

BL O/0457/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. WO1603426

BY K2pharm s.r.o

TO REGISTER THE TRADE MARK:



IN CLASSES 3, 5 AND 35

AND

**THE LATE FILING OF FORM TM8 AND
COUNTERSTATEMENT
FILED IN DEFENCE OF THAT REGISTRATION
IN OPPOSITION PROCEEDINGS
UNDER NO. 431117
BY THE BOOTS COMPANY PLC**

Background

1. International trade mark no.1603426 ('the contested mark') shown on the cover page of this decision was registered by K2pharm s.r.o ('the holder') with effect from 25 November 2020. From the same date, the holder designated the UK as a territory in which it seeks to protect the contested mark under the terms of the Protocol to the Madrid Agreement. The holder seeks protection for a range of goods and services in Classes 3, 5 and 35.

2. On 17 February 2022, The Boots Company PLC ('the opponent') filed a Notice of Opposition and statement of grounds ('Form TM7') opposing the application in full on the basis of sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act').

3. On 16 March 2022, the registry served the Form TM7 on the holder. The deadline for the holder to file its Notice of defence and counterstatement ('Form TM8') was set at 16 May 2022 which was communicated by the registry in the serving letter. The registry's letter included the following:

"Please find enclosed a copy of the notice of opposition- Form TM7- filed against your international registration. Copies of these documents have been sent to the World Intellectual Property Organisation (WIPO) informing them of this opposition.

If you wish to continue with your international registration, 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 16 May 2022.

The holder of the International Registration must provide us with an address for correspondence in the United Kingdom (which for the purpose of the Act include the Isle of Man, the Channel Islands and Gibraltar) on a form TM33 'Appointment or change of agent or contact address', which is available at ipo.gov.uk/tmforms within this two month period. If one is not provided within this time, the international registration will be treated as withdrawn in whole or part.

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 international registration will be treated as abandoned.**

[...]" (original emphasis)

4. On 27 June 2022, Agile IP submitted a Form TM33 naming them as representatives for the holder along with a Form TM8. Although the Form TM8 referenced this opposition number, it was clear from the form that the defence was actually supposed to be for another matter concerning the parties as it referenced a different opponent and earlier marks. On 4 July 2022 Agile IP requested the documentation relating to this opposition.

5. The registry wrote to the holder on 29 July confirming that the TM8 received on the 27 June referred to the related proceedings between the parties and not 431117. The letter set out that the TM8 deadline of 16 May 2022 had been missed and that the registry was minded to deem the application as abandoned. The letter allowed the holder until 12 August 2022 to provide full written reasons as to why the TM8 was filed outside of the prescribed time period.

6. Agile IP wrote to the registry on 12 August 2022 and said that the holder did not have a UK representative at the time this opposition was filed and had stated that no letter had been sent to them. They also requested a hearing regarding this issue. Attached with the letter was a witness statement from Martina Marková of the Patent Agency of Ing. Petr Soukup. This simply stated that they had not received any communication related to the opposition filed against IR No 1603426 in the United Kingdom.

7. A hearing was originally set for 18 October 2022 however, the matter was suspended whilst the registry reviewed matters relating to the Appointed Person decision relating to Address for Service issues O/681/22.

8. Subsequently, a hearing was set for 4 April 2023 and the details were sent to the parties in an official letter from the registry on 10 March 2023. Both parties confirmed they would attend the hearing.

9. The holder filed submissions/skeleton arguments on 31 March 2023.

10. The hearing took place before me via telephone on 4 April 2023. The holder was represented by Mr Reuben Emeni of Agile IP. The opponent was represented by Mr Miguel Mendes of The Boots Company PLC, Group Intellectual Property.

Skeleton Arguments

11. The holder's skeleton argument states that the holder had not been served the necessary TM7 to respond to the opponent's claim and therefore, they missed the deadline. They stated that the IPO directed the opponent to file the form TM7 to the

holder's address in Czechia but due to international postage, the holder never received the form. A witness statement from Martina Marková was included which stated that the holder's Czech representatives had not received any communication relating to the opposition filed by THE BOOTS COMPANY against IR No. 1603426 in the United Kingdom.

