

O-713-21

TRADE MARKS ACT 1994

IN THE MATTER OF A JOINT HEARING HELD IN RELATION TO
APPLICATION NO. 3536090

IN THE NAME OF MUHAMMAD ALI
TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASSES 29 AND 43

AND

IN RELATION TO AN OPPOSITION THERETO UNDER NO. 423001
BY D ET VE ET ÜRÜNLERİ GIDA PAZARLAMA TİCARET ANONİM SİRKETİ

BACKGROUND AND PLEADINGS

1. On 22 September 2020, Muhammad Ali (“the applicant”) filed trade mark application number UK00003536090 for the mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 6 November 2020, in respect of goods in class 29 and services in class 43.¹

2. On 5 January 2021, D ET VE ET ÜRÜNLERİ GIDA PAZARLAMA TICARET ANONİM SİRKETİ (“the opponent”) filed a Notice of threatened opposition on Form TM7a, notifying the applicant of its intention to file an opposition against its application.

3. The opponent subsequently filed a Form TM7 (“TM7”) on 29 January 2021, opposing the application in full on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent was required to file an amended TM7, which it did on 1 March 2021.

4. On 2 March 2021, the Registry served the TM7 on the applicant. The deadline for the applicant to file its Form TM8 (Notice of defence and counterstatement) (“TM8”) was 4 May 2021, communicated by the Registry in the serving letter. The Registry’s letter included the following:

“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 4 May 2021

¹ Shown in the annex to this decision.

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.**” (original emphasis)

5. The applicant did not file a TM8 by the deadline and so, in an official letter dated 24 May 2021, the Registry advised both parties of its preliminary view to deem the application as abandoned. Either party, if it disagreed with the preliminary view, was to provide full written reasons and request a hearing by 7 June 2021. The request was to be accompanied by a witness statement containing reasons for the late filing of the TM8.

6. On 7 June 2021, the applicant filed the TM8 and provided written reasons for its lateness in an email to the Registry. Since the reasons were not provided in the form of a witness statement, the applicant was given a further opportunity to file a witness statement by 28 June 2021.

7. On 22 June 2021, the applicant filed a witness statement and evidence in the form of CCTV footage, giving the following reasons for the late filing of his TM8:

“As from the CCTV evidence attached in my previous email our shop sustained a great deal of damage due to a criminal who has not yet been caught driving his vehicle into our shop 3 times deliberately. This incident took place in February time and date is on the CCTV for evidence. As we are a new business and spent a lot of money on all the décor and shop front this set us back a lot. It caused a lot of stress and strain on the business as we had to sort this all out.

2nd reason for the late TM8 was due to my father in laws brother passing away in January. As you can understand any death is difficult but as it was so close to home this caused a great deal of sadness for the family. The reason I mention this is because he died from COVID and many members of our immediate

family contracted the virus so as you can imagine it was even more of stressful time.”

8. In an official letter dated 30 June 2021, sent to both parties, the Registry issued a preliminary view to refuse the late TM8, explaining as follows:

“Trade mark appeal authorities have established that it is only in cases where there are “extenuating circumstances”, or “compelling reasons” that the Registrar is able to exercise his discretion to admit into proceedings a Form TM8 filed outside the stipulated period. I draw your attention in particular to the appeal decisions in *Kix*: BL Number O/035/11 and *Mercury*: BL Number O/050/12, which provide further guidance on this type of issue. Those decisions can be found on the IPO website <https://www.ipo.gov.uk/t-challenge-decision-results.htm>.

After careful consideration of the contents of the papers you have provided, it is the preliminary view of the Registrar that the reasons given are not sufficient to exercise his limited discretion and admit a late filed Form TM8 into these proceedings.”

9. In the same official letter, the parties were given until 14 July 2021 to request a hearing if they wished to challenge the preliminary view.

10. On 14 July 2021, the applicant notified the Registry that he disagreed with the preliminary view and requested a hearing.

