

**O/988/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003724829 IN THE NAMES OF  
NANCY AMOUDI AND MCKICKZ LIMITED FOR THE FOLLOWING TRADE  
MARK:**



**IN CLASSES 18, 25 AND 35**

**AND**

**THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT  
IN DEFENCE OF AN OPPOSITION  
UNDER NO. 431697 BY KICKZ.com GmbH**

## BACKGROUND

1. On 24 November 2021, Nancy Amoudi and McKickz Limited ('the Applicants') applied for the trade mark shown on the front page of this decision (no. 3724829) in the UK. Registration is sought for the following goods and services:

Class 18	<i>Leather and imitations of leather; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; bags, purses and wallets, cases, luggage, pouches; attaché cases; backpacks; garment bags; shopping bags; bands of leather; shoulder belts; belts; canes; card cases [notecases]; collars for animals or pets; key cases; laces made of leather or imitations of leather; vanity cases; muzzles; school satchels; straps; suitcase handles; suitcases; travelling sets; travelling trunks; umbrella covers; umbrella handles; walking stick seats; luggage belts; beach bags; briefcases; boxes and cases, of leather or leatherboard; handbags; leather straps; mountaineering sticks; music cases; net bags for shopping; rucksacks; school bags; tool bags of leather or imitations of leather [empty]; valises; game bags; bags, envelopes and pouches of leather for packaging; furniture coverings of leather or imitations of leather; handbag frames; sling bags for carrying infants; wheeled shopping bags; card holders and cases; cardboard trunks and cases; key cases/carriers of precious metal; all included in class 18.</i>
Class 25	<i>Articles of clothing, footwear, headgear; aprons; beach clothes; swimwear, swimsuits; sportswear; waterproof clothing; gloves; mittens; belts; clothing for children, men and women; babies clothing; babies' napkins of textiles; bibs, not of paper; underclothing; sleep wear and pajamas; bath robes; suspenders; hats, caps, sun visors, berets; bathing and shower caps; muffs; ear muffs; neckwear, neck ties, cravats, bow, bow ties; socks and stockings, panty hoses; garter belts, socks, stocking and panty</i>

	<p><i>hose suspenders; shoes, sports shoes, slippers, beach shoes; masquerade costumes; working sleeves; kerchiefs; bandanas [neckerchiefs]; bath sandals; bath slippers; ski boots; boots; braces for clothing [suspenders]; brassieres; breeches [for wear]; camisoles; coats; cuffs; fur stoles; headbands [clothing]; headgear for wear; jackets [clothing]; jerseys [clothing]; jumpers [shirt fronts]; knitwear [clothing]; outerclothing; overcoats; pants; parkas; pullovers; sandals; scarves; shawls; shirts; slips [undergarments]; smocks; spats; boots for sports; sports jerseys; suits; bathing suits; tee-shirts; trousers; underwear; uniforms; vests; wet suits for water skiing; wristbands [clothing]; lingerie; gymnastics shoes; bodices [lingerie]; clothing for gymnastics; sashes for wear; all included class 25.</i></p>
Class 35	<p><i>Advertising; business management; business administration; the bringing together for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase clothing by internet, mail order or by means of telecommunications; consultancy, advisory and information services relating to the aforesaid services; but not including retail store services.</i></p>

2. On 9 March 2022, KICKZ.com GmbH (“the Opponent) opposed the Application by way of filing a notice of opposition and statement of case (“Form TM7”). The Opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (‘the Act’) and is directed against all of the Applicants’ goods and services.
  
3. On 22 March 2022, the Tribunal served the Form TM7 on the Applicants by post and email at the addresses (both physical and email) provided by them. That 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 23 May 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.**”

4. No Form TM8 was filed by the Applicants on or before 23 May 2022. On 5 July 2022, the Tribunal wrote to the Applicants, by post and by email, as follows:

“The official letter dated **22 March 2022** invited the applicant to file a TM8 and counterstatement on or before **23 May 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 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, **19 July 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.”

5. Neither a Form TM8 nor a Witness Statement setting out the reasons for late filing was filed by the Applicants on or before 19 July 2022. On 27 July 2022, the Applicant<sup>1</sup> wrote to the Tribunal by email in the following terms:

“Can I request additional time for a hearing please on the matter of OP0000431697 – McKickz. ? [sic]

Unfortunately the previous letters were sent to our previous registered address (returned to sender) and the redirected emails were redirected to our spam folder.

