

O-381-19

TRADE MARKS ACT 1994

IN THE MATTER OF

APPLICATION NO. 3344171

BY ALCHEMY WINES LIMITED

TO REGISTER AS A TRADE MARK IN CLASS 33

The Ritual

AND

THE LATE FILING OF FORM TM8 IN DEFENCE OF THAT APPLICATION

IN OPPOSITION PROCEEDINGS (NO. 415140) BROUGHT BY

ALTO DE CASABLANCA, S.A.

Background

The Application

1. On 9 October 2018 Alchemy Wines Limited (“**the Applicant**”) filed an application (No. 3344171) to register as a UK trade mark the words ‘The Ritual’ in respect of various alcoholic beverages in Class 33, including wines.¹ The application was published for opposition purposes on 19 October 2018.

Threatened Opposition

2. On 17 December 2018, the registry wrote to inform the Applicant that following the publication of the Applicant’s trade mark application, Alto de Casablanca, S.A. (“**the Opponent**”) had filed a Form TM7a Notice of Threatened Opposition, thereby giving it a further month to oppose the application. The letter stated:

“the Intellectual Property Office cannot comment on the likely success or failure of an opposition, nor is it suggesting you should withdraw your application. You may want to consider obtaining professional advice from your solicitor or trade mark attorney before you make any decisions at this stage ...”

3. For those without a professional advisor in such matters, the letter provided links to further information and guidance, including the Chartered Institute of Trade Mark Attorneys (CITMA), The Law Society and IPO’s website.

The Opposition

4. On 17 January 2019 the Opponent filed a notice of opposition (Form TM7) opposing the whole of the application, on grounds under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).
5. *The Opponent’s earlier mark:* The Opponent relies for its section 5(2)(b) claim on its UK trade mark No. 3192356 “RITUAL ALTO DE CASABLANCA”, registered in respect of wines in Class 33. The Opponent’s trade mark was filed on 20 October 2016, and was registered on 13 January 2017, having been published for opposition purposes on 4 November 2016.

¹ (A full list of the Applicant’s goods is set out at the end of this decision.)

6. According to the Opponent's section 5(2)(b) claim:

"The Applicant's mark, The Ritual, is similar visually and aurally, and conceptually similar to a certain degree to the Opponent's earlier mark RITUAL ALTO DE CASABLANCA. The most distinctive element in the Applicant's mark "RITUAL" is fully contained in the Opponent's earlier mark and it is identical to the first element of the Opponent's earlier mark.

The Applicant's mark cover goods which are identical and/or similar and related to those covered by the Opponent's mark.

In view of the significant similarities between the respective marks and the identity/close similarity between the goods, there exists a likelihood of confusion on the part of the public which includes a likelihood of association."

7. *The Opponent's claimed unregistered sign:* According to the Opponent's section 5(4)(a) claim, the Opponent first used the unregistered sign "RITUAL" throughout the UK in relation to wines from December 2018 and that it consequently has goodwill and reputation in the sign "RITUAL". The Opponent claims that:

"use of an almost identical mark THE RITUAL by the Applicant in relation to identical and similar goods to those in which the Opponent trades, would cause a misrepresentation to the public, resulting in damage to the Opponent."

Deadline for submitting a Form TM8

8. The registry served the notice of opposition on 24 January 2019, with a covering letter that informed the parties that if the Applicant wished to continue with its application, it had two months to file a Form TM8² notice of defence and counterstatement. The letter provided a link to a blank Form TM8 on the IPO website, together with brief guidance. The letter emphasised the importance of the deadline and stated as follows:

"IMPORTANT DEADLINE: A completed Form TM8 (or else a Form TM9c) MUST be received on or before 25 March 2019

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.*

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

It is important to understand that if the deadline date is missed, then in almost all circumstances, the application will be treated as abandoned.”

The missed deadline

9. The Applicant did not file a Form TM8 by the stipulated deadline date of 25 March 2019; therefore, on 11 April 2019, 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 25 April 2019 to challenge that position by setting out fully in a witness statement “*why the TM8 and counterstatement are being filed outside of the prescribed period.*”
10. The first response to the registry’s 11 April 2019 letter, was a reply by email on that same day by Mr David Rowledge, Managing Director of the Applicant, stating that he believes that he has provided:

“all the required evidence as to why I have this ongoing complaint / issue. [The Opponent] should never have been given their trade mark, as [the Applicant] was never given the option to oppose – when they put forward their trade mark, which so obviously was in direct conflict with ours that was already granted. Please let me know how this mess is going to be reconciled.”

