O-346-20

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. 3429892
IN THE NAME OF EMOJIES LTD
TO REGISTER

EMOJIES

AS A TRADE MARK IN CLASS 43
AND
THE LATE FORM TM8 AND COUNTERSTATEMENT
FILED IN DEFENCE OF THAT APPLICATION
IN OPPOSITION PROCEEDINGS (UNDER NO. 419168)
LAUNCHED BY
EMOJI COMPANY GMBH

Background

1. On 19 September 2019, Emojies LTD ("the applicant") applied to register the trade mark **EMOJIES** in class 43.

2. The application was published for opposition purposes on 18 October 2019. Further to the filing of form TM7a (Notice of Threatened Opposition) on 17 December 2019, a form TM7 (Notice of Opposition) was filed on 20 January 2020 by emoji company GmbH ("the opponent") against all services in the application under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") on the basis of its earlier EU trade mark no. 017995704 for the mark **emoji** registered in class 43.

3. The form TM7 was served on the applicant on 22 January 2020 by the Tribunal who set a deadline of 23 March 2020 for the filing of a Form TM8 and counterstatement.

4. No Form TM8 and counterstatement for these proceedings were received on or before 23 March 2020. Consequently, the Tribunal wrote to the applicant on 2 April 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, **04 May 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 1 May 2020, the Tribunal received a form TM33 to appoint Black Solicitors LLP as the applicant's representative and a witness statement stating why the Form TM8 and counterstatement were not filed within the specified deadline. The witness statement was dated 29 April 2020 and filed in the name of Mr Jiten Patel, an employee of the applicant company.

6. The Tribunal wrote to Black Solicitors LLP on 5 May 2020 acknowledging receipt of the above referenced documents and requesting the filing of Form TM8 and counterstatement so the witness statement could be considered. The Form TM8 and counterstatement were received by the Tribunal on 11 May 2020.

7. Following receipt of all the relevant documents, the Tribunal issued a preliminary view on 21 May 2020 stating that the reasons given in the witness statement were insufficient and the Form TM8 should not be admitted into the proceedings and if either party wished to challenge that preliminary view then a hearing should be requested by 18 June 2020.

Hearing

8. The hearing took place before me by telephone conference on 3 July 2020. The applicant was represented by Mr Yat Wong of Blacks Solicitors LLP whilst the opponent was represented by Mr Marijan Stephan Hucke of Hucke & Schubert. Both sides sent skeleton arguments in advance of the hearing.

9. Mr Wong began by stating that the applicant made two trade mark applications in September 2019. The first application was for a word and device mark (referred to as the "logo") being UK TM No.3427630. The second application for a word mark, being UK TM No.3429892, which is the subject of these proceedings. The applicant was unrepresented during the application process and also at the point it received the Notices of Opposition via forms TM7 on both of its applications. The applicant was served with two Notices of Opposition in relation to its logo mark on 14 January 2020 and served with a single Notice of Opposition regarding its word mark on 22

January 2020. As a relevant point of information, the opponent in these proceedings, emoji company GmbH, is one of the two opponents for the applicant's logo mark

10. Mr Wong further states that when the applicant appointed his firm as its legal representative, they were given instructions to deal with the opposition matters relating to its logo mark but not its word mark. However he drew my attention to the applicant's witness statement dated 29 April 2020 in which Mr Jiten Patel stated that he incorrectly believed that Blacks Solicitors had been instructed to deal with both the logo and word applications whereas in fact Blacks Solicitors had only received documentation related to the logo mark. Mr Patel further stated that the confusion was caused by the fact that emoji company GmbH was an opposing party in both cases and he overlooked entirely the deadline for the defence of the word mark believing that all matters had already been dealt with for both marks by Blacks Solicitors when in fact this was only the case for the logo mark. Mr Patel only realised this error when correspondence was received from the Tribunal dated 2 April 2020 informing him that no Form TM8 had been received for the word mark. Mr Wong stressed that his firm had acted promptly once the applicant had contacted them to ensure that all relevant documentation was filed with the Tribunal to consider the late admittance of the defence for the word mark.

11. In reply Mr Hucke referred to the discretion accorded to the Registrar under Rule 18(2) of the Trade Mark Rules 2008 ("the Rules") to allow late filed defences. Exercise of such discretion has been set out in case law as being subject to "extenuating circumstances"[1] and "compelling reasons"[2]. Mr Hucke added that he did not believe that either applied in these proceedings as the evidence provided by the applicant was insufficient, namely the applicant was confused and had misunderstood the opposition proceedings. In his view the applicant could have noted the deadline dates in a calendar or sought legal advice sooner than appears to be the case. Either way Mr Hucke stated that the reasons given were insufficient to allow the admittance of the late filed Form TM8.