The reason why it was brought to our attention was due to the fact that another applicant had received an opposition from the same company and that prompted him to contact us. [sic] Which then led us do [sic] a general search on the matter – which showed us the emails from our spam folder.”

6. On 25 August 2022, the Tribunal wrote to the Applicants, by post and by email, in the following terms:

“Thank you for your letter dated 27 July 2022 in which you requested additional time to respond to the official letter dated 5 July 2022.

In the circumstances and in view of the length of time that has already elapsed the Registry is prepared to allow you a short extension of time until **8 September 2022** for you to file a witness statement setting out the reasons as to why the TM8 and counterstatement are being filed outside of the prescribed period and request the appointment of a hearing.

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<sup>1</sup> The email was received from the address ‘mckickz007@gmail.com’ and was signed off ‘McKickz Management’. The author of the email did not divulge their name.

Guidance on how to file a witness statement can be found here: <https://www.gov.uk/government/publications/filing-evidence-about-an-application-or-in-tribunal-proceedings>

However, please note, you are required to provide reasons why the form TM8 and counter statement were not filed within the period allowed under Rule 18(2) of the Trade Marks Rules 2008.

Please note, if you do not file a witness statement or request the appointment of a hearing the registry will proceed to deem the application abandoned.”

7. On 8 September 2022, the Applicant<sup>2</sup> wrote to the Tribunal by email in the following terms:

“Apologies for the delay in response, I’m currently in South East Asia.

Please find the details [sic] below:

[...]

I’ve been unable to locate the witness statement form so I have attached my reasons as to why the TM8 and counterstatement are being filed outside of the prescribed period and I would like to request a hearing please.

Reasons:

Unfortunately the previous letters were sent to our previous registered address (returned to sender) and the redirected emails were redirected to our spam folder.

The reason why it was brought to our attention was due to the fact that another applicant had received an opposition from the same company and that prompted him to contact us. Which then led to us do [sic] a general search on the matter – which showed us the emails from our spam folder.”

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<sup>2</sup> The email was received from the address ‘mckickz007@gmail.com’ and was signed off ‘McKicz Management’. The author of the email did not divulge their name.

8. On 16 September 2022, the Tribunal wrote to the Applicants, by post and by email, in the following terms:

“I refer to your email dated 5 September 2022 providing your reasons for the non-filing of the form TM8.

The official letter dated 5 July 2022 stated that if you disagreed with the preliminary view, you must file a Witness Statement, setting out the reasons as to why the TM8 and counterstatement were being filed outside of the prescribed period.

I note you have requested a hearing, however, before we are able to examine and comment on the provided reasons, the reasons must be submitted within an official witness statement. The registry also requires a form TM8 to be filed.

Please see below link for guidance on filing a witness statement.

<https://www.gov.uk/government/publications/filing-evidence-about-an-application-or-in-tribunal-proceedings>.

A **final** period of 7 days is given from the date of this letter, that is on or before **23 September 2022**, in which to file a **TM8 and witness statement** outlining the reasons why no TM8 was filed within the prescribed period.

The Registry will then issue a preliminary view as to whether it should invoke the discretion contained within Rule 18(2) and to accept the Form TM8 into the proceedings.

If no response is received the Registrar will proceed to deem the application abandoned in accordance with Rule 18(2) which states that the application: “.....shall, unless the registrar otherwise directs, be treated as abandoned.”

9. Neither a Form TM8 nor a Witness Statement setting out the reasons for late filing was filed by the Applicants on or before 23 September 2022. On 4 October 2022, the Applicant<sup>3</sup> wrote to the Tribunal by email in the following terms:

Firstly I'd like to begin by stating that we paid a fee upfront to trademark a slogan on an already existing trademarked brand name - unaware of how this process works once an opposition is filed. On that note I would like to inform you that I have been in the other part of the world in South East Asia for the past 2 weeks (returned 02/10) and this email is used only for non emergency communications between our company and outside companies hence the monitoring of it is quite limited whilst I'm away from my usual working desk. I note from your previous correspondence that you have given us 7 days from the dated letter up until the 23 September for someone to respond to your email. Unfortunately once again that is the root of the problem we have been experiencing with yourselves and the problem is that you send an email with a time limit - NOT a recorded delivery with tracking or anything of that nature that ensures that urgent correspondence with a time limit is dealt with accordingly.

