

**O-742-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF A JOINT HEARING HELD IN RELATION TO  
REGISTRATION NO. 3366221  
IN THE NAME OF LAVANT HOUSE STABLES LTD**

**AND**

**CANCELLATION THERETO UNDER NO. 502559 BY  
MRS LUCY THOMSON**

## Background

1. Registration no. 3366221 is for the trade mark **Lavant House Stables**. It was applied for on 10 January 2019 and entered in the register on 29 March 2019. It stands registered for services in classes: 39, 41 and 44 in the name of Lavant House Stables Ltd (“the proprietor”).

2. On 8 April 2019, Mrs Lucy Thomson (“the applicant”) filed a Form TM26(I). The cancellation, which is directed against all of the services in the registration, is based upon sections 3(6) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. Having amended the Form TM26(I) on a number of occasions in response to questions raised by the Tribunal, on 12 June 2019, the Tribunal served the amended Form TM26(I) on the proprietor. The letter contained the following paragraphs:

“If you wish to continue with your registration, you need to file a notice of defence and counterstatement by completing a Form TM8 - please note the important deadline below. You will find a blank Form TM8 on the IPO website, together with brief guidance on what happens after it is filed...

Rule 41(6) of the Trade Marks Rules 2008 require that you must file your notice of defence and counterstatement (Form TM8) within **two months** from the date of this letter.

**IMPORTANT DEADLINE: A completed Form TM8 MUST be received on or before 12 August 2019.**

In accordance with rule 41(6) if the TM8 and counter-statement are not filed within this period, (a period which cannot be extended), the registration of the mark shall, unless the registrar otherwise directs, be declared invalid in whole or part. **It is important to understand that if the deadline date is missed, then in almost all circumstances, the registration will be treated as invalid in whole or part.**”

4. On 19 August 2019, the Tribunal received an email from Natasha Olivant who describes herself as “Director Lavant House Stables Ltd, Classical Riding Academy Ltd”. That email, to which was attached a Form TM8 dated 28 June 2019 signed by Ms Olivant, contained the following:

“Thank you for your previous correspondence. Further to my submission and supporting documents of 28<sup>th</sup> June...”

5. In an official letter dated 5 September 2019, the Tribunal stated:

“I refer to the Form TM8 and counterstatement filed on 19 August 2019. It is noted that you refer to having filed it on 28 June 2019, but this has not been received by the registry. The Form TM8 has therefore been filed late.

The official letter dated 12 June 2019 informed you that if you wished to continue with your registration you should file a Form TM8 and counterstatement on or before 12 August 2019.

As no TM8 and counterstatement have been filed within the time period set, Rule 41(6) applies. Rule 41(6) states that:

“...otherwise the registrar may treat the proprietor as not opposing the application and registration of the mark shall, unless the registrar otherwise directs, be declared invalid.”

The registry is minded to treat the proprietor as not opposing the application for invalidation and declare the registration as invalid as no defence has been filed within the prescribed period.”

6. The proprietor was allowed 19 September 2019 to request a hearing and to provide a witness statement “setting out the reasons as to why the TM8 and counterstatement are being filed outside the prescribed period.”

7. On 19 September 2019, the Tribunal received an email from Ms Olivant. Attached to that email were two documents dated 16 and 18 September 2019 respectively. Both are in the form of letters in the name of Ms Olivant. Although the letter dated 16 September 2019 is headed “Natasha Olivant’s Witness Statement”, it does not contain a statement of truth (a point to which I will return later in this decision). The accompanying letter contained the following:

“1. Our original letter (with TM8 form) was sent at the end of June 2019 together with several high quality printed attachments, and would be most concerning and potentially irregular if there is no record of it having been received. We would appreciate it if this could be re-checked, and ensure it has not simply gone missing or perhaps been assigned to a different case.”

8. The document headed as a witness statement reads as follows:

“I hereby wish to make the following witness statement:

1. I did not receive any TM26 form by email.

2. I did not receive a TM26 form by post until some time after the date it should have been received by me. The TM26 form in question was opened (I understand) by the same competitor who is attempting to invalidate our trademark.

