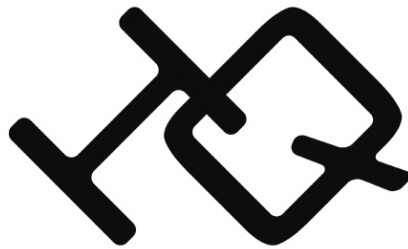


O/667/19

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. UK00002445688
IN THE NAME OF HQ INTERNATIONAL LTD
FOR THE FOLLOWING TRADE MARK:**



IN CLASSES 25, 41, 42 AND 45

AND

**THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT
IN DEFENCE OF AN APPLICATION FOR REVOCATION
UNDER NO. 502508
BY HARPERCOLLINS PUBLISHERS LIMITED**

BACKGROUND

1. On 19 April 2017, HarperCollins Publishers Limited (“Harper Collins”) applied for the trade mark **HQ** (no. 3225673) in the UK. On 7 August 2017, HQ International Ltd (“HQI”) opposed the application, relying upon UK trade mark no. 2445688 shown on the cover page of this decision (“the Contested Mark”) under opposition no. 409940. The Contested Mark was filed on 5 February 2007 and registered on 29 February 2008.

2. On the Form TM7, Mr Anthony Ward was listed as HQI’s representative, although I understand him to be a director of HQI. The Form TM7, was served upon Harper Collins on 19 September 2017.

3. On 20 November 2017, Mathys & Squire LLP filed a Form TM33P to record themselves as HQI’s representative in the opposition. On the same date, a Form TM9C was filed to request a cooling off period. A Form TM9E was then filed on 20 June 2018, giving the parties the full cooling-off period up to 19 March 2019.

4. Harper Collins filed a Form TM8 on 19 March 2019. The Form TM8 recorded Wiggin LLP as Harper Collins’ representative. On the same date, Wiggin LLP also filed a Form TM26(N) seeking revocation of the Contested Mark, on behalf of Harper Collins.

5. Some amendments were required to the Form TM26(N), the substance of which are not relevant for the purposes of this decision. However, when the amended TM26(N) was filed on 18 April 2019, Harper Collins’ representative stated: “As you will see, HQ International Ltd’s representatives are copied in to this email.” At this time, the address of Mr Anthony Ward was still recorded as the address for service in the revocation proceedings. However, it was not Mr Ward who was copied in to that email, but rather, several personnel from Mathys & Squire.

6. The email from Wiggin LLP copying in Mathys & Squire led the Registry to write to Mathys & Squire, on 26 April 2019, as follows:

“I note from the attached that Mathys & Squire have been referred to as the proprietor’s representative in this matter (Anthony Ward is currently shown as the representative).

Please let me know if you are representing HQ International in the above cancellation and if a TM33 has been filed, and if so on what date. If possible please email me a copy of the TM33 so it can be expedited in order to be able to correspond with you.

I note that Mathys & Squire LLP are the representative in the related proceedings.”

7. No response was received from Mathys & Squire. Consequently, on 7 May 2019, the amended Form TM26(N) was served on Mr Ward at the address for service provided. The Registry’s letter stated:

“Rule 38(3) of the Trade Marks Rules 2008 require that you must file your notice of defence and counterstatement (Form TM8(N)) within **two months** from the date of this letter.

IMPORTANT DEADLINE: A completed Form TM8(N) MUST be received on or before 8 July 2019.

[...]

Rule 38(6) of the Trade Marks Rules 2008 states that “**Where the proprietor fails to file a Form TM8(N) within the period specified in paragraph (3) the registration of the mark shall, unless the registrar directs otherwise, be revoked**”. It is important to understand that **if the deadline date is missed, then in almost all circumstances, the registration will be treated as revoked in whole or in part.**” (original emphasis)

8. On the same date, the Registry wrote to Mathys & Squire as follows:

“Dear Sirs

Related proceedings OP409940 and CA502508

The Registry is suspending the above proceedings pending advice from yourselves as to whether you are representing HQ International in related proceedings CA502408 [sic].

The Registry will review the situation again when a response has been received. If you *are* appointed, OP409940 will be suspended until the TM8 in CA502408 [sic] has been received. The proceedings will then be consolidated.”

9. The official header to that letter also contained the following information:

“Trade Mark No.: UK00002445688 Proprietor: HarperCollins Publishers
Limited

Cancellation No: OP000409940 Cancellation Applicant: HQI
International Ltd

Please quote your Cancellation ID Number in all correspondence”

10. No TM8(N) was received by 8 July 2019. Consequently, on 15 July 2019, the Registry wrote to Mr Ward to confirm that as no TM8(N) had been received the Registry was minded to treat the proprietor as not opposing the application for revocation and to revoke the registration. It went on to state:

“If you disagree with the preliminary view you **must** provide full written reasons and request a hearing on, or before, **29 July 2019**. This **must** be accompanied by a Witness Statement setting out the reasons as to why the TM8(N) and counterstatement are being filed outside of the prescribed period.” (original emphasis)

11. No response was received, and the Registry issued a decision dated 7 August 2019, confirming revocation of the Contested Mark, in the absence of a defence.

12. On 4 September 2019, the Registry received a Form TM9, TM33 and letter from Mathys & Squire confirming that they were instructed to represent HQI in the revocation proceedings and objecting to the decision to revoke the Contested Mark.

13. On 9 September 2019, the Registry wrote to the parties as follows:

“I refer to Mathys & Squire LLP’s letter dated 4 September 2019, which was accompanied by a TM9 and TM33.

Having considered the comments, it is the Registry’s preliminary view to admit a late filed TM8 as it is accepted that the information in the letter of 7 May 2019 was misleading.

