

O-657-22

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. UK00003651295**

**BY SIM'S FOODS LIMITED
TO REGISTER**

NISH

**AS A TRADE MARK
IN CLASSES 25 AND 29
AND OPPOSITION THERETO**

**UNDER NO. OP000428277
BY COCOFINA LIMITED**

BACKGROUND AND PLEADINGS

1. On 4 June 2021, SIM'S FOODS LIMITED (“the applicant”) applied to register the trade mark shown on the cover page of this decision.
2. The application was published for opposition purposes on 24 September 2021 for the following goods:

Class 25 Clothing.

Class 29 Chilled and Frozen Vegan Seafood products.

3. On 17 November 2021, Cocofina Limited (“the opponent”) opposed the application in respect of the Class 29 goods based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) by way of filing a Notice of opposition and statement of grounds (“Form TM7”). The Form TM7 was amended on 29 November 2021 to show the correct address information.
4. On 26 January 2022, the Registry served the Form TM7 on the applicant by email, allowing the applicant until 28 March 2022 to file a Notice of defence and counterstatement (“Form TM8”) or request a cooling off period using Form TM9C. The serving letter contained the following paragraphs:

“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 March 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.**”

5. As no TM8 was filed within the time period set, the Tribunal wrote to the applicant on 8 May 2022. The letter contained the following paragraphs:

“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, **23 May 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.”

6. The applicant’s late-filed Form TM8 was received on 17 May 2022, at which point the applicant was given a further fourteen days to submit its

witness statement. The witness statement, from Santokh Sandhu, the applicant's Managing Director, was received on 6 June 2022. The relevant parts of Mr Sandhu's statement are reproduced below:

"2. I can confirm that no postal correspondence was received in reference to the communication of 26 January 2022. I have however located the e-mail that was sent on 26 January 2022 but this was unfortunately overlooked by mistake at the time because I was unwell and isolating due to Covid-19 at the time and was away from work for about 3 weeks due to weakness from the effect of Covid. I wish to apologise sincerely for this oversight."

7. Having considered the explanation, in an official letter dated 15 June 2022, the Tribunal issued a preliminary view in which it (i) refused to exercise its discretion in favour of the applicant and (ii) allowed until 29 June 2022 for a hearing to be requested. On 28 June 2022, the applicant requested a hearing.

THE HEARING

8. A hearing took place before me, via Microsoft Teams as an audio call, on 21 July 2022. Mr Sandhu attended the hearing. As a litigant in person, the applicant was not required to submit skeleton arguments, nor did it do so. The opponent, also a litigant in person, did not attend the hearing, having previously made brief comments on the matter at hand by email.

9. Mr Sandhu stated that he usually deals with the company emails, but he had COVID for a period of three weeks up until mid-February. In his absence, Mr Sandhu's emails were dealt with by "my colleague June".

10. I asked Mr Sandhu why the email was not dealt with given that he had appointed someone to respond to emails and that person would have had a

responsibility to notify him of any emails that needed to be responded to by a particular date.

11. Mr Sandhu usually gets over one hundred emails a day and is “signed up” to numerous emails from the IPO, including those for webinars and news. June only dealt with urgent emails relating to the operational side of the business – orders and clients. She “left the others aside”. Mr Sandhu also said that he did not make June aware of the fact that he was going through the trade mark application process as it was something he was looking into himself. Mr Sandhu made a further point, that he was accustomed to receiving any letter from the IPO in two forms – by email and through the post.

12. I also asked why the email was not actioned once Mr Sandhu was back in the office between mid-February and the deadline of 28 March. He said that it continued to be overlooked as he had been ill when the email came in. Furthermore (notwithstanding the fact that he was aware that he was going through the trade mark application procedure and had discussed his application with the opponent), the fact that a copy of the letter serving the Form TM7 by email had not also been sent through the post was a contributory factor. Had he been notified by hard copy, he would have responded.

13. Mr Sandhu pointed out that it was not in his interests to fail to file a Form TM8 and he dealt with the matter when he received the IPO’s letter of 8 May. At that point, Mr Sandhu searched his inbox and was able to find the email from the IPO dated 26 January.

DECISION

14. The filing of a Form TM8 in opposition proceedings is governed by rule 18 of the Trade Mark 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 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.”

15. The combined effect of Rules 77(1), 77(5) and Schedule 1 of the Rules means 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.”

16. It is apparent that the applicant expected any document from the IPO to be sent through the post as well as by email. He believes this expectation led to the email being overlooked. However, the Form TM7 was legitimately served by email on 26 January. Mr Sandhu has confirmed that the email in question was received having located it in his inbox following the Tribunal’s letter of 8 May. It is incumbent upon applicants to have arrangements in place whereby emails sent to the email address that the IPO has on file are regularly checked. As such, there is no error on the part of the Registrar in this case.