3. That (despite this irregularity) I dispatched an original TM8 form by Royal Mail at the end of June 2019, and included several attachments including photographs of the 300 year old stables at Lavant House.

4. I sent a further email (having had no further reply from any party to the original TM8) on the 19<sup>th</sup> August 2019 - further showing our legitimate plans for this trademark.”

9. Having considered Ms Olivant’s explanation of events, on 16 October 2019, the Tribunal wrote to the parties stating:

“It is the preliminary view of the registry that the Registrar intends to admit the late filed Form TM8, serve it on the applicant and set the evidential timetable.

In reaching this decision the Registrar has acknowledged that the registered proprietor has clearly demonstrated its intention to oppose the invalidity application; that a TM8 was sent to the Tribunal but not received; that refusing to admit the defence would deny the registered proprietor an opportunity to defend the attack on its proprietary right; and the public interest in settling this dispute quickly and with minimum cost to the parties and the Tribunal.”

10. The parties were allowed until 30 October 2019 to request a hearing and, on 16 October 2019, the applicant requested a hearing.

### **The joint hearing**

11. A joint hearing took place before me, by telephone conference, on 6 November 2019. At the hearing, the applicant was represented by Mr Paul Hillier of Oval Law and the proprietor by Mr David Youngs, its Business Manager. Both parties filed skeleton arguments in advance of the hearing.

### **My directions following the hearing**

12. As I mentioned earlier, the document referred to as a “Witness Statement” did not include a statement of truth; that is an important omission. In a letter dated 7 November 2019, I wrote to Ms Olivant. The operative part of that letter read as follows:

“At the hearing, I asked Mr Youngs if there was any evidence available, proof of posting for example, to support your explanation of events i.e. that the original Form TM8 and associated documents were sent to the tribunal via the Royal Mail at the end of June 2019. While he doubted there was, he indicated that this information would be known to you. I also explained that the document sent to the tribunal dated 16 September 2019 and headed “Natasha Olivant’s Witness Statement” is incomplete, as it does not include a

statement of truth i.e. “I believe that the facts stated in this witness statement are true.”

### **What happens now?**

With the above in mind, you are now allowed **seven days from the date of this letter to provide a correctly filed witness statement including a statement of truth** and, if any supporting evidence is available to corroborate your explanation of events, to include such evidence as an exhibit(s) to your statement. Any amended witness statement filed (whether with supporting evidence or not), is to be copied to the applicant who is **then allowed seven days from its receipt of same in which to comment.**”

### **The proprietor’s response**

13. In an email dated 17 November 2019 (copied, as directed, to Mrs Thomson), Ms Olivant provided an amended copy of the document (described by me at paragraph 8 above) but which included the additional sentence: “I believe that the facts stated in this witness statement are true.” Insofar as the document was filed after the seven day period allowed by me in my letter of 7 November 2019, Ms Olivant explained she “was not able to attend to this sooner” because she had “been off sick.” In her covering email, Ms Olivant further explained:

“I did not send the original documents recorded delivery. I have rarely had a problem with post getting through (apart from inbound post to us going astray sometimes now!)...”

14. In line with my directions mentioned above, the applicant had until 25 November 2019 to comment upon the above. No comments were received from either the applicant or her professional representatives, Oval Law, either by the deadline set or prior to the issuing of this decision.

## Statutory provisions

15. The filing of a Form TM8 and counterstatement in cancellation proceedings is governed by rule 41 of the Trade Marks Rules 2008 (“the rules”). The relevant parts of which read as follows:

“41 (1) An application to the registrar for a declaration of invalidity under section 47 shall be filed on Form TM26(I) and shall include a statement of the grounds on which the application is made and be accompanied by a statement of truth.

...

(5) The registrar shall send a copy of Form TM26(I) and the statement of the grounds on which the application is made to the proprietor.

(6) The proprietor shall, within two months of the date on which a copy of Form TM26(I) and the statement was sent by the registrar, file a Form TM8, which shall include a counter-statement, otherwise the registrar may treat the proprietor as not opposing the application and registration of the mark shall, unless the registrar otherwise directs, be declared invalid.”

