

**O/657/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003504015  
IN THE NAME OF CHRIS BOARDMAN FOR  
THE TRADE MARK:**

**CHRIS  
BOARDMAN**

**IN CLASSES 12 AND 41**

**AND**

**THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT  
IN DEFENCE OF AN OPPOSITION  
UNDER NO. 423267 BY HALFORDS LIMITED**

## BACKGROUND

1. On 23 June 2020, Chris Boardman (“the applicant”) applied to register “Chris Boardman” as a trade mark in the United Kingdom. Registration is sought for the following goods and services:

Class 12: *Babies' buggies; Babies' carriages; Babies' strollers; Baby carriages; Baby carriages (Covers for -); Baby carriages [prams]; Baby, infant and child seats for vehicles; Baby strollers; Back-gear transmissions for land vehicles; Backrests adapted for use in vehicles; Backrests for vehicle seats; Bag carriers for cycles; Bags adapted for pushchairs; Bags adapted for strollers; Bags for bicycles; Bags [panniers] for bicycles; Balance bicycles [vehicles]; Balance weights for vehicle wheels; Balancing weights for vehicle wheels; Ball joints [vehicle parts]; Balloons (Dirigible -); Band brakes for land vehicles; Band brakes [for land vehicles]; Bands for wheel hubs; Barges; Barrage balloons; Bars (Torsion -) for vehicles; Baskets adapted for bicycles; Baskets adapted for cycles; Baskets for perambulators; Baskets for pushchairs; Bellows for articulated buses; Bells for bicycles; Bells for bicycles, cycles; Bells for cycles; Bells for motorcycles; Belt pulleys for land vehicles; Berths (Sleeping -) for vehicles; Bicycle bells; Bicycle brake lever grips; Bicycle brakes; Bicycle carriers; Bicycle chains; Bicycle cranks; Bicycle frames; Bicycle gears; Bicycle handle bars; Bicycle handlebar grips; Bicycle handlebars; Bicycle horns; Bicycle hubs; Bicycle kickstands; Bicycle motors; Bicycle mudguards; Bicycle pedals; Bicycle pumps; Bicycle racks [carriers]; Bicycle racks for vehicles; Bicycle rims; Bicycle saddle covers; Bicycle saddles; Bicycle seat posts; Bicycle seats; Bicycle spokes; Bicycle sprockets; Bicycle stabilisers; Bicycle stands; Bicycle stands [kickstands]; Bicycle structural parts; Bicycle tires; Bicycle tires [tyres]; Bicycle trailers; Bicycle trailers (riyakah); Bicycle training wheels; Bicycle tyres; Bicycle water bottle cages; Bicycle wheel hubs; Bicycle wheel rims; Bicycle wheel spokes; Bicycle wheels; Bicycles; Bike bags; Blinds adapted for vehicles; Block brakes for land vehicles; Boat bumpers; Boat chafe guards; Boat chocks; Boat cleats; Boat fenders; Boat hooks; Boat hulls; Boat launching trolleys; Boat rudders; Boat shells; Boat tillers; Boat-hooks.*

Class 41: *Education; Education and instruction services; Education and training; Education and training consultancy.*

The application was published for opposition purposes on 20 November 2020.

2. On 27 November 2020, HGF Limited filed a Form TM7A (“Notice of threatened opposition”) on behalf of Halfords Limited (“the opponent”). The effect of filing Form TM7A was to extend the period in which it could file an opposition until 22 February 2021. On 18 February 2021, Halfords Limited opposed the application based upon sections 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”) by way of filing form TM7 (“Notice of opposition and statement of grounds”).

3. On 8 March 2021, the TM7 was served on the applicant), allowing him until 10 May 2021 for the filing of a form TM8 (“Notice of defence and counterstatement”) or TM9C (“Request for a cooling off period”). The serving 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, which will extend the 2 month period in which to file a Form TM8 by up to a further seven months. Form TM9c is also available on the IPO website (above). Please note both parties must agree to enter into cooling off.

**IMPORTANT DEADLINE: A completed Form TM8 (or else a Form TM9c) MUST be received on or before 10 May 2021**

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 otherwise directs, be treated as abandoned.”