I have read back the emails sent to us - bear in mind at the time we were unaware of the emails we received, Unfortunately the previous letters were being sent to our previous registered address (returned to sender) and the redirected emails were redirected to our spam folder. The reason why it was brought to our attention was due to the fact that another 3rd party applicant had received an opposition from the same company Kickz GMBH and that prompted him to contact us. It had become apparent that yourselves had sent us an email requesting a defence from ourselves.

Upon contacting yourselves by phone we were told by a colleague of yours that an email stating the reasons why we were requesting a hearing outside the prescribed period was sufficient enough, in fact the email was dictated to myself by your colleague who was very helpful at the time. I believe and please don't quote me on this - we provided an up to date address. We then proceeded to seek legal advice in relation to the matter after attempting to contact the opposition's solicitor to find out the reasons behind the opposition to our slogan. Our grounds are a very simple one and that is the word "Kickz" since its initial trademark application, has now become a very generic word used widely across the globe to refer to Sneakers/ Trainers / Crepes - In fact it is also in our trademarked brand name and as such we are referring to it in our slogan. We are a Sneaker/Trainer Reseller unlike the opposition who are a sneaker retailer.

To now find that you have sent us a reply email almost 2 months later with a 7 day time limit requesting forms which were not sent out to us to fill out - (we have now found them out and filled them in). I feel that this is quite unfair and as I write this email the deadline has already elapsed. It is quite clear from the offset here, that this case is not abandoned nor has it ever been our intention to abandon this case and that we aim to pursue this matter to its full extent. However provided that your responses are quite delayed and now being received whilst I am away on a working holiday - I may add - I feel strongly that this is an unfair outcome.

I have attached the TM8 Form and a witness statement - please excuse any errors, it is my first time filling out such forms. I kindly ask that you take this into consideration and allow us ample time to prepare for a hearing to determine the outcome of this matter.

If in the case that you are not prepared to take the above email into your discretion and grant us a hearing - I kindly ask that you provide ourselves with the relevant Department /Ombudsman contact details to whom we can escalate this matter forward to. It's not my wish to escalate this matter however provided that we paid an upfront fee for a trademark application which I believe is non-refundable - I don't think the case has been dealt with fairly.

10. A Witness Statement and blank Form TM8 were attached to the above-mentioned email. The Witness Statement was in the name of one of the Applicants, Nancy Amoudi. I will not detail the content of the document, suffice to say that the statement is wholly concerned with the substantive matter of the Opposition itself and does not, at any point, address the matter of the late filing of the Form TM8.

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<sup>3</sup> This was the first occasion on which the Applicant provided a name. The email was signed off as 'Sean', although no surname was provided.



11. On 11 October 2022, the Tribunal wrote to the Applicants, by post and by email, in the following terms:

“Thank you for your email sent with attached witness statement and a blank TM8 form on 4 October 2022.

The Registry has noted that you have requested the appointment of a hearing to discuss why the TM8 and counterstatement was not filed within the prescribed time limit.

I can confirm that the case has been passed to our hearings team who will contact you in due course to make arrangements for the hearing.

However, the TM8 and counterstatement filed on 4 October 2022 was blank, prior to the hearing being held you are required to submit a completed Form TM8 and counterstatement.

You are also required to submit a witness statement which explains why the Form TM8 and counterstatement was not filed on time. It is noted that you have already filed a witness statement on 4 October 2022, however, this did not provide any explanation as to why the TM8 was not filed.

Please note, if the Hearing Officer at the hearing maintains the preliminary view, you may be required to contribute to the other party’s costs. This is not intended to dissuade you from attending the hearing, but merely to inform you of the potential consequences should you be unsuccessful in overturning the preliminary view to treat the application as abandoned.