16. Rule 41(6) appears in Schedule 1 to the rules and is not extendable except in very limited circumstances. Rule 77(5) reads:

“77(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.”

17. The Form TM26(l) was served upon the proprietor on 12 June 2019 by both Royal Mail “Signed for” delivery and email to the address for service held on the official record. Although there appears to have been a delay in the proprietor receiving the letter sent by post and a suggestion that the email sent by the Tribunal may have been intercepted by “an active spam/anti-virus system”, there has been no error on the part of the registrar.

### **Considerations**

18. The deadline to file the Form TM8 was set in the official letter of 12 June 2019. It indicated that a completed Form TM8 “must be received on or before 12 August 2019.” As my background details show, when a proprietor fails to file a Form TM8 in the period allowed, it is the Tribunal’s practice to issue a further letter indicating that as no defence has been received, the registrar is minded to declare the registration invalid. The proprietor is then allowed a further short period in which to request a hearing and, to explain in a witness statement, why the registrar should not adopt that course of action. In my experience, it is the issuing of the official letter following the expiry of the period allowed to file a Form TM8, that leads to the majority of requests for a late defence to be admitted and for proceedings to continue. That, however, is not the case here. As Mr Youngs correctly pointed out at the hearing, the proprietor had been proactive.

19. In these proceedings it was the proprietor who contacted the Tribunal. In her email of 19 August 2019 (i.e. seven days after the official deadline had expired), Ms Olivant provided a Form TM8 signed by her and dated 28 June 2019. In that email, she referred to her: “submissions and supporting documents of 28<sup>th</sup> June” and she provides the Tribunal with what she describes as an update on “commercial activity under this trade mark in the last six weeks...”. Ms Olivant also asked for an update on when the cancellation action may be resolved.

20. Further, in her letter dated 18 September 2019, Ms Olivant explained:

“Our original letter (with TM8 form) was sent at the end of June 2019 together with several high quality printed attachments...”



and, in the document headed "Witness Statement" (which is now accompanied by a statement of truth), she further stated that she:

"dispatched an original TM8 form by Royal Mail at the end of June 2019, and included several attachments including photographs of the 300 year old stables at Lavant House."

## **Decision**

21. Despite the apparent problems associated with the receipt by the proprietor of the Tribunal's original letter of 12 June 2019 which was sent by both post and email, it appears that by the end of June 2019 (and most likely 28 June 2019 given the date on the Form TM8), Ms Olivant had prepared and then sent to the Tribunal (by Royal Mail) a Form TM8 and a number of associated documents. Although Ms Olivant has no supporting evidence to corroborate her explanation, her various statements are consistent with one another and her witness statement in this regard is now accompanied by a statement of truth.

22. Thus having sent the documents to the Tribunal by Royal Mail at the end of June 2019 and, as the Tribunal has confirmed it never received them, it appears that something went wrong after Ms Olivant had handed the documents over to the Royal Mail.

23. Rule 76 reads as follows:

"Delays in communication services

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

(2) Any extension under paragraph (1) shall be -

(a) made after giving the parties such notice; and

(b) subject to such conditions,  
as the registrar may direct.

(3) In this rule “communication service” means a service by which documents may be sent and delivered and includes post, facsimile, email and courier.”

**24. In my view, the circumstances described above justify invoking the provisions of rule 76 in the proprietor’s favour and, in so doing, the time limit for the filing of the Form TM8 is extended until 19 August 2019 i.e. the date the Form TM8 was received by the Tribunal.**

#### **Next steps**

25. The Casework Examiner will scrutinise the Form TM8 and, subject to its acceptability, will admit it into the proceedings, serve it upon the applicant and set an evidential timetable.

#### **Possibility of an amicable settlement**

26. At the hearing, both representatives indicated they would seek instructions as to whether meditation or negotiations towards an amicable resolution of this dispute were realistic options. Should this be the case, the parties should advise the Tribunal at the earliest opportunity, as to do so, may result in savings in time and costs for all concerned.

**Dated this 4<sup>th</sup> day of December 2019**

**C J BOWEN**

**For the Registrar**