

O/578/21

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001554110

DESIGNATING THE UNITED KINGDOM

IN THE NAME OF VENNER OY IN RESPECT OF THE TRADE MARK

Venner Nutrition

IN CLASSES 5, 9, 38, 39, 41, 43 AND 44

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 423974 BY

VENNERS LIMITED

BACKGROUND AND PLEADINGS

1. International trade mark 1554110 (“the IR”) consists of the sign shown on the cover page of this decision. The holder is Venner Oy (“the holder”). The IR was registered on 15 July 2020. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the term of the Protocol to the Madrid Agreement. The holder seeks protection for the mark for a range of goods and services in classes 5, 9, 38, 39, 41, 43 and 44.
2. The request to protect the IR was published on 15 January 2021. On 11 March 2021, VenPowa Limited filed a notice of its intention to oppose the IR by way of a Form TM7a. This extended the deadline to file a notice of opposition by a further one month.
3. On 15 April 2021, a notice of opposition was filed in which Venners Limited was identified as the opponent. This was served on the holder on 26 April 2021. In response, HGF Limited (“the holder’s representative”), requested that the decision to accept the notice of opposition filed by Venners Limited be reviewed and reversed on the basis that it was not compliant with Rule 17(3) of the Trade Mark Rules 2008 (“the Rules”).
4. On 17 May 2021, the Tribunal requested Venners Limited’s comments on the holder’s query regarding the relationship between VenPowa Limited and Venners Limited. In response, Boulton Wade Tennant, being the representative of both VenPowa Limited and Venners Limited (“the opponent’s representative”) responded confirming that both VenPowa Limited and Venners Limited were subsidiaries of the same company, being Christies PLC. A print out from Companies House confirming the relationship between Christies and both VenPowa Limited and Venners Limited was attached to its response.
5. This information was reviewed by the Tribunal and, on 27 May 2021, the Tribunal wrote to the parties giving a preliminary view that the notice of opposition was not compliant with Rule 17(3) of the Rules and as a result, was deemed to have been filed out of time and, therefore, was to be struck out. The opponent was given a

period of 14 days from the date of this letter to request a hearing if it wished to contest the preliminary view of the Tribunal. A hearing was requested by the opponent's representative and the matter was listed for a hearing on 28 June 2021. Upon receiving notice of the hearing, the holder's representative requested a postponement to the hearing, a request which was supported by the opponent's representative. The hearing was re-scheduled for 19 July 2021.

6. The hearing took place before me via telephone on 19 July 2021. The opponent's representative filed a skeleton argument on 15 July 2021. Catherine Wolfe of the opponent's representative attended the hearing on behalf of the opponent. The holder's representative elected not to attend the hearing or file any written submissions in lieu.

DECISION

7. Rule 17 of the Rules states that:

17. — (1) Any notice to the registrar of opposition to the registration, including the statement of the grounds of opposition, shall be filed on Form TM7.

(2) Unless paragraph (3) applies, the time prescribed for the purposes of section 38(2) shall be the period of two months beginning with the date on which the application was published.

(3) This paragraph applies where a request for an extension of time for the filing of Form TM7 has been made on Form TM7A, before the expiry of the period referred to in paragraph (2) and where this paragraph applies, the time prescribed for the purposes of section 38(2) in relation to any person having filed a Form TM7A (or, in the case of a company, any subsidiary or holding company of that company or any other subsidiary of that holding company) shall be the period of three months beginning with the date on which the application was published.

8. At the hearing, the opponent submitted that the wording of Rule 17(3) above allows for a subsidiary of a parent company to rely on a Form TM7a filed by another subsidiary of that same parent company. In this case, as Christies PLC was the parent company of both VenPowa Limited and Venners Limited, this meant that when Venners Limited filed its Form TM7 it was entitled to rely on the Form TM7a filed by VenPowa Limited.
9. The opponent's representative also referred me to paragraph 3.1.3 of the Tribunal Section of the Trade Mark Manual ("the Manual") which, as at the time of this decision, states that "where the TM7a is filed by a company, the TM7 may be filed by a subsidiary or holding company of that company." The opponent's representative states that the wording in the Manual is narrower than what is allowed for in Rule 17(3) of the Rules and that the Tribunal's application of the wording of the Manual rather than the wider Rule 17(3) was incorrect.
10. The focus of the decision I must now make is the interpretation of the wording of Rule 17(3) of the Rules, particularly the following:

“(...or, in the case of a company, any subsidiary or holding company of that company or **any other subsidiary of that holding company**)” (emphasis added)
11. Firstly, use of the wording 'holding company' covers parent companies. Clearly, the above wording covers scenarios where a parent company files a Form TM7a and a subsidiary of that company files a Form TM7 and also where a subsidiary files a Form TM7a and its parent company files a Form TM7. However, the wording emphasised above also covers the scenario where one company files a Form TM7a and another company that is owned by the same parent company of the company that filed the Form TM7a files a Form TM7. Applying the wording of Rule 17(3) of the Rules to the current circumstances, VenPowa Limited filed the Form TM7a. The parent company of VenPowa Limited is Christies PLC. *Another subsidiary of that parent company*, being Christies PLC, is Venners Limited.

12. As Venners Limited were entitled to rely on the Form TM7a filed by VenPowa Limited, the Form TM7 filed on 15 April 2021 was correctly filed in time.

CONCLUSION & NEXT STEPS

13. The preliminary view of the Tribunal dated 27 May 2021 is hereby overturned. As a result, the Form TM7 filed by Venners Limited on 15 April 2021 is hereby admitted into these proceedings, which will now continue. As a consequence of this decision the holder now has two months from the date of this decision to file its Form TM8 and counterstatement.

COSTS

14. At the hearing, the opponent's representative submitted that as this matter had arisen in consequence of the divergence between the Tribunal Work Manual and the Rules, no costs were being sought.

Dated this 3rd day of August 2021

A COOPER
For the Registrar