

O-780-18

TRADE MARKS ACT 1994

IN THE MATTER OF
APPLICATION NO. 3275446

BY LULLY GOLD

TO REGISTER



AS A TRADE MARK IN CLASS 35

AND

THE LATE FILING OF FORM TM8

IN DEFENCE OF THAT APPLICATION

IN OPPOSITION PROCEEDINGS (NO. 412574)

BROUGHT BY

WARNER BROS. ENTERTAINMENT INC.

Background

1. On 6 December 2017 Mr Lully Gold (“**the Applicant**”) filed an application (no. 3275446) to register as a UK trade mark the figurative presentation of the words ‘World of Wizardry’ (as shown on the front page of this decision) in respect of services in class 35 (being retail services in relation to confectionery, games, clothing, clothing accessories and toys). The application was published for opposition purposes on 23 February 2018.
2. On 19 April 2018, Warner Bros. Entertainment Inc. (“**the Opponent**”) notified the Applicant of its intention to oppose the trade mark application¹, and on 23 May 2018 duly filed a notice of opposition (Form TM7) opposing the application, on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).
3. The registry served the notice of opposition on 31 May 2018, with a covering letter that informed the parties that if the Applicant wished to continue with his application, it had until 31 July 2018 to file a Form TM8² and counterstatement, else the “... *application shall, in accordance with rule 18(2) of the Trade Marks Rules 2008 (“the Rules”), be treated as abandoned in whole or part unless the registrar otherwise directs.*”
4. The Applicant did not file a Form TM8 by the stipulated date; therefore, on 10 August 2018, the registry informed the parties by letter that in line with rule 18(2) the registry was minded to deem the application as abandoned. The letter gave the Applicant until 24 August 2018 to challenge that position by requesting a hearing and by setting out fully in a witness statement “*why the TM8 and counterstatement are being filed outside of the prescribed period.*”
5. On 22 August 2018 the Applicant sent a letter to the registry, stating that “*a number of factors*” caused the delay, specifically:
 - (i) that the Applicant “*had to go out of the country for a number of weeks just after receipt of [the Registry’s] communication in May; this was in relation to [his] wife suffering from early pregnancy complications, which caused catastrophic impact on [his] work life. This issue was one that simply could not be avoided*” and required a visit to a U.S.-based specialist;

¹ Per response to question 8 of the filed Form TM7.

² (Or else a Form TM9C requesting an extension for a cooling-off period by mutual agreement.)

and

(ii) delays in obtaining suitable advice.

6. The Applicant's letter of 22 August 2018 included a request for an extension of a further two weeks in which to submit the Form TM8. On 23 August 2018, the registry replied, referring back to the content of the official letter dated 10 August 2018. Although the Applicant's letter, sent via his email, had cited the relevant case reference and contained his name and address, it did not include the legal formalities required of a witness statement (primarily a signed statement of truth). The registry's letter of 23 August 2018 therefore gave the Applicant a final opportunity – until 6 September 2018 - to set out his reasons in full in a witness statement and to request a hearing, else his application would be deemed abandoned. The letter also drew the Applicant's attention to relevant trade mark appeal authorities case law³ that have established that it is only in cases where there are "extenuating circumstances", or "compelling reasons" that the registrar is able to exercise discretion to admit into proceedings a Form TM8 filed outside the stipulated period.
7. On 31 August 2018, the registry received a completed Form TM8, with the witness statement of the Applicant, signed and dated 28 August 2018, which repeated the reasons for missing the deadline given in the Applicant's letter of 22 August 2018. The witness statement also included information about the Applicant's business use and investment in the applied-for trade mark; however, that information can have little or no bearing on the narrow procedural issue of the late-filed Form TM8.
8. On 6 September 2018, the registry replied, giving the preliminary view of the registrar that the reasons given were not sufficient to exercise his limited discretion and admit a late filed Form TM8 into these proceedings. It gave the Applicant until 20 September to express an objection and request a hearing, else the application would be confirmed as deemed abandoned. The letter advised that before requesting a hearing to challenge a preliminary view, parties should bear in mind the following points: (i) the deadline for filing a counter-statement on Form TM8 is not a flexible time limit⁴; (ii) the legal constraints on the exercise of discretion by the registrar in these circumstances; and (iii) that in the event

³ *Kix*: BL Number O/035/11 and *Mercury*: BL Number O/050/12.

