

O-893-22

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION No. 918288949

**REGISTERED IN THE NAME OF
FRENCH ARABIAN PERFUMES LIMITED**

AND

**THE LATE FILING OF A FORM TM8
IN DEFENCE IN INVALIDITY PROCEEDINGS (No. CA504690)**

**BROUGHT BY
MY PERFUME FACTORY LLC**

Background

1. FRENCH ARABIAN PERFUMES LIMITED (“**FAP**”) is the proprietor of the following UK comparable trade mark (“**the 949 registration**”):



*My*PERFUMES

Trade Mark Registration No: 918288949

Filing date: 13 August 2020

Registration date: 5 December 2020


Registered in Class 3: *Perfumes; Solid perfumes; Liquid perfumes; Perfumes for ceramics; Extracts of perfumes; Perfumes in solid form; Natural oils for perfumes; Perfumes for industrial purposes; Oils for perfumes and scents*

2. In cancellation proceedings No. CA 504690, My Perfume Factory LLC (“**MPF**”) has applied for a declaration of invalidity against the 949 registration.¹
3. The grounds of objection under the Trade Marks Act 1994 (“**the Act**”) are set out in the Form TM26(I) to include:
 - (i) section 5(4)(a) (based on passing off);
 - (ii) section 5(4)(b) (based on a copyright claim);
 - (iii) section 3(6) (bad faith);
 - (iv) section 5(6) (applied in name agent or representative without consent);
 - (v) Initially, the statement of grounds also included a claim under section 3(3)(b) – where it was claimed that the mark was deceptive.

¹ It is noted that MPF has brought a related invalidity action under No. CA504689 against FAP’s UKTM 3391034 (“**the 034**



MY PERFUMES

registration”), which is for the following mark  again in respect of various perfumes, oils and sprays goods in Class 3, and additionally for air freshener goods in Class 5.

4. The Form TM26(I) was received by the registry on 17 March 2022. On 8 April 2022, the registry wrote to MPF, seeking clarification of the goods for which the earlier right was claimed to have been used under the section 5(4)(a) ground. MPF responded the same day by filing a clarifying continuation sheet.
5. On 20 April 2022, the registry wrote to FAP, serving the Form 26(I), setting a deadline of 20 June 2022 for FAP to file a Form TM8 notice of defence and counterstatement. The letter stated that “in accordance with rule 41(6), failure to file a Form TM8 and counterstatement within this period (a period which cannot be extended) the registration of the mark shall, unless the registrar otherwise directs, be declared invalid in whole.”
6. On 11 May 2022, Professor Mark Engelman, acting on behalf of FAP, sent a six-page letter to the registry, claiming that the Form TM26(I) remained deficient in various ways and seeking strike-out of the Form TM26(I) in its entirety. Some of the points raised by Professor Engelman were simply wrong, particularly his contention that a claim under section 5(6) does not provide a basis for invalidity. Other points were very minor, such as a potential objection to the reference to “goods and services” in the tick-box pleading under Section C, Q3 of the Form TM26(I), since the 949 registration covers only goods. Another objection was made with regard to Section C, Q1 of the form, where the claimed first use of the earlier right in the UK was described as having been “nationally” - rather than “throughout the UK”. Professor Engelman objected that there are distinct legal and definitional differences between the 2 phrases.
7. Professor Engelman’s letter also raised a matter of illegality – *ex turpi causa non oritur actio* – where he claimed that MPF has routinely supplied FAP with perfumes manufactured by MPF that carried third-party registered trade marks. He argued that such use of third-party trade marks constitutes both an offence under section 92 of the Act and gives rise to civil law liability, and that a party that flouts trade mark law in such a manner is precluded from enjoying the protective jurisdiction of the United Kingdom Intellectual Property Office.²

2 He referred to the judgment of Laddie J. in *Inter Lotto (UK) Ltd v Camelot Group Plc* [2003] EWHC1256 which cited the dicta of Lord Kingsdown in *Leather Cloth Co. Ltd v American Leather Cloth Co. Ltd* (1865) 11 E.R 1435 (H.L.)

