

O/0177/23

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL
REGISTRATION NO. WO0000001658883
DESIGNATING THE UNITED KINGDOM IN THE
NAME OF SOREMARTEC S.A.
FOR THE FOLLOWING MARK:**

GENTLE MESSENGER

IN CLASSES 9, 30 AND 38

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 438023
BY PAGEONE COMMUNICATIONS LIMITED**

1. SOREMARTEC S.A. (“the holder”) is the holder of the international registration shown on the cover page of this decision (“the IR”). The IR was registered on 8 November 2022. With effect from 28 February 2022, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement. The IR enjoys a priority date of 2 September 2021. The holder seeks protection for the IR in relation to the goods and services set out in the Annex to this decision. The IR stands registered for goods and services in classes 9, 30 and 38 which can be seen in the **Annex** to this decision.

2. The applicant’s mark was published for opposition purposes on 5 August 2022. The opposition period ended on 5 October 2022. On 27 September 2022, Shoosmiths filed a TM7a (notice of threatened opposition) on behalf of PageOne Communications Limited (“the opponent”), as a result, the deadline for the filing of the TM7 was extended to 5 November 2022.

3. On 13 December 2022, the Registry received an email from the opponent with the TM7 and a TM9R attached. In the email, the opponent stated that an email from the opponent to the Registry was inadvertently sent to the wrong email address on 4 November 2022 due to an administrative error. The opponent requested that the TM7 be accepted in the exceptional circumstances. In addition, a TM9R was attached requesting an extension to the TM7 deadline if it was necessary.

4. On 14 January 2023, in an official letter, sent to both parties, the Registry stated:

“Dear Sirs,

I acknowledge receipt of your email correspondence dated 13 December 2022. Your comments regarding the intention to file a form TM7 on 04 November 2022 against the above trade mark application and the error in email address have been noted.

Your attention is respectfully drawn to the last page of the form TM7 in which it states to ‘send your form, saved as a PDF to: forms@ipo.gov.uk. Your comments have also been noted regarding filing a form TM9R to extend the deadline, however, please note the time for filing a formal opposition is a non- extendable deadline, in line with legislation, other than Rule 17(3) filing of a form TM7a.

In view of the above, it is the Registry's preliminary view that the notice of opposition has been filed outside the statutory 2 month period, set in accordance with Rule 17(1) of the Trade Mark Rules 2008 and the form TM7 cannot be accepted.

The above mark has been recorded protected and published as of 08 November 2022. If you wish to remove the trade mark from the register you need to apply to invalidate the mark by filing TM26(l) accompanied by a statement of grounds on which the application is made.

If either party disagrees with the preliminary view, they should request a hearing within 14 days from the date of this letter, that is on or before **30 January 2023**.

If no hearing is requested, a refund of the opposition fee will be issued in due course."

5. On 16 January 2023, an email was received from the opponent requesting a hearing.
6. In the official letter dated 17 January 2023, sent to both parties, the hearing was listed for 7 February 2023.
7. In support of the joint hearing, the opponent filed evidence which came in the form of the witness statement of Ms Nicola Priest dated 3 February 2023. Ms Priest is a Senior Paralegal at Shoosmiths LLP, a position she has held since 2013. I do not intend to summarise the parties' witness statement in full at this stage. However, I have taken the submissions into consideration in reaching my decision and will refer to them below, where necessary.

THE JOINT HEARING

Representation

8. The joint hearing took place before me, by telephone, on 7 February 2023. Both parties attended. Ms Sarah Williams of Walker Morris attended on behalf of the applicant. Mr Dominic Murphy and Ms Niki Priest of Shoosmiths attended on behalf of the opponent.

Hearing discussion

9. At the hearing, I asked Mr Murphy to explain why the TM7 was filed late. Mr Murphy submitted that the TM7 was late because it was sent to the wrong email address at the UKIPO. He submitted that there was a clear intention to submit the TM7 on time and the view was that the opposition should be allowed.

10. Drawing on the witness statement of Ms Priest that was submitted by the opponent, I stated that it was clear that Ms Priest was a senior paralegal who often submits forms such as the TM7 to the UKIPO regularly and as such could not be afforded the same level of leniency as a more junior member of staff making mistakes submitting forms. The opponent recognised that Ms Priest does have experience submitting forms to the UKIPO.

11. I drew the opponent's attention to the fact that the end of the TM7 form clearly states the correct email address that the TM7 should be submitted. Ms Priest stated that on all previous occasions, she had always sent the email to the correct email address. Ms Priest stated that when she was sending the email to the UKIPO the incorrect email address was selected which resulted in the TM7 form being sent to the wrong address at the UKIPO.