Please submit the complete form TM8 and counterstatement, together with a witness statement explaining why the form TM8 and counterstatement was not filed within the prescribed time period on or before **25 October 2022.**”

12. On 12 October 2022, in response to the Applicants’ request for a hearing, the Tribunal wrote to the Applicants, by post and by email, in the following terms:

“I refer to the request for a joint hearing in respect of the above proceedings. The Hearing is to discuss the Registry’s preliminary view to discuss the late TM8. The Hearing Officer will make a decision in respect of the above and may give case management directions in addition to deciding the issue giving rise to the hearing. The Hearing Officer has reviewed the papers and is of the opinion that this matter can be dealt with as a telephone hearing. I hereby give you notice that the Hearing will take place on **Thursday 3 November 2022** at **10:30am** via the TEAMS Telephone Conference Link. You can contact the number with the PIN or click on the link in the email which will be sent out. The Registry has allocated one hour for the above Hearing in line with TPN 5/2000.

Please note that it is incumbent on the parties to provide the Tribunal with a landline or, if using a mobile telephone, to ensure that there is sufficient mobile coverage. Failure to provide a robust telephone connection can cause unnecessary delay and inconvenience and may impact on any award of costs. Please note that the Registrar will only consider changing the hearing date if the parties submit an alternative date, agreed between them which is convenient to the Registrar, provided the request is made within a convenient timescale.

Unless you have already done so, I would be grateful if you could inform the Registrar within 7 days from the date of this letter who will represent your clients at the above Hearing. Please provide a contact telephone number and email address for all attendees then we can send the appointment. Should you wish to provide the Hearing Officer with written submissions, please send them for the urgent attention of the Hearings Clerk to [tribunalhearings@ipo.gov.uk](mailto:tribunalhearings@ipo.gov.uk). Any submissions should be filed at least two working days prior to the hearing – **Tuesday 1 November 2022** and copied to the other side; late submissions will not be taken into account if they do not reach the Hearing Officer in time for the hearing. The Registrar should be informed immediately if Counsel are attending the hearing. Trade Marks Registry Cardiff Road Newport South Wales NP10 8QQ Switchboard: 0300 300 2000 Direct Line: 01633 811040 Fax: 01633 811175 Minicom: 0645 222250 E-mail: [tribunalhearings@ipo.gov.uk](mailto:tribunalhearings@ipo.gov.uk). In line with the Tribunal Practice Notice TPN 1/2004, the Trade Marks Registry will

require all parties professionally represented at Hearings to submit a skeleton argument. Please see Annex A for guidance on skeleton arguments. Please note that Annex B is a list of authorities readily available to the Hearing Officer therefore, if referred to by either party, copies are not required. Skeleton arguments should be received by 14.00, 2 working days before the hearing. That is on or before Tuesday 1 November 2022. Please send these by e-mail to [tribunalhearings@ipo.gov.uk](mailto:tribunalhearings@ipo.gov.uk). Your attention is drawn to Tribunal Practice Notice 1/2016 regarding the provision of skeleton arguments and attendance at hearings in Trade Mark proceedings and the potential consequences of non-compliance with the published guidance, which can be found at <https://www.gov.uk/government/publications/tribunal-practice-notice-12016>. If you have any queries concerning the above please telephone me on the above number.”

13. On 14 October 2022, the Applicants filed a completed Form TM8.

14. On 19 October 2022, the Tribunal wrote to the Applicants, by post and by email, in the following terms:

“I confirm receipt of your email, Form TM8 and counterstatement filed on 14 October 2022.

Please note, you are still required to submit a witness statement which explains why the Form TM8 and counterstatement was not filed on time. As previously noted in my letter dated 11 October 2022, you previously filed a witness statement on 4 October 2022, however, this did not provide any explanation for why no TM8 was filed.

Please can you submit a witness statement explaining why the form TM8 and counterstatement was not filed within the prescribed time period on or before **25 October 2022.**”

15. No Witness Statement setting out the reasons for the late filing of the Form TM8 was received on or before 25 October 2022.

16. On 27 October 2022, the Applicant<sup>4</sup> wrote to the Tribunal by email in the following terms:

“I’ve just checked my schedule – I am currently still away in the far east until January 2023, and we are currently in Q4 which in retail is our busiest quarter. I wouldn’t be able to guarantee that I could make that date. Is there any chance we can move this into the new year please?”

17. On 28 October 2022, the Tribunal wrote to the Applicants by email in the following terms:

“Thank you for your email.

The Hearing Officer has responded:

The hearing will go ahead on 3 November at 10:30am as scheduled, with or without the Applicant present. The Hearing Officer will consider the Applicant’s case by way of a paper exercise. Submissions in lieu of a hearing can be filed by 2pm on Tuesday 1 November 2022.’