8. Professor Engelman's letter also highlighted that MPF's pleaded case in support of its section 3(3)(b) ground was that deceptiveness arose from the sale of goods said by MPF to be no longer quality controlled by it. He contended that that argument does not support a valid section 3(3)(b) claim, and referred to Kerly 13th Edition at [7-165], which states: "There are two features of the provision to note. First, it is an absolute ground and not a relative ground for refusal. It is concerned with deceptiveness which is inherent in the mark itself as opposed to deception caused by similarity of the mark to another". He requested that the relevant pages of the TM26(I) and Statement of Grounds therefore be struck out for that reason.
9. On 7 June 2022, the registry wrote to the parties to say that on review of the proceedings in light of FAP's correspondence of 11 May 2022, further points were to be actioned in relation to the Form TM26(I), as follows:
 - (i) Section 5(4)(a) claim – to remove the term 'Nationally' and to indicate if use were claimed 'throughout the UK';
 - (ii) Section 3(3)(b) claim – The registry gave its preliminary view to strike out this ground because it appeared misconceived since MPF gave no reason as to how the Contested registration is inherently deceptive. MPF was invited, if it disagreed with that preliminary view, to file written reasons and to request a hearing by 21 June 2022;
 - (iii) Section 5(6) claim – to clarify the claimed relationship between the parties as to whether FAP was acting as an Agent or Representative of MPF "by filing the applications for UKTM nos. 3391034 and EUTM 18288949";
 - (iv) Section 5(4)(b) – to provide further details around the copyright claim, and noting that the statement of grounds referred to "section 5(4)(c)".
10. The registry's 7 June 2022 letter gave MPF a period of 21 days – until 28 June 2022 - to file an amended Form TM26(I) addressing the above points.
11. On 8 June 2022, the attorneys for MPF replied in objection, because the Form 26(I) had been accepted and served on 20 April 2022, with a deadline set for 20 June 2022 for FAP to file a Form TM8 and counterstatement. However, on 12 June 2022, MPF's attorneys then wrote to the registry, with copy to Professor Engelman, expressing the following:
 - (i) withdrawal of MPF's section 3(3)(b) ground;

- (ii) agreeing to address the other matters raised by filing amended Forms TM26(I), with amended continuation sheets, by 28 June 2022;
- (iii) proposing that “the deadline for the Forms TM8 be appropriately extended, without the need for a hearing.”

12. On 14 June 2022, the registry replied in the following terms:

- (i) Noting the withdrawal of the section 3(3)(b) claim and that MPF would file an amended TM26(I) by 28 June 2022;
- (ii) That “*in accordance with Rule 41(6) of the Trade Mark Rules 2008, the Form TM8 and Counterstatement should be submitted by the deadline of 20 June 2022, the set date being a non-extendable deadline for the filing of the defence. As the filing of the amended TM26(I) has a deadline subsequent to the deadline of the TM8, if the Proprietor feels that it is not in a position to either accept or deny the grounds on which the application for invalidation is based, this should be indicated as such in the TM8 and Counterstatement. Following receipt of the Proprietor’s TM8 and counterstatement, and the Cancellation Applicant’s amended TM26(I), the Proprietor will be afforded the opportunity to file an amended TM8.*”

13. On 22 June 2022, MPF’s attorneys wrote to the registry, with copy to Professor Engelman, noting that while a Form TM8 had been filed (on 15 June 2022) in respect of CA504689 against the 034 registration, no Form TM8 had been filed in respect of the 949 registration, where the deadline had in each case been the same – 20 June 2022. Since the registry’s letter of 14 June 2022 had confirmed that the deadline of 20 June 2022 was non-extendable, MPF understood invalidity action CA504690 to be undefended and that the 949 registration should be immediately cancelled.

14. The following day, 23 June 2022, FAP filed a Form TM8 and counterstatement in defence of the 949 registration.

15. On 24 June 2022, Professor Engelman sent a letter to the registry requesting a retrospective extension of time for FAP to file its Form TM8 in defence of the 949 registration.³ The registry responded on 18 July 2022, acknowledging that the related proceedings of CA000504689 and CA000504690 had been fraught with challenges. (This

³ (A Form TM9R with fee, requesting the same, was filed on 25 June 2022.)

comment likely had in mind not only the series of amendments to be made to the Forms TM26(I), but also the previously commenced rectification proceedings which appeared based on challenges to the validity of the registrations and as such were properly to be pursued by way of cancellation proceedings.) The registry letter stated that it appeared clear throughout that the intention on the part of the proprietor had been to defend both sets of proceedings. It gave the preliminary view that the late filed TM8 for CA000504690 be accepted into proceedings.

Representation and the hearing

16. MPF disagreed with that preliminary view and requested a hearing on that point, which forms the subject of this decision. Following a rescheduling request by MPF, the hearing took place by telephone conference on 21 September 2022. Dr Heather Lawrence of counsel attended on behalf of MPF; Professor Mark Engelman of counsel attended for FAP. (The hearing also dealt with various other case management issues; directions on those issues will be communicated to the parties by separate correspondence.)

Applicable law

17. The Trade Mark Rules 2008, (“**the Rules**”), by rule 41(6) provide:
- “(6) The proprietor shall, within two months of the date on which a copy of Form TM26(I) 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.”
18. 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—
- (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.”