**It is important to understand that if the deadline date is missed, then in almost all circumstances, the application will be treated as abandoned.”**

4. As no TM8 was filed within the prescribed period (i.e. by 10 May 2021), on 28 May 2021, the Tribunal wrote out to the applicant (with the letter copied to the opponent) stating:

“The official letter dated **08 March 2021** invited the applicant to file a TM8 and counterstatement on or before **10 May 2021**.

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, 11 June 2021. 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. The official record shows that the registry received a call from Mr John Buckby of Gateley Plc (“Gateley”) on 28 May 2021 querying why the aforementioned letter was issued. During that call, Mr Buckby advised that Gateley were representing the applicant in all matters, as indicated on the TM33 filed alongside a TM8 in related opposition 423271 on 5 May 2021. The opposition file was updated to reflect the applicant’s appointed representation and correspondence issued previously was forwarded to Gateley.

6. On 11 June 2021, the registry received an email from Mr Buckby requesting a hearing. The email enclosed written reasons as to why the applicant failed to file a form TM8 in respect of the present opposition, a witness statement from Mr Boardman dated 7 June 2021 and a form TM8 and counterstatement. Within that witness statement, Mr Boardman submits:

“5. On 8 March 2021, I received communications from the UK Intellectual Property Office, explaining that my application had been opposed. The UK Intellectual Property Office sent me details of the oppositions, and I saw that Boardman Bikes Limited and Halfords Limited were opposing my application.

6. Boardman Bikes Limited and Halfords Limited are well known to me. I have a long-standing commercial relationship with them both, and I originally set up Boardman Bikes Limited. I am aware that Halfords Limited acquired Boardman Bikes Limited a few years ago, and that the companies now belong to the same group.

### **Dealing with the opposition**

7. I was recently appointed as the Transport Commissioner for Greater Manchester. I have been busy with this new role, alongside my existing engagements.

8. I have no experience of dealing with trade mark oppositions, and I was confused by the lengthy forms submitted by the legal representative acting for Boardman Bikes Limited and Halfords Limited. The two documents looked the same to me, they were both from the same group of companies using the same legal representative.

9. I asked my solicitors (Gateley Legal) to deal with the opposition, but I now realise that I only sent the Boardman Bikes Limited documentation (TM7 form) to my solicitors, and not the Halfords Limited documentation (TM7 form). This was my own clerical error.

10. After I sent the Boardman Bikes Limited opposition documentation to my solicitors, their trade mark attorney (John Buckby) prepared the necessary documentation to defend my application against the opposition.

11. On the evening of 10 May 2021, Mr Buckby confirmed that my documentation

(TM8 and counter-statement) had been submitted to the UK Intellectual Property Office within the deadline. The next afternoon, Mr Buckby forwarded a copy of a letter he had received from the UK Intellectual Property, which acknowledged receipt of my Form TM8 on 10 May 2021.

### **Missed deadline**

12. On 28 May 2021, I received the UK Intellectual Property Office's letter saying that I had missed the deadline to respond to the opposition. I was extremely surprised by this. I assumed that we must have missed the deadline for the Boardman Bikes Limited opposition after all.

13. I forwarded the letter to Mr Buckby the same day, expressing my surprise and asking him to advise on what had happened. He replied shortly afterwards, saying that he had telephoned the UK Intellectual Property Office to check the situation. Mr Buckby explained that the letter actually related to another opposition which I had not made him aware of. He asked if I had known about the other opposition, and at that point I realised that I must have confused the two oppositions, and omitted to send all the relevant documents to my solicitors."

7. On 28 June 2021, the opponent's representative filed a witness statement in the name of Mr Tim O'Gorman, General Counsel and Company Secretary of Halfords Limited. Though Mr O'Gorman's statement originally introduced four exhibits, subsequent to an agreement between the parties at the hearing, the first exhibit ("TOG1") has since been returned and the witness statement reduced to satisfy the applicant's 'without prejudice' concerns. In its existing condition, the statement is supported by three exhibits. Mr O'Gorman submits that Gateley were explicitly made aware that there were two threatened oppositions. Mr O'Gorman also points to select information relating to the contended application which was readily available on the UKIPO website.

8. In regards the exhibits, at TOG2 Mr O'Gorman encloses the professional biographies of Mr Glaskie and Mr Lye of Gateley Legal. At TOG3 is an extract from the

UKIPO website showing various information pertaining to UKTM 3504015. Amongst that information is a record of two 'Notices of Threatened Opposition' being filed. At TOG4 is a further extract from the UKIPO website, serving to show the status of the aforementioned application. Under a section headed 'Opposition details', two oppositions are recorded; one from Halfords Limited and the other from Boardman Bikes Ltd ("BBL").

