to file a TM8 and counterstatement on or before **28 June 2022**.

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 have 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, **31 August 2022**. 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.

If no response is received the registry will proceed to deem the application abandoned.”

(original emphasis)

7. An email from Mr Auer to the Registry dated 17 August 2022 reads as follows:

“I could not reach you by phone just now.

I was ill at the deadline and will send you a doctor's confirmation.

Furthermore, I will submit my statement of opposition (counterstatement) with witness statement by 8/31/2022.

You write that I must also request a hearing.

Where should a hearing take place?

I am Austrian and live in Switzerland.”

8. On 31 August 2022, the Registry received an email from Mr Auer with the TM8, witness statement and a medical certificate in German ( translated into English). In the witness statement, Mr Auer stated that due to illness he was unable to meet the TM8 deadline and provided the medical certificate in support of this.

9. On 7 September 2022, in an official letter, sent to both parties, the Registry stated its preliminary view was that no mitigating circumstances would appear to exist that permit the Registrar to exercise his limited discretion and admit a late filed Form TM8 into these proceedings. Further, the Registry stated that if either party disagreed

with the preliminary view they may express an objection and request a hearing by 21 September 2022.

10. On 20 September 2022, an email was received from the applicant requesting a hearing. In an official letter dated 22 September 2022, sent to both parties, the hearing was listed for 11 October 2022.

## **THE JOINT HEARING**

### **Representation**

11. The joint hearing took place before me, by telephone, on 11 October 2022. Both parties attended. Mr Auer of Parabolica Ltd attended on behalf of the applicant. Mr Robert Milligan of Bird & Bird attended on behalf of the opponent.

### **Hearing discussion**

12. At the hearing, I asked the Mr Auer why the TM8 was filed late. Mr Auer submitted that the TM8 was late due to his illness, as evidenced by the medical certificate Mr Auer provided. As was his right, Mr Auer did not wish to state the nature of his illness or provide any further information, other than what was contained within his medical certificate. I asked Mr Auer how his illness impacted his ability to file his TM8. Mr Auer submitted that his illness meant he was unable to prepare the written submissions. When asked when he had recovered from his health issues, Mr Auer confirmed that his health issues were resolved at the end of June – aligning with the medical certificate that he submitted.

13. I asked Mr Auer to provide an explanation as to why, following the end of his period of illness, the Form TM8 was delayed. Mr Auer submitted that the Form TM8 was further delayed after the deadline because of guidance he received from the Registry in a telephone conversation. Mr Auer submitted that he was informed that he should wait until he received correspondence informing him of a new TM8 deadline

and provide reasons for the delay. Neither the opponent nor I were aware of this conversation.

14. I then asked Mr Auer, why the TM8 was not filed during the 3 weeks before he became ill. Mr Auer submitted that he is an EU Trade Mark Attorney, and as is common practice for many legal professionals, he usually sends his documentation to the court towards the later part of the deadline due to time pressures.

15. I asked the opponent for their submissions. The opponent submitted that rule 18 of the trade mark rules state the circumstances in which an application may be treated as abandoned. The opponent's submitted that there was a discretion on behalf of the registry that could be exercised if the extenuating circumstances were sufficient to justify the exercise of such discretion. The opponent drew my attention to the case law of *Music Choice Limited*<sup>1</sup> and *Mark James Holland v Mercury Wealth Management Ltd.*<sup>2</sup> The opponent recognised Mr Auer's right not to comment on the specifics of his illness but submitted but it was difficult without specifics to have an awareness of the level of incapacity of Mr Auer. The opponent's submitted that the fact that Mr Auer was able to call the registry which suggests that he was not entirely incapacitated. Further, the opponent submitted that the delay of two months, following Mr Auer's period of illness, in filing the TM8 was excessive. the opponent submitted that Mr Auer should have filed the TM8 as soon as he was able, which judging from the dates on his certificate, should have been 1 July. Taking all this into account, the opponent submitted that the reasoning was insufficient for the Registry to exercise its discretion to allow the late TM8. Further, the opponent's submitted that there were no extenuating circumstances present in this case. The opponent directed my attention to *Reliance Homes Limited*;<sup>3</sup> the opponent submitted that where a party to proceedings fails to father defence, the consequence will be the loss of some or all of the application and this alone is not sufficient reasoning in itself to allow the late TM8.