11. A hearing was scheduled for 10 August 2021, the details of which were sent by the Registry to both parties in an official letter dated 16 July 2021. Both parties confirmed attendance. Whilst the applicant is unrepresented in the substantive proceedings, he confirmed that he had instructed a representative to represent him at the hearing only.

THE HEARING

Representation

12. The hearing took place before me, by conference call, on 10 August 2021. The opponent was represented by Ms Kate Cruse of Forresters IP LLP. The applicant was represented by Mr Amar Alyas, but also attended the hearing himself.

The skeleton arguments

13. The opponent filed skeleton arguments prior to the hearing, which consisted of five pages and included a timeline of events in the proceedings and submissions in relation to the applicant's witness statement. It contended that no extenuating circumstances or compelling reasons were provided by the applicant and that the opponent agreed with the Registry's preliminary view not to admit the late-filed TM8 into the proceedings.

14. The applicant's representative did not file skeleton arguments prior to the hearing. At the hearing, it became clear that this was an oversight on Mr Alyas' part given his unfamiliarity with tribunal proceedings. I decided to continue with the hearing without skeleton arguments from the applicant. There was no opposition to this decision by the opponent.

Hearing discussion

15. At the hearing, Mr Alyas referred me to the applicant's witness statement and submitted that the TM8 was late due to the damage to his business premises and the passing of two of his relatives. Mr Alyas explained that the applicant had a lapse of concentration on the proceedings and that the other matters had taken priority in his life.

16. Ms Cruse explained that whilst the opponent has sympathy with the applicant, it has done everything it should have to make the applicant aware of the opposition

proceedings. She further submitted that there was a period of three months between the incident at the applicant's premises and the deadline to file the TM8 and that the applicant had ample time after said event and the passing of the applicant's relatives to file the TM8. Ms Cruse also pointed to the applicant's missing of the deadline provided by the Tribunal to file his witness statement and the lack of evidence filed in support of it.

17. Mr Alyas submitted that the events referred to constitute extenuating circumstances and that the applicant's inability to file a witness statement in the correct format were as a result of having no representation. The response given by Ms Cruse was that being unrepresented was a choice made by the applicant and should have no bearing on the ability to adhere to important deadlines.

18. Drawing on the applicant's filing of his witness statement, I advised the parties that the deadlines given to the applicant to file his witness statement in the correct format were set by the Tribunal and were, in my view, entirely reasonable to allow him to file the required documents. I then asked for the parties' submissions in relation to costs. Mr Alyas requested no award of costs be made; Ms Cruse requested an award of costs be made in the opponent's favour.

19. The applicant then requested to make submissions, in addition to those made by Mr Alyas. I allowed him to do so but advised that if any submissions were made that were not foreshadowed in his original witness statement, he may be required to file an additional witness statement to which the opponent could respond. The applicant addressed some of the submissions made by Ms Cruse. In relation to a lack of evidence, the applicant highlighted that he had filed CCTV footage with the Tribunal showing the vehicle reversing into his premises. Further, the applicant wanted to clarify that rather than just a simple smashed window needing to be replaced, the inside of the premises suffered significant structural damage. He also explained that one of his relatives who had passed away was his Grandmother and that it was a difficult time for the whole family.

20. I stated that I had seen the CCTV footage filed as evidence and asked Ms Cruse whether the opponent had received it, which they had not.

21. At the conclusion of the hearing, I reserved my judgment to give me an opportunity to reflect on the submissions made at the hearing and to allow the opponent time to file submissions in response to the applicant's CCTV evidence.

Post hearing

22. The applicant's evidence was sent to the opponent on 11 August 2021, giving the opponent 14 days to respond.

23. The opponent responded with written submissions dated 20 August 2021. I have considered them but do not intend to reproduce them here. The opponent submits that the length of time between the date of the incident at the applicant's premises (15 February 2021) and the deadline to file its TM8 (4 May 2021) was sufficient to ensure the TM8 was filed on time and maintains that the late-filed TM8 should not be admitted into the proceedings.

