

**O-158-20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF A JOINT HEARING HELD IN RELATION TO  
APPLICATION NO. 3418011  
IN THE NAME OF MAMMOTH SPORT LTD**

**AND**

**A REQUEST TO OPPOSE UNDER NO. 419009 BY  
YOSEMITE RESEARCH LLC**

## BACKGROUND

1. Application No. 3418011 is for the trade mark **MAMMOTH**. It was applied for on 31 July 2019 in relation to a range of goods and services in classes: 9, 10, 20, 24, 35, 41, 42, 44 and 45. It stands in the name of Mammoth Sport Ltd (“the applicant”) and was published for opposition purposes on 4 October 2019.

2. On 2 December 2019, Advokatfirman Vinge KB (“AV”) filed a Form TM7A (Notice of threatened opposition) on behalf of the putative opponent, Yosemite Research LLC (“Yosemite”), the effect of which was to extend the opposition period for Yosemite until 4 January 2020.

3. On 3 January 2020, AV filed a Form TM7 (Notice of opposition and statement of grounds) on behalf of Yosemite. The opposition, which is directed against all of the goods and services in the application, is based upon section 5(2)(a) of the Trade Marks Act 1994 (“the Act”) relying upon European Union Trade Mark (“EUTM”) no. 12399895 for the trade mark **MAMMOTH** for goods and services in classes 9, 38 and 42.

4. On 10 January 2020, the Tribunal wrote to AV stating:

“I refer to the TM7 filed on 3 January 2020 against the above application. Unfortunately, our finance department have confirmed that they did not receive the £100 bank transfer until 7 January 2020. Please note that while the form TM7 was received on 3 January 2020, the form is not deemed filed until the appropriate fee has been received.

Rule 4(2) of the Trade Marks Rule 2008 confirms that ‘Any form required to be filed with the registrar in respect of any specified matter shall be subject to the payment of the fee (if any) prescribed in respect of that matter by those rules.’

Application number 3418011 was published on 4 October 2019. The final date to file the TM7 along with the appropriate fee, taking into account the TM7a and the fact that the deadline fell on the weekend, was **6 January 2020**.

Therefore, as the fee was not received until 7 January 2020 your notice of opposition has been filed outside of the statutory period set in accordance with Rule 17(3).

In view of this there is no course available for your opposition to be launched against the application. The application will shortly proceed to registration. You may wish to take alternative action against the mark once the mark is registered. Your attention is drawn to the following link:

<https://www.gov.uk/government/publications/trade-marks-invalidation>

In view of this your fee of £100 will be refunded in due course.”

Yosemite was allowed until 24 January 2020 to comment upon the above approach.

5. On 16 January 2020, AV replied, stating:

“...We wish to draw your attention to the attached print out confirming that the bank transfer of the opposition fee was completed on the morning of 3 January 2020 at 09.58am GMT, three days prior to the opposition deadline. Please also note that the attached print out evidences the credit date to the UKIPO account as 6 January 2020, within the permitted time. As such, the opposition fee was transferred and received within the time frame set by the Office and in accordance with the Trade Mark Rules.

Further, any purported minor administrative delay in the fee reaching the UKIPO account should not prejudice the admissibility of our client's filing of its opposition. This is particularly so given that any delay (if it in fact occurred) was not foreseeable and outside of our control.”

6. In an official letter dated 17 January 2020, the Tribunal replied, stating:

“I refer to your email dated **16 January 2020** stating that the £100 fee for filing the TM7 receipts a credit date of **6 January 2020**.”

I can confirm that although the funds were deducted from the named account on that date the effective date that the office received the fees was **7 January 2020. Therefore it is the registry's view that the form is filed out of time.**"

7. Yosemite was allowed until 31 January 2020 to request a hearing, and in an email dated 17 January 2020, it asked to be heard.