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<sup>1</sup> [2006] RPC 13

<sup>2</sup> O/050/12

<sup>3</sup> O/483/17

The opponent requested that the application be treated as abandoned and that an award of costs is made in the opponent's favour.

16. In reply to the opponent's submissions, Mr Auer provided additional details concerning the telephone conversations with the Registry, reiterated that his illness was the reason for the late submission and submitted that illness is the most serious reason to miss a deadline within all jurisdictions. Further, Mr Auer submitted that the applicant's asset and trade mark application was protected under the ECtHR in the case of *Anheuser-Busch Inc v Portugal*.<sup>4</sup>

17. Turning to the issue of costs, I asked both parties for their submissions in relation to costs. Both parties requested costs on the normal scale.

18. At the end of the hearing, I reserved my decision to give me an opportunity to reflect on the additional information provided by Mr Auer which was not foreshadowed in his emails and witness statement. I informed both parties that I would investigate the conversation that Mr Auer referenced. The opponent requested that if the conversation mentioned did exist, the opponent would like the opportunity to respond to these new submissions. I informed the opponent that if that was the case, the opponent would be given the opportunity to make submissions.

### **Post joint hearing**

19. In an official letter dated 12 October 2022, sent to both parties, the Registry gave the opponent until 26 October 2022 to make written submissions on the issue raised by Mr Auer at the joint hearing.

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<sup>4</sup> 73049/01 [2005] ECHR 686

20. On 14 October 2022, the opponent requested the Registry to provide a copy of the transcript or written note of the conversation mentioned by Mr Auer in the joint hearing. In a letter dated 26 October 2022, both parties were sent the following summary of the conversations that Mr Auer had with the Registry:

**“Telephone conversation dated 29 June 2022**

On 29 June 2022, the applicant telephoned to advise that he missed the deadline to file the Form TM8 by one day, due to illness. The casework examiner explained that the applicant could file a late Form TM8 along with a witness statement explaining why the deadline was missed. The applicant was informed that once filed, the documentation would be considered by the Registry and a preliminary view would be issued to advise whether the Form TM8 would be admitted into proceedings.

During this phone call, the applicant queried how to transfer the trade mark to a new owner and was advised that this could be actioned by completing a Form TM16 with a £50.00 fee. However, the applicant was informed that as the application had not been defended, it would be deemed abandoned if a late Form TM8 was not filed and admitted.

In light of this, the applicant asked whether costs would be awarded against the current owner or new owner following the filing of a Form TM16. The casework examiner explained that the Registry asks for comments from both parties before costs are awarded. Further, the casework examiner stated that it was not possible to confirm who costs would be awarded against at this time, as the new owner was not the owner at the deadline for filing the Form TM8.

At this stage in the call, the applicant began repeating themselves and expressing that they felt it was unfair as his mark was a cloned mark. The case



work examiner explained that the mark had been applied for pursuant to Article 59 of the Withdrawal Agreement.

The applicant advised that he wanted to appeal the preliminary view that the application be deemed abandoned to the Appointed Person or the High Court. The casework examiner responded that the application had not yet been deemed abandoned and could not be appealed until the Registry had issued a decision refusing the late filed Form TM8. The applicant began repeating that the process was unfair and that it was better to follow EU law, the casework examiner terminated the call after informing the applicant that they could not continue to repeat the same information.

#### **Telephone conversation dated 30 June 2022**

On 30 June 2022, the applicant telephoned the Registry and received further instructions on how to complete the Form TM16 and what information was required in each box.

The applicant asked what the deadline to file the late Form TM8 and witness statement was. The applicant was advised that the deadline had not yet been set, and that correspondence with a deadline and how to file the TM8 would be issued in due course. The applicant was also informed that on receipt of a late filed Form TM8 and witness statement, a preliminary view would be issued.

The applicant asked what he needed to write in the witness statement. The casework examiner stated that they were not able to advise what content to include in the witness statement but directed the applicant to the template and guidance on the website.”