The Applicant’s complaint

11. One of the central circumstances giving rise to the issue to be resolved by this decision relates to the Applicant having previously expressed to the registry its dissatisfaction at not having been notified of the application for the mark “RITUAL ALTO DE CASABLANCA” which is relied on by the Opponent for one of the grounds of its opposition. It is necessary to set out some detail in this context.
12. *The Applicant’s previous mark:* The Applicant had previously owned a registration (No. 2468315) for the trade mark THE RITUAL which had been filed on 2 October 2007 and was registered on 22 February 2008 in respect of the following goods in Class 33: Wines, alcoholic beverages (except beers). That mark had been renewed once, but expired on 2 October 2017 and was removed from the register on 9 April 2018.

13. The Opponent's trade mark (RITUAL ALTO DE CASABLANCA) had been filed and published for opposition purposes in 2016, at which point the Applicant still held a registered trade mark for THE RITUAL. On 24 January 2019, on receiving the notice of opposition (Form TM7) and the registry's covering letter setting the deadline for filing a defence (Form TM8), the Applicant contacted by email the registry's information centre and the trade mark examiner who had processed the Opponent's trade mark to ask that they look into the situation. The Applicant's email stated that the Applicant "was looking to re-register "The Ritual" last year – 3344171, but has now been put on hold, due to the fact "Ritual Alto de Casablanca" is now in place – even though we owned The Ritual at the time of the registration." It stated that the Applicant faced "a situation that should never have happened – surely we should have been notified" ... "about the duplication of the word "Ritual" in class 33" and have been given the option to oppose the registration.
14. Mr Rowledge stated in another email on 25 January 2019 that he hoped "to hear from the relevant department soon, as you know there is a timeline involved with the TM7." The information centre replied the same day to say that "as the Form TM7 is a formal opposition" information centre had directed the case to the tribunal section. Mr Rowledge further replied that he understood that "may be the case" but that "the issues I have stem from way before the situation we find ourselves in now. Giving a third party a trade mark in the same category (Class 33) using exactly the same word, and giving the existing trade mark holder (Alchemy) no chance to oppose."
15. On 29 January 2019, Mr Rowledge sought from the tribunal section "a progress report as soon as possible" and on 31 January 2019 Tribunal Section replied stating:
- "As you have advised in your previous correspondence, you are unhappy with the lack of notification given to you when [the Opponent's 3192356 mark] was applied for, not the opposition which has now been lodged against [the Applicant's 3344171 mark] and currently being dealt with by the Tribunal. The matter has therefore been referred to the Trade Mark Examiner who dealt with 3192356 and I anticipate a response to your query will be dealt with as a matter of urgency. To make the Examiner fully aware of your request for a prompt response to your query, I have copied him into this email."
16. Mr Rowledge replied the same day (31 January 2019) to say that he was:

“unhappy about both elements to be honest. I would not be in this situation / with the opposition against me now if I was notified at the correct time. It would be totally unfair for me to have to spend additional funds opposing the situation now.”

17. He referred to having had protection for The Ritual mark for ten years and to having sold wine over that period in the UK market and that “to have another company in opposition as we were not notified is a very hard pill to swallow !” Mr Rowledge hoped to hear from the Trade Mark Examiner shortly as he “needed some support from the IPO to rectify this unfair situation asap.”
18. On 5 February 2019 Mr Rowledge again contacted the Tribunal Section and the Trade Mark Examiner restating that he is “unhappy with both situations” (identifying the Opponent’s trade mark registration 3192356 and the Applicant’s application 3344171) and asking when he could expect “some structured feedback on how this situation is going to be resolved.”
19. On 8 February 2019, the Trade Mark Examiner sent Mr Rowledge his response in relation to trade mark registration 3192356. The Examiner’s letter referred to the subjective assessment of whether or not to notify when the marks being compared are not identical, but apologised for not meeting Mr Rowledge’s expectations in not bringing the later filed application to the Applicant’s attention. The Examiner’s letter also explained:
 - that it was not possible to reopen examination of the Opponent’s registration 3192356;
 - that notification is for information only and would not have prohibited the later filed 3192356 application from proceeding;
 - that had the registry notified the Applicant of the Opponent’s application for 3192356, the Applicant would have had to file opposition proceedings if it wished to challenge the mark;
 - that now that the Applicant is aware of the later filed trade mark, the Applicant still has a right to challenge it if the Applicant considers that it has sufficient grounds to do so; the letter suggested that as such the Applicant was now in the same position as it would have found itself in had the registry notified it of the Opponent’s application;
 - that if the Applicant is considering making an application for invalidity, it was recommended to seek legal advice and the letter included relevant links;

- that if Mr Rowledge wished to pursue the complaint further, he should explain why the responses thus far have not addressed his concerns and request that a senior manager review his complaint.

