

O-255-20

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO 3418048
IN THE NAME OF JIANGSU 4MONSTER INDUSTRIAL CO., LTD
TO REGISTER**

4monster 

**AS A TRADE MARK IN CLASSES 18 & 24
AND
THE LATE FORM TM8 AND COUNTERSTATEMENT
FILED IN DEFENCE OF THAT APPLICATION
IN OPPOSITION PROCEEDINGS (UNDER NO. 418423)
LAUNCHED BY
MONSTER ENERGY COMPANY**

Background

1. On 1 August 2019, Jiangsu 4monster Industrial Co., Ltd (“the applicant”) applied to register the mark set out on the title page in classes 18 and 24.
2. The application was published for opposition purposes on 16 August 2019. Further to the filing of Form TM7a (Notice of threatened opposition) on 15 October 2019, a Form TM7 (Notice of opposition) was subsequently filed on 15 November 2019 by Monster Energy Company (“the opponent”) under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).
3. The Form TM7 was served on the applicant on 19 November 2019 setting a deadline of 20 January 2020 for the filing of Form TM8 and counterstatement. On 31 December 2019, the IPO received a Form TM33 appointing IPEY as the new representatives for the applicant. The Tribunal case worker wrote to IPEY on 3 January 2020 confirming its appointment and enclosing all previous correspondence.
4. No Form TM8 and counterstatement for these proceedings was received on or before 20 January 2020. The Tribunal wrote to the opponent on 30 January 2020 in the following terms,

“...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 13 February 2020. 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.”

5. On 30 January 2020, the Tribunal received an email from IPEY stating,

“[...] could you please check your records because the TM8 and counterstatement were filed at the same time as the TM33 and you evidently received that as you have written to us in place of the previous agent. All the aforesaid documents were posted to you under cover of our letter of 15 December 2019.”

6. The Tribunal did not respond to this email and IPEY emailed again on 10 February 2020 asking that its email of 30 January 2020 be reviewed. The Tribunal responded on 10 February 2020 stating the following,

“According to our record although the TM33 is dated 15 December 2019, it wasn’t received in the Office until 31 December 2019. There is no record on file of the TM8 and Counterstatement or the cover letter you refer to in your email of 30 January 2020.

A further 14 days is allowed from the date of this letter, that is on or before **24 February 2020**, for the applicant to provide a Witness Statement setting out the reasons why the TM8 and counterstatement are being filed outside of the proscribed period. You may wish to include any evidential content that shows the documents were sent on 15 December 2019.”

7. The Applicant subsequently wrote to the Tribunal on 22 February 2020 enclosing a Form TM8 and counterstatement dated 26 November 2019, a copy of the covering letter dated 15 December 2019, a witness statement setting out reasons for the late filing of the Form TM8 in the name of Ms Xuesong Yang of IPEY and one annexed exhibit. The Form TM8 and counterstatement were stated by Ms Yang to be exact copies of those sent to the IPO on 27 December 2019. As can be seen from the first extract below the cover letter refers to Opposition no. 418423, but the second extract below from the Form TM8 refers to a different opposition number, namely Opposition

no. 418176, a different application number and a different applicant name. The third extract is taken from the header of the counterstatement which references both opposition numbers.

Extract 1:

UK Intellectual Property Office
Concept House
Cardiff Road
Newport
Gwent
NP10 8QQ

15 December 2019

Our ref: BJWB-1

Dear Sirs

Trade Mark Application No. 3418048

**Applicant: Jiangsu 4monster Industrial Co.,Ltd. – 4Monster (Figurative) – Classes 18 and 24
and**

Opposition No. 418423 by Monster Energy Company

We are filing herewith:

Form TM33 to appoint ourselves as representatives on the above Application; and

Form TM8 and a Counterstatement in connection with Opposition No. 418423.

Yours faithfully,

IPEY

IPEY – Representatives for the Applicant

Extract 2:

Form TM8

Notice of defence and counterstatement

No Fee

Use this form if your trade mark has been opposed or subject to cancellation proceedings and you want to defend your application or registration.