12. The holder submitted that the UK representatives had not been notified of the opposition and had only become aware upon examination of the UKIPO website. The holder also stated that they requested the TM7 from the IPO on 4th July which was not sent to them and that this meant the holder was not allowed to reply to the TM7.

13. The holder made reference to the recent changes regarding valid address for service, in particular BL O/681/22 and Tribunal Practice Notice 2/2023. In particular, paragraph 2:

“With immediate effect, the Registrar will now seek to obtain a UK AFS before any formal serving of documents. This includes proceedings which have been suspended since the Appointed Person's decision.”

Hearing discussion

14. In the hearing Mr Emeni submitted that the TM8 was filed late due to an international postage error. He believed this discrepancy was down to a potential wrong address being used- Czechia versus the Czech Republic. It was submitted that this opposition was found when using a database for a different matter. The holder then asked the IPO for a copy of the TM7.

15. Mr Emeni stated it was the 7 October 2022 when the UK representatives finally had first sight of the Form TM7 and a response was then filed on 17 October 2022 which was in the two month period since they had received the document. So their submission, particularly in light of the recent decision mentioned above, was that they had indeed filed the TM8 in time.

16. I clarified that I believed Czechia and the Czech Republic both refer to the same country. I confirmed the address he had been referring to was that of the previous representatives in Czechia and Mr Emeni confirmed this was correct. I explained that the letter containing the Form TM7 was actually sent to the holder themselves and read the address to Mr Emeni. Within that letter they were asked to provide a UK address for service within the same two month deadline that was set to respond with the Form TM8. Therefore, we had already complied with the guidelines that were subsequently set out in TPN 2/2023.

17. Mr Emeni responded by saying that they were not aware of the opposition being sent to the address of the holder themselves and not their previous representatives that that the current representatives had only had a dialogue between themselves and the previous representatives.

18. I explained that when the registry sends letters internationally, it does so under tracked postage via Royal Mail and that the caseworker had checked prior to the hearing and the letter had been marked as delivered. I therefore stated that it seemed the Form TM7 had been sent to the holder themselves rather than their Czech representatives and so they would have been aware of the opposition. Mr Emeni stated that he believed there to be a language barrier and that he was not sure they would understand any correspondence sent to them.

19. I further said that when dealing with international registrations such as this one, upon receipt of an opposition, we inform WIPO of the proceedings and that it is WIPO who undertake service of the documents on the relevant parties. I asked whether there were any comments regarding receipt of documents from WIPO and Mr Emeni said that the party had no recollection of documents sent to them as per the witness statement from the previous representatives.

20. Mr Mendes commented that they had been in previous discussions with the holder about their concerns regarding the registrations and had written to both the holder themselves and their representatives regarding this prior to filing the oppositions. They then filed oppositions against their EU designation and received a positive decision.

As far as the opponent is concerned, the holder was aware of the intention to oppose both the EU and UK registrations due to this.

21. Mr Mendes further stated that he did not believe the holder had provided reasonable grounds as to why the Form TM8 was late and why the holder themselves did not file the form.

22. Mr Emeni responded that there was a general form of surprise as no initial documentation had been received. They understand that there was tracking however, no official record or correspondence has been sent to them directly confirming the previous correspondence and this matter only came to light to them due to their own searches.

23. I confirmed to both parties that I was reserving judgement in order to review the transcript of the hearing and the submissions of both parties and that a written decision would be sent to both parties in due course.

Decision

24. The filing of a Form TM8 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 counterstatement.

(2) Where the applicant fails to file a TM8 or counter-statement within the relevant period, the application for registration, insofar as it related to the goods and services in respect of which the opposition is directed, shall, **unless the registrar otherwise directs**, be treated as abandoned."

25. 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.”