21. The Registry extended the period for the opponent to file their written submissions until 2 November 2022.

#### Opponent's submissions

22. On 2 November 2022, the opponent provided submissions. The opponent filed attachments alongside its submissions, I note that where the attachments are deemed as evidence, I will not consider them.

23. The opponent drew the Hearing Officer's attention to Trade Mark Rules 18, 77 and 43 and the cases of *Mark James Holland v Mercury Wealth Management Ltd* and *Kickz*.<sup>5</sup>

24. The opponent submitted that the telephone conversations between Mr Auer and the Registry, referenced above in paragraph 20, did not explain the further two-month delay by Mr Auer to file the applicant's TM8. Further, the opponent submitted that the correspondence from the Registry dated 26 June 2022 and the telephone conversation between Mr Auer and the Registry on 29 June 2022 informed Mr Auer that the applicant could file the TM8 at any time. On this basis, the opponent submitted that there is no compelling reason why it took Mr Auer so long to file the TM8.

25. The opponent submitted that as a European Union Trade Mark Attorney Mr Auer should be familiar with the procedures at the Registry and understand that a missed deadline would need to be met as soon as possible. On that basis, the opponent submitted that Mr Auer should have filed the TM8 immediately after his illness. Further, the opponent submitted that Mr Auer failed to establish any extenuating circumstances. The opponent also submitted that they were prejudiced by

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<sup>5</sup> O/035/11

the failure of Mr Auer to meet the deadline and that they had incurred the costs of preparing for a hearing and attending a hearing without all of the facts. The opponent submitted that the Registry should treat the application as abandoned and grant costs to the opponent.

### Applicant's submissions

26. On 3 November 2022, Mr Auer filed submissions in reply to the opponent's submissions. I note that the submissions contain without prejudice information which was inappropriate to file. I will put this information out of my mind and not consider the information; it will form no part of my decision.

27. Mr Auer submitted that he behaved as was instructed according to the telephone conversations that he held with the Registry on 29 and 30 June 2022. Mr Auer submitted that when he called the Registry on 29 and 30 June 2022 as he had missed the TM8 deadline due to illness and if he had been informed to submit the TM8 immediately he would have done so. Mr Auer went on to submit that he had been a Trade Mark Attorney since 2006 in the EUIPO and practised before the EUIPO and not the UKIPO – his experience with trade marks reflected this. Mr Auer submitted that the practices before each national office and the EUIPO follow different procedural rules, which are all variants he cannot be expected to know.

28. In submissions Mr Auer also makes mention of the grounds of opposition, state of the register and other oppositions that are not directly linked to these current proceedings. These submissions are not relevant to the matter of discussion at the joint hearing. Mr Auer also drew the Hearing Officer's attention to the ECtHR case of *Anheuser-Busch Inc v Portugal*. Mr Auer submitted that this case explicitly mentioned that trade mark applications can be put to use by third parties in the sense of legal transactions such as a sale or licensing and it gives rise to a bundle of financial rights or interests.

## **DECISION**

## Statutory provisions

29. 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 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.”

30. 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.”

31. In reaching my decision, I recognise that if the late TM8 is not accepted, the application will be treated as abandoned and the applicant will lose the filing date for its mark. Further, I recognise that it may be that the applicant will simply re-file its application and that this may, once again, be opposed by the opponent resulting in further opposition proceedings arising at some point in the future. However, the loss of priority and possibility of further proceedings on much the same basis are often the consequences of a failure to comply with the non-extendable deadline to file Form TM8s. In my view, to regard the mere prospect of another application as a strong consideration would significantly undermine the prescriptive nature of the timeframes under the rules for filing a Form TM8. Further, whilst repeated proceedings, which I accept may be likely in this case, are, in my view, regrettable on the account of wasted cost and efforts of the parties, not to mention the further strain on the Registry’s resources, I must consider the specific circumstances at hand.

