

**BL O/0464/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NOS. UK3713876 & UK3613222**

**IN THE NAME OF ACTIV MARKETING GROUP LIMITED**

**FOR THE TRADE MARKS:**



**Activ Digital Marketing**

**IN CLASSES 9, 16, 35 & 42**

**AND**

**THE LATE FILING OF FORM TM8 AND**

**COUNTERSTATEMENTS**

**FILED IN DEFENCE OF THOSE REGISTRATIONS**

**IN INVALIDATION PROCEEDINGS**

**UNDER NOS. 504772 & 504773**

**BY ACTIVE DIGITAL COMMUNICATIONS LIMITED**

## **Background**

1. Trade mark nos. 3713876 and 3613222 ('the contested marks') shown on the cover page of this decision stand registered in the UK in the name of Activ Marketing Group Limited ('the proprietor'). Application number 3713876 was filed on 25 October 2021 and 3613222 on 19 March 2021. The trade marks were subsequently registered on 25 February 2022 and 6 August 2021 respectively.

2. On 11 April 2022, Active Digital Communications Limited ('the cancellation applicant') filed Form TM26I (Application to declare invalid a registration or protected international trade mark). The Form TM26I records that the cancellation applicant seeks to invalidate the marks on the basis of sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act'). The applications for invalidity were filed in respect of the following goods and services:

### *CA504772 against mark 3713876*

Class 9: Electronic directories including local business information and contact details; electronic software relating to the organisation, operation and supervision of a local online business directory and local online business directory franchise.

Class 16: Printed matter, publications, promotional material, brochures and pamphlets, training materials and teaching material all relating to the operation and franchising of a local online business directory.

Class 42: Web design services relating to the hosting and maintaining a local on-line business directory including web design services.

### *CA504773 against mark 3613222*

Class 42: Graphic arts design; computer software design; creating and designing website based indexes of information for others; creating and maintaining websites for others; graphic design of promotional materials;

hosting computer sites [web sites]; web design services; design of web sites; providing information relating to computer technology and programming via a website; server hosting; updating of computer software; technological consultancy; technological research; rental of web servers; website design consultancy; user authentication services; designing and developing web pages; creating, designing and maintaining web sites; creating and designing web pages for others; design and maintenance of web sites for others; web hosting services; graphic design for the compilation of web pages on the internet; research in the field of social media.

3. On 3 May 2022, the Registry served both Form TM26Is on the proprietor. The deadline for the proprietor to file its Notice of defence and counterstatement ('Form TM8') was set at 4 July 2022 which was communicated by the Registry in the serving letter. The Registry's letter included the following:

"Please find enclosed a copy of a TM26(I), application for invalidity, filed against your registration.

If you wish to continue with your 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 the 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 41(6) 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.

**IMPORTANT DEADLINE: A completed Form TM8 MUST be received on or before 04 July 2022.**

In accordance with rule 41(6) if the TM8 and counter-statement are not filed 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 or part.

**It is important to understand that if the deadline date is missed, then in almost all circumstances, the registration will be treated as invalid in whole or part.**

...”

(original emphasis)

4. The proprietor did not file a TM8 by the deadline and so, on 20 September 2022, the Tribunal wrote to the proprietor again. In the letter, the Tribunal stated that:

“The official letter dated 03 May 2022 informed you that if you wished to continue with your registration you should file TM8 and counterstatement on or before 4 July 2022.

As no TM8 and counterstatement have been filed within the time period set, Rule 41(6) applies. Rule 41(6) states that:

“...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.”

The registry is minded to treat the proprietor as not opposing the application for invalidation and declare the registration as invalid 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, **04 October 2022**. This **must** be accompanied by a Witness Statement setting out the reasons as to why the TM8 and counterstatement are being filed outside the prescribed period.

...”

5. The proprietor wrote to the Registry on 4 October 2022 with a Witness Statement from Garry Sutherland Mackay who is a director of GS Verde Law, the representatives for the proprietor. The witness statement set out the reasons for the missing of the TM8 deadline. Mr Mackay also confirmed that he had been told on the telephone that a Form TM8 was not required to be filed alongside the Witness Statement. A letter was subsequently sent from the Registry on 7 November 2022 confirming that a TM8 was indeed required and allowing 14 days for it to be filed. The Form TM8 was then filed on 21 November 2022.

6. A hearing was set for 6 April 2023 and the details were sent to the parties in an official letter from the Registry on 10 March 2023. Only the proprietor confirmed they would attend the hearing.

7. The proprietor filed submissions/skeleton arguments on 31 March 2023.

8. The hearing took place before me via telephone on 6 April 2023. The proprietor was represented by Mr Garry Mackay of GS Verde Law. The cancellation applicant was not in attendance.

### **Skeleton Arguments**

9. The proprietor's skeleton argument submits that the late filing for the TM8 was not due to acts or omissions of the proprietor themselves but a human error by their advisors and that the proprietor should not be penalised for this oversight. Further, they state that it was a single event that should amount to an extenuating circumstance.