1. Trade mark number <small>If the defence concerns an International Registration, help us identify the correct case by adding "IR"</small>	3413495
2. Opposition / Cancellation number <small>Enter the opposition or cancellation number in the relevant field</small>	
Opposition number	OP000418176
Cancellation number	
3. Name of applicant/registered owner	Xiamen Light Wine Co., Ltd.

Extract 3:

TRADE MARKS ACT 1994

IN THE MATTER OF
Application No. 3418048 by
Jiangsu 4monster Industrial
Co.,Ltd. to register
4Monster (Figurative) in
Classes 18 and 24

and

IN THE MATTER OF
an Opposition 418176 thereto
by 418423 by Monster Energy
Company

COUNTERSTATEMENT

8. Furthermore the declarant's witness statement was also headed up with reference to the two opposition numbers, as per the extract below.

Extract 4:

TRADE MARKS ACT 1994

IN THE MATTER OF
Application No. 3418048 by
Jiangsu 4monster Industrial
Co.,Ltd. to register
4Monster (Figurative) in
Classes 18 and 24

and

IN THE MATTER OF
an Opposition 418176 thereto
by 418423 by Monster Energy
Company

WITNESS STATEMENT

I Xuesong Yang of 47 Drysgol Road, Radyr, Cardiff, CF15 8BS, United Kingdom, do solemnly and sincerely declare as follows: -

9. The witness statement sets out the detail around the instructions Ms Yang received from Chinese associates regarding preparing a defence for opposition no. 418176.

The dates mentioned, being 26 November and 9,15, 26 and 27 December 2019 do not make sense in the timeline for opposition no.418176 as a valid Form TM8 and counterstatement had already been filed in those proceedings on 26 November 2019. The Exhibit XY-1 annexed to the witness statement consists of an email exchange dated between 9-15 December 2019 to and from IPEY and its Chinese associates relating to the filing of a Form TM8 and counterstatement, but no opposition numbers are referenced. None of the attached documents referred to in the email exchange were provided as part of the exhibit. For the sake of clarity, I reproduce the details of the subject title and attachment detail, with English translation, in the extract below.

Extract 5:

From: IPEY - UK & European Patents & Trade Marks <mail@ipey.co.uk>
Sent: 15 December 2019 14:18
To: '北京五邦知识产权'; Xuesong Yang
Subject: RE: 北京五邦知识产权代理有限公司 潘晓双 来函 Our Ref: BJWB-1
Attachments: Counterstatement.doc; TM8.pdf; TM33.pdf; 15.12.2019 letter to UKIPO.docx

Case from Beijing Wuobang IP Agent limited Xiaoshuang Pan Our Ref : BJW

晓双:

10. It appears from this extract that IPEY did not use a UK Opposition number as a reference but instead used its own internal reference number. Ms Yang states that following receipt of confirmation to proceed from the Chinese associates, she had prepared the Form TM8 and counterstatement attached to her witness statement, with a Form TM33 and cover letter and had sent the documents to the IPO on 27 December 2019 but was unable to use the Royal Mail Signed For® service due to issues with the Post Office computer systems. Ms Yang further states that “the allegedly missing documents must have become erroneously separated from the TM33 upon receipt at the UKIPO”.

11. The discrepancies regarding opposition numbers, applicant details and dates were pointed out by the opponent in its response dated 27 February 2020.

12. A further email was received from IPEY on 1 March 2020 apologising for the oversight and attaching a Form TM8 referencing the current opposition proceedings.

IPEY states in its email that the corrected Form TM8 is the attachment sent in draft to its Chinese associates in the email thread set out in Exhibit XY-1. But as previously outlined, the attachment to the email exchange was not presented with the witness statement or Exhibit XY-1.