18. Later that day, the Applicant emailed the Tribunal to indicate that ‘Sean’<sup>5</sup> would attend the hearing.

## **THE HEARING**

19. A joint hearing took place before me, by telephone conference, on 3 November 2022. Jane Kennedy, of Freeths LLP, attended on behalf of the Opponent. Ms Kennedy filed a skeleton argument in advance of the hearing. The Applicant due to attend, a litigant-in-person, was not present at the appointed time of 10:30am. I commenced the hearing at 10:36am, by which time the Applicant had still not joined.

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<sup>4</sup> The email was signed off as ‘McKicks Management Team’. The name of the author of the email was not provided.

<sup>5</sup> No surname was provided.

20. Ms Kennedy submitted that the application ought to be struck out on the basis that the Applicants has had numerous opportunities to file their Form TM8; their failures to do so amounting to a five-month-or-so delay since the original prescribed deadline of 23 May 2022. It was submitted that the Applicants had provided numerous reasons for their failure to observe the deadlines, but that they had nevertheless managed to correspond with the Tribunal by email from at least July 2022.

21. Ms Kennedy further submitted that the Opponent had striven to do all that it possibly could to enable the proceedings to progress, but to no avail. For example, the Opponent had been prudent to send Letters Before Action to the addresses of both Applicants. It was submitted that, in spite of these efforts, the Applicants had repeatedly failed to respond.

22. Ms Kennedy requested that an award of costs be made in favour of the Opponent. It was submitted that the hearing had been appointed at the request of the Applicants and that it further prolonged proceedings that had already been protracted by virtue of the Applicants' repeated failures to adhere to the stipulated deadlines.

## **DECISION**

23. 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 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.”

24. 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 out the period within 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.”

25. There has been no irregularity on the part of the Tribunal. The Applicants’ comments regarding the official letters being sent to the incorrect address are noted. However, Rule 11 of the Trade Mark Rules is clear that the onus is on the Applicant to file the correct address for service:

**“Address for service**

**11.—(1)** For the purposes of any proceedings under the Act or these Rules, an address for service shall be filed by—

(a) an applicant for the registration of a trade mark;

[...]”

Consequently, the only basis upon which the Applicants may be allowed to defend the opposition proceedings is if I exercise in their favour the discretion afforded to me by the use of the words 'unless the registrar otherwise directs' in Rule 18(2).

26. In making my assessment as to whether to exercise my discretion to admit the Applicants' defence in the instant case, I will take into account 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) i.e. I must be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the Applicants' favour.

27. In *Music Choice Ltd's Trade Mark* [2005] RPC 18, the Court indicated that a consideration of the following factors (underlined below) is likely to be of assistance in reaching a conclusion as to whether or not the discretion should be exercised in favour of a party in default. That is the approach that I will adopt.

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

28. As noted above, the Form TM7 was served by post and email on 22 March 2022 at the addresses (both physical and email) provided by the Applicants. Although the hard copies of correspondence did not reach the Applicants' correct physical addresses,<sup>6</sup> the Applicants nevertheless received electronic copies of all correspondences sent and were able to communicate with the Tribunal by email, from at least July 2022, with some consistency.

29. The contents of the Applicants' email of 4 October 2022 are noted. The point made that the email address that the Applicants had supplied in their application was 'used only for non emergency communications between our company and outside companies hence the monitoring of it is quite limited' is of little weight. The fact that the email correspondence sent by the Tribunal was redirected to the Applicants' spam folder is also unconvincing. In the case of *Kickz AG v Wicked Vision Limited*

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<sup>6</sup> The letters were returned to the Tribunal by Royal Mail as undelivered.

(BL O-035-11), it was held that the Applicant had been 'the author of its own misfortune' in its failure to adhere to any system or procedure for checking and dealing with registered letters. It is my view that this also applies to the matter of email correspondence. In my view, the onus is on the Applicant to ensure that there is a system or procedure in place to check its spam folder. It is, in my view, not uncommon for legitimate emails to occasionally be caught by spam filters. There is, to my mind, an expectation that businesses are aware of the risk of this occurring and therefore make appropriate checks on their email folders.

30. The Applicants' filed their Form TM8 on 14 October 2022, four months and one week after the original prescribed deadline of 23 May 2022.