20. Mr Rowledge replied the same day (8 February 2019) to say that he was not sure that the information provided helped him in any way. Mr Rowledge argued that he “was now on the back foot” when he should have been notified about the Opponent’s trade mark “directly competing” with his registration. He repeats that the Opponent’s mark “clearly copies / infringes on the main word “Ritual”” and asks why the Applicant was not notified of this duplication in Class 33. Mr Rowledge stated:

“I really do not understand – I should have been given the opportunity to oppose”. ... “For me to oppose a newer trade mark – given the green light – when it should not have been is wrong – especially as we had the original trade mark for 10 years and were now looking to reinstate.” ... “If the trade mark of “Ritual Alto de Casablanca” was given when [the Applicant] held “The Ritual” (and I was not given the opportunity to oppose) – surely the IPO office can grant the same now for my new application – as this only seems fair.”

21. Mr Rowledge asked in that email of 8 February 2019 that the complaint be taken further. On 13 February 2019, he sent a progress-chasing email to the Examiner (copied to Tribunal Section) asking “What are the proposed next steps for this situation please?”

22. The Examiner replied on 15 February 2019 providing a link to the Office’s complaints procedure and providing the name of a senior manager who could review Mr Rowledge’s case. Later the same day, Mr Rowledge forwarded to that senior manager “all of the historical email trails ... which I believe covers why I cannot understand how I find myself in this position”, adding that he wanted “to get the situation with “The Ritual” – and “Ritual Alto de Casablanca” reviewed as soon as possible.”

23. Mr Rowledge sent a progress-chasing email for the attention of the named senior manager (copied to Tribunal Section) asking for an update on the situation. On 5 March 2019 Mr Rowledge sent a further progress-chasing email for the attention of the named senior manager (copied to Tribunal Section) pointing out that he had received no update since 15 February 2019 and asking that “someone please let me know what this situation is, as time is moving on and I believe we should be allowed to be given the opportunity to have this trade mark.” An email from Mr Rowledge on 11 March 2019 shows that he spoke to the named senior

manager in examination that day and sent her the email trail going back to 24 January 2019.

24. The registry continued the requested further review of Mr Rowledge's complaint about not having been notified about the Opponent's application No. 3192356, but meanwhile the Applicant did not file a Form TM8 by the stipulated deadline date of 25 March 2019, which therefore led the registry to issue its letter on 11 April 2019, that in line with rule 18(2) the registry was minded to deem the application as abandoned. Mr Rowledge responded to the 11 April letter as set out in paragraph 10 above, emailing the senior manager and the Divisional Director (with copy to Tribunal Section).

25. In an email to Mr Rowledge on 11 April 2019, the Divisional Director stated that the 11 April 2019 letter was "in relation to the opposition process, which is a legal process dealt with separately to the complaint you have raised." The Divisional Director stated that she was looking into Mr Rowledge's complaint about not being notified about the application by Alto de Casablanca, and apologised for the delay in responding substantively to that complaint. Mr Rowledge replied the same day to state:

"I believe both lie hand in hand. I would not be in this situation if the process was correctly dealt with from the outset.

I do not agree that I should need to oppose – when we have held The Ritual trade mark for 10 years and had wines in the market with that name on.

If I need to oppose, then I believe any charges should be waived in this instance."

26. The Divisional Director replied on 12 April 2019 stating that she was dealing with the complaint but that "in terms of the opposition, it is a legal case and will have to proceed under the terms of the relevant legislation, which [Tribunal Section] will be able to help you with." The email also referred to free advice clinics offered by CITMA, and provided a link.

The filed Form TM8

27. On 15 April 2019, Mr Rowledge filed a completed Form TM8, with a covering email apologising for not having filed it previously which Mr Rowledge stated was "due to the simple fact, I thought my historical correspondence would have made it clear I was opposing." The counterstatement in the Form TM8 largely repeated points made by Mr Rowledge in the course of his complaint, as set out below:

The Applicant's Counterstatement

My initial Trade Mark was "The Ritual" – was safe and was obtained in October 2007.

The new trade mark "Ritual alto de Casablanca" – clearly copies / infringes on the main word "Ritual". Filing date 20th October 2016. Register 13th January 2017.

Why was Alchemy not notified of this duplication in category 33?

It would be totally unfair for me to have to spend additional funds opposing this situation now. Alchemy owned The Ritual Trade mark for 10 years – we protected the name as we were selling the attached wines from Western Australia – over this period in the UK market.

We have now created our own brand out of Spain to target our growing UK customer base attached – using the name. To have another company in opposition as we were not notified is a very hard pill to swallow!