13. Following receipt of IPEY's email, the Tribunal issued a preliminary view on 3 March 2020 stating that the Form TM8 dated 1 March 2020 and counterstatement dated 22 February 2020 should be admitted into the proceedings and that if either party wished to challenge that preliminary view then a hearing should be requested.

Hearing

14. A hearing took place before me by telephone conference on 14 April 2020. Prior to this the Tribunal wrote to the parties on 30 March 2010 setting out the hearing details, and stating that,

"In line with the Tribunal Practice Notice TPN 1/2004, the Trade Marks Registry will require all parties professionally represented at hearings to submit a skeleton argument. Please see Annex A for guidance on skeleton arguments. Please note that Annex B is a list of authorities readily available to the hearing officer therefore if referred to by either party, copies are not required.

Skeleton arguments should be received by **14.00, 2 working days** before the hearing. **That is on or before Thursday 9 April 2020"**

15. The opponent filed skeleton arguments by the deadline set out in the Tribunal letter. The applicant did not submit formal skeleton arguments, but submitted by email what were referred to as "factual observations" at 20:30 on 9 April. These observations are set out in full below,

"We were a bit confused by your letter dated 30 March 2020, where it said *"Skeleton arguments should be received by 14.00, 2 working days before the hearing. That is on or before Thursday 9 April 2020"*.

Because of public holidays on Friday 10 and Monday 13 April 2020, 2 working days before is, by our calculation, Wednesday 8 April 2020. However, as you conversely stated, “on or before Thursday 9 April 2020”, in the next sentence, we assume anything filed on Thursday 9 April 2020 would seem acceptable instead as no time was specified on that day.

We don't have any *arguments* as such but offer the following factual observations, which are probably self-evident anyway.

In this case, the UKIPO rightly accepted (in their letter dated 3 March 2020) that we did file the TM8 and Counterstatement with the TM33 that was received on 31 December 2019. We maintain that the TM8 (bearing the correct details as per our email of 1 March 2020) was filed with a Counterstatement (bearing the correct details apart from in heading) and the TM33 which was received on 31 January 2020.

We responded to the UKIPO letter dated 30 January 2020 by email on 30 January 2020 and again on 10 February 2020 asking for the UKIPO to check their records because the TM8 was posted with a Counterstatement and the TM33 in time. The UKIPO then issued a letter dated 10 February 2020 stating “*A further 14 days is allowed from the date of this letter, that is on or before, 24 February 2020, for the applicant to provide a Witness Statement setting out the reasons as to why the TM8 and Counterstatement are being filed outside of the prescribed period. You may wish to include any evidential content that shows the documents were sent on 15 December 2019*”: a Witness Statement and evidence was duly filed in time (on 22 February 2020) erroneously along with a TM8 pertaining to another opposition and with the correct Counterstatement. Since, the letter dated 10 February 2020 solely asked for a Witness Statement (not a TM8), the fact that the correct TM8 was sent after 24 February 2020 (by email on 1 March 2020) is of no consequence because the requested Witness Statement was filed in time.

We believe that the UKIPO interpreted the Rules correctly: Rule 18(2) states that the application: “.....shall, **unless the registrar otherwise directs**, be treated as abandoned.”

16. I note the applicant states it was confused by the Tribunal’s deadline. However I do not believe that the letter is ambiguous in its direction and it clearly states the time and date, i.e. 14.00 on 9 April 2020, that the skeleton arguments are expected by. This is emphasised by the use of the words “**that is on or before 9 April 2020**”. Furthermore, there seems to be a misunderstanding on the part of the applicant that there are no consequences to the late filing of the Form TM8 simply because the witness statement was filed by the set deadline. This is not the case. If a Form TM8 is not filed by the deadline given when the Form TM7 is served then a short period of time is given to explain why the deadline was missed by means of a witness statement. It is not to be regarded as a further delay to filing the Form TM8.

17. At the hearing the applicant was represented by Ms Xuesong Yang of IPEY and Ms Christine Danos of Bird & Bird LLP represented the opponent.