The nature of the Opponent's allegations in its Statement of Grounds;

31. The Opposition is based upon section 5(2)(b) of the Act and relies upon two earlier registrations, 901256262 and 909423278. The Opponent relies upon its class 25 goods only in respect of the former earlier registration, and class 35 services only in respect of its latter earlier registration. The opposition is directed against all of the goods and services in respect of which the Applicants seek registration of their mark. I note that the proof of use provisions<sup>7</sup> are engaged in respect of both earlier marks, but that the Applicants have not requested such proof. Neither party is required to adduce evidence.<sup>8</sup>

The consequences of treating the Applicant as defending or not defending the Opposition;

32. If the Applicants are allowed to defend the Opposition, the proceedings will continue with the parties given an opportunity to file evidence and the matter will be determined on its merits.

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<sup>7</sup> Section 6A of the Act.

<sup>8</sup> Although a party may elect to file evidence.



33. If, however, the Applicants are not allowed to defend the Opposition, the Application will be deemed abandoned in respect of all of the goods and services applied for and the Applicants will lose their filing date of 24 November 2021. It will remain open to the Applicants to re-file their Application in respect of the same goods and services, which may, in turn, be opposed again by the Opponent.

Any prejudice caused to the Opponent by the delay

34. As noted above at [22], Ms Kennedy submitted that the Opponent's position had been prejudiced by virtue of the delays caused by the Applicants' failure to adhere to the five deadlines set by the Tribunal, and the further delay caused by the Applicants' request for a hearing, which they did not attend.

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

35. There do not appear to be any other relevant considerations.

**Conclusions**

36. In reaching my decision, as noted above, I recognise that if the discretion is not exercised in the Applicants' favour, the opposition will succeed in full, and the Applicants will lose their filing date. I further recognise that it may be that the Applicants will simply re-file their Application and that this may, once again, be opposed by the Opponent, resulting in opposition proceedings arising at some point in the future. However, as the loss of priority and possibility of further proceedings on much the same basis is often the consequence of a failure to comply with the non-extensible deadline to file a Form TM8, these are not factors that, in my view, are particularly compelling.

37. The fact that the Applicants have, to date, failed to provide the reasons for the late-filing of the Form TM8 in the form of a Witness Statement, despite this having been requested on five occasions, has been unhelpful. I have nevertheless considered

the comments made by the Applicants in their email correspondence. I am not satisfied that the Applicants have demonstrated extenuating circumstances or compelling reasons. In my view, it would therefore be inappropriate for me to exercise my discretion to admit the late-filed TM8 into these proceedings. The Applicants have, in my view, been afforded ample opportunities to comply with the requirements of the Tribunal, those requirements having been set out clearly in the correspondences sent to them. The Applicants have been able to correspond with the Tribunal by email since at least July 2022. The matter of the incorrect postal address to which hard copies of correspondence were sent is something that the Applicants could have rectified, if they had chosen to do so; and the onus was on them to ensure that a correct address for service was provided to the Tribunal. The Applicants have, in my view, been the author of their own misfortune.

## Outcome

38. My decision is not to exercise the discretion available under Rule 18(2) in favour of the Applicants. Subject to appeal, the Application is deemed abandoned in respect of all of the goods and services in respect of which registration is sought.

## Costs

39. As my decision terminates the proceedings, I must consider the matter of costs. The Opponent has been successful and is entitled to a contribution towards its costs, based upon the published scale<sup>9</sup>, calculated as follows:

Official fee for filing Form TM7	£200
Preparing the Statement of Case	£200
Preparing for and attending the hearing	£400
<b>Total</b>	<b>£800</b>

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<sup>9</sup> <https://www.gov.uk/government/publications/tribunal-practice-notice-22016/tribunal-practice-notice-22016-costs-in-proceedings-before-the-comptroller>

40. I order Nancy Amoudi and McKickz Limited to pay to KICKZ.com GmbH the sum of £800 as a contribution towards its costs.<sup>10</sup> 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 11<sup>th</sup> day of November 2022**

**N. R. MORRIS**

**For the Registrar**

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<sup>10</sup> The Applicants are jointly and severally liable for the Opponent's costs award i.e. the Opponent may seek payment of the full award from either Applicant, or the Applicants may agree to their respective liabilities.