26. It appears from the submissions of the holder that it suggests there may have been irregularities on behalf of the registry in this matter. However, the registry sent all necessary letters to the address provided by the holder and tracking shows this as delivered. As I mentioned within the hearing, when an international registration is opposed, as per the Madrid Agreement, a ‘notice of provisional refusal based on an opposition’ will be sent to WIPO, who will then transmit those grounds to the holder of the international registration. This transmission by WIPO constitutes effective service of the opposition. The notice was indeed sent to WIPO by the registry.

27. This case occurred prior to the introduction of TPN 2/2023 and was suspended whilst the registry considered the best course of action following the Appointed Person’s decision in *Tradeix Ltd v New Holland Ventures Pty Ltd* (BL O/681/22) however, the caseworker had indeed followed the procedure that is now set out under the heading “New Approach (2): Trade Mark opposition against published International Registration (UK)”. Therefore, I cannot see where any procedural regularities occurred and the only basis on which the applicant may be allowed to defend the opposition proceedings is if I exercise in its favour the discretion afforded to me by the use of the words “unless the registrar otherwise directs” in Rule 18(2).

28. When approaching the exercise of discretion here, I must take into account the decision 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) where it is set out that I have to be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the applicant’s favour.

29. 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 discretion should be exercised in favour of a party in default. That is the approach I intend to adopt, referring to the parties' submissions to the extent that I consider it necessary to do so.

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

30. As mentioned above, the deadline for filing the Form TM8 was 16 May 2022. The UK representatives requested a copy of the Form TM7 on 4 July 2022. The Form TM8 together with a witness statement and reasons for the delay were submitted on 12 August 2022. Therefore, the deadline was missed by 87 days. The main reason for missing the deadline was that the holder's Czech representatives stated they did not receive the Form TM7 and that the opposition was only discovered by the appointed UK representatives upon searching a database.

The nature of the opponent's allegations in its statement of grounds;

31. The opposition is brought under sections 5(2)(b), 5(3) and 5(4)(a) of the Act. Whilst it is not for the present hearing to determine the merits of the case, there is nothing to suggest that the opposition is without merit.

The consequences of treating the holder as defending or not defending the opposition;

32. If the Form TM8 is admitted into proceedings and the holder is therefore allowed to defend its mark, the proceedings will continue and the parties will be able to file evidence and submissions as necessary and the matter will be determined on its merits. Alternatively, if the applicant is not allowed to defend its mark then the registration will be abandoned and the applicant will lose its 25 November 2020 designation date.

Any prejudice caused to the opponent by the delay;

33. No submissions were made by either party regarding prejudice to the opponent.

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

34. There are other proceedings involving the holder and the mark however, this involves another party and I do not believe it has any bearing on this decision.

Considerations

35. The holder has maintained in these proceedings that the Form TM8 was not filed on time due to not receiving the Form TM7 from the Registrar, most likely due to posting issues as the letters would have been sent by international postage. I note that Mr Emeni suggested this could be due to the country being listed as Czechia and not Czech Republic. It was submitted that the holder had actually filed the Form TM8 on time when taking into consideration the first time that the UK representatives had sight of the Form TM7.

36. However, the registry sends international postage by a tracked delivery and upon checking this prior to the hearing, the letter was listed as being successfully delivered on 25 March 2022 at 12.12pm. Secondly, when a mark being opposed is an international registration, as is the case in this matter, the service of the documents is actually carried out by WIPO after receiving a 'notice of provisional refusal based on an opposition' from the registry which was indeed sent. Therefore, the Form TM7 for this matter was sent twice to the holder.

37. I note that the holder has provided a witness statement from their Czech representatives confirming they had not received any documents relating to this opposition. However, as I confirmed in the hearing, it appears the documents from the registry were sent directly to the holder's own address and not that of their Czech representatives. Mr Emeni explained in the hearing that the UK representatives had only had dialogue with the Czech representatives and not the holder themselves.