Conclusion of the complaint process

28. On 18 April 2019, the Divisional Director sent an update email apologising again for not yet having provided a "substantive response" to the complaint, but that the complaint was being treated seriously and, that in the Director's maternity absence, would be taken forward by another named Director, who was aware of the circumstances.
29. Mr Rowledge emailed on 29 April 2019 seeking an update. The covering Director sent the conclusion of his investigation on 2 May 2019, which included the following points:
- i. It gave an unequivocal apology for an error in the search that led to the registry's failure to notify, and for not meeting expected standards, and that more training has been given to examiners to reduce the chances of such rare instances;
 - ii. That the Applicant did not renew its original trade mark in 2017;
 - iii. The Applicant now seeks a new registration, but is opposed by a mark filed during the period in which the Applicant held a trade mark for "The Ritual";
 - iv. Under the Trade Marks Act 1994 and its associated Rules, to attempt to prevent the registration of the Opponent's mark would have required opposition proceedings, involving filing the relevant form and paying a fee;
 - v. That the registry accepts that the Applicant was denied an opportunity to oppose due to an error by the registry;

- vi. It was noted that the Applicant has asked that the registry 'therefore' reinstate the Applicant's original trade mark that was not renewed and is outside of the late renewal period;
 - vii. That under legislation and the Rules the registry is not able to reinstate an expired mark nor to reopen the examination process of the Opponent's mark;
 - viii. That a potential avenue of challenge to the Opponent's mark still exists through invalidation proceedings;
 - ix. That parties may seek settlement of the issue without legal proceedings;
 - x. That the registry urged Mr Rowledge to read the guidance provided and to consider seeking legal advice before deciding on a course of action (links to independent legal advice provided);
 - xi. That nothing in the Director's letter, nor the failure to notify of the Opponent's mark, prejudices any proceedings that either party may commence, which matters must be left to the courts or the IPO's independent tribunal to determine.
30. Mr Rowledge emailed on 9 May 2019 stating that the sum of the ex gratia payment was far short of the Applicant's investment and expenditure on its brand. He was also unclear how the Director's response would influence the Applicant's Form TM8 and Witness Statement moving forward and he sought an explanation of the next steps.

The Applicant's witness statement

31. The registry's letter of 11 April 2019, which stated that the registry was minded to treat the application abandoned as the Form TM8 deadline had been missed, requested a witness statement to set out fully the reasons why the Form TM8 had not been filed within the prescribed period. The same was repeated in a telephone call between Mr Rowledge and tribunal section on 15 April 2019. Although Mr Rowledge filed a Form TM8 on 15 April 2019, no witness statement was filed. Therefore, by a letter on 30 April 2019, the registry made a further request for the required witness statement. Mr Rowledge filed a witness statement on 1 May 2019, the substance of which is set out below.

The Witness Statement

2. On 19th October 2018 I reapplied for a trade mark which I previously held for 10 years. In October 2017 I by error failed to renew the trademark. Once noticing this I immediately set out to re instate the trademark and discovered I had to reapply as the time frame had lapsed.

I was notified the trademark would go out to publication on the 19th October 2018, on the 17th December 2018 I received a letter stating there was opposition to the trade mark from a Alto de Casablanca S.A. Their trademark (UK00003192356-Ritual Alto de Casablanca, registered date 13th January 2017). At no time were we informed of this or offered the chance to oppose, because of this error by the IPO Office the trademark was registered in class 33 along side Alchemy's existing trade mark 'The Ritual'.

3. Now we are trying to re-register our trademark and are being opposed and could potentially lose identity within the wine industry because of an error on your behalf. This situation appears to be unfair and unjust on our behalf. We have created wine brands (see attached) clearly stating Alchemy and The Ritual the loss of earnings that we could potentially incur could run into the thousands as consumers get confused between our brand and the brand of Alto de Casablanca.

4. I would like Alchemy to be given the same standard that was afforded to Alto de Casablanca, i.e. our trademark to be re-stated alongside Alto de Casablanca.

The preliminary view

32. By a letter on 16 May 2019, the registry gave the preliminary view in relation to the late filed TM8 and counterstatement. The preliminary view letter referred to the Form TM7 service letter of 24 January 2019 that had emphasised the date of 25 March 2019 as the deadline for the Form TM8, whereas it was in fact filed on 15 April 2019, 22 days late. The letter stated that in line with the Appointed Person decisions in *Mercury O/050/12* and *KIX O/035/11*, the Registrar is required to consider whether there are '*extenuating circumstances*' and/or '*compelling reasons*' which may permit the Registrar to exercise its limited discretion to treat an applicant as defending an opposition. The letter concluded as follows:

"If the discretion is not exercised in favour of the applicant, the application will be deemed abandoned. This will most likely lead to the applicant filing another application, with every likelihood that the opponent will then oppose it. If the discretion is made in favour of the applicant, the proceedings will move forward to the evidential stage, with a final determination being made on the full facts and merits of the case.

