

O/384/19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3281977
IN THE NAME OF JOLLEY GOOD LTD
TO REGISTER**

NEXTGOALWINS

**AS A TRADE MARK IN CLASS 25
AND
THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT
IN DEFENCE OF THAT APPLICATION
IN OPPOSITION PROCEEDINGS UNDER NO. 412364
LAUNCHED BY
NEXT RETAIL LIMITED**

Background

1. On 11 January 2018, Jolley Good Ltd (“the Applicant”) filed an application to register the trade mark shown on the cover page of this decision for a range of goods in class 25.
2. Next Retail Limited (“the Opponent”) has opposed the registration in full. The opponent relies upon grounds under Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).
3. The opponent initially filed the opposition (Form TM7) on 2 May 2018, but it required amendment. The opponent filed an amended Form TM7 on 25 May 2018.
4. On 11 June 2018, the Registry served the amended Form TM7 on the applicant. The accompanying letter advised the parties that a period expiring on 13 August 2018 was allowed either for the applicant to file a Form TM8 and counter-statement or for either party to file a Form TM9C to request to enter a cooling-off period which would allow the parties the opportunity to negotiate a possible settlement. The letter stated, *inter alia*:

“The Form TM8 and counterstatement, or Form TM9C must be received on or before 13 August 2018.

If no TM8, or TM9c is filed on or before the date given above, the 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 otherwise directs.”

5. No Form TM8 and counter-statement was received by the deadline of 13 August 2018; instead, on that date, Mr Keith Jolley, the applicant’s Director, filed a request for a cooling-off period on a Form TM9C on behalf of the applicant. That Form TM9C included a declaration to the effect that the opponent had agreed to the request for a cooling-off period.

6. By way of an official letter dated 16 August 2018, the Tribunal advised the parties that the request had been granted and that the cooling-off period would expire on 11 March 2019 and could be extended for a further nine months with the agreement of both parties. It also explained that (1) any request to extend the cooling-off period had to be filed on Form TM9E on or before the deadline of 11 March 2019 and that (2) if no request to extend the cooling off period was made, the Form TM8 and counter-statement needed to be filed by the same deadline of 11 March 2019 or the application would, unless the registrar otherwise directed, be treated as abandoned in whole or part in accordance with Rule 18(2) of the Trade Marks Rules 2008 (“the Rules”).

7. As no Form TM8 and counter-statement or Form TM9E was received by the deadline of 11 March 2019, on 19 March 2019, the Tribunal wrote to the applicant in the following terms:

“The official letter dated **16 August 2018** invited the applicant to file a TM8 and counterstatement on or before **11 March 2019**.

As no TM8 and counterstatement has been filed within the time period set, Rule 18(2) applies. Rule 18(2) states that the application:

“.....shall, unless the registrar otherwise directs, be treated as abandoned.”

The registry is minded to deem the application as abandoned as no defence has been filed within the prescribed period.

If you disagree with the preliminary view you **must** provide full written reasons and request a hearing on, or before, **2 April 2019**. This **must** be accompanied by a Witness Statement setting out the reasons as to why the TM8 and counterstatement are being filed outside of the prescribed period.

If no response is received the registry will proceed to deem the application abandoned.”

8. On 22 March 2019, the Tribunal received an email from Mr Jolley stating the following:

“Apologies on the lack of response and delay of submitting the TM8 form.
I have no legal representation and I was unaware that this date was looming.

I was in a ‘cooling off period’ which was actioned by NEXT and their lawyers, this literally only ended last week at their request, I assume I would have been made aware of the next steps.

Do I have a chance to submit this form?”

9. By letter of 25 March 2019 the Tribunal reiterated the same information contained in the letter of 19 March 2019 and re-warned the applicant that if the required documents were not received by the deadline of 2 April 2019, the Registry would proceed to deem the application abandoned.

10. On 2 April 2019, the Tribunal received a Form TM8, counterstatement and a witness statement in the name of Andrew Fell, who, it was explained at the hearing, is another Director of the applicant’s company. The witness statement was deficient in that it was undated, did not indicate the address of the person giving the statement and did not contain a statement of truth. Mr Fell made various statements to the effect that (1) the applied for mark is different from the opponent’s mark and (2) the applicant, in an attempt to settle the matter with the opponent, had agreed not to use the word “next” on its own. However, the witness statement did not explain why the TM8 was filed late. These documents were sent by Mr Jolley via email. The email stated:

“As mentioned in earlier correspondence I was unaware I had missed the deadline, as I was in an extended ‘cooling off period’ with the other party, which they had then ended abruptly with little movement in agreeing a settlement or solution where both parties were happy. I do not have access to a trade mark attorney/lawyer to represent myself and was unaware as soon as the cooling off period was over”.