18. Ms Yang began by referring to the Form TM8 and counterstatement filed on 27 December 2019. She acknowledged that the Form TM8 had been “badly edited” and contained references to opposition no. 418176 but that the counterstatement correctly referenced these current proceedings for opposition no. 418423. In fact as can be seen from Extract 3 above, the counterstatement header contains both opposition numbers although I accept that the main body of text refers to the marks in the current opposition proceedings. Ms Yang offered her apologies for the error in giving the wrong opposition number but maintained that the covering letter and TM33 were correctly referenced for these proceedings. Furthermore, she believes that the benefit of the doubt should be given to her client and that the case should proceed to decision on the substantive merits of the case. In response to Ms Yang’s submission regarding the referencing of the documents sent to the IPO, and for the sake of clarity I explained the IPO’s document reception procedure of separating all document bundles in to their component parts for scanning and indexing so that each document is sent to the correct team for action, e.g. the Recordals team would receive the Form TM33 and the Tribunal team would receive the Form TM8 and each team would action the form

based on the details that were given, i.e. the application number and the opposition number.

19. In reply Ms Danos referred to her skeleton argument, along with a timeline of events (Annex A to the skeleton) and set out her concerns that the applicant had been offered two opportunities to submit a witness statement, Form TM8 and counterstatement and had failed to do so correctly by those dates. She also pointed out that the applicant had continued to file documents relating to these opposition proceedings in February 2020 which contained discrepancies, i.e. the wrong opposition numbers. Ms Danos submitted that the applicant had filed the Form TM8 for the wrong set of opposition proceedings, namely No.418176 and not No.418423 and therefore it was not a Tribunal error as per Rule 77(5)(a) of the Trade Marks Rules 2008. Ms Danos also referred to the discretion accorded to the Registrar to allow late filed defences as being “narrow”¹ and subject only to “extenuating circumstances”² and “compelling reasons”³, which are set out in case law and to which I will return later in this decision. Ms Danos added that there were no such “extenuating circumstances” or “compelling reasons” in these proceedings as the evidence provided by the applicant was insufficient to allow the late filed defence to be admitted.

Decision

20. With regard to the late filing of a Form TM8, I must refer to Rule 18 of the Trade Marks Rules 2008 which states:

“(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.

¹ *Kickz AG v Wicked Vision Limited* BL-O-035-11

² *Ibid*

³ *Mark James Holland v Mercury Wealth Management Limited* BL O-050-12

(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.” (my emphasis)

21. 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.”

22. As has been previously stated, the Form TM8 filed on 27 December 2019 by IPEY did not refer to the current proceedings, namely opposition no.418423 but rather to opposition no.418176 which was for an entirely different applicant but who were also represented by IPEY. As that Form TM8 contained a reference to opposition no. 418176, it was scanned and indexed to that case number following normal IPO document reception procedure. As such, there has been no error on the part of the registrar or the Office, so therefore rule 77(5) is not relevant. As the opponent states in its skeleton arguments, Mr Geoffrey Hobbs QC sitting as the Appointed Person, in *Kickz*, held that the discretion conferred by rule 18(2) is a narrow one and can be exercised only if there are “extenuating circumstances”. In *Mercury*, Ms Amanda Michaels, also sitting as the Appointed Person, in considering the factors the Registrar should take into account in exercising the discretion under rule 18(2), held that there must be “compelling reasons”. Ms Michaels also 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 an opposition case) are:

- (1) The circumstances relating to the missing of the deadline including reasons why it was missed and the extent to which it was missed;
- (2) The nature of the opponent's allegations in its statement of grounds;
- (3) The consequences of treating the applicant as opposing or not opposing the opposition;
- (4) Any prejudice caused to the opponent by the delay;
- (5) Any other relevant considerations, such as the existence of related proceedings between the same parties.