10. The proprietor says that they have a strong case to defend the allegations and requests the opportunity to do so.

11. Also raised is the issue that by requesting the submission of the Form TM8 the Registry had led the proprietor to believe that the request for an extension had been agreed to and there were costs associated with the subsequent time spent preparing the form. It is also noted in the skeleton arguments that the application for invalidity

relates to only part of the goods and services and not the whole as has been referred to in some correspondence.

### **Hearing discussion**

12. At the hearing, Mr Mackay started by saying that whilst he was aware that there are two cancellation proceedings here, he proposed to address both matters together as the fundamental reasons were the same for both. I agreed that I was happy to proceed in this manner.

13. Mr Mackay acknowledged that the Form TM8 was late and that the consequences of such lateness was that the Registrar has the power to deem the matter as undefended which in turn would invalidate the marks. However, he was speaking to the discretion of the Registrar to allow the form to be admitted into the proceedings for extenuating circumstances.

14. The primary reason put forward by Mr Mackay was that the lateness had nothing to do with the proprietor of the mark but rather from an oversight of the advisers. What essentially happened was that the firm were in the middle of changing their processes to ensure that matters were centralised and it was during this crossover the deadline was missed due to human error. The proprietor wanted and intended to defend this issue.

15. Mr Mackay suggested the basis of determining the discretion was found in *Hilife Music Limited* and that human error is a sufficient ground on which to allow exercise of the discretion especially where that error is from the proprietor.

16. The second reason put forward was that the nature of the case and circumstances around it mean the proprietor is in a far worse position than the cancellation applicant. The cancellation applicant has not engaged in anything further than the submission of the Form TM26. Failure to defend the TM26 has a greater impact than failure to defend a TM7. The cancellation applicant had every opportunity to object when the application was first submitted but did not do so and then subsequently having had the mark registered the proprietor had built their brand using that registration.

17. Mr Mackay also stated that if we go ahead with cancelling their marks then the reality is that they will immediately refile the marks and will likely be back in this position further down the line.

18. The final matter Mr Mackay put forward was that he contacted the registrar about the filing of the witness statement and to check whether the TM8 needed to be filed and was told that it did not need to be filed at this stage. They then subsequently received a request to file the Form TM8 and on the back of that incurred significant time and costs in doing so.

19. I asked Mr Mackay to clarify whether the person who's email address we had on file had left which had caused the oversight or whether it was the change in system completely. He confirmed that the firm had taken the decision to centralise all emails coming in from the Registry and this email had been set up so that six or seven of them had access and received all statements, etc. All subsequent applications had been filed using that email address. This matter was a legacy position with the old details still on file going through to a single person. That person forwarded it on to someone else to look at but it had not been followed up.

20. I asked what happened in the 8 days between telling the client of the missed deadline (22 September 2022) and speaking to the Registry on 30 September. Mr Mackay said it was to do with taking instructions and telling the client what was going on. Also, they were trying to find out what had happened and what the position was. The Registry had given a set time for a response and as Mr Mackay was not initially involved he was undertaking investigations to find out what had happened.

21. On closing Mr Mackay reiterated that previous correspondence had referred to the proceedings as being against the whole registration where it actually is against part and he wanted that noted in case the decision was to deem the proceedings as undefended. I said I would certainly note that.

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

## **Decision**

23. The filing of a Form TM8 in opposition proceedings is governed by Rule 41(6) of the Trade Marks Rules 2008 (“the Rules”). The relevant parts read as follows:

“(6) The proprietor shall, within two months of the date on which a copy of Form TM26(l) 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.”

24. The combined effect of rules 77(1), 77(5) and Schedule 1 of the Rules mean 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 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. The proprietor has not raised any issue of procedural irregularity other than being incorrectly told not to file the Form TM8 along with the witness statement which impacted the length of delay in receiving the form. However, on reviewing the case files for both matters I noted that both Form TM26ls were only sent to the proprietor’s representatives by email. It is usual practice for the Registry to send this form by both email (where one is on file) and by registered post. This approach was confirmed by



Mr Geoffrey Hobbs acting as Appointed Person in BL O/874/22. Had the Form TM26Is been sent by post also, the likelihood of them being overlooked due to a new email system being installed would have been greatly reduced.

26. In light of this omission by the Registry, I believe this to be an irregularity which should be rectified. Especially as, if not rectified and if the proprietor is not allowed to defend its marks, then the registrations as far as they are subject to the proceedings at hand will be declared invalid.

### **Outcome**

27. The consequence of the above finding is that the proprietor's Form TM8 and counterstatement will be admitted into both sets of proceedings and assessed accordingly. Providing no anomalies are identified, it will then be formally served upon the cancellation applicant and a timetable will be set for filing evidence.

### **Costs**

28. As I have admitted the proprietor's defence into the proceedings, and the invalidity proceedings are allowed to continue, costs will be considered at the final determination of the case.

**Dated this 17<sup>th</sup> day of May 2023**

**L NICHOLAS**  
**For the Registrar**