⁴ (See Trade Mark Rule 77(6) and Schedule 1 to those rules.)

that the hearing officer upholds the preliminary view, there may be costs implications arising from the hearing against the party who requested the hearing.

The Hearing

9. The Applicant requested a hearing, which took place before me by telephone conference on 5 November 2018. Mr Paul Shabbir attended on behalf of the Applicant and Mr Jonathan Moss of Hogarth Chambers attended at the instruction of CMS, the professional representatives for the Opponent. Mr Sam Omar of CMS also dialled in to listen to the hearing. In advance of the hearing, Mr Hogarth duly filed a skeleton argument. Mr Shabbir also provided written skeleton arguments, which reached me in time for the hearing. Mr Hogarth objected that Mr Shabbir's arguments arrived after the 1 November deadline for filing skeletons (and having had sight of the submissions by Mr Hogarth). However, I did not disregard the submissions (whose contents were anyway largely covered at the hearing), particularly since Mr Shabbir is a layman employee of the Applicant and not strictly required to provide written skeleton arguments.
10. I shall not refer to all points argued, some of which focused on other interactions between the parties, and which have no influence in my decision on this matter. Both parties' arguments addressed the factors identified in case law as relevant in determining whether to exercise the Registrar's discretion to admit a late filed defence – and I take account of such points in my decision.

The law

11. Rule 18 of the Trade Marks Rules 2008 ('the Rules') provides as follows:

“(1) The applicant shall, within the relevant period, file a Form TM8, which shall include a counter-statement.

(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 otherwise directs, be treated as abandoned.

(3) Unless either paragraph (4), (5) or (6) applies, the relevant period shall begin on the notification date and end two months after that date.”

12. The combined effect of rules 77(1), 77(5) and Schedule 1 of the Rules means 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 rules 77(5)(a) and (b) 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.”

13. It is clear that in this instance there has been no irregularity in procedure. Accordingly, I need not consider rule 77(5). The only possible basis on which I may allow the Applicant to defend the opposition proceedings is provided by the discretion inherent in the words “*unless the registrar otherwise directs*” in rule 18(2).

14. In order to promote consistency and fairness the registry must take account of relevant principles set out in previous decisions of appellate bodies such as the Appointed Persons⁵. Sitting as the Appointed Person in *Kickz AG and Wicked Vision Limited* (BL-O-035-11) (*‘Kickz’*) Mr Geoffrey Hobbs QC held that the discretion conferred by rule 18(2) can be exercised only if there are “*extenuating circumstances*”. And sitting as the Appointed Person in *Mark James Holland and Mercury Wealth Management Limited* (BL-O-050-12) (*‘Mercury’*) Ms Amanda Michaels QC held that there must be “*compelling reasons*” to justify the registrar exercising that discretion. In considering relevant factors, Ms Michaels referred to the criteria established in *Music Choice Ltd’s Trade Mark* [2006] R.P.C. 13 (*‘Music Choice’*), which provides guidance applicable by analogy when exercising the discretion under rule 18(2). Such factors, adapted for opposition proceedings, are as follows:

- i. The circumstances relating to the missing of the deadline, including reasons why it was missed and the extent to which it was missed;
- ii. The nature of the opponent’s allegations in its statement of grounds;

⁵ An “Appointed Person” is a senior lawyer expert in matters of trade mark law, who sits in an independent capacity to hear appeals from first instance decisions by the trade mark tribunal.