Having carefully taken account of all the facts of the case, the guidance provided by the legal authorities, the public interest in resolving the dispute in a timely manner, the cost and resource implications to the Registrar and parties, and the prejudice that the parties may suffer due to

any delay in a legal resolution to the dispute, **it is the Registrar's preliminary view to admit the late filed TM8 and counterstatement.**"

33. On 28 May 2019, the Opponent requested a hearing to challenge the preliminary view. The Opponent argues that the preliminary view is based on presumptions and fails to satisfy the applicable case law principles.

The Hearing

34. A hearing took place before me by telephone conference on Friday 21 June 2019. Andrew Hawley, a Chartered Trade Mark Attorney with the Opponent's professional representatives Marks & Clerk LLP, attended the Hearing on behalf of the Opponent. Mr David Rowledge attended on behalf of the Applicant. In advance of the hearing, Mr Hawley duly filed a skeleton argument. Being a litigant in person, Mr Rowledge was not required to provide any written arguments, but nonetheless he provided some written points primarily outlining the chain of correspondence arising during the registry's investigation of his complaint about not having been notified of the Opponent's application for the registration on which it relies for its section 5(2)(b) ground. I take account of the parties' points so far as they are relevant in determining whether to exercise the Registrar's discretion to admit a late filed defence.

The law

35. 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."

36. 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.”

37. As to criterion (a) above, clearly it might be said that “a default, omission or other error” has featured in the circumstances of this case. Indeed, there has, on the part of the Office, been an admission of and apology for the failure to notify the Applicant about the Opponent’s application for its RITUAL ALTO DE CASABLANCA trade mark (3192356). Although the application for that mark was duly published for opposition purposes, the Applicant was evidently not aware of the application. The registry’s failure to notify meant that, at a time when the Applicant held a registration for “THE RITUAL”, the Applicant was not actively alerted to the existence of another trade mark in Class 33, both covering wines, both featuring the word “RITUAL”. The Applicant missed the opportunity to oppose the 3192356 application.

38. However, whilst the Applicant has directed its efforts into pursuing his complaint about the failure to notify, I do not find that it can fairly be said that the Applicant’s failure to file a Form TM8 within the prescribed period is an irregularity that is attributable, even in part, to the Office’s omission to give notification of the Opponent’s 3192356 application. I accept that Mr Rowledge seems to have considered the two issues inextricable, and to have repeatedly stated much to that effect; however, the Office’s omission to notify on the one hand, and the Opponent’s subsequent/current opposition proceedings on the other, are two separate matters. Mr Rowledge has given his attention to the former at the cost of losing focus on the latter. I appreciate that the Applicant has acted in these proceedings without the benefit of legal representation, but the firm conflation of the two matters by Mr Rowledge arises from a misapprehension on his part. They are separate and distinct processes relating to separate and distinct trade mark applications. I return later in this

decision to consider further the elements of conflation and misunderstanding on the part of Applicant.

39. As to criterion (b) above, even if I had found that the late filing of the defence by the Applicant in relation to its new application for a trade mark may be considered attributable in part to the registry's error in failing to notify the Applicant of the Opponent's trade mark application – presumably on the basis of the associated distractive effect on the Applicant - I would not find that the irregularity (the missing of the deadline) is one that should be rectified. I would reach this latter conclusion on the basis that the filed Form TM8 and counterstatement express no clear defence against the opposition. I shall also return to this point below.
40. Having rejected the rule 77(5) basis for extending the deadline, the only 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).
41. 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 Persons³. 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;

³ 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.

42. 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

43. The Form TM8 was filed 22 days late. It is arguable whether the Witness Statement directly addresses the need to set out full and detailed reasons for seeking an extension or to set out in proper detail any 'extenuating circumstances'.⁴ The Witness Statement does not directly refer to missing the deadline, but instead refers to the Applicant having previously held a trade mark for ten years, but which it allowed to lapse. The Witness Statement references the Applicant's new application for a trade mark, over a year after its previous registration had lapsed. It refers to not having been notified about the application for the trade mark on which the Opponent now bases one of its grounds for opposition; it also refers to the prospect of confusion among wine consumers and requests reinstatement of its trade mark. The registry's letter of 16 May 2019 appears to have overlooked the content of the Witness Statement and instead refers to the reason offered by Mr Rowledge in the email accompanying his late filing of the Form TM8, in which he states "I thought my historical correspondence would have made it clear I was opposing".

44. In considering the circumstances relating to the missing of the deadline, I now return to the elements of conflation and misunderstanding on the part of Applicant (as mentioned at paragraph 38 above).