9. On 20 July 2021, a joint hearing was appointed for 10 August 2021. In an email of 22 July 2021, Mr Lee Curtis of HGF Limited confirmed that he would be attending on behalf of the opponent. In an email dated 26 July 2021, Mr John Buckby of Gateley Legal confirmed that he would be attending on behalf of the applicant. In an email of the same date, Mr Curtis notified the registry that Mr Tim O'Gorman, of Halfords Limited, wished to observe the hearing. Mr Curtis, in a further email, clarified that he would be the only person making submissions for the opponent.

10. A hearing took place before me, by telephone, on 10 August 2021. Mr Curtis attended on behalf of the opponent and Mr Buckby on behalf of the applicant. Both parties filed skeleton arguments in advance of the hearing.

### **The hearing**

11. I feel I must begin by acknowledging that Mr Buckby was late in attending the hearing. Having not received any notification from our Hearings team of any correspondence from Mr Buckby regarding his absence or an anticipated lateness, I allowed a short period of time before making the appropriate introductions and recommending that Mr Curtis begin the opponent's opening submissions. Mr Buckby joined the call soon afterwards and explained that he had been awaiting a call from the Hearing Officer, despite the hearing invitation asking attendees to 'dial-in' via a link provided within the appointment. I asked Mr Curtis if he was willing to recommence his submissions, which he obliged. For the avoidance of doubt, I am satisfied that Mr Buckby had the opportunity to comment on all of Mr Curtis' submissions; there was nothing noteworthy said in Mr Buckby's absence that wasn't returned to after his arrival and, nevertheless, much of Mr Curtis' opening statement reiterated what was

explained in the opponent's skeleton arguments and went to the matter of without prejudice, which is now resolved. Once that resolution had been reached, I turned, as originally intended, to Mr Buckby for the applicant's submissions.

12. Mr Buckby began by explaining that the parties had been engaged in a commercial relationship for approximately 15 years and clarified that Halfords Limited and BBL are under common control and that their oppositions against Mr Boardman's application are, indeed, related. Mr Buckby submitted that when Mr Boardman informed him of the opposition, he clearly did not know there was a second opposition, referring to it simply as the 'Halfords' opposition. Mr Boardman was therefore shocked upon receiving the registry's letter of 28 May 2021. As Mr Buckby had sight of only the BBL opposition, the letter was assumed to be a mistake until clarification was sought from the registry. It was at that time that Mr Boardman recalled conversations months earlier in respect of *two* threatened oppositions which must have been 'forgotten'. Mr Boardman treated the circumstances very seriously and took an active role in defending his application. Mr Buckby noted that the Halfords opposition makes reference to the BBL opposition, but the same cannot be said of the reverse. He also submits that the clarification (of there being two distinct oppositions) was not forthcoming from Halfords in previous liaisons between the parties.

13. Mr Buckby proceeded to consider the factors laid out in *Music Choice Ltd's Trade Mark* [2005] RPC 18. In those proceedings, the Court proposed several factors which would likely be of assistance when reaching a conclusion as to whether or not discretion should be exercised in favour of a party in default. Such discretion is afforded to me by the use of the words "unless the registrar otherwise directs" in rule 18(2) of the Trade Mark Rules 2008 ("the Rules").

14. As to the nature of the pleadings, Mr Buckby acknowledged that they pertain to sections 3(6) and 5(4)(a) of the Act. With regards the 3(6) claim, Mr Buckby submitted that Mr Boardman takes the pleading of bad faith extremely seriously and wishes the opportunity to defend his reputation. Of the two related oppositions, Mr Buckby stated that the Halfords opposition is the weaker of the two and that all the points raised in Halfords' pleadings have been addressed in Mr Boardman's defence of the BBL opposition. Finally, Mr Buckby stated that there is readily available evidence



concerning the substantive merits of the opposition which, he considers, a compelling reason to move forward.