### **The joint hearing**

8. A joint hearing took place before me, by telephone conference, on 11 February 2020. At the hearing, Yosemite was represented by Messrs. Lindvall and Leander of AV. As required, AV filed a skeleton argument in advance of the hearing. It was accompanied by a witness statement from Mr Leander, accompanied by five exhibits. Although the applicant was not represented at the hearing, in a letter dated 31 January 2020, its professional representatives, Keystone Law, filed written submissions supporting the approach the Tribunal had adopted.

9. Yosemite's position is summed up by the following paragraphs which appear in its skeleton argument:

"17. In conclusion, the Opponent's position can be summarised as follows:

(a) In the absence of actual evidence from the Office (bank records, as opposed to a simple statement made in correspondence) attesting to the date on which the opposition fee was credited, there is nothing to disprove/contradict the facts averred by the Opponent. The Opponent has supplied banking records demonstrating that the Office's account was credited prior to the expiry of the opposition period. It is therefore incumbent on the Office to rebut the Opponent's factual position by producing evidence of its own. Failure to do so means that the factual position relied upon by the Opponent cannot be challenged;

(b) In the alternative, should the Office be able to produce evidence that at least gives rise to an ambiguity concerning the accuracy of the parties'

banking records, the UKIPO should consider the matter on its facts, which demonstrates that the Opponent took all reasonable and appropriate steps, not just to pay the fee in time, but also to ensure it had been paid in time. Therefore, there was nothing more the Opponent could have done to advance payment within the permitted time, which should permit the Office to exercise its discretion and thus deem the payment of the opposition fee to have been made in time.”

### **My letter following the hearing**

10. On 12 February 2020 I wrote to AV. The operative parts of that letter read:

“Having considered your written and oral submissions, I explained that investigations with the UKIPO’s Finance Section had revealed that the bank charged with paying the official fee had used the payment method known as BACS (Bankers Automated Clearing Services). I am further advised that payments made using this method take three working days and not “2 banking days” as mentioned in paragraph 5 of the skeleton argument.

This advice is consistent with the “Credit Advice Details” (a copy of which is attached) which confirms that the official fee of £100 was not received by the UKIPO until 7.04am on 7 January 2020 which, as I explained, is the “effective date”.

Thus as matters stand, the preliminary view expressed in the official letter of 17 January 2020 is maintained.

The putative opponent is now allowed a **period of 7 days from the date of this letter** to review the document provided and to comment upon it. Any comments the putative opponent elects to file must be copied to the applicant, who **is allowed 7 days from receipt of same** to consider providing any comments in reply.

At the conclusion of those periods, I will review the matter and issue a decision, which, as I explained, will be open to appeal.”

11. As Yosemite elected not to respond to that invitation either by the deadline set or prior to the issuing of this decision, I now give my reasons for the approach adopted.

## **DECISION**

12. The relevant statutory provisions are as follows:

### **The Trade Marks Act 1994**

“38 (1) When an application for registration has been accepted, the registrar shall cause the application to be published in the prescribed manner.

(2) Any person may, within the prescribed time from the date of the publication of the application, give notice to the registrar of opposition to the registration. The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.”

“79(1) There shall be paid in respect of applications and registration and other matters under this Act such fees as may be prescribed.”

“80 (1) The registrar may give directions specifying the hours of business of the Patent Office for the purpose of the transaction by the public of business under this Act, and the days which are business days for that purpose.

(2) Business done on any day after the specified hours of business, or on a day which is not a business day, shall be deemed to have been done on the next business day; and where the time for doing anything under this Act expires on a day which is not a business day, that time shall be extended to the next business day.

(3) Directions under this section may make different provision for different classes of business and shall be published in the prescribed manner.”

#### **The Patent Office website contains the following directions:**

##### **“Weekends and bank holidays**

The office is deemed to be closed on weekends, Good Friday, Christmas Day and all England and Wales bank holidays for all types of business, except for the filing of new applications not claiming priority. If documents are filed for these types of business at times when the office is deemed to be closed, they will receive an official filing date of the next working day.