45. The Applicant's position appears to be that it would not now face this opposition to its new application to register a trade mark had it been notified.⁵ This assertion is based on presumptions: it presumes, firstly, that the Applicant, at the time that it held its registration, had good grounds for opposition and that had it filed a Form TM7 and paid the requisite

⁴ (per paragraph 32 of *Mercury Trade Mark* O/050/12)

⁵ See paragraphs 10, 16, 25 and 31 (second and third paragraph of the witness statement).

fee to oppose the Opponent's 3192356 application, then that opposition would have succeeded and the Opponent would not have achieved registration of the mark on which it now relies. That assertion is to presume the outcome of a matter that would have to be decided by the tribunal on the basis of the grounds claimed and in line with case law principles. Secondly, it presumes that even if the opposition had succeeded, that the Opponent might not have subsequently re-applied for its trade mark during a period when the Applicant had no live trade mark in the register, having allowed its registration to lapse.

46. It may be understandable that a party who is not familiar with trade mark law and process may not fully appreciate the significance of the required steps in opposition proceedings. However, throughout the process – starting with the notice of threatened opposition in December 2018 (paragraph 2 above) - the Applicant has been directed to guidance and to consider seeking legal advice. The registry's 24 January 2019 letter (paragraph 8 above) informed the Applicant in the clearest terms about the deadline for filing its Form TM8 and of the consequences of not meeting that deadline. Mr Rowledge explicitly acknowledged the deadline in his email to the registry the following day (paragraph 14 above) – it is not clear why he lost sight of that important deadline.
47. Although Mr Rowledge has persisted in regarding the issue of his complaint and the opposition as being linked matters, there is nothing in the content of the communications from the registry that should have led him to that understanding. Not only was the registry's 24 January 2019 emphatic on the importance of the deadline in the opposition proceedings, there are subsequent references by the registry to the complaint investigation being separate from the opposition and various references to the formal nature of the opposition process and to the constraining framework of the applicable legislation and rules.
48. Challenges to the registration of trade marks, such as through opposition proceedings, are dealt with by the tribunal section of the IPO. It is a fundamental point that the tribunal function is one that must be exercised with independence and impartiality. This necessarily limits the extent to which the Office is able to provide assistance to either side in a dispute between two parties. It cannot offer advice on how either party should run its case or pre-empt the outcome to matters that will be decided by the tribunal. This position

of independence informed the message content of the initial notice of threatened opposition letter (paragraph 2 above).

49. Mr Rowledge requested for support and structured feedback, (paragraphs 17 and 18 above) and the registry duly and appropriately relayed numerous points in response, notably, via the Examiner's letter of 8 February 2019 (paragraph 19 above). The Examiner's letter had made clear that it was not possible to reopen the examination of the Opponent's application and had identified an option of cancellation proceedings as the post-registration equivalent to (pre-registration) opposition proceedings. Similar points were made again on 2 May 2019 in the correspondence from the covering Director on conclusion of his review, which also stated that under the legislation and the Rules the registry is not able to reinstate an expired mark. This is a new application and separate opposition; despite Mr Rowledge's claims to the contrary there is nothing unjust in his having to defend his application.⁶

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

50. The claims under section 5(2)(b) and 5(4)(a) are not complicated, even for a party unfamiliar with trade mark law and process. The section 5(2)(b) ground is a claim that the marks "The Ritual" and "RITUAL ALTO DE CASABLANCA" are similar and that the parties' goods are identical or similar, such that there is likelihood of confusion on the part of the average consumer. As indicated in the Opponent's statement of grounds, any assessment of a claimed similarity between marks will take account of visual, aural and conceptual factors. The section 5(4)(a) ground is a claim that the Opponent has acquired goodwill in the unregistered sign "RITUAL", such that the Applicant's use of its applied-for mark would be a misrepresentation, causing damage to the Opponent. The Form TM8 does not require an elaborate or detailed response in defence of such claims; it invites an applicant to deny or admit the grounds and an applicant may put forward any applicable defence.

⁶ Mr Rowledge refers (e.g. at paragraph 16 above) to considering it unfair to have to be 'opposing', by which I understand him to mean opposing the opposition; the point would apply similarly in relation to a post-registration challenge.