15. Moving to the consequences of not admitting the applicant's defence, Mr Buckby made several points. Firstly, Mr Boardman's application would be deemed abandoned. Secondly, as a result, the opponent's BBL opposition would fall away; an opposition which, Mr Buckby reminded me, is predominant (over the Halfords opposition), has been defended and requires evidence and proof of use. Moreover, the cost and effort paid by the opponent in respect of the BBL opposition would essentially be wasted and the result ultimately a 'backdoor' success. Thirdly, Mr Buckby considered that, to abandon the application now would simply be 'kicking the can down the road', so to speak. Mr Boardman would pursue an identical application (which, at the time of the hearing, had already been filed), BBL and Halfords would refile their Notices of Opposition and counterstatements would be invited, resulting in a delay of two or three months. Mr Buckby points to the opponent's skeleton argument where it states that it would be "happy" to oppose the second application and he questions why the existing opposition should therefore not be allowed to proceed. Mr Buckby adds that the duplicitous proceedings would waste Tribunal resources and contradict its overriding objective.

16. Next, Mr Buckby turned to consider the potential prejudice faced by Halfords. With the TM8 having been filed on 11 June, the delay suffered by Halfords would be approximately one month which Mr Buckby considers relatively minimal given that discussions between the parties had been ongoing for over a year. Mr Buckby also compared this delay to a delay of approximately three months, which would be incurred should the proceedings be abandoned and begin again (in respect of Mr Boardman's newly filed application). There is no prejudice, he submits, with regards Halfords' contractual rights which still remain in force. Mr Buckby acknowledged that Halfords had been put to the filing of a form TM9 [Request for an Extension of Time], which carries a £100 fee, in the related opposition (pending the resolution of the matter at hand). To that end, Mr Buckby stated that Mr Boardman would be willing to cover the fee.

17. Mr Buckby turned finally to any further considerations or related proceedings which may be of relevance. Mr Buckby listed the BBL opposition as a ‘major factor’ and reminded me that the Halfords opposition has been pleaded in the alternative, that the BBL opposition had already been defended (and the opponent’s form TM9 admitted) and, that much of the foundation of the applicant’s defence in the BBL opposition was also applicable in the present proceedings. Furthermore, Mr Buckby reiterated that there was a written agreement available of the utmost relevance to the proceedings, laying out the parties’ expectations and respective rights. Finally, Mr Buckby stated that talks between the parties are continuing and expressed a concern that, if Mr Boardman is forced to pursue the newly filed application, the talks will be further delayed. That concludes my summary of Mr Buckby’s initial submissions.

18. Before addressing the *Music Choice* factors, Mr Curtis turned to Rule 18(2) which, he stated, allows the registry only a *narrow* opportunity to exercise discretion. He also referred to longstanding case law which holds that, to exercise such discretion, there should be shown to be compelling reasons<sup>1</sup> and/or extenuating circumstances<sup>2</sup>. Mr Curtis also submitted that none of the *Music Choice* factors are singly determinative; they are interdependent. He dismissed any reliance on Rule 77(5)(A), referring to the decision of Geoffrey Hobbs in *Kickz AG v Wicked Vision Limited*<sup>3</sup> which distinguished between a “failure to receive” and a “failure to read”, of which he submits these proceedings fall into the latter. Mr Boardman clearly received notice of two distinct oppositions but failed to read or interpret them properly. In other words, he did not apply a “minimal degree of vigilance”.

19. When considering the circumstances of the case, Mr Curtis pointed to paragraph 18 of the applicant’s skeleton argument which states that Mr Boardman was not professionally represented at the time the oppositions were served. Mr Curtis accepts that Gateley were not officially on the record at that time but claims that they were assisting Mr Boardman ‘in the background’, at least. In reply to the applicant’s submission (at the same paragraph) that “Mr Boardman was confused by the lengthy opposition forms, which looked similar to his untrained eye”, Mr Curtis refers to the

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<sup>1</sup> *Mark James Holland v Mercury Wealth Management Limited* (BL O-050-12)

<sup>2</sup> *Kickz AG v Wicked Vision Limited* (BL-O-035-11)

<sup>3</sup> *Kickz AG v Wicked Vision Limited* (BL-O-035-11)

decision of Geoffrey Hobbs QC in *BOSCO*<sup>4</sup>. In that decision, Mr Hobbs maintained that “being a litigant in person with no previous experience of legal proceedings is not a good reason for failing to comply with the rules”. Mr Curtis surmised that the lawyers within Gateley were trying to displace or offload responsibility for the missed deadline but, at large, Gateley Plc is a legal practice and its lawyers should have been on notice and applied a greater degree of vigilance. In reply to the applicant’s reliance on *SOLAS*<sup>5</sup>, where the registrar acknowledged that “no-one is perfect and that mistakes, though regrettable, do occur”, Mr Curtis refers to the decision of Geoffrey Hobbs in *TESCON*<sup>6</sup> where he found that “I readily accept that human error is not necessarily inconsistent with the existence of extenuating circumstances or compelling reasons for permitting invalidity proceedings to be defended in the exercise of discretion conferred by rule 41(6) [...] It is nonetheless clear that the test to be applied cannot be taken to permit or require all human errors to be treated as excusable for the purposes of rule 41(6).”

