

O/295/20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003429052

IN THE NAME OF MAANMOHAN SINGH

FOR THE FOLLOWING TRADE MARK:

ICE N BERG

IN CLASS 34

AND

THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT

IN DEFENCE OF AN OPPOSITION

UNDER NO. 418774

BY RYAN LORD

BACKGROUND

1. On 16 September 2019, Maanmohan Singh (“the applicant”) applied for the trade mark **ICE N BERG** (no. 3429052) in the UK. Registration is sought for the following goods:

Class 34 Electric cigarettes [electronic cigarettes]; Electronic cigarette atomizers; Electronic cigarette boxes; Electronic cigarette cartomizers; Electronic cigarette cases; Electronic cigarette cleaners; Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of flavourings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Electronic cigarettes; Electronic cigarettes for use as an alternative to traditional cigarettes; Refill cartridges for electronic cigarettes.

2. On 13 December 2019, Ryan Lord (“the opponent”) partially opposed the application based upon section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against only the goods underlined above.

3. On 3 January 2020, the Tribunal served the Form TM7 on the applicant by post and email at the addresses (both physical and email) provided by him. That letter contained the following paragraphs:

“Rule 18(1) and 18(3) 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. Alternatively, if both parties wish to negotiate to resolve the dispute, they may request a “cooling off period” by filing a Form TM9c [...]

IMPORTANT DEADLINE: A completed Form TM8 (or else a Form TM9c) MUST be received on or before 3 March 2020.

Rule 18(2) of the Trade Marks Rules 2008 states that “*where an applicant fails to file a Form TM8 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 directs otherwise, be treated as abandoned.*” **It is important to understand that if the deadline is missed, then in almost all circumstances, the application will be treated as abandoned.**”

4. No TM8 was filed by the applicant on or before 3 March 2020. On 5 March 2020, the applicant filed a Form TM33 appointing Lamb & Co as his representative in these proceedings. On 11 March 2020, the Tribunal wrote to the applicant as follows:

“I can confirm that the amended TM7 was served by email and Royal Mail Signed For delivery. The TM7 was delivered on 6 January 2020 at 2:58pm and signed for by SINGH.

The official letter dated **3 January 2020** invited the applicant to file a TM8 and counterstatement on or before **3 March 2020**.

[...] 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 a TM8 and counterstatement on, or before, **25 March 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.”

5. On 12 March 2020, the applicant’s representative responded to the Tribunal requesting a copy of the Tribunal’s email dated 3 January 2020 and a copy of the signed for delivery confirmation. These were duly provided on 16 March 2020.

6. Following a short extension of time to allow the applicant’s representative to obtain instructions in light of the current global pandemic, a Form TM8 was filed on 31 March

2020. This was accompanied by a witness statement from the applicant explaining why the deadline was missed. Having considered this explanation, in an official letter dated 3 April 2020, the Tribunal issued a preliminary view in which it (i) refused to exercise its discretion in favour of the applicant and (ii) allowed until 4 May 2020 for a hearing to be requested. On 8 April 2020, the applicant requested a hearing.

THE HEARING

7. A joint hearing took place before me, by telephone conference, on 28 April 2020. Mr John Lamb, of Lamb & Co attended on behalf of the applicant. Mr Lord represented himself. Mr Lamb filed a skeleton argument in advance of the hearing.

DECISION

8. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by rule 18 of the Trade Marks Rules 2008 (“the Rules”). The relevant parts read as follows:

“18. – (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.”

9. 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 rule 77(5) 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.”

10. There is no suggestion that there has been any irregularity on the part of the Tribunal. Consequently, the only basis on which the applicant may be allowed to defend the opposition proceedings is if I exercise in his favour the discretion afforded to me by the use of the words “unless the registrar otherwise directs” in rule 18(2).

11. In approaching the exercise of discretion in these circumstances, I take into account the decisions of the Appointed Person in *Kickz AG v Wicked Vision Limited* (BL O-035-11) and *Mark James Holland v Mercury Wealth Management Limited* (BL O-050-12) i.e. I have to be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the applicant’s favour.

12. In *Music Choice Ltd’s Trade Mark* [2005] RPC 18, the Court indicated that a consideration of the following factors (underlined below) is likely to be of assistance in reaching a conclusion as to whether or not discretion should be exercised in favour of a party in default. That is the approach I intend to adopt, referring to the parties’ submissions to the extent that I consider it necessary to do so.