12. Mr Murphy went on to submit that there had been an IT issue which affected their ability to send emails internally and externally, which started the week before the TM7 was sent to the incorrect address and was resolved 2 weeks afterwards. I asked the opponent for further details concerning the technical issue that was experienced at their firm. Mr Murphy stated that when selecting email addresses there was a tendency that the wrong email address would be selected from the drop-down menu. Further, Mr Murphy submitted that he even experienced issues when attempting to email Ms Priest during this period. Mr Murphy submitted that in response to the firmwide issue, their internal IT services reimported contacts into the contact books to resolve the issue. These IT issues were confirmed by Ms Priest.

13. I then asked Ms Priest whether she had received the automatic undeliverable email response that I have been assured would have been sent following the incorrect email address being used. Ms Priest responded that she did not personally receive an undeliverable response but given that the mailbox the email would have been sent to was shared with another paralegal there was a possibility that it may have been picked up by another paralegal.

14. I asked Ms Williams for her submissions on behalf of the applicant. The applicant submitted that whilst it recognised that the issue was between the Registry and the opponent the view was that the matter should be dismissed. Ms Williams submitted that the deadline to

file the TM7 is a non-extendable deadline in line with legislation that the opponent failed to meet.

15. 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.

16. At the end of the hearing, I reserved my decision to give me an opportunity to reflect on the additional information provided by Mr Murphy and Ms Priest which was not foreshadowed in Ms Priest's witness statement and the skeleton arguments.

DECISION

17. Opposition to the registration of an application is provided for by Section 38 of the Act. Section 38(2) states:

“Any person may, within the prescribed time from the date of the publication of the application, give notice to the registrar of opposition to the registration. The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.”

Rule 17(2) –(4) specifies that:

“ (2) Unless paragraph (3) applies, the time prescribed for the purposes of section 38(2) shall be the period of two months beginning immediately after the date on which the application was published.

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

(4) Where a person makes a request for an extension of time under paragraph (3), Form TM7A shall be filed electronically using the filing system provided on the Office website or by such other means as the registrar may permit.”¹

18. Rule 78 of the Rules (*Filing of documents by electronic means*) provides that:

“The registrar may permit as an alternative to the sending by post or delivery of the application, notice or other document in legible form the filing of the application, notice or other document by electronic means subject to such terms or conditions as the registrar may specify either generally by published notice or in any particular case by written notice to the person desiring to file any such documents by such means.”

19. The Manual of Trade Marks Practice stipulates that: “The terms ‘to file’ or ‘filing’ means to ‘deliver to the Registry’; and “the recommended e-mail address to be used for all fee-bearing forms is forms@ipo.gov.uk.”²

20. I note that there has been no default, omission or error by the Registry and no suggestion that there has been any irregularity on the part of the Registry.

21. At the hearing, Mr Murphy submitted that the TM7 was late because it was sent to the wrong email address at the UKIPO. He submitted that there was a clear intention to submit the TM7 on time and the view was that the opposition should be allowed. This, to my mind, undermines Rule 17(3). The fact of the matter remains that the Registrar has, in accepting the TM7a, allowed the opponent 3 months from the date of application to file its TM7 and in failing to send the form through to the address on the form itself and the email address recommended by the Manual of Trade Mark Practice the opponent has not successfully filed its TM7. The opponent admits that it has sent forms through to the correct email address on many occasions and Ms Priest has experience filing these forms, therefore, I infer should be aware of the correct process. In the circumstances, it is reasonable to accept that the opponent should have checked that the correct email address was used. It did not.

¹ Rule 3 also refers: 3.—(1) Any forms required by the registrar to be used for the purpose of registration of a trade mark or any other proceedings before the registrar under the Act pursuant to section 66 and any directions with respect to their use shall be published on the Office website and any amendment or modification of a form or of the directions with respect to its use shall also be published on the Office website.

² See § 2.4, Tribunal Section, last updated: January 2023

22. It is worth noting, that I have been informed that an automatic undeliverable email would have been sent to the opponent following sending an email to the incorrect email address used. When asked whether this email had been received, Ms Priest did not deny that it was received but stated that it may have been picked up by another paralegal who shares the same outlook inbox as her.

23. The tenability of the human error argument (albeit on the application of Rule 41(6) in relation to an invalidity application) was considered by Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *TESCON Trade Mark* [2020] FSR 33; BL O/240/20, as follows:

“32. I readily accept that human error is not necessarily inconsistent with the existence of extenuating circumstances or compelling reasons for permitting invalidity proceedings to be defended in the exercise of the discretion conferred by rule 41(6). I would, for example, regard it as appropriate for the discretion to be exercised in favour of permitting a claim for invalidity to be defended in circumstances where it was clearly established that the failure to comply with a filing deadline of (say) 12 February 2020 was the result of an unnoticed keystroke error which caused the due date to be incorrectly entered in an otherwise reliable record keeping system as (say) 21 February 2020. It is nonetheless clear that the test to be applied cannot be taken to permit or require all human errors to be treated as excusable for the purposes of rule 41(6). There must, in other words, be a fact specific evaluation for the purpose of determining whether the particular error in question should or should not be treated as excusable in the circumstances of the case at hand.

