

O-412-17

TRADE MARKS ACT 1994

**IN THE MATTER OF A JOINT HEARING HELD IN RELATION TO
APPLICATION NO. 3200735
IN THE NAME OF ACADEMY INTERNATIONAL LIMITED**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 409272 BY ACADEMY MUSIC GROUP LIMITED**

Background

1. On 6 December 2016, Academy International Limited (“the applicant”) applied to register the trade mark **ACADEMY** under no. 3200735, for a range of goods and services in classes 3, 14, 26 and 38. The application was published for opposition purposes on 24 February 2017.

2. Following the filing of a Notice of Threatened Opposition (form TM7a), on 12 May 2017 Academy Music Group Limited (“the opponent”) filed a form TM7 (Notice of Opposition). The opposition was directed against the services in class 38 of the application and was based upon sections 5(2)(a), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. On 18 May 2017, the tribunal wrote to the parties and served the form TM7 on the applicant. The method of service was by email to tm.ipo.uk@gmail.com, the applicant’s chosen address for service. The applicant does not dispute that it received this letter. In its letter, the tribunal informed the applicant that, if it wished to defend its application, it should file a form TM8 (notice of defence and counterstatement) on or before 18 July 2017. The letter contained the following paragraph:

“If you choose not to file a TM8, or a TM9C your application shall, in accordance with rule 18(2) of the Trade Marks Rules 2008, be treated as abandoned in whole or part unless the registrar directs otherwise”.

4. On 26 July 2017, the tribunal wrote to the parties again. It indicated that, as no form TM8 had been filed within the period allowed, the tribunal was minded to deem the application abandoned in respect of the opposed services. The applicant’s attention was again drawn to the provisions of rule 18(2) and it was allowed until 9 August 2017 to respond.

5. On 9 August, the applicant filed a form TM8, along with a witness statement by Alfean Samad, a paralegal in the applicant’s Legal Affairs Department. In his witness statement, Mr Samad explained that the applicant attempted (via a third party,

Matthew Bedford of Morton & Associates LLP) to file the form TM8 by facsimile at 2156hrs, Hong Kong Time, on 18 July 2017. Mr Samad continues:

“6. It is undoubted that [Mr Bedford] had indeed sent the electronic facsimile through his email address, mb@moas.com, on July 18, 2016 [sic] at 2156 hrs, Hong Kong time, to +44 163381777, which is the facsimile number of the Office [...].

7. Thereafter, on even date at 2205 hrs, Hong Kong time, [Mr Bedford] received an unsuccessful transmission notice. In the said notice, it was indicated that the transmission “*did not go through because someone answered the call*” [...].

6. Mr Samad has provided evidence of the original facsimile (though there is no indication of the content of the message) and the notice that the transmission had failed at exhibits 1 and 2 to his statement.

7. In a letter dated 17 August 2017, the tribunal issued a preliminary view, in which it indicated that it did not consider the reasons provided “sufficient for the Registrar to exercise his discretion” and refused to admit the late-filed form TM8. It added:

“It is noted that one attempt was made to file the TM8. However, from the evidence it appears that on receipt of an unsuccessful transmission notice, no further action was taken. There is no evidence another attempt was made to file the form, nor is there any evidence that the IPO was contacted for assistance”.

The statutory provisions

8. There is no need for me to set out all of the provisions governing opposition proceedings before the tribunal. For the purposes of this decision, it suffices to note that the period allowed to an applicant to file a form TM8 by rule 18(1) is an inextensible period, governed by Schedule 1 to the Trade Marks Rules 2008 (“the Rules”).

Nevertheless, the registrar has discretion to admit a late-filed TM8 if he considers it appropriate to do so. This discretion is contained in rule 18(2), which reads:

“18(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 directs otherwise, be treated as abandoned” [my emphasis].

9. Rule 76(1) reads:

“76.-(1) The registrar shall extend any time limit in these Rules where the registrar is satisfied that the failure to do something under these Rules was wholly or mainly attributed to a delay in, or failure of, a communication service”.

10. Facsimile transmission is included within the definition of “communication service” at rule 76(3).

Preliminary issue

11. A hearing was appointed to take place by telephone conference, at 10:30 on 4 September 2017. Skeleton arguments were filed by both parties on 31 August 2017. The applicant was due to be represented by Alfean Samad and the opponent by Harry Rowe for Squire Patton Boggs LLP.

12. At the appointed time on the date of the hearing, the tribunal’s hearings clerk attempted to contact Mr Samad on the telephone number provided. However, the number was unobtainable. A second telephone number, also on file, was tried but without success.

13. The hearing was put back until 11am to enable the hearings clerk to make contact with the applicant and I am grateful to Mr Rowe for his cooperation in this regard. The hearings clerk duly emailed Mr Samad to ask for an alternative telephone number. He

replied within five minutes but was unable to provide a different number, although he suggested that the hearings clerk omit the first '0' or use the UK code +44 at the start. Both suggestions were attempted, with no greater success. The hearings clerk responded to Mr Samad at 10:40am to advise him of that fact. She again requested that he provide an alternative telephone number and advised Mr Samad that the hearing would go ahead at 11am. No response having been received, the hearing proceeded. At 11:12, by which time the hearing had already concluded, Mr Samad emailed the tribunal. He stated that "[as] we do not have alternative telephone lines to the ones that you have already attempted to contact, we will unable [sic] to attend the CMC due to technical difficulties".