- iii. The consequences of treating the applicant as opposing or not opposing the opposition;
- iv. Any prejudice caused to the opponent by the delay;
- v. Any other relevant considerations, such as the existence of related proceedings between the same parties.

15. I take account of all the above factors in my decision below.

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

16. The Form TM8 was not filed until 28 August 2018 – four weeks late. The accompanying witness statement explains that the Applicant and his wife had to visit an IVF specialist in America. As the Opponent pointed out, the witness statement only refers to being out of the country “for a number of weeks”, just after receipt of the IPO’s communication on 31 May 2018. This may be understood to indicate that the Applicant would have had time on his return to attend to the Form TM8 and to meet the deadline. At the hearing, Mr Shabbir stated that in fact the Applicant was out of the country for eight weeks (exceeding the two weeks he’d initially anticipated) and that he and his wife did not return to the UK until August 2018. I asked if the Applicant would be able to provide evidence to substantiate that version of events and Mr Shabbir affirmed that the Applicant could indeed provide such evidence. I shall return to this central point later in this decision, in light of the post-hearing letter.

17. The Applicant also referred delays in obtaining suitable advice in relation to responding to the opposition. Mr Hogarth commented at the hearing that the witness statement indicated that the Applicant’s business was generating relatively substantial sums and that it would have been open to it to secure timely legal advice. In any case, case law makes it clear that being a litigant in person is not of itself a good reason for failing to comply with the rules and deadlines clearly set out in official correspondence⁶.

⁶ See, for example, Mr Geoffrey Hobbs QC sitting as the Appointed Person in BOSCO (BL-O-399/15).

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

18. The grounds of opposition under sections 5(2)(b), 5(3) and 5(4)(a) are standard. The Opponent submitted that such allegations give no reason to grant any extension; the Applicant argued the contrary. While the claims would require a considered response by the Applicant, especially as one relatively unfamiliar with trade mark law and process, I find this factor does not warrant the exercise of the Registrar's discretion.

The consequences of treating the applicant as opposing or not opposing the opposition

19. If the Form TM8 is not admitted, the Applicant will lose his priority date. Were he to refile a fresh application for the same trade mark, such an application would be allocated a later filing date and would therefore be subject to a different relevant date for the purposes of the assessment of the Opponent's various claims under the Act. This is no more than the normal consequence of a failure to meet the clearly communicated deadline set out under the Rules.

Any prejudice caused to the opponent by the delay

20. The Opponent argued that "the on-going delay in keeping the mark alive is ... continually causing prejudice to the Opponent" as the Opponent's solicitors have, in previous correspondence between the parties, informed the Applicant of its objections to their trading and that the Opponent has raised potential trade mark infringement and passing off. I did not find this an entirely clear line of objection; nonetheless, even if there were no specific prejudice caused to the Opponent by the delay of a matter of weeks in filing the defence, this would not of itself counterbalance the lack of any compelling reason for the Applicant to be treated as defending the opposition, notwithstanding his failure to comply with the inextensible time limit in Rule 18⁷.

Any other relevant considerations / related proceedings

21. As to the fifth and final of the *Music Choice* factors, there seemed no live related proceedings as such between the same parties, but both parties referred to "parallel discussions". The Opponent invoked those discussions as requiring resolution of the

⁷ See paragraph 36(v) of *Mercury* (BL O/050/12).

current proceedings, with no extension granted, so that the parties then know their position. For the Applicant, Mr Shabbir wished to defend the opposition, as the parallel talks between the parties “are in very early stages” and until they are concluded the Applicant is “keen to safeguard its shops signage and reputation” and “proceed with its plans and not be caught off guard by potential false promises.” I do not consider such vaguely referenced and inchoate discussions to amount to “related proceedings” that may be influential in the decision before me. (However, the registry does encourage recourse to mediation, and indeed offers such a service⁸, where parties both agree to it.)