33. This is the point at which the Proprietor’s request for relief under rule 41(6) ran into difficulty. The general tenor of the representations made on its behalf was that its attorneys had taken reasonable and proper steps to ensure that the required Form TM8 and Counterstatement were filed before expiry of the specified deadline, but were inadvertently deflected from doing so until after the deadline had expired. However, the Registrar was presented with assertions rather than evidence and materials of sufficient clarity and precision to substantiate that or any proposition to the like effect. In the end, as emphasised in the Respondent’s Notice, the Hearing Officer was left with no satisfactory explanation for the default which had occurred.”

24. Therefore, for similar reasons, I do not accept that the opponent’s failure to comply with the procedure for filing the Form TM7 was due to human error that falls within the

scope of the case law above and this argument has no foundation given the circumstances surrounding the failure to satisfy the procedural requirement. Further, there was no evidence to corroborate the claim that the opponent's IT system had failed, nor that it had failed at the material time, or that failure continued beyond the deadline. It is also evident on a balance of probabilities that the opponent was able to send emails from the internal system (even if it went to the incorrect email address); the email correspondence was also copied to other colleagues at the representative company including Mr Murphy, who had the opportunity to check the email address the form was being sent to; and as the opponent admits, it has extensive experience of IPO proceedings.

25. In reaching my decision, I recognise that if the late TM7 is not accepted, the application will continue to be recorded protected and published as of 08 November 2022 and the opposition proceedings will no longer continue. Further, I recognise that it may be that the opponent will simply file an application for invalidity of the applicant's mark resulting in further proceedings arising at some point in the future. However, the possibility of further proceedings on much the same basis is often the consequence of a failure to comply with the non-extendable deadline to file Form TM7s. In my view, to regard the mere prospect of invalidation proceedings as a strong consideration would significantly undermine the prescriptive nature of the timeframes under the rules for filing a Form TM7. 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.

26. In considering whether any unfairness or prejudice is caused to the opponent, I note that the opportunity has been afforded, by way of this hearing, to the opponent (who at all material times has been professionally represented) to rectify the situation by providing cogent arguments for the Registry to validate its late filing on its TM7. I considered that if there is any inconsistency in complying with the overriding objective, it is more likely to be found on the part of the opponent, who has effectively unilaterally departed from the prescribed mode of filing the Form TM7 by sending it to the incorrect email address.

27. I must also take into consideration the fairness of subjecting the applicant to opposition proceedings when it has had no prior warning of those proceedings, and more importantly, based upon an action filed outside of the strict three-month opposition window (taking into account the filing on the TM7a) when the applicant could have reasonably expected oppositions or notices of threatened opposition to have been filed.

28. In reaching a decision, I have taken all the above matters into account, including the overriding objective (which is to ensure fairness to both parties) to deal with this case expeditiously and justly. I have found no single reason or combination of reasons sufficient to enable me to admit the Form TM7 into these proceedings. The opponent has failed to fulfil the procedural requirement (one that professional representatives were entirely familiar with) and did not provide sufficient or cogent evidence to demonstrate that it had made a real attempt to file the Form TM7 in accordance with the Rules.

29. In all the circumstances I find that the opponent has failed to show any compelling reason to justify its deviation from the rules and consider that the strict adherence to the procedural requirement outweighs the opponent's interest in having the matter determined via opposition proceedings.

OUTCOME

30. I uphold the Registry's preliminary view that the Form TM7 is not to be admitted as a formal opposition against the application. Therefore, the opposition has failed.

COSTS

31. As my decision terminates the proceedings, I must consider the matter of costs. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. Applying this TPN as a guide, I award costs as follows:

Preparing for and attending the hearing	£300
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32. I order PageOne Communications Limited to pay Soremartec S.A. 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.

Date this 20th day of February 2023

A Klass

For the Registrar

Annex

Class 9: Scientific, research, navigation, surveying, photographic, cinematographic, audio-visual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media, computer software, blank digital or analogue recording and storage media; mechanisms for coin-operated apparatus; cash registers, calculating devices; computers and computer peripheral devices; diving suits, divers' masks, ear plugs for divers, nose clips for divers and swimmers, gloves for divers, breathing apparatus for underwater swimming; fire-extinguishing apparatus.

Class 30: Coffee, tea, cocoa and artificial coffee; rice, pasta and noodles; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; chocolate; ice cream, sorbets and other edible ices; sugar, honey, treacle; yeast, baking-powder; salt, seasonings, spices, preserved herbs; vinegar, sauces and other condiments; ice (frozen water).

Class 38: Telecommunication services.