20. Turning to the nature of the pleadings, Mr Curtis submits that a bad faith pleading is not a sufficient reason for the registry to exercise its discretion and further points out that Mr Boardman would have the opportunity to defend his reputation (in reply to the anticipated opposition directed toward the newly filed application); he would not be robbed of the opportunity entirely should the present application be deemed abandoned. Mr Curtis rejects the applicant’s focus on the readily available evidence or ‘roadmap’, as Mr Buckby put it, reminding me that the matter at hand is a procedural one.

21. As to the consequences of treating the application as withdrawn, Mr Curtis describes the success of the BBL opposition as a ‘natural consequence’. In reply to the applicant’s skeleton arguments which states that “Mr Boardman will be deprived of a trade mark for his own personal name”<sup>7</sup>, Mr Curtis submitted that Mr Boardman had allowed a prior trade mark (in his own name) to lapse. Mr Curtis stated that the outcome would have no bearing on the parties’ contractual discussions. Mr Curtis further

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<sup>4</sup> BL-O-399-15

<sup>5</sup> BL-O-202-20

<sup>6</sup> BL-O-240-20

<sup>7</sup> Paragraph 34 of the applicant’s skeleton arguments

submitted that inaction *should* bear consequences. In regard Mr Boardman's newly filed application, Mr Curtis admitted that the applicant does intend to oppose.

22. Moving to any potential for prejudice, Mr Curtis admitted that the opponent was not claiming a great deal of prejudice, but there was some, primarily in the form of the uncertainty in the related BBL opposition (in which a TM9 had been filed).

23. Finally, when considering any other relevant proceedings, Mr Curtis referred briefly to the BBL opposition but submitted that the argument of 'inferred intent', i.e. that the applicant's defence of the BBL opposition demonstrated that Mr Boardman had always intended to defend the Halfords opposition did not have a great bearing on the case; he stated that this is often the case in proceedings of this nature. In addition, Mr Curtis was eager to clarify that there were no legal proceedings between the parties, at the time of filing, only discussions.

24. Returning to Mr Buckby, in his closing comments, he stated that the case's substantive merits *are* relevant as Mr Boardman should be allowed the right to address the claims made by the opponent. Regarding the delay, which Mr Curtis identified as a period of 32 days, Mr Buckby reiterated that the applicant was unaware of the deadline having passed until 28 May 2021 when it sought clarification from the UKIPO. Mr Buckby advised that, as it would have been of no benefit to the opponent for the applicant to rush the completion of the form TM8, an appropriate amount of care was applied to ensure it was fit for purpose (should the proceedings continue).

## **DECISION**

25. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by rule 18 of 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.”

26. 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.”

27. Neither party has indicated that there has been an irregularity, wholly or in part, on the part of the registrar. In approaching the exercise of discretion under rule 18(2), I take into account the decisions of the Appointed Person in *Kickz AG* and *Mark James Holland v Mercury Wealth Management Limited*<sup>8</sup> i.e. I have to be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the applicant’s favour. I turn now to consider the *Music Choice* factors, though the parties’ submissions have been fairly comprehensive.

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

28. Mr Boardman has admitted that he received two letters from the registry, enclosing notification of two distinct oppositions. Mr Boardman notified his solicitors at Gateley

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<sup>8</sup> BL O-050-12

of the BBL opposition but failed to notify them of the Halfords opposition. Consequently, Mr Boardman's representative prepared a defence only in respect of the BBL opposition. On the same day he received it, 28 May 2021, Mr Boardman forwarded the official letter stating that the deadline for filing a defence had been missed to Mr John Buckby (of Gateley) and Mr Buckby swiftly contacted the UKIPO to check its accuracy. At that time, it became apparent that Mr Boardman had confused the oppositions and that the letter in fact referred to a second opposition. On 11 June 2021, Mr Boardman's representatives filed a form TM8 in reply to the Halfords opposition alongside a witness statement from Mr Boardman and request for a hearing. The amount of time between the deadline for filing a TM8 (10 May 2021) and the filing of a form TM8 was, therefore, 32 days.