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

13. As noted above, the Form TM7 was served by post at the address provided by the applicant. It is not disputed that the address used for service was the correct address. There is no suggestion that the address provided by the applicant is one that houses multiple businesses, such that it could have been delivered to the correct address, but the wrong recipient. Similarly, it is not disputed that the correct email address was

used for electronic service of the Form TM7. Rather, the applicant states in his evidence that he was abroad during January when this correspondence was sent and that, at the time, his premises were closed and emails were not being monitored. He states that he “did not return until later in January”.

14. Although the applicant states that his premises were closed at that time, the correspondence was signed for by ‘SINGH’ according to the Royal Mail delivery record. In this regard, the applicant states that the signature shown on this delivery receipt was not his and has provided a copy of his actual signature to demonstrate this. However, it is not clear who it was that did in fact sign for the letter and no trace of it can be found at the applicant’s premises.

15. The applicant also notes that sometimes emails with attachments (such as the Tribunal’s email in this case attaching the Form TM7) are directed to his junk mail box. The applicant explains that this email was not seen by him, and that his junk mail box was subsequently deleted.

16. The applicant was notified of the failure to file a Form TM8 by letter dated 11 March 2020. A Form TM8 was filed on 31 March 2020, following a slight delay caused by difficulties in obtaining instructions as a result of the current global pandemic.

The nature of the opponent’s allegations in its statement of grounds;

17. At the hearing, Mr Lamb drew my attention to the applicant’s case as set out in his Statement of Grounds. I have, of course, read these and am aware of the issues in the case. However, I note in his skeleton argument that Mr Lamb lists “the nature of [the applicants]’s allegations” as one of the factors to be considered. That is, of course, correct as the factors were stated in *Music Choice*. However, that was an application for invalidation. The present case is an opposition. Consequently, by analogy, it is the opponent’s allegations (rather than the applicant’s) that are relevant to my assessment.

18. The opposition is based upon section 5(4)(a), with the opponent relying upon earlier rights in the sign **ICENBERG** which he claims to have used throughout the UK

since August 2017 in relation to e-liquids for electronic cigarettes. I recognise that an opposition based upon section 5(4)(a) requires the filing of cogent evidence in support.

The consequences of treating the applicant as defending or not defending the opposition;

19. If the applicant is allowed to defend the opposition, the proceedings will continue with the parties given an opportunity to file evidence and the matter will be determined on its merits.

20. If, however, the applicant is not allowed to defend the opposition, his application will be deemed abandoned in respect of those goods against which this opposition is directed and he will lose his filing date of 16 September 2019. The application will, of course, proceed to registration for those goods that are unopposed. It will also remain open to the applicant to re-file his application for those goods against which this opposition is directed which may, in turn, be opposed again by the opponent.

Any prejudice caused to the opponent by the delay;

21. At the hearing, Mr Lamb noted that there had only been a very small delay and there did not appear to be any significant prejudice caused to the opponent. Mr Lord did not mention any particular prejudice at the hearing.

Any other relevant considerations such as the existence of related proceedings between the parties.

22. In relation to other relevant considerations, Mr Lamb directed me to the fact that he considered the opponent's Form TM7 to be defective. The issue raised by Mr Lamb was that this form did not appear to contain a representation of the sign relied upon by the opponent.

Conclusions

23. In reaching my decision, as noted above, I recognise that if the discretion is not exercised in the applicant's favour, the opposition will succeed and the applicant will lose his filing date in respect of those goods against which the opposition is directed. I further recognise that it may be that the applicant will simply re-file his application in respect of those goods and that this may, once again, be opposed by Mr Lord resulting in opposition proceedings arising at some point in the future. However, as the loss of priority and possibility of further proceedings on much the same basis is often the consequence of a failure to comply with the non-extensible deadline to file a Form TM8, these are not factors that, in my view, are particularly compelling.

24. I also recognise that it goes in the applicant's favour that there is no apparent significant prejudice to the opponent as a result of the delay. As noted above, Mr Lord did not make any submissions at the hearing to suggest otherwise.

25. I note that Mr Lamb has directed me to the reasons as to why the applicant considers the opposition should be unsuccessful, as set out in his Statement of Grounds. As noted above, it is the opponent's allegations that are the relevant factor in my assessment. However, an opposition based upon section 5(4)(a) requires the filing of cogent evidence in order to succeed.