14. I should note that, in making my decision to proceed without Mr Samad in attendance, I bore in mind a number of factors. They include Tribunal Practice Notice ("TPN") 1/2016, in which the consequences of failure to provide a correct telephone number are set out. The TPN was drawn to the applicant's attention in the official letter dated 21 August 2017. Moreover, the applicant was given two further opportunities to provide a viable telephone number on the morning of the hearing and failed to do so. I also bore in mind that the evidence to be taken into account had already been filed and the outline of the applicant's case was before me in the form of its skeleton argument. Given the very straightforward nature of the issue before me, and taking into account all of the circumstances, I considered it appropriate to proceed with the hearing.

The hearing

15. At the hearing, Mr Rowe summarised the arguments he had made in his skeleton argument, which had been copied to the applicant and which are recorded on the official file. That being the case, I see no need to repeat them at any length here. In particular, Mr Rowe stressed that the applicant had made no attempt to re-send the form TM8 when it received notice that the fax transmission had failed. In his comments on rule 76(1), Mr Rowe accepted that there had been a failure of a communication service but maintained that the failure to file the TM8 was attributable to the omissions of the applicant in failing to re-send the document. He also argued that this was not an exceptional case warranting the exercise of the registrar's discretion. He submitted

that it was the applicant's failure to re-send a fax which resulted in the form TM8 not being submitted correctly.

16. At the hearing, I reserved my decision. In making my decision, I have reviewed all of the papers on file and both parties' skeleton arguments and submissions, which I take into account.

Decision

17. In respect of rule 76(1), there was, undoubtedly, a failure in a communication service. However, by the applicant's own testimony, it knew that the fax transmission had failed at 10pm Hong Kong time. As Hong Kong was seven hours ahead of the UK at the time, that would have been 3pm in the UK. The applicant has not claimed that it attempted to re-send the fax, nor that it tried to email the TM8 to the email address in the tribunal's letter of 18 May 2017, nor that it attempted to contact the tribunal in any other way to enable it to meet the TM8 deadline. In those circumstances, the failure to meet the deadline is plainly not "wholly or mainly" attributable to a failed facsimile transmission; rather it is attributable to the applicant's failure to take reasonable steps to file its form TM8 once it received the notice that its fax transmission had failed.

18. In approaching the discretion provided by the use of the words "unless the registrar otherwise directs" in rule 18(2), I take into account the decisions of the Appointed Person ("AP") in *Kickz AG v Wicked Vision Limited* (O/035/11) and *Mark James Holland v Mercury Wealth Management Limited* (O/050/12). Bearing those decisions in mind, and in the absence of any allegation of an irregularity by the tribunal which would engage rule 77(5), I must be satisfied that there are extenuating circumstances or compelling reasons to exercise the registrar's discretion in favour of the applicant.

19. As far as the discretion under rule 18(2) is concerned, the reasons I have given above in relation to rule 76(1), namely that the applicant made no efforts to ensure that its TM8 was properly filed after receiving notice of the failed fax, also apply here. In addition, whilst there is potential prejudice to the applicant because its application will be partially refused, it is a consequence entirely of its own making. I note that the

applicant argues at paragraph 4 of its skeleton argument that “the facsimile which included the TM8 and Counter-Statement sent was [sic] within the prescribed deadline”. However, as the tribunal’s letter of 18 May made clear, the TM8 was to be received by 18 July. Whilst the fax transmission did fail, the applicant knew that to be the case within ten minutes of attempting to send the fax: there can be no doubt that it did not rely upon the transmission being successful. Despite knowing that the TM8 had not been received by the tribunal, and despite having time in which to attempt to file it before the deadline, the applicant made no attempt to do so. In fact, the applicant did not contact the tribunal regarding its defence until after the tribunal had notified it that no TM8 had been received and that the application would be deemed abandoned in part. I can see no compelling reason or extenuating circumstance which would justify the use of the registrar’s discretion. The applicant has, in the words of Mr Hobbs in *Kickz*, been the author of its own misfortune.

20. In summary, having considered the competing written and oral submissions in light of the relevant case law, my decision is not to exercise the discretion available under rule 18(2) in the applicant’s favour. Any claim that rule 76(1) applies is dismissed. Subject to appeal, the application will be treated as abandoned in respect of the opposed services.

Costs

21. As my decision terminates the proceedings, I must consider the matter of costs. Awards of costs are governed by TPN 2/2016. I award costs to the opponent on the following basis:

Opposition fee:	£200
Preparing the Notice of Opposition	£200
Reviewing the late-filed TM8 and witness statement, and attending the hearing	£200
Total:	£600

22. I order Academy International Limited to pay to Academy Music Group Limited the sum of £600. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of September 2017

Heather Harrison

For the Registrar

The Comptroller-General