32. Mr Auer has submitted that the applicant’s TM8 was initially late due to illness. This submission is supported by the medical certificate Mr Auer provided. In relation

to the further delay in filing the TM8, Mr Auer submits that this was due to guidance that he received from the Registry in telephone conversations dated 29 and 30 June 2022. There has been no default or omission by the Registry, however, there has been a suggestion that there has been an error on the part of the Registry. In consideration of the submissions and the conversations between the applicant and the Registry, it is clear that there was an error made on behalf of the Registry. Whilst Mr Auer was informed in correspondence dated 26 June 2022 and via a telephone conversation on the 29 June 2022 of the correct procedure he was required to apply following missing his TM8 deadline, I note the conversation held with the Registry on 30 June 2022. In the telephone conversation, Mr Auer was informed of the incorrect procedure to follow in filing his late TM8. In the conversation, Mr Auer asked what the deadline to file the late Form TM8 and witness statement was. Mr Auer was advised that the deadline had not yet been set and that correspondence with a deadline and how to file the TM8 would be issued in due course.

33. It is my view that Mr Auer upon receiving this information from the Registry waited until correspondence was sent to him with a new deadline. I note that following the provision of the new deadline, the applicant filed its TM8 and witness statement within the deadline provided. I note that Mr Auer submitted that this is the first time that he has engaged with the UKIPO and I understand that the defence of a Trade Mark opposition in another jurisdiction, especially in another language, might be somewhat confusing to Mr Auer. Despite this, regardless of Mr Auer's expertise, there was an expectation that he would make himself aware of the procedures.

34. Taking all of the above into account, I consider that the reason for failing to file the TM8 was due to an error made by the Registry, which it appears should be rectified. Therefore, based on rule 77(5) the late filed TM8 will be admitted into proceedings. Consequently, as the TM8 is admitted under rule 77(5) there is no need to discuss the discretion to admit late TM8's under rule 18(2).

## **OUTCOME**

35. After careful consideration of the parties' oral and written submissions and in light of the trade mark rules, my decision is to allow the late filed TM8 and counterstatement to be admitted into proceedings under rule 77(5) on the basis of the error/irregularity caused by the Registry. Providing no anomalies are identified, it will then be formally served upon the opponent and a timetable will be set for filing evidence.

## **COSTS**

36. As I have admitted the applicant's defence into the proceedings, and the opposition is allowed to continue, costs will be considered at the final determination of the case.

**Date this 15<sup>th</sup> day of November 2022**

**A Klass**

**For the Registrar**

## **ANNEX**

**Class 12:** *Passenger vehicles included in class 12; Electric motorcycles, included in class 12; Electrically powered mopeds, included in class 12; Electrically operated motorcycles, included in class 12; Electrically operated bicycles, included in class 12; Electrically operated tractors, included in class 12, electrically operated motor homes and caravans, included in class 12; Aircraft, included in class 12, namely motorised and non-motorised lighter-than-air electrically operated aircraft and motorised and non-motorised heavier-than-air electrically operated aircraft; Electrically powered space vehicles, included in class 12; Electrically operated rail vehicles, included in class 12; Electrically powered tracked vehicles, included in class 12; Electrically powered water vehicles, included in class 12, namely underwater vehicles and electrically powered underwater vehicles; Electrically powered amphibious vehicles, included in class 12; Electrically operated wheelchairs; electrically powered mobility scooters; Electric golf buggies; Electric prams; Vehicle parts, included in class 12, namely bodywork components; Drives; Motors; Chassis components, in particular brake parts; Springs; Steamers; Steering; Wheel suspensions; Wheels; Tyres; Hub caps; Wheel trims; Axle suspensions; Transmission components, in particular couplings, gearboxes, chains, transfer cases, cardan shafts, differential gears; Accessories for vehicles, included in class 12, Namely trailer hitches, Bicycle carriers, Roof racks, Travel baggage Of the following materials, Leathers, Aluminum, Titanium, Fabrics made from natural fibres, Namely cotton, Jute, Flax, Viscose, restraints and Fine animal hairs (wool), synthetic fibre industry and Plastics, For transport in electric vehicles, Child's seats, Tarpaulins, namely The aforesaid relating to the following vehicles, electric land vehicles, Electrically operated air vehicles, Electric amphibious vehicles and Electrically powered water vehicles; Snow chains, namely the aforesaid for cars, two-wheeled vehicles, buses, utility vehicles, forestry machines, military vehicles, 4x4 and SUV vehicles, tractors, electrically operated special-purpose vehicles.*

**Class 25:** *Clothing, footwear, headgear.*



**Class 28:** *Clothing, footwear, headgear.*