26. With regard to the alleged defectiveness of the Form TM7 I noted at the hearing that the original form filed by Mr Lord was rejected for a number of reasons, one of which was the fact that it did not include a representation of the sign relied upon. Mr Lord was invited by the Tribunal to re-file his Form TM7 with these defects rectified. He duly did so and I note that the Form TM7 which was subsequently served upon the applicant includes the following handwritten information:

"ICENBERG THE BRAND WAS DESIGNED ON THE 18/08/2017.

I PURCHASED THE DOMAIN NAME VIA 12RGEN.CO.UK ON THIS DAY ALSO. IT IS REGISTERED TO ME PERSONALLY, RYAN LORD.

THE FIRST SALE OF THE BRAND ICENBERG WAS ALSO IN AUGUST 2017 AND IS RECOGNISED AS AN ESTABLISHED E-LIQUID BRAND. THIS

BRAND IS SOLD ON COUNTLESS WEBSITES ONLINE AND IN OUR 100 SHOPS IN THE UK. WE ALSO SELL THIS BRAND TO COMPANIES IN ITALY, SPAIN, DENMARK AND IRAQ.

THIS BRAND IS CLEARLY ADVERTISE [sic] ON MY WEBSITE WWW.EFINITYLABS.COM AND WE HAVE ALWAYS BEEN THE ORIGINAL MANUFACTURER + BRAND OWNER.

MAANMOHAN SINGH IS TRYING TO REGISTER A NAME WHICH IS IDENTICAL TO THE ONE I ALREADY OWN.”

27. At the hearing, Mr Lamb explained that he considered the Form TM7 to be defective because it merely contained a handwritten reference to the word ICENBERG rather than examples of the actual sign used, such as the form in which it is presented on products. I do not consider this line of argument to assist the applicant. There is no reason why an opponent should not be entitled to handwrite a Form TM7 if they wish to do so. Nor are they required to file evidence at the time of filing a Form TM7; the appropriate time to file such documents would be during the evidence rounds. Indeed, if the sign relied upon by the opponent is, essentially a word-only mark, I see no reason why the Form TM7 should be considered defective simply because it is handwritten rather than printed.

28. I sympathise with the applicant that he was out of the country when the Form TM7 was served and that, whoever it was that signed for the letter with the Royal Mail, did not pass it on to him. However, it seems to me that these circumstances arose largely from a failure on the part of the applicant to put in place a suitable system for monitoring both post whilst he was away and his junk mail box prior to its contents being deleted. It is clear to me from the applicant's evidence, that there was at least some awareness on his part, that there was a risk that emails with attachments may find their way into his junk mail box. The failure on the part of the applicant to have a system in place for the collection of mail whilst he was out of the country and/or to regularly review junk mail items before their deletion presented an inherent risk that important correspondence might be missed.

29. Notwithstanding the fact that there will be minimal prejudice caused to the opponent by the exercise of discretion, taking all of the above factors into account as

well as the submissions made by both parties, I do not consider that the reasons for failing to file the Form TM8 constitute extenuating circumstances or compelling reasons to enable me to exercise my discretion to admit the late filed TM8 and counterstatement into these proceedings.

30. My decision is not to exercise the discretion available under rule 18(2) in favour of the applicant. Subject to appeal, the application is deemed abandoned in respect of the following goods:

Class 34 Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of flavourings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin;

31. The application can proceed to registration in respect of the unopposed goods:

Class 34 Electric cigarettes [electronic cigarettes]; Electronic cigarette atomizers; Electronic cigarette boxes; Electronic cigarette cartomizers; Electronic cigarette cases; Electronic cigarette cleaners; Electronic cigarettes; Electronic cigarettes for use as an alternative to traditional cigarettes; Refill cartridges for electronic cigarettes.

COSTS

32. As my decision terminates the proceedings, I must consider the matter of costs. The opponent has, of course, been successful. As he is unrepresented, if he wishes to make a claim for costs, he will be required to file a costs proforma within 28 days of receipt of this decision, setting out the time spent and expenses incurred in bringing this opposition.

33. The applicant will have 28 days from receipt of the proforma in which to make written submissions regarding costs.

34. A supplementary costs decision will then be issued. The period for appeal against this decision will run from the date of the supplementary decision on costs.

Dated this 28th day of May 2020

S WILSON

For the Registrar