23. To begin with the first *Music Choice* factor, I note that a correct Form TM8 was filed on 1 March so some 40 calendar days after the original deadline of 20 January 2020. In addition, I note the circumstances of the delay were that the original Form TM8 gave the wrong opposition number and was subsequently scanned and indexed to that particular opposition. The error was further compounded by IPEY's persistent reference to the wrong opposition number in the filing of the witness statement and copy Form TM8 dated 22 February before a correct version was submitted on 1 March. I find there was an intention to defend the current application, however it is also clear that IPEY were at fault in the filing of the defence because they did not record the correct details on the Form TM8. The explanation given by Ms Yang was that the Form TM8 dated 26 November 2019 was "badly edited" when it was initially completed in December for filing at the IPO. However, no explanation was provided as to why the wrong opposition number continued to be referenced in the witness statement of 22 February 2020.

24. Regarding the second *Music Choice* factor, the grounds of opposition were claimed under sections 5(2)(b), 5(3) and 5(4) of the Act, on the basis of five earlier UK and EU trade marks.

25. Turning to the third *Music Choice* factor, it follows that if discretion is exercised in its favour, then the applicant would have the opportunity to defend its trade mark and

it is likely a decision would be made on the merits of the case. Whereas if discretion is not exercised in its favour then the application would be deemed abandoned for want of a defence. The latter is clearly a serious consequence. In its skeleton argument, the opponent referred me to a previous Tribunal decision for the mark **RecruitMeNot** (opposition no.404250 and set out in Annex C to the skeleton), particularly paragraph 17 which states,

“It will always be the case that where a party to proceedings fails to file a defence resulting in an adverse decision from the Tribunal, the consequence will be the loss of some or all of the subject application/registration. This is not a sufficient reason in and of itself for a finding in the applicant’s favour, rather, it is a possible consequence and is one of the factors to be considered.”

I agree with the comments made above and will weigh the consequence for the applicant within the balance of the other factors I must consider.

26. Insofar as the fourth *Music Choice* factor is concerned, the opponent states in its skeleton arguments⁴ that it has suffered prejudice to the extent that,

“The opponent has an interest in the opposition being dealt with efficiently and expeditiously, and this has been prejudiced by the failure of the applicant to meet the deadline”.

27. Finally turning to the fifth *Music Choice* factor, there are no other related proceedings between the parties nor have I been made aware of any other relevant considerations.

Conclusion

28. Having addressed each of the relevant factors in *Music Choice*, I must now decide whether there are sufficient extenuating circumstances or compelling reasons to enable me to exercise my discretion. After careful consideration, my decision is

⁴ Paragraph 25

that the necessary reasons have not been made out. An incorrect opposition reference is an unfortunate and serious error but does not amount to either an extenuating circumstance or compelling reason in my view. I am mindful that the consequence for the applicant is that it will lose its application. However, I do not consider that this consequence offsets the less than compelling reason as to why the deadline was missed. The incorrect filing of the Form TM8 on 31 December 2019 and the continued reference to the wrong opposition number in the subsequent correspondence indicates that IPEY has perpetuated its own error by not recognising that they filed the defence on the wrong opposition number until the opponent pointed this out to them in its email of 27 February 2020. Whilst human error cannot always be avoided, it is pertinent to note that IPEY are professional trade mark practitioners and it is their role to ensure that all official forms are correctly completed before they are filed. To the extent that in these proceedings IPEY did not fulfil that function then in my view and echoing the comments made in *Kickz*, it has been “the author of its own misfortune” as it did not exercise the “minimal degree of vigilance” required to correctly meet the deadline set of 20 January 2020.

29. The late Form TM8 and counterstatement is not to be admitted into the proceedings. The application is treated as abandoned.

Costs

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

Official fee for the Notice of Opposition	£200
Preparing the Notice of Opposition	£300
Preparing for & attending the hearing	£500
Total	£1000

31. I order Jiangsu 4monster Industrial Co., Ltd to pay Monster Energy Company the sum of £1000. This sum is to be paid within 21 days of the expiry of the appeal

period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23rd day of April 2020

June Ralph

For the Registrar,

The Comptroller-General