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

29. The opposition is based upon sections 3(6) and 5(4)(a) of the Act. For the purpose of the present opposition, in respect of section 5(4)(a), the opponent relies upon six unregistered signs, five of which it claims to have used throughout the UK since 2007 and one since 2016.

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

30. Should the TM8 be admitted and the applicant is allowed an opportunity to defend the present opposition, the proceedings will continue with the parties each given an opportunity to file evidence and the matter will be determined on its own merits.

31. If the preliminary view is upheld and the applicant is not allowed to defend the present opposition, the application will be deemed abandoned in respect of all goods and services for which registration is sought. An application in identical terms has already been filed and the opponent has admitted that, should the present application be deemed abandoned, it intends to oppose the application on the same grounds. In reply to Mr Buckby's concerns regarding the incurred delay should the proceedings begin once more, Mr Curtis expressed a willingness to oppose the application as

soon as it is advertised (rather than at the end of the opposition period, for example). Still, if the present application were to be deemed abandoned, the applicant would lose its filing date of 23 June 2020. I note the filing date for the re-filed application is 1 June 2021. Were the present application to fall away, so would the (existing) BBL opposition.

Any prejudice caused to the opponent by the delay;

32. The opponent is not claiming to have incurred a great deal of prejudice but, as above, submits that it has faced some uncertainty in respect of the related opposition and that it has had to file a form TM9 (in those proceedings) to extend the deadline for filing its evidence whilst awaiting the outcome of the present matter.

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

33. The parties are engaging in ongoing commercial discussions. As already stated, the related opposition filed by BBL has been defended but will fall away if Mr Boardman's application is to be deemed abandoned.

## **Conclusions**

34. In reaching my decision, I acknowledge that if discretion is not exercised in the applicant's favour, the opposition will succeed and the applicant will lose its filing. I further acknowledge that the applicant has already filed an application in identical terms which the opponent intends to oppose on the same grounds as the present proceedings. The identical application will also be open to opposition from third parties. However, as the loss of priority and a likelihood 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 are, in my view, particularly compelling.

35. Mr Curtis identifies, rightly so, that the discretion awarded to me under rule 18(2) is narrow. Whilst duplicitous proceedings, which I accept are highly likely in this case, are, in my view, regrettable on account of the wasted cost and efforts of the parties, not to mention the further strain on the registry's resources, I must consider the specific circumstances at hand. I am sympathetic towards Mr Boardman and I can appreciate his confusion, particularly in light of the similarities in the oppositions and the closely linked relationship between Halfords and BBL. However, he was admittedly in receipt of two distinct sets of pleadings and, whilst I accept that, at the time of receipt, Mr Boardman was formally unrepresented, he brought only one to the attention of his solicitors. Moreover, having been informed of the BBL opposition, had the applicant's representatives undertaken a cursory inspection of the trade mark register, they would soon have realised that the application faced two separate oppositions and the necessary action could have been taken. Whilst I do not wish to comment on the working practices of the opponent's representatives, that additional act of vigilance would have alerted them to both oppositions where Mr Boardman had failed to do so and he could have defended his application on both counts, which I believe would have been Mr Boardman's intention.

36. After careful consideration of the respective written and oral submissions in light of the relevant case law, my decision is that the reasons for the failure to file the TM8 within the given period do not constitute exceptional circumstances such to allow the exercise of the registrar's narrow discretion. My decision is not to exercise the discretion available under rule 18(2) in Mr Boardman's favour. Subject to appeal, the application will be deemed abandoned.

## **COSTS**

37. As my decision terminates the proceedings, I must consider the matter of costs. The opponent has been successful and is entitled to a contribution towards its costs. Costs are governed by Tribunal Practice Notice 2/2016. In line with that Notice, I award costs to the opponent on the following basis:

Official fee

£200



Preparing the Notice of Opposition £200

Reviewing the late-filed TM8 and witness statement  
and preparing for and attending the hearing £300

Total: £ 700

38. I order Chris Boardman to pay Halfords Limited the sum of £700. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 10th day of September 2021**

**Laura Stephens  
For the Registrar**