

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 99891

IN THE NAME OF KICKZ AG

TO TRADE MARK APPLICATION No.2514079

IN THE NAME OF WICKED VISION LIMITED

DECISION

1. On 20 April 1998 Wicked Vision Ltd (*'the Applicant'*) applied under number 2514079 to register the designation **KIX** as a trade mark for use in relation to *'balls for use in sports, for leisure and as toys and gifts'* in Class 28.

2. The application was published for the purposes of opposition on 11 September 2009. It was published on notice to Kickz AG (*'Kickz'*) as the proprietor of an earlier registered trade mark which might potentially be raised as an obstacle to registration. The Applicant was aware that Kickz would be notified of the pending trade mark application.

3. On 26 October 2009 Kickz obtained an extension of time from 11 November to 11 December 2009 within which to file a Form TM 7 and Grounds of Opposition. It did so by filing a request for extension in the form prescribed for that purpose by Rule 17(3) of the Trade Marks Rules 2008. The Applicant was notified of the request and it warned by

Kickz in writing to expect an opposition if the application for registration was not voluntarily withdrawn. By not contacting Kickz in response to that warning, the Applicant signalled that it intended to wait and see what would happen.

4. On 11 December 2009 Kickz filed a Form TM7 and Grounds of Opposition. Copies of these documents were forwarded to the Applicant by the Registrar under cover of a letter sent to its address for service in accordance with the provisions of Rule 17(8) on 21 December 2009. The letter was sent by registered post. Although it is not possible to decipher the scrawl electronically recorded as proof of delivery, the Applicant does not dispute that the letter was received by someone who signed for it at about 10:35am on 23 December 2009 at the address to which it had been sent.

5. The Applicant is unable to explain what became of the letter after it had been received. It is likely to have been taken unopened to the office area of the Applicant's business premises along with other letters received at the same time. The particular individual whose responsibility it would have been to deal with the opposition was not in the office. He was away from 22 December 2009 to 4 January 2010. The letter was not among the papers set aside for him to deal with on his return. He was not aware that it had been received. Although he appreciated that Kickz was '*active in opposing the mark*' and that the deadline for commencing opposition proceedings was 11 December 2009 (Transcript p.7, lines 1 to 17) he took no steps to find out whether Kickz had opposed his company's trade mark application within the time allowed.

6. The Applicant was required to file a Form TM 8 and Counterstatement in answer to the Form TM 7 and Grounds of Opposition '*within the relevant period*': Rule 18(1).

The relevant period began ‘*on the notification date*’ and ended ‘*two months after that date*’: Rule 18(3). The notification date was the date upon which copies of the Form TM 7 and Grounds of Opposition were ‘*sent*’ to the Applicant: Rule 17(8). These were sent to the Applicant by the Registrar on 21 December 2009. Therefore, the period of two months beginning ‘*on the notification date*’ ended on 20 February 2010 in accordance with the specified commencement-date-inclusive approach to computation of that period: see Chandrika Joshi v. Manchester City Council UKEAT/0235/07 (30 January 2008) at paragraphs [11] to [16] where the relevant authorities were considered and applied by HH Judge McMullen QC.

7. The deadline of 20 February 2010 for filing the Applicant’s Form TM 8 and Counterstatement was not a ‘*flexible time limit*’ within the meaning of that expression as used and defined in Rule 77. It was a time limit prescribed by a rule listed in Schedule 1 to the 2008 Rules. It was therefore governed by the restriction contained in Rule 77(5):

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.

Since there was no basis on which the Applicant could seek to invoke the power conferred upon the Registrar by Rule 77(5), the deadline of 20 February 2010 was final and binding upon it.

8. Inevitably in the circumstances I have described in paragraphs 4 and 5 above, the Applicant failed to comply with the applicable deadline. The effect of such failure is spelled out in Rule 18(2) in the following terms (with emphasis added):

Where the applicant fails to file a Form TM 8 or counterstatement within the relevant period, the application for registration, insofar as it relates to the goods or services in respect of which the opposition is directed, **shall, unless the registrar otherwise directs, be treated as abandoned.**

9. The words I have emphasised enable the Registrar to provide an applicant for registration with the opportunity to defend an opposition that would otherwise be treated as well-founded for lack of any defence. They only enable the Registrar to make such an opportunity available if there are extenuating circumstances sufficient to justify the exercise of his discretion in favour of doing so. They do not enable the Registrar simply to extend the fixed period of two months within which an applicant for registration is entitled to file a defence as of right in accordance with the provisions of Rules 18(1) and 18(3).

10. On 29 March 2010 the Registrar wrote to the Applicant indicating that he was minded to treat its pending application for registration as abandoned under Rule 18(2). The Applicant was offered an opportunity to make representations before any decision was taken. It availed itself of that opportunity at a hearing which took place before Mr. Edward Smith acting on behalf of the Registrar of Trade Marks on 17 May 2010.