11. On 4 April 2019, the Tribunal replied, giving the preliminary view that the reasons provided were considered to be insufficient to warrant the exercise of the Registrar's discretion to not deem the application abandoned. A period of 14 days, until 18 April 2019, was allowed to request a hearing on the matter. The applicant was informed that if it wished to request a hearing, it needed to provide an amended witness statement with the address of the party providing the witness statement and a statement of truth.

12. By way of an email dated 18 April 2019, Mr Jolley requested a hearing on behalf of the applicant and filed an amended witness statement. The new witness statement resolved the deficiencies in relation to the address, date and statement of truth, but still lacked any explanation as to why the Form TM8 was filed late.

13. Eventually, on 12 June 2019, Mr Jolley re-filed an amended witness statement, in which Mr Fell addressed the reasons for the late file of the Form TM8. The relevant parts of Mr Fell's statement are reproduced below (as written):

“Reason for late submission:

Keith Jolley was advised to outline and reasons for the late submission, which are detailed below:

Keith Jolley was unaware he had missed the deadline, as he thought he was still in an extended 'cooling off period' with next plc, which they then ended abruptly with little movement in agreeing a settlement or solution where both parties were happy. Keith Jolley does not have funds to access to a trademark attorney/lawyer to represent himself and was unaware that as soon as the cooling off period was over, the deadline would pass.

Keith Jolley to the best of his knowledge did not receive a letter from the Intellectual Property Office to outline this, so was unaware the deadline had elapsed to submit the various forms.

Even though next plc had indicated they were closing the 'cooling off period' they were in continual contact via email, asking questions and giving more suggestions regarding the proposed trademark, which confused matters even more, for Keith Jolley.

Keith Jolley apologies about this lack of understanding due to inexperience and would appreciate the opportunity to discuss this matter further as well as seek any support from the Intellectual property office regarding how he can simply gain approval of trade mark UK00003281977 which is very clearly different to the next plc TM.”

The hearing

14. The interlocutory hearing took place before me by telephone conference on 3 July 2019. Mr Jolley and Mr Fell attended on behalf of the Applicant. The opponent’s professional representative, Mr David Kemp from Marks & Clerk LLP, elected not to attend but filed written submissions in advance of the hearing. Mr Kemp’s submission were very brief and essentially maintained that, for the reasons set out in the Tribunal letter of 4 April 2019, the application should be deemed abandoned. No skeleton argument was required of the Applicant, who is not professionally represented in these proceedings.

The law

15. 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.”

16. 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.”

17. Though Mr Fell stated that Mr Jolley was unaware that he missed the deadline and that “to the best of his knowledge did not receive a letter from the Intellectual Property Office to outline this”, which would suggest that some correspondence from the Tribunal might not have been received, no argument was advanced at the hearing that Mr Jolley was unaware of the deadline of 11 March 2019 because he did not receive the official letter of 16 August 2018 which set out that deadline. Instead, Mr Jolley explained at the hearing that at 3 pm on the 11 March 2019 the opponent’s representatives informed him that they did not want to extend the cooling off period, by which point (1) he had forgotten the content of the official letter he had received nine months earlier which required the applicant to file the TM8 by 11 March 2019 in the absence of a further request to extend the cooling off period and (2) he was expecting to be prompted by the Tribunal with a supplementary reminder about the imminent deadline for the filing of the Form TM8 which never arrived.

18. Accordingly, it is clear that in this instance there has been no irregularity in procedure. Therefore, 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).

How should the discretion be approached?

19. In *Kickz AG and Wicked Vision Limited* (BL-O-035-11) Mr Geoffrey Hobbs QC sitting as the Appointed Person held that the discretion conferred by Rule 18(2) can be exercised only if there are “*extenuating circumstances*”. In *Mark James Holland and Mercury Wealth Management Limited* (BL-O-050-12), Ms Amanda Michaels QC sitting as the Appointed Person 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:

- a. The circumstances relating to the missing of the deadline, including reasons why it was missed and the extent to which it was missed;
- b. The nature of the opponent’s allegations in its statement of grounds;
- c. The consequences of treating the applicant as opposing or not opposing the opposition;
- d. Any prejudice caused to the opponent by the delay;
- e. Any other relevant considerations, such as the existence of related proceedings between the same parties.

20. I consider each of these factors in reaching my decision.

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

21. The deadline for filing the Form TM8 was 11 March 2019; a Form TM8 was filed on 2 April 2019, over three weeks later; although the covering email offered a brief explanation in relation to the late filing, it was not until 12 June 2019 (three months after the filing deadline) that the reasons were communicated by witness statement. In this connection, the witness statement, whose purpose was to support the applicant’s request to allow the late filed defence, was (1) partially deficient in form because, as I pointed out at the hearing, the facts that Mr Fell gave evidence about

are facts in relation to which Mr Jolley has first-hand knowledge and so should have been written and signed by Mr Jolley¹; (2) late, as it should have been filed by 2 April 2019 together with the Form TM8 and counter-statement.