Any official time period which expires on a weekend or any other day on which the office is closed is extended to the next working day.”

#### **The Trade Marks Rules 2008**

“4(1) The fees to be paid in respect of any application, registration or any other matter under the Act and these Rules shall be those (if any) prescribed in relation to such matter by rules under section 79 (fees).

(2) Any form required to be filed with the registrar in respect of any specified matter shall be subject to the payment of the fee (if any) prescribed in respect of that matter by those rules.”

#### **The Trade Marks Fees Rules 2008**

“1(2) These Rules shall be construed as one with the Trade Marks Rules 2008...

2.(1) The fees to be paid in respect of any matters arising under the Act and the 2008 Rules shall be those specified in the Schedule to these Rules.

(2) In any case where a form specified in the Schedule as the corresponding form in relation to any matter is specified in the 2008 Rules, that form shall be accompanied by the fee specified in respect of that matter (unless the 2008 Rules otherwise provide).”

## Decision

13. Although mentioned earlier, for the sake of convenience, the relevant chronology is as follows:

**4 October 2019** – the trade mark application is published for opposition purposes;

**2 December 2019** – AV files Form TM7A on behalf of Yosemite; opposition period extended to 4 January 2020. As 4 January 2020 was a Saturday, under the provisions of section 80 of the Act and the UKIPO’s published directions, the period in which to file opposition is extended to Monday 6 January 2020;

**Friday 3 January 2020** – AV files Form TM7 which, in this case, attracts an official fee of £100;

**10 January 2020** – the tribunal advises AV that the official fee was not received until 7 January 2020;

**16 January 2020** – AV provides a copy of a document headed “**Search Payments**” obtained from the bank charged with making the relevant payment on its behalf and which contains a range of entries including: “**Currency** GBP, 100”, “**Credit date** – 2020-01-06”, “**Ben. name and address** – Intellectual Property Office”, “**Details of payment** – Notice of Opposition regarding trademark no. 3418011” and, under the heading “**Signing Process**”, there appears 3 sub-headings i.e. “Registration”, “Signed” and “Countersigned.” All the entries contain references to “2020-01-03” with the final entry reading “2020-01-03 10.58.26”;



**17 January 2020** – the tribunal advises AV that although the funds “were deducted from the named account [on 6 January 2020] the effective date that the office received the fees was 7 January 2020...”

**12 February 2020** – AV are provided with a “Credit Advice Details” obtained from the UKIPO’s financial system in relation to the transaction in question. Under the heading “Date & Time Received”, it indicates that the official fee of £100 was received at “07/01/2020 07.04.00”. AV were also advised that investigations undertaken by the UKIPO’s Finance Section confirmed that the bank transfer which was initiated on 3 January 2020 was completed using the BACS (Bankers Automated Clearing Services) method which takes 3 working days and excludes, inter alia, weekends.

#### **Yosemite’s argument - (a) above**

14. AV filed a Form TM7A to extend the opposition period from two to three months from the date the application was published. In order to constitute a properly filed opposition, Yosemite had until 6 January 2020 to file a Form TM7 together with the appropriate fee. AV filed the Form TM7 on 3 January 2020 and the process to pay the official fee was initiated on the same date.

15. In its skeleton argument AV stated:

“5. In particular, the finance department of the Opponent’s representative’s, Vinge, completed the payment instructions and its request to make payment from a debit account with account number...to the UKIPO account at 09:58 GMT on 3 January 2020. The method of instruction was completed via an online form and banking system at the Corporate & Institutional Services Online portal via the Opponent’s representative’s bank...which, following submission of the form to...Vinge received confirmation of the payment instructions, which provided a guarantee that the transfer was in process and that the transfer, according to...bank procedures, would credit the recipient’s account within 2 banking days.”