[1] *Kickz AG v Wicked Vision Limited* BL-O-035-11
[2] *Mark James Holland v Mercury Wealth Management Limited* BL O-050-12

Decision

12. As referenced above, I refer to rule 18 of the Rules regarding the late filing of a Form TM8. This rule 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.
> (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)

13. 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."

14. There has been no error on the part of the registrar or the Office, so therefore rule 77(5) is not relevant. 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 when 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*[3], which provides guidance when exercising 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.

15. Taking the first Music Choice factor into account, I note that the Form TM8 was filed on 11 May which is 49 calendar days after the original deadline of 23 March 2020. The declarant on behalf of the applicant admitted in his witness statement that he found the trade mark application and opposition processes "complicated and confusing". Although he received three notifications of oppositions against the two trade mark applications, he was additionally confused because the opponent in these proceedings, emoji company GmbH, had also opposed the logo application. There was further misunderstanding on the part of the declarant when he mistakenly believed that instructions had been given to Blacks Solicitors to deal with both the logo and word mark oppositions when in fact instructions had only been given to deal with the logo mark. Mr Patel put this mistaken belief down to the presence of the same opponent in both cases.

16. Regarding the second *Music Choice* factor, the ground of opposition was claimed under sections 5(2)(b) of the Act, based on an earlier EU trade mark.

[3] *Music Choice Ltd's Trade Mark* [2006] R.P.C. 13

17. Turning to the third *Music Choice* factor, if discretion is exercised in its favour, then the applicant would have the opportunity to defend its trade mark and the proceedings would move to the evidence stage. Whereas if discretion is not exercised in its favour then the application will be deemed abandoned for want of a defence. This is a serious consequence, but this would be the same for all cases where an applicant fails to file a defence and receives an adverse decision from the Tribunal. Therefore the seriousness of such a consequence is not a sufficient reason in and of itself for finding in the applicant's favour, but rather it is one of the factors I must consider.

18. Insofar as the fourth *Music Choice* factor is concerned, Mr Hucke states in his supplemental skeleton argument[4] that that opponent has suffered prejudice due to the "extensive delay" in the filing of the defence. He also stated that the opponent had relied on the applicant to abandon its word mark, as it had admitted in the defence of its logo mark that the same word element therein was both visually and aurally similar to the opponent's earlier trade mark. However Mr Hucke has not stated if there were any consequences for the opponent because of this reliance.

19. Finally regarding the fifth *Music Choice* factor, and as has already been noted, the same parties are also engaged in opposition proceedings relating to the logo mark application, under opposition no. 418949.

Conclusion

20. Having addressed the relevant factors set out in the *Music Choice* criteria and having read the skeleton arguments and heard the submissions made by the parties, I now have to decide if sufficient extenuating circumstances or compelling reasons have been made out to enable me to exercise discretion in this matter. There has clearly been some considerable human error on behalf of the applicant in these proceedings. However in *Tescon*[5]*,* Mr Geoffrey Hobbs QC sitting as the Appointed Person held that,

[4] Paragraph 14
[5] *Praesidiad NV v Tescon Sicherheitssysteme Schweiz GmbH* BL O/240/20

> "There must, in other words, be a fact specific evaluation for the purposes of determining whether the particular error in question should or should not be treated as excusable in the circumstances of the case at hand."

21. In considering all the factors at play here, I do not find that the necessary reasons have been made out. I am alert to the consequence for the applicant that it will lose its application. However, the applicant received three Notices of Opposition in relation to its two trade mark applications. Each notice was accompanying by a Tribunal letter giving a deadline for the receipt of the Form TM8, therefore in my view the applicant was made aware of all the relevant dates by which it needed to act. I note the applicant's stated confusion regarding the opponent being the same in both applications. Notwithstanding the applicant's confusion, the Tribunal letters made clear which application number was being opposed and by whom. It is unfortunate that the applicant overlooked the relevant deadline in these proceedings because it believed the matter had already been addressed in instructions to its newly appointed legal representatives. However to echo the comments made by the Appointed Person in *Kickz,* the applicant does not appear to have exercised the "minimal degree of vigilance" required to correctly ensure that all the deadlines set out by the Tribunal letters relating to each of its applications had been correctly communicated when instructing its legal representatives.

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

Costs

23. As my decision terminates the proceedings, I must consider the matter of costs. Awards of costs are set out in Tribunal Practice Notice (TPN) 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	£100
Preparing the Notice of Opposition	£200
Preparing for & attending the hearing	£300
Total	**£600**

24. I order Emojies LTD to pay emoji company GmbH the sum of £600. This sum is to be paid within two months 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 9th day of July 2020

June Ralph
For the Registrar,
The Comptroller-General