38. Further, from the skeleton argument and submissions of Mr Emeni and the holder, was the reliance on the changes made regarding UK address for service following BL O/681/22. This matter was indeed suspended as a precaution. The registry had however, already carried out the process now set out in TPN 2/2023:

“14...A ‘notice of provisional refusal based on an opposition’ will immediately be sent to WIPO, who will then transmit those grounds to the holder of the international registration. This transmission by WIPO constitutes effective service of the opposition, and does not - at this stage - require the holder to deposit a valid UK AFS at the IPO.

15. Notwithstanding WIPO’s primary role as effective server of the opposition notice, the IPO will continue its current practice of issuing a letter to the IR(UK) holder using the (non-UK AFS) address details provided by WIPO. Duplicating information already communicated to the holder via WIPO’s transmission, this IPO letter will confirm that a counterstatement is required inside of the (activated) two-month period in order to initiate a defence. It will also confirm that a valid UK AFS will be required, via submission of a completed Form TM33, in order to contest the opposition and engage beyond initial submission of the TM8 and counterstatement.

16. At the point of receiving the WIPO notice and IPO letter, the holder need only submit a completed Form TM8 and counterstatement within the two-months reply period. It may choose to accompany its Form TM8 with a Form TM33 recording a valid UK AFS, but it is not required to do so. A Form TM8, submitted inside of the deadline, is sufficient notice to the Registrar that the holder intends to defend the challenge.”

Therefore, paragraph 17 of the TPN still applies:

“Regardless of whether a valid UK AFS has been forwarded to the IPO, failure to submit a completed Form TM8 and counterstatement within the relevant period will result in the application being treated as abandoned in respect of

those goods/services against which the opposition was directed, pursuant to Rule 18(2).”

39. I acknowledge that there was a delay in sending on documents to the UK representative after they were requested due to the wrong documents being attached to the letter however, this was already 48 days past the deadline date.

40. The responsibility of maintaining up to date contact details, representative details and responding to correspondence from the UKIPO and WIPO remains with the owner of the marks. There are two sets of correspondence that have been sent to the holder regarding this opposition, one from the registry and one from WIPO and both set out the deadline for filing the Form TM8. If the holder has any doubt or questions regarding their understanding of the documents received it is for them to seek advice relating to it. As it stands, the UK representatives have had no dialogue with the holder themselves to confirm whether they received the documentation, just confirmation from the Czech representatives that they had not received anything relating to this opposition.

41. In reaching my decision, I have carefully considered the seriousness of the resulting impact if discretion is not exercised in the holder’s favour i.e. the registration will be declared invalid. Further, I recognise that this will affect other proceedings against the mark and will mean those oppositions will fall away. However, as this is a consequence of the failure to comply with the non-extendable deadline to file form TM8 I do not consider this to be a compelling factor or extenuating circumstance sufficient to justify me exercising my discretion in the holder’s favour.

42. The registry followed the correct procedures and notice of the opposition would have been sent to the holder twice- once by the UKIPO and once by WIPO. No rebuttal has been given to the information that the letter from the UKIPO was tracked and marked as delivered and that documentation also would have been sent by WIPO. I therefore can find no single reason or combination of reasons sufficient to constitute extenuating circumstances or compelling reasons to enable me to exercise my limited discretion in the holder’s favour to admit the late filed TM8 and counterstatement into these proceedings.

Outcome

43. The preliminary view is upheld and the late form TM8 and counterstatement is not to be admitted into the proceedings. Subject to any appeal, the holder's mark will be deemed as undefended and treated as abandoned.

Costs

44. As my decision terminates the proceedings, I must consider the matter of costs. The opponent is entitled to a contribution towards its costs, based on the scale published in the TPN 2/2016. I therefore assess the costs as follows:

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| Official fee | £200 |
| Preparing the statement of case: | £200 |
| Preparing for and attending the hearing: | £200 |

45. I therefore order K2pharm to pay The Boots Company Plc the sum of £600. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 16th day of May 2023

Laura Nicholas
For the registrar