16. Although the bank charged with making the payment “guaranteed” to AV that the payment “would credit the recipients account within 2 banking days”, it elected to make the payment using the BACS method which takes 3 working days and does not include weekends. Having initiated the transfer on a Friday i.e. the first day, Monday 6 January 2020 became the second day and the transfer was completed on Tuesday 7 January 2020 i.e. the third day. That is consistent with the timing of BACS payments and with the “Date & Time Received” information contained in the “Credit Advice Details” provided by the UKIPO. As a consequence, the “effective date” became 7 January 2020. It is also consistent with the comments of the Hearing Officer in BL-O-132-16 which AV referred to in its skeleton argument i.e.

“22. Whilst a cheque is regarded as payment, a bank transfer is not. It is an instruction given to a bank to pay a sum in the recipient’s bank account. It is not regarded as a ‘payment’ until the funds are actually cleared into the recipient’s bank account. Although there is no clear provision to this effect in the Trade Mark Directive, a similar position is outlined in the Community Trade Mark Fees Regulation at Articles 5(1)(a) and 8(1)(a), which state that in relation to fees paid by payment or transfer to a bank account held by the Office “the date on which payment shall be considered to have been made to the Office” is “the date on which the amount of the payment or of the transfer is actually entered in a bank account held by the Office”. (both are my emphasis).

17. In my view the information provided to AV mentioned above proves conclusively that although the Form TM7 was filed in good time and the initiation process to pay the official fee began on 3 January 2020, as the official fee was not received by the UKIPO until after the opposition period had expired, Yosemite’s request to oppose cannot be accepted.

#### **Yosemite’s argument - (b) above**

18. In its skeleton argument, AV also referred me to the decision of the Appointed Person, Ms Amanda Michaels, in BL-O-052-18 in which she stated:

“16. The Hearing Officer also rejected the Proposed Opponent’s submission that the FS2 form should have carried a warning about the use of bank transfers, saying at paragraph 24 “The responsibility lies with a putative opponent to satisfy itself that it has done everything that needs to be done in order to meet the requirement of filing a notice of opposition within the prescribed period which necessarily includes satisfying itself that it has paid the fee on time.”

19. Of this extract AV states:

“15. This is an important extract from this decision. The Hearing Officer is clearly attempting to strike a balance. This balance comprises the strict approach of the Office as to receipt of opposition fees within the prescribed time, but also acknowledging that in reality there are instances in which a proposed opponent has taken all reasonable steps and discharged its obligations in attempting to pay the fee in time. Clearly, there will be instances that are unique where the Office should be able to accept that the Opponent was simply unable to do any more in those particular **unique circumstances**.

16. Indeed, not to have in place such a carve-out in exceptional circumstances **based on clear and compelling facts and evidence** would lead to an impossible commercial reality for other parties wishing to file an opposition. It is simply not possible in many instances for clients to decide to take action and subsequently instruct solicitors to pay opposition fees up to a week or more before a deadline, just in case there is an unforeseeable delay outside of the control of the paying party. Indeed, **instances such as these are rare**, namely where banking reports inform the proposed opponent that a fee has been credited to the UKIPO account, only to be told later by the recipient of the funds that the banking report was incorrect. As such, a finding in favour of the Opponent in this instance is entirely reasonable and does not materially depart from the principle that an opposition fee must be received and credited to the UKIPO account within time.”

20. While I have some sympathy with AV's position, it appears that the "guarantee" it was given as to the timing of the payment may have been incorrect. I have no discretion in this matter and so cannot accede to AV's request. Although the approach I have adopted may appear draconian, in reality, any prejudice Yosemite may suffer as a result of my decision, will, at best, be slight. That is because as was pointed out in the official letter of 10 January 2020, Yosemite has an alternative remedy available to it i.e. as an applicant in a cancellation action following registration of the trade mark at issue.

#### **Overall conclusion and further action**

**21. Subject to any successful appeal, application no. 3418011 will proceed to registration and, as indicated in the official letter of 10 January 2020, the official fee of £100 will be refunded.**

**Dated this 11<sup>th</sup> day of March 2020**

**C J BOWEN  
For the Registrar**