19. It is clear therefore that the relevant time period can be extended if the reasons trigger both arms (a) and (b) of rule 77(5). Professor Engelman submitted that with regard to arm (a), FAP's failure to file its TM8 in relation to its '949 mark was attributable to a delay caused, in part, by the Office, which failed to resolve the various procedural issues arising in connection with MPF's TM26(I)s and statement of grounds before they were served in a correct form capable of a response by way of TM8 and that addressing the deficiencies in the TM26(I)s had taken up a large part of the two months allotted to FAP. His submissions included the following:

"Taken to its logical conclusion if an applicant drafts a wholly defective TM26I and refuses to amend it properly (much in the same way as MPF has done) then a respondent is forced to seek amendment which an applicant can ignore/delaying filing until a respondent has no time to draft a TM8. Put simply, the benefit of the entire 2-month period is not conferred on the Respondent.

...

FAP also had a legitimate expectation it would be provided "two months' from the date the amended Forms TM26I had been sent by MPF. r.41(6) TMR provides that 2-month period would commence next following FAP's receipt of MPF's amended TM26Is, amendments directed by letter of the Office of 07.06.22 and which had been belatedly accepted by MPF on 12.06.22. Had that latter date been applied by the Office it would have afforded FAP until 12.08.22 to file its TM8s.

...

FAP was further disadvantaged because MPF had not at the time been provided a copy of the amended TM26Is but had to merely conceptualise the proposed amendments from MPF's letter of 12.06.22. "A party wishing to amend its pleading should have provided a draft first (as FAP is now required by the Office with respect to its proposed amendments to its TM7). "When seeking leave to amend full details of the amendment together with the reasons for the amendment should be submitted".

20. I consider these to be fair and reasonable points. While it is appreciated that the registry likely had in mind the prima facie non-extendable nature of the deadline, and the desirability of moving matters forward, I find that the more correct approach would have been to have deemed the original service of the TM26(I) a nullity and to have afforded

FAP the full benefit of up to two months to file its counterstatement in light of the amendments to the file form and pleadings in MPF's statement of grounds. I consider this an irregularity that should be rectified.

21. There is consequently no need to have recourse to the discretion inherent in the words "unless the registrar otherwise directs" in rule 41(6). Nonetheless, I note that case law based on Appointed Person decisions in *Kickz AG v Wicked Vision Limited* (BL O-03511) and *Mark James Holland v Mercury Wealth Management Limited* (BL O-050-12) explains that the Office would have to be satisfied that there are extenuating circumstances or compelling reasons which justify the exercise of the discretion in favour of a proprietor.⁴ In that regard, Professor Engelman additionally submitted that FAP should be permitted to defend its '949 trade mark registration because of extenuating factors.
22. I note that the Form TM26(I) filed by MPF in the related proceedings CA504689 included references both to FAP's 949 registration as well as to its 034 registration. The grounds raised in CA504690 overlap with the grounds raised in CA504689, where a Form TM8 was filed on time. That Form TM8 included express reference in defence of the 949 registration. Furthermore, the contested registrations 034 and 949 are very closely aligned to one another both in their sign and registered goods, and the attacks on them are so comparably based, that it will have been reasonably obvious that FAP resisted both the invalidity attacks.
23. Moreover, FAP relies on both its 034 and 949 registrations as earlier marks in related opposition proceedings commenced by FAP against MPF's applications to register the following trade marks:

TM application No: 3800096
Filed on 17 June 2022 for perfume goods in Class 3



⁴ Relevant criteria are set out in *Music Choice Ltd's Trade Mark* [2006] R.P.C. 13 ('*Music Choice*')

(Opposition No. 435186, commenced on 22 July 2022)

and

TM application No.: 38009100

Filed on 17 June 2022 for perfume goods in Class 3



*My*PERFUMES

(Opposition No. 435262, commenced on 27 July 2022)

24. Determination of those oppositions (once the TM7 have been served and TM8s received) should be permitted on the basis of FAP's best case, to the extent that FAP may legitimately own its earlier registrations (034 and 949).
25. Other relevant factors include:
- that FAP had previously supported an extension to the deadline;
 - that the Form TM8 was filed only 3 days late;
 - there is no real prejudice is caused to MPF, since the 034 registration is defended and disposal of '034 & '949 together will not burden the Office nor MPF.
26. Taken together the various factors above may well have been enough to warrant the exercise of the limited discretion not to treat the cancellation application as unopposed, despite a failure to meet the deadline under the Rules for filing the Form TM8. However, as I have stated, the basis for my decision is the irregularity that may considered attributable in part, to a default, omission or other error by the Office. Nonetheless those additional factors reinforce my conclusion that the irregularity should be rectified, in line with the provision of rule 77(5)(b).
27. The relevant next steps in this and its related cases will be addressed by a separate letter dealing with the other matters discussed at the CMC.

Costs

28. No costs arise in respect of this hearing.

Dated this 17th day of October 2022

Matthew Williams

For the registrar