Given the contents of that letter, the Tribunal letter dated 15 July 2019 should not have been issued without first confirming whether it should have been sent to Anthony Ward or to Mathys & Squire.

This error in procedure is to be rectified utilising the provisions of rule 74(1).

If either party objects to the preliminary view they should request to be heard on or before **23 September 2019**.

The proprietor has been requested to file a form TM8 on or before **18 September 2019**.” (original emphasis)

14. Mathys & Squire filed a Form TM8(N) on 18 September 2019, on behalf of HQI.

15. On 23 September 2019, Harper Collins objected to the Registry’s preliminary view and requested that the matter be heard.

THE HEARING

16. The joint hearing took place before me by telephone conference on 24 October 2019. Mr Peter Dawson of Wiggin LLP attended on behalf of Harper Collins and Ms Rebecca Tew of Mathys & Squire LLP attended on behalf of HQI. Both parties filed skeleton arguments in advance of the hearing. Mr Dawson made a request for costs of the hearing to be awarded off the scale.

THE LAW

17. The period allowed to a proprietor to file a Form TM8(N) by rule 38(3) of the Trade Marks Rules 2008 (“the Rules”) is a non-extendable period governed by Schedule 1 to the Rules.

18. Rule 74(1) states as follows:

“(1) Subject to rule 77, the registrar may authorise the rectification of any irregularity in procedure (including the rectification of any document filed) connected with any proceedings or other matter before the registrar or the Office.”

19. Rule 77 states as follows:

“77(1) Subject to paragraphs (4) and (5), the registrar may, at the request of the person or party concerned or at the registrar’s own initiative extend a time or period prescribed by these Rules or a time or period specified by the registrar for doing any act and any extension under this paragraph shall be made subject to such conditions as the registrar may direct.

[...]

(5) A time limit listed in Schedule 1 (whether it has already expired or not) may be extended under paragraph (1) if, and only if –

(a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the registrar, the Office or the International Bureau; and

(b) it appears to the registrar that the irregularity should be rectified.”

20. It is upon these provisions that HQI relies in seeking to have its late filed Form TM8(N) admitted into these proceedings.

DECISION

21. At the hearing, Ms Tew accepted that Mathys & Squire did not formally record themselves as HQI’s representatives in the revocation proceedings until 4 September 2019, when they filed Form TM33. However, Ms Tew confirmed that they were advising HQI throughout, behind the scenes, in relation to both the related opposition and these revocation proceedings.

22. Ms Tew explained that Mathys & Squire were unaware of the letter that had been sent to Mr Ward directly. However, she confirmed that Mathys & Squire’s advice to HQI was that there was no need for a Form TM8(N) to be filed at that stage, because the Registry had suspended both the opposition and revocation proceedings pending confirmation of HQI’s representatives. Ms Tew explained that it was the Registry’s letter of 7 May 2019 that led Mathys & Squire to advise HQI in this way.

23. Mr Dawson submitted that if Mathys & Squire were advising HQI then the proper course of action was to file a Form TM33. Mathys & Squire not having done so, meant that the Registry had acted correctly in serving the TM26(N) on Mr Ward directly (his address being recorded as the address for service). Mr Dawson submitted that Mr Ward had elected not to engage in these proceedings and had ignored the letters addressed to him dated 7 May 2019 and 15 July 2019, which were quite clear.

24. In my view, the Registry’s letter of 7 May 2019 addressed to Mathys & Squire was far from clear. In the letter’s official header, although the opposition number was recorded, it was described as the cancellation number and the parties were referred

to as “proprietor” and “cancellation applicant”, rather than “applicant” and “opponent”. Further, the title in the substance of the letter made reference to both the opposition and cancellation numbers. The letter then began “The Registry is suspending the above proceedings...”. In my view, this letter was clearly misleading as to which proceedings had been suspended.

25. I agree with Mr Dawson that the Registry acted correctly in serving the Form TM26(N) on Mr Ward directly, as it was his address that was listed as the address for service for the Contested Mark at the time. That action did not amount to a procedural irregularity. However, the misleading nature of the letter of 7 May 2019 cannot be ignored. As mentioned above, Ms Tew confirmed that, although not on the record in the revocation proceedings, Mathys & Squire were advising HQI in relation to both the opposition and the revocation. This is supported by the email of 18 April 2019 from Wiggin LLP to the Registry in the revocation proceedings, which copied in Mathys & Squire, who were referred to as HQI’s representatives.

26. Of course, having received that letter of 7 May 2019, Mathys & Squire could have taken action to clarify the position. They failed to respond in writing to the Registry and did not file a Form TM33 until September, some four months later. However, these issues would not have arisen in the first place were it not for the Registry’s own error.

27. Whilst the TM26(N) was properly served on Mr Ward, he was informed by his legal advisors that he did not have to file a Form TM8(N) as proceedings had been suspended. That position arose as a direct result of a misleading letter sent by the Registry. Ultimately, the letter of 7 May 2019 sent a message to HQI’s legal advisors that was contradictory to the message sent to HQI themselves. To my mind, this is clearly a procedural irregularity resulting from an error on the part of the Registry as set out in Rule 77(5) and this error should be corrected.

CONCLUSION

28. I direct as follows:

a) Mr Colombo's decision of 7 August 2019 will be set aside, and trade mark registration no. 2445688 will be immediately reinstated to the Trade Marks Register;

b) Form TM8(N) filed in revocation no. 502508 will be admitted and served upon Harper Collins; and

c) Opposition no. 409940 and revocation no. 502508 will be consolidated.

COSTS

29. Although I make no award of costs at this stage, the matter of costs arising from this hearing will be assessed when the substantive issues between the parties are determined.

Dated this 1st day of November 2019

S WILSON

For the Registrar