DECISION

Statutory provisions

24. 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 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 is the period of two months beginning immediately after the notification date.

(4) This paragraph applies where—

(a) the applicant and the person opposing the registration agree to an extension of time for the filing of Form TM8;

(b) within the period of two months beginning immediately after the notification date, either party files Form TM9C requesting an extension of time for the filing of Form TM8; and

(c) during the period beginning on the date Form TM9C was filed and ending nine months after the notification date, no notice to continue on Form TM9t is filed by the person opposing the registration and no request for a further extension of time for the filing of Form TM8 is filed on Form TM9e,

and where this paragraph applies the relevant period is the period of nine months beginning immediately after the notification date.”

25. The combined effect of rules 77(1), 77(5) and Schedule 1 of the Rules mean 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.”

26. 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).

27. 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.

28. 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

29. The TM8 was due by 4 May 2021; it was received by the Tribunal on 7 June 2021. The reasons given by the applicant for it being filed late were: (i) due to the damage to his business premises and (ii) the passing of two of his relatives.

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

30. The opponent relied upon grounds under section 5(2)(b) of the Act. There is nothing to suggest that the opposition is without merit.

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

31. 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.

32. If, however, the applicant is not allowed to defend the opposition, his application will be deemed abandoned in respect of those goods and services against which this opposition is directed, and he will lose his filing date of 22 September 2020. It will remain open to the applicant to re-file his application, which may, in turn, be opposed again by the opponent.

Any prejudice caused to the opponent by the delay

33. The opponent fairly submits that the prejudice extends to a time delay and additional costs.

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

34. There do not appear to be any other relevant considerations.

Conclusions

35. 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 all the goods and services in the application (since the opposition is directed against the application in full). I further recognise that it may be that the applicant will simply re-file his application and that this may, once again, be opposed by the opponent 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.

36. In the official letter dated 2 March 2021 the Tribunal made it very clear that failure to file a Form TM8 by the deadline would result in the application being treated as abandoned. Whilst I accept and sympathise with the applicant that he had other matters - namely, the damage caused to his premises - to deal with, there were 11 weeks between the incident shown in the CCTV evidence and the applicant's deadline to file the TM8. To my mind, that is ample time to complete and return what is essentially a straightforward form. The applicant chose not to prioritise these proceedings and I am not satisfied that this is a compelling reason for failing to file his TM8 on time.

37. In relation to the bereavements suffered by the applicant, I pass on my sincere condolences. The applicant, in his witness statement of 22 June 2021, mentioned the passing of one relative in January 2021. At the hearing, the passing of a second relative, the applicant's Grandmother, was mentioned but no other details were given i.e. whether this was before or after the TM8 deadline, the circumstances that occurred, or how this affected the applicant's ability to file the TM8 within the given time. While I have sympathy for the applicant, with no specific explanation as to why the TM8 could not be filed (particularly given there were approximately four months between the passing of one of his relatives in January and the applicant's deadline of 4 May 2021), I am not satisfied that these reasons constitute extenuating circumstances or compelling reasons. Having considered all of the applicant's reasons for his failure to file his TM8 by the deadline set, they are not, in my view, sufficient to enable me to exercise my discretion to admit the late-filed TM8 into these proceedings.

Outcome

38. 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 all the goods and services applied for.²

² Shown in the annex to this decision.