17. Sitting as the Appointed Person in *Kickz AG and Wicked Vision Limited* (BL-O-035-11) (“*Kickz*”) Mr Geoffrey Hobbs QC held that the discretion conferred by Rule 18(2) can be exercised only if there are “extenuating circumstances”. And sitting as the Appointed Person in *Mark James Holland and Mercury Wealth Management Limited* (BL-O-050-12) (“*Mercury*”) Ms Amanda Michaels QC held that there must be “compelling reasons” to justify the Registrar exercising that discretion. In considering relevant factors, Ms Michaels referred to the criteria established in *Music Choice Ltd’s Trade Mark* [2006] R.P.C. 13 (“*Music Choice*”), which provides guidance applicable by analogy when exercising the discretion under rule 18(2). The factors are as follows:

The circumstances relating to the missing of the deadline including reasons why it was missed and the extent to which it was missed

18. The deadline for filing the Form TM8 was 28 March 2022. Mr Sandhu says that, at the time the email serving the Form TM7 was received (26 January 2022), he was ill with Covid for approximately three weeks. The person appointed to check his emails in his absence, “June”, only dealt with urgent matters relating to orders and clients and was not aware that Mr Sandhu was involved in a trade mark dispute.

19. By the middle of February Mr Sandhu was back at work and attending to emails, which means that there were several weeks available to him before the deadline of 28 March. However, Mr Sandhu said that the email continued to be overlooked as he had been ill when the email came in and the absence of a copy of the letter sent through the post was a contributory factor.

20. No action was taken by the applicant until receipt of the Tribunal’s letter of 8 May which prompted the late filing of the Form TM8 on 17 May 2022.

The nature of the applicant's allegations in its statement of grounds

21. The opposition is brought under section 5(2)(b) of the Act. There is nothing to suggest that the opposition is without merit.

Consequences of treating the proprietor as opposing or not opposing the application

22. If the applicant is allowed to defend the opposition, the proceedings will continue, and the matter will be determined on its merits. If, however, the applicant is not allowed to defend the opposition, its application will be deemed abandoned in respect of those goods against which this opposition is directed and the applicant will lose its filing date of 4 June 2021 for those goods. The application will, of course, proceed to registration for those goods that are unopposed. It will also remain open to the applicant to re-file its application for the opposed goods which may, in turn, be opposed again.

Any prejudice caused to the opponent by the delay

23. The opponent has not identified any prejudice caused to itself other than costs. The applicant has made no comment on this subject.

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

24. There are no other relevant considerations.
25. Having addressed each of the relevant factors as proposed in *Music Choice*, I must now decide whether the applicant's witness statement and subsequent comments at the hearing reveal extenuating circumstances or compelling reasons that would enable me to exercise the discretion to admit the late-filed Form TM8.

26. After carefully considering the expected detriment to the applicant in the event the discretion is not exercised in its favour, I find that the loss of a filing date and the possibility of further proceedings on much the same basis is often the consequence of a failure to comply with the non-extensible deadline for filing a Form TM8. These factors are not, therefore, particularly compelling.

27. While it is true that Mr Sandhu was ill for three weeks at the point when the letter serving the Form TM7 was received by email (26 January), he appointed somebody to check his emails in his absence. It was incumbent upon Mr Sandhu that proper arrangements were put in place to deal appropriately with important matters. A letter serving a Form TM7 falls into that category and the required deadline and the consequences of missing the deadline were set out in bold in the letter concerned.

28. Even allowing for the letter not having been dealt with in his absence, Mr Sandhu was back at work from mid-February until the deadline of 28 March. Aware that he was in the process of a trade mark application, he had ample time to go back through his emails, find the letter and deal with it.

29. Having considered all of the applicant's reasons for its failure to file a TM8 by the deadline set, I find no single reason or combination of reasons sufficient to enable me to exercise my discretion to admit the late-filed TM8 into these proceedings.

CONCLUSION

30. The late-filed Form TM8 is not to be admitted into the proceedings. Subject to appeal, the application is treated as abandoned in relation to the Class 29 goods and may proceed to registration for the Class 25 goods that were not opposed.

COSTS

31. As my decision terminates the proceedings, I must consider the matter of costs.

32. Having been sent a copy of the Tribunal's letter of 8 May regarding the non-receipt of the applicant's Form TM8, the opponent requested an award of costs. It said:

"We had given ample opportunity to discuss the application and spoken to them personally too. Please could [you] award costs as its costing us money to defend the mark on an ongoing basis.

In addition to the standard costs of £200 please could I also request £350 in addition for fees from IP Lab in connection with the application."

33. While I am prepared to award the opponent costs in line with Tribunal Practice Notice 2/2016, awards of costs in these proceedings must be approached on a contributory and not a compensatory basis. I do not agree to the request above for that reason and I award costs as follows:

Preparing a statement:	£200
Official fee:	£100
Total:	£300

34. I order SIM'S FOODS LIMITED to pay Cocofina Limited the sum of £300 as a contribution towards its costs. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 4th day of August 2022

John Williams
For the Registrar