11. The Applicant contended that the power conferred upon the Registrar by Rule 18(2) should be exercised so as to allow the opposition proceedings to continue on the

basis: (1) that it had always intended to defend any opposition that Kickz might decide to pursue in relation to the pending trade mark application; (2) that it had not consciously allowed the opposition brought by Kickz to go undefended; (3) that it wanted to defend the opposition on its merits and would do so if the Registrar permitted the proceedings to continue; and (4) that as soon as it received the official letter pointing out that it had not complied with the requirements of Rules 18(1) and 18(3) and therefore needed relief from the sanction specified in Rule 18(2) in order to proceed, it had promptly directed its efforts to keeping the proceedings on foot.

12. The case for the Applicant sought to establish that it was in effectively the same position as if it had not received the Form TM 7 and Grounds of Opposition to it on 21 December 2009. In cases where an applicant for registration can demonstrate to the reasonable satisfaction of the Registrar that there has been a failure to comply with the requirements of Rules 18(1) and 18(3) '*due to a failure to receive Form TM 7*' it is open to the Registrar to grant relief from the sanction specified in Rule 18(2) prospectively (by deciding that the sanction should not be imposed) or retrospectively (by ordering pursuant to an application made within the period of six months allowed for that purpose, that a decision imposing the sanction should be set aside). That is the combined effect of the discretion conferred by Rule 18(2) and the discretion conferred by Rule 43.

13. Rule 43 provides:

**Setting aside cancellation of application or revocation or
invalidation of registration; (Form TM 29)**

43.(1) This rule applies where -

(a) an application for registration is treated as abandoned under rule 18(2);

(b) ...

(c) ...

and the applicant or the proprietor (as the case may be) claims that the decision of the registrar to treat the application as abandoned or revoke the registration of the mark or declare the mark invalid (as the case may be) (“the original decision”) should be set aside on the grounds set out in paragraph (3).

(2) Where this rule applies, the applicant or the proprietor shall, within a period of six months beginning with the date that the application was refused or the register was amended to reflect the revocation or the declaration of invalidity (as the case may be), file an application on Form TM 29 to set aside the decision of the registrar and shall include evidence in support of the application and shall copy the form and the evidence to the other party to the original proceedings under the rules referred to in paragraph (1).

(3) Where the applicant or the proprietor demonstrates to the reasonable satisfaction of the registrar that the failure to file Form TM 8 within the period specified in the rules referred to in paragraph (1) was due to a failure to receive Form TM 7, Form TM 26(N), Form TM 26(O) or Form TM 26(1) (as the case may be), the original decision may be set aside on such terms and conditions as the registrar thinks fit.

(4) In considering whether to set aside the original decision the matters to which the registrar must have regard include whether the person seeking to set aside the decision made an application to do so promptly upon becoming aware of the original decision and any prejudice which may be caused to the other party to the original proceedings if the original decision were to be set aside.

The expression ‘*failure to receive*’ as used in Rule 43(3) does not appear to me to mean or embrace a ‘*failure to read*’ the relevant Form. Since the present case evidently involved a ‘*failure to read*’ rather than a ‘*failure to receive*’ the Form TM 7 and Grounds

of Opposition sent on 21 December 2009, it was a case to which the provisions of Rule 43 could never apply.

14. The Hearing Officer was thus required to consider whether the Applicant should or should not be sanctioned for its failure to read the Form TM 7 and Grounds of Opposition delivered to its address for service on 23 December 2009 by treating its pending application for registration as abandoned under Rule 18(2). In his written decision issued on 17 May 2010 he concluded that the application should be treated as abandoned on the basis that *'There is no default on the part of the registry or persons (or systems), other than [the Applicant], into whose custody the letter had been safely delivered'* (paragraph 16). He ordered the Applicant to pay £400 to Kickz as a contribution to its costs of the registry proceedings.

15. The Applicant appealed to an Appointed Person under Section 76 of the Trade Marks Act 1994. At the hearing before me it renewed its arguments to the effect summarised in paragraph [11] above. However, it was plain on the facts that the Applicant had been the author of its own misfortune. There had been no adherence to any system or procedure for checking and dealing with registered letters. The official notification had been mislaid because the minimal degree of vigilance required to prevent that from happening was not exercised. Even though the Applicant knew there was a risk of opposition by Kickz with a deadline of 11 December 2009 for filing the Form TM 7 and Grounds of Opposition, it did nothing to monitor the risk. In short, there were no extenuating circumstances for its failure to comply with the requirements of Rules 18(1) and 18(3). The Hearing Officer's decision to that effect was correct.

16. For these reasons the appeal is dismissed. I direct the Applicant to pay Kickz the sum of £275 as a contribution to its costs of the unsuccessful appeal. That sum is to be paid within 14 days of the date of this decision. It is payable in addition to the sum of £400 awarded by the Hearing Officer in respect of the proceedings at first instance.

Geoffrey Hobbs Q.C.

27 January 2011

The Applicant was represented by its Managing Director, Mr. David Strang.

Mr. Richard May of Rouse appeared on behalf of Kickz.

The Registrar was not represented.