22. At the hearing, Mr Jolley started off by saying that he has limited knowledge of trade mark matters and is unable to afford a trade mark lawyer. His argument was that he had tried to manage the case himself but was unaware of the specific date to file the Form TM8 because, by the time the cooling off period was terminated by the other party, he had forgotten the content of the letter setting out the deadline for the filing of the Form TM8 and the consequences of failing to file the Form TM8 on time. Mr Jolley apportioned some of the responsibility for the failure to file the Form TM8 on time to the opponent's legal representatives, stating that they waited up until the last minute, i.e. 3 pm on 11 March 2019, to communicate their intention to terminate the cooling off period, which left him unable to file the Form TM8 on the same day.

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

23. The Section 5(2)(b) claims allege some similarity between the parties' marks and between their goods, which is likely to confuse; and the Section 5(3) alleges a reputation on the part of the opponent, such that the applied-for mark will enjoy an unfair advantage or cause detriment to the opponent's mark. The claims are quite straightforward, even for a party not familiar with trade mark law and process; they do not require an elaborate response and it is open to an applicant to deny or accept all or part of the opposition. An opponent is not required to fully substantiate their allegations at the point of filing an admissible notice of opposition; while the merits of the allegations are not the focus of this joint hearing, nor can it be said that the claims are self-evidently so without merit, as to warrant no substantive consideration.

¹ As it has been filed Mr Fell's evidence is hearsay evidence.

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

24. If the Form TM8 were admitted, the parties' claims would proceed to be decided on their merits. If the Form TM8 is not admitted, the application will be treated as abandoned. This is the consequence of a failure to meet the deadline set out under the Rules. Such a consequence would be no bar to the applicant filing a new application should it wish to do so.

Any prejudice caused to the opponent by the delay

25. No prejudice to the opponent has been identified nor can I see any material prejudice caused by the delay.

Any other relevant considerations / related proceedings

26. There are no related proceedings between the same parties.

Decision

27. Having considered the various factors and matters in the round, I then consider whether this is a situation where discretion should be exercised favourably in the applicant's favour. Regrettably for the applicant (and as I communicated to Mr Jolley and Mr Fell at the hearing), the answer is "no". The circumstances in this case, do not, in my view, warrant the exercise of the limited discretion to admit into proceedings the late filed Form TM8.

28. The deadline for filing a TM8 and counterstatement in opposition proceedings is an inextensible one. The case law indicates that before the Registrar can be persuaded that discretion can be exercised in favour of applicants who did not conform with the request to file a defence within the non-extendable deadline, there must be "extenuating circumstances" and "compelling reasons" for their failure. Even if there were no specific prejudice caused to the opponent by the delay in filing the defence, this does 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 non-extendable time limit in Rule 18.

29. It seems to me that the responsibility for the failure by the applicant to file a defence within the prescribed period lies directly with the applicant itself. Official correspondence from the Registry, both on 11 June and 16 August 2018 clearly specified the deadline for filing the Form TM8 and set out the consequences of failing to do so. It was the applicant's choice not to seek professional advice and, as Mr Jolley confirmed at the hearing, the failure to comply in filing the applicant's defence on time came and went without any awareness of those events on Mr Jolley's part. This lack of awareness and supervision/control over the pending deadline clearly indicates that the applicant did not manage its dealings with the application as carefully as it might (and should) have; this is also reflected in the way the applicant dealt with the requirement to file a witness statement in order to explain the reasons for the late filing of the Form TM8: it took it over three months to address the issue, and even then, when an explanation was eventually provided, there were a number of issues related to the formalities of the evidence filed. Further, whatever might be said about the opponent communicating their intention to terminate the cooling off period on the last day of that period, the responsibility for being vigilant of the deadline for the filing of the applicant's defence should not be laid at the door of the opponent. The facts of the case are such that, in the words of Mr Hobbs in *Kickz*, there was a failure on the part of the applicant to exercise the "minimal degree of vigilance" required to meet the relevant deadline.

30. Finally, whilst I bear in mind that the applicant is not familiar with trade mark matters and nor legally represented, the case law makes clear that there are not specific or separate provisions for litigants in person and 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 correspondence².

31. Taking all of the above into account, I can see no compelling reason or extenuating circumstance which would justify the use of the Registrar's discretion. In view of my

² *BOSCO Trade Mark* BL-O-399-15

above conclusions, the Form TM8 and counterstatement filed on 2 April 2019 will not be admitted into the proceedings and, subject to any successful appeal, the application will be treated as abandoned.

Costs

32. As my decision terminates the proceedings, I must consider the matter of costs. Using the guidance set out in Tribunal Practice Notice 2/2016, I award the opponent costs on the following basis:

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| Official fee for the Notice of Opposition: | £200 |
| Preparing the Notice of Opposition: | £200 |
| Reviewing witness statement and preparing written submissions: | £200 |
| Total: | £600 |

33. I order Jolley Good Ltd to pay Next Retail 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 09th July 2019

Teresa Perks
For the Registrar,
The Comptroller-General