Post-hearing letter

22. At the hearing, I gave my view that having a child is an impactful life event and complications during pregnancy may be capable of giving rise to extenuating circumstances that could warrant the exercise of the registrar’s discretion to admit a TM8 filed late. I accepted Mr Hogarth’s concerns about the sufficiency of the evidence and so, in light of Mr Shabbir’s account, I said that I would delay making my decision and setting out my reasoning until the Applicant had had an opportunity to provide further evidence to corroborate the reasons for his failure to file a timely defence. I set out the allowance to that effect in a post-hearing letter sent to the parties later the same day.
23. In that letter I stated that if the evidence established the Applicant’s absence from the UK for the eight-week period as stated, and that it was for the purpose stated, I would find that there are extenuating circumstances enabling the exercise of the registrar’s limited discretion and would admit the Form TM8. The Applicant was to file such material by Friday 16 November 2018.
24. The letter further stated that in particular, such evidence would need to show to the satisfaction of the Tribunal (i) the dates when the Applicant travelled with his wife to and from America and (ii) corroboration from a medical professional/facility as to the broad purpose/necessity of the travel. Notwithstanding the sensitive nature of such material, transparency in proceedings requires that it will also need to be simultaneously copied to the Opponent’s representatives, who would be allowed at least a week or so to comment in writing on the sufficiency of the evidence provided.

⁸ <https://www.gov.uk/guidance/intellectual-property-mediation>

Further evidence from the Applicant

25. The Applicant filed its further evidence on 19 November 2018 and the Opponent was given an opportunity to comment it. The Opponent's legal representatives (CMS) responded on 27 November 2018. The evidence filed included an e-ticket document showing that a Bulhar Singh and Sukvinder Kaur were to depart Edinburgh airport on 28 August 2017 bound for New York; the return journey to take place on 27 September 2017. The relevance of those two individuals is not apparent; they may be Mr Lully Gold and his wife, but that is not clear from the evidence. Moreover, those dates do not correspond with the account given by Mr Shabbir at the hearing; the e-tickets relate to nearly a year before the Application in question had even been filed.
26. The second exhibit appears to be a letter drafted and signed by a junior administrator in the Human Resources department of a company named GL Attractions Limited, explaining that Bulhar Singh was out of the business in June, July and August 2018. The Opponent makes the following comments on that letter: "No explanation is given as to: (i) what "business" Bulhar Singh was "out of"; (ii) how the sender (Elias Gkionis) is connected to the Applicant or is aware of his work patterns; (iii) the relevance of "GL Attractions Limited"; or (iv) whether Bulhar Singh is the Applicant. However, even if the exhibit is taken at face value, it confirms that an individual was "out of the business" in June, July and August 2018, not that the Applicant was out of the country for the entire 8-week period."

Conclusion

27. I find that the further evidence fails to offer any corroborating evidence from a medical professional/facility as to the purpose of the travel (such as an appointment email, which need only to have indicated the fact of attendance, with no further disclosure of sensitive material); I find too that it fails to confirm the Applicant's travel dates over a period that is relevant to these proceedings (i.e. between June 2018 and August 2018 as previously stated by Mr Shabbir). Therefore, in line with my post-hearing letter of 5 November 2018, **my decision is to uphold the registry's preliminary view and confirm that the trade mark application is treated as abandoned under rule 18(2).**

Costs

28. As my decision concludes these proceedings I must also deal with the matter of costs. The Opponent is entitled to a contribution towards the cost of the proceedings, which assessment I make based on the guidance in Tribunal Practice Notice 2/2016. I award the Opponent the sum of £550. The sum is calculated as follows:

Official fees for filing the Form TM7:	£200
Preparing a statement of grounds:	£200
Costs arising from the joint hearing (principally preparation and attendance):	£300
Total:	£700

29. I order Mr Lully Gold to pay Warner Bros. Entertainment Inc the sum of £700 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period.

Dated this 6th day of December 2018

Matthew Williams

For the registrar