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

51. If the Form TM8 is not admitted (i.e. the Applicant treated as not opposing the opposition), the application will be treated as abandoned. This is no more than the normal consequence of a failure to meet the clearly communicated deadline set out under the Rules.
52. If the Form TM8 were admitted (i.e. the Applicant treated as opposing the opposition), the matter would progress towards a substantive decision that would need to take into account the parties' claims – the Opponent's statement of grounds and the Applicant's counterstatement. While the merits of the parties' respective positions are not the subject or focus of this joint hearing, I do note that the counterstatement in the Form TM8 filed by the Applicant focuses on its former trade mark registration, the registry's notification failure and the Applicant's contention that it "would be totally unfair to have to spend funds opposing this situation now". The Applicant states that the Opponent's registered mark "clearly copies / infringes on the main word "Ritual". The counterstatement does not, in clear terms, deny either of the Opponent's claims; it might reasonably be argued that, on the face of the counterstatement as expressed, the opposition must inevitably succeed and that from that perspective, there is no prejudice to the Applicant in not admitting the filed Form TM8.
53. I note too the previous information in the registry's correspondence as to the available option of a post-registration challenge to a trade mark – if a party considers that it has grounds to do so. In this context, and noting some of the thrust of the Applicant's counterstatement, I consider it reasonable to point to the guidance set out in Trade Mark Practice Notice TPN 4/2009 "Trade mark opposition and invalidation proceedings – defences." Ms Anna Carboni, sitting as the Appointed Person,⁷ has made clear that defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark are wrong in law: *"If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."*

⁷ Ion Associates Ltd v Philip Stainton and Another, BL O-211-09

Any prejudice caused to the opponent by the delay

54. Mr Hawley identified no specific prejudice caused to the Opponent by the delay in filing the defence, but he took issue with the explanation expressed to underpin the preliminary view and argued that timeliness in proceedings is best served by following the ordinary consequence of the rules and to treat this application as abandoned.

Any other relevant considerations / related proceedings

55. As to the fifth and final of the *Music Choice* factors, there are no live related proceedings between the same parties and no further relevant considerations beyond those I have considered above. I note that at the hearing the Applicant raised the possibility of the parties coming to an agreement, absent the need for legal proceedings, that would allow both trade marks to co-exist on the register and on the market. Mr Hawley was unable to speak to that suggestion, nor would the Hearing have been the forum to explore that. However, as a general point, the registry does encourage recourse to mediation, and indeed offers such a service⁸, where parties both agree to it.

Conclusion

56. Although I recognise that the Form TM8 was not filed exceedingly late, the deadline is not flexible; guidance from case law indicates that even one day late could lead to a refusal. 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 the failure to comply with the inextensible time limit in Rule 18.⁹ I also bear in mind that the Applicant is not familiar with trade mark matters, nor legally represented, but case law makes 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 correspondence.¹⁰ I have dealt with the central issue put forward by the Applicant to explain the late filing, and while I recognise that Mr Rowledge has mistakenly considered two separate issues as inextricably linked, that is a misapprehension on his part. While this may be regrettable, the Applicant may reasonably, in the language of the Appointed

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

⁹ See paragraph 36(v) of *Mercury* (BL O/050/12)

¹⁰ See, for example, Mr Geoffrey Hobbs QC sitting as the Appointed Person in *BOSCO* (BL-O-399/15)

Person in the Kickz case, be considered “the author of its own misfortune”¹¹. Moreover, as per paragraph 52 above, I have also taken into account that the Applicant has not denied the claims, which omission would tend to lead the opposition to succeed.

57. In light of my findings above, **my decision is that the trade mark application is to be treated as abandoned under rule 18(2)**. It was agreed at the Hearing, that I would indicate any consequent options arising from decision. I therefore note that the fact that this application has been deemed abandoned does not prevent the Applicant from filing a subsequent application for its trade mark. The Applicant has already been made aware of the option of seeking to cancel another’s registered trade mark - if it considers that it has grounds to do so - and its attention has been drawn to seeking legal advice in deciding how best to proceed.

Costs

58. 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 £600 reflecting the minimums indicated by the scale (including a reduction in relation to the hearing element, reflecting the limited nature and non-substantive focus of the hearing). The sum is calculated as follows:

Official fees for filing the Form TM7:	£200
Preparing a statement of grounds:	£200
Preparation and attendance for the joint hearing:	£200
Total:	£600

59. I order Alchemy Wines Limited to pay Alto de Casablanca, S.A.the sum of £600 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period.