Costs

39. 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, based upon the scale published in Tribunal Practice Notice 2/2016. I assess these as follows:

Official fee for filing the Form TM7	£100
Preparing the statement of case	£200
Preparing for and attending the hearing	£300
Preparing written submissions	£100
Total	£700

40. I order Muhammad Ali to pay D ET VE ET ÜRÜNLERİ GIDA PAZARLAMA TICARET ANONİM SİRKETİ the sum of £700 as a contribution towards its costs. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 29th day of September 2021

E VENABLES

For the Registrar

Annex

- Class 29 Burgers; Buttermilk; Chicken; Chicken breast fillets; Chicken burgers; Chicken wings; Chips [french fries]; Cooked meat; Cooked meat dishes; Cooked meats; Falafel; French fries; Fresh chicken; Fresh meat; Fried chicken; Fried meat; Fried potatoes; Fruit desserts; Fruit snacks; Garlic [preserved]; Gherkins; Grilled chicken (Yakitori); Grilled vegetables; Ground meat; Hamburgers; Hash browns; Isinglass for food; Mashed potato; Mashed potatoes; Meat; Meat and meat products; Meat burgers; Meat-based snack foods; Meats; Milk shakes; Milkshakes; Minced meat; Mozzarella sticks; Mushrooms, prepared; Mushrooms, preserved; Oils for food; Onion rings; Pepperoni; Prepared beef; Prepared meals consisting primarily of meat; Prepared meals containing [principally] chicken; Prepared meat; Pulled beef; Pulled chicken; Roast beef; Roast chicken; Salted meat; Salted meats; Sausage meat; Sausages; Smoked meats; Snack food (Fruit-based -); Steaks of meat; Stock; Tahini; Turkey; Turkey burger patties; Turkey burgers; Vegetable burgers; Vegetable chips; Waffle fries.
- Class 43 Advice concerning cooking recipes; Agency services for reservation of restaurants; Agency services for the reservation of temporary accommodation; Bar and restaurant services; Bistro services; Booking of restaurant seats; Business catering services; Café services; Cafe services; Cafés; Cafeteria services; Cafeterias; Canteen services; Canteens; Carry-out restaurants; Carvery restaurant services; Catering; Catering (Food and drink -); Catering for the provision of food and beverages; Catering for the provision of food and drink; Catering in fast-food cafeterias; Catering of food and drink; Catering of food and drinks; Catering services; Catering services for company cafeterias; Catering services for the provision of food and drink; Contract food services; Delicatessens [restaurants]; Eateries; Fast food restaurants; Fast-food restaurant services; Food and drink catering; Food and drink catering for banquets; Food and drink preparation services; Food preparation; Grill restaurants; Ice cream parlors; Ice cream parlour services; Information,

advice and reservation services for the provision of food and drink; Information and advice in relation to the preparation of meals; Mobile catering; Mobile catering services; Mobile restaurant services; Outside catering; Outside catering services; Pizza parlors; Preparation of food and drink; Providing food and beverages; Providing food and drink; Providing food and drink for guests; Providing food and drink for guests in restaurants; Providing food and drink in bistros; Providing food and drink in doughnut shops; Providing food and drink in Internet cafes; Providing food and drink in restaurants and bars; Providing of food and drink; Providing of food and drink via a mobile truck; Providing restaurant services; Provision of food and beverages; Provision of food and drink; Provision of food and drink in restaurants; Provision of information relating to the preparation of food and drink; Rental of food service equipment; Reservation and booking services for restaurants and meals; Restaurant and bar services; Restaurant services; Restaurant services for the provision of fast food; Restaurants; Restaurants (Self-service -);Self-service restaurant services; Self-service restaurants; Services for providing food; Services for providing food and drink; Services for the provision of food and drink; Serving food and drink for guests; Serving food and drink for guests in restaurants; Serving food and drink in doughnut shops; Serving food and drink in restaurants and bars; Serving food and drinks; Shisha bars; Snack bar services; Snack-bar services; Snackbars; Supplying of meals for immediate consumption; Take away food and drink services; Take away food services; Take-away fast food services; Takeaway food and drink services; Take-away food and drink services; Takeaway food services; Take-away food services; Takeaway services; Take-out restaurant services; Tapas bars; Tea room services; Tea rooms; Tempura restaurant services; Tourist restaurants; Travel agency services for booking restaurants; Don and soba restaurant services; Washoku restaurant services.