Dated this 9th day of July 2019

**Matthew Williams,
For the registrar**

¹¹ *KIX* Trade Mark O/035/11 (at para 15)

The Applicant's goods in Class 33

Absinthe; Acanthopanax wine (Ogapiju); Aguardiente [sugarcane spirits]; Alcohol (Rice -); Alcoholic aperitif bitters; Alcoholic aperitifs; Alcoholic beverages containing fruit; Alcoholic beverages, except beer; Alcoholic beverages (except beer); Alcoholic beverages except beers; Alcoholic beverages (except beers); Alcoholic beverages [except beers]; Alcoholic beverages of fruit; Alcoholic bitters; Alcoholic carbonated beverages, except beer; Alcoholic cocktail mixes; Alcoholic cocktails; Alcoholic cocktails containing milk; Alcoholic cocktails in the form of chilled gelatins; Alcoholic coffee-based beverage; Alcoholic cordials; Alcoholic egg nog; Alcoholic energy drinks; Alcoholic essences; Alcoholic extracts; Alcoholic fruit beverages; Alcoholic fruit cocktail drinks; Alcoholic fruit extracts; Alcoholic jellies; Alcoholic punches; Alcoholic tea-based beverage; Alcoholic wines; Alcopops; Amontillado; Anise [liqueur]; Anisette; Anisette [liqueur]; Aperitif wines; Aperitifs; Aperitifs with a distilled alcoholic liquor base; Arak; Arak [arrack]; Arrack; Arrack [arak]; Baijiu [Chinese distilled alcoholic beverage]; Beverages (Alcoholic -), except beer; Beverages containing wine [spritzers]; Beverages (Distilled -); Bitters; Black raspberry wine (Bokbunjaju); Blackberry wine; Blackcurrant liqueur; Blended whisky; Bourbon whiskey; Brandy; Cachaca; Calvados; Canadian whisky; Cherry brandy; Chinese brewed liquor (laojiou); Chinese mixed liquor (wujiapie-jiou); Chinese spirit of sorghum (gaolian-jiou); Chinese white liquor (baiganr); Chinese white liquor [baiganr]; Cider; Ciders; Cocktails; Coffee-based liqueurs; Cooking brandy; Cooking wine; Cordials [alcoholic beverages]; Cream liqueurs; Curacao; Dessert wines; Digesters [liqueurs and spirits]; Distilled beverages; Distilled rice spirits [awamori]; Distilled spirits; Distilled spirits of rice (awamori); Dry cider; Extracts of spiritous liquors; Fermented spirit; Flavored tonic liquors; Fortified wines; Fruit (Alcoholic beverages containing -); Fruit extracts, alcoholic; Fruit wine; Gaolian-jiou [sorghum-based Chinese spirits]; Gin; Ginseng liquor; Grape wine; Grappa; Herb liqueurs; Hulless barley liquor; Hydromel [mead]; Japanese liquor containing herb extracts; Japanese liquor containing mamushi-snake extracts; Japanese liquor flavored with Japanese plum extracts; Japanese liquor flavored with pine needle extracts; Japanese regenerated liquors (naoshi); Japanese sweet grape wine containing extracts of ginseng and cinchona bark; Japanese sweet rice-based mixed liquor (shiro-zake); Japanese sweet rice-based mixed liquor [shiro-zake]; Japanese white liquor (shochu); Japanese white liquor [shochu]; Kirsch; Korean distilled spirits (soju); Korean traditional rice wine (makgeoli); Liqueurs; Liqueurs containing cream; Liquor-based aperitifs; Low alcoholic drinks; Low-alcoholic wine; Malt whisky; Mead [hydromel]; Mulled wine; Mulled wines; Natural sparkling wines; Naturally sparkling wines; Nira [sugarcane-based alcoholic beverage]; Peppermint liqueurs; Perry; Piquette; Potable spirits; Pre-mixed alcoholic beverages; Pre-mixed alcoholic beverages, other than beer-based; Preparations for making alcoholic beverages; Prepared alcoholic cocktails; Prepared wine cocktails; Red ginseng liquor; Red wine; Red wines; Rice alcohol; Rose wines; Rum; Rum [alcoholic beverage]; Rum infused with vitamins; Rum punch; Rum-based beverages; Sake; Sake substitutes; Sangria; Schnapps; Scotch whisky; Scotch whisky based liqueurs; Sherry; Shochu (spirits); Sorghum-based Chinese spirits; Sparkling fruit wine; Sparkling grape wine; Sparkling red wines; Sparkling white wines; Sparkling wine; Sparkling wines; Spirits; Spirits and liquors; Spirits [beverages]; Still wine; Strawberry wine; Sugar cane juice rum; Sweet cider; Sweet wine; Sweet wines; Table wines; Tonic liquor containing herb extracts (homeishu); Tonic liquor containing mamushi-snake extracts (mamushi-zake); Tonic liquor flavored with japanese plum extracts (umeshu); Tonic liquor flavored with pine needle extracts (matsuba-zake); Vermouth; Vodka; Whiskey; Whiskey [whisky]; Whisky; White wine; White wines; Wine; Wine coolers [drinks]; Wine punch; Wine-based aperitifs; Wine-based drinks; Wines; Wines of protected appellation of origin; Wines of protected geographical indication; Yellow rice wine.