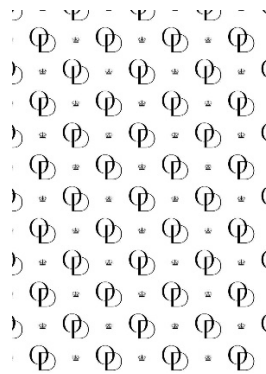


O/780/21

CONSOLIDATED PROCEEDINGS

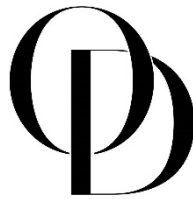
TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NOS. UK00003417369
AND UK00003464307 BY ODOLLS COLLECTION LIMITED
FOR THE FOLLOWING MARKS:**



AS A TRADE MARK IN CLASSES 25 & 26

AND



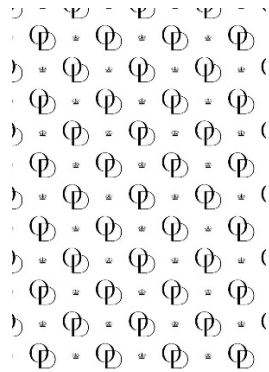
AS A TRADE MARK IN CLASSES 3, 18 & 25

AND

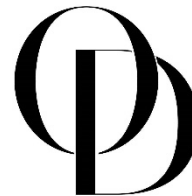
**APPLICATIONS FOR DECLARATIONS OF INVALIDITY UNDER
NOS. 503804 AND 503805
BY OWEN DREW LUXURY CANDLES LIMITED**

BACKGROUND

1. ODolls Collection Limited (“the proprietor”) is the registered proprietor of the following trade marks:



(“the proprietor’s first mark”)



(“the proprietor’s second mark”)

2. The proprietor’s first mark was filed on 29 July 2019 and registered on 1 November 2019. The proprietor’s second mark was filed on 5 February 2020 and registered on 8 August 2020. The goods for which the proprietor’s marks are registered are set out in the Annex to this decision.
3. On 30 April 2021, Owen Drew Luxury Candles Limited (“the applicant”) applied to declare the proprietor’s marks invalid. The applications are based on sections 5(4)(a) and 5(4)(b) of the Trade Marks Act 1994 (“the Act”).
4. On 6 May 2021, the Tribunal served the applications for invalidity on the appointed representatives of the proprietor. The proprietor was informed that it had two months within which to file its notices of defence and counterstatement, namely, on or before 6 July 2021.
5. The proprietor filed its notices of defence and counterstatement on 6 July 2021 and these were served on the applicant via a letter from the Tribunal dated 7 July 2021. The proprietor was informed in this letter that it should file its evidence and/or submissions on or before 7 September 2021. The letter set out that:

“Failure to file evidence by the due date may result in the application being deemed withdrawn.”

6. By way of another letter dated 7 July 2021, the Tribunal confirmed to the parties that the proceedings would be consolidated under Rule 62(1)(g) of the Trade Marks Rules 2008.
7. A request for an extension of one month to the evidence deadline (until 7 October 2021) was filed by Wilson Gunn (“the applicant’s representative”) on 7 September 2020 by way of a Form TM9. The reasons given for the request were as follows:

“An outline witness statement has been prepared to cover the consolidated cases and we are completing the exhibit information for the statement. This includes a copyright assignment which we have obtained and included, and evidence to support the passing off claim. We are including evidence of sales for a wide range of goods and we are also including evidence relating to the copyright claim and the awareness of the registered proprietor in respect of the cancellation applicant’s business and its logo. The additional time is required to complete this exhibit information and supporting observations. We kindly request a short extension of one month to complete the evidence.”

8. On 24 September 2021, the Tribunal wrote to both parties confirming that it was the preliminary view that the request for an extension be denied. The Tribunal confirmed that it was not satisfied that the reasons and information provided by the applicant was sufficient to enable the Registrar to exercise its discretion and allow the full extension of time that has been requested. The Tribunal confirmed that if either party disagreed with the preliminary view, then it could request a hearing by no later than 1 October 2021. The Tribunal also confirmed that as the grounds relied upon are evidential grounds, the applications for invalidation would be struck out if no hearing was requested.

9. On 24 September 2021, the applicant's representative requested a Case Management Conference ("CMC") to discuss this issue further. The CMC was listed for 10:30 on 13 October 2021.

PRELIMINARY ISSUE

10. At the hearing, the applicant's representative made me aware of a second request for an extension that was filed on 7 October 2021. I note that, at the time of the hearing, this request had not made its way onto the Tribunal's file, meaning that I had not had sight of it prior to the hearing. A copy of the same was provided to me directly by the applicant's representative. From the forwarded correspondence, I could see that the request was also copied to the proprietor's representatives, Trademark Eagle Limited. I was unable to fully review the second request for an extension at the CMC so confirmed to the applicant that I would need to review it in detail at the conclusion of the CMC.

11. Upon considering the second request further, I am of the view that it was unnecessary. This is on the basis that (1) these proceedings were suspended pending the outcome of the CMC, (2) the decision I am required to make will take into account the position as at the date of the hearing and the fact that the originally requested extension had expired is one of those factors and (3) the applicant's representative confirmed to me at the CMC that the extension was now required until 29 October 2021, being when it expects to be able to file the evidence and it is upon these submissions that I will base my decision. As a result, the second request makes no material difference to the outcome of this decision.

12. While I have deemed the second request unnecessary, I will still take into account the written reasons that accompanied the request on the basis that it provides reasons for the applicant's failure to meet the original deadline and reflects the position as at the date of hearing.

THE HEARING

13. The CMC took place before me by telephone on 13 October 2021. At the CMC, Mr Andrew Marsden of the applicant's representatives appeared for the applicant. The proprietor elected not to attend.
14. Mr Marsden confirmed that, on reflection, he should have requested more time when making the initial request for an extension and explained that the applicant now requires until 29 October 2021 to file its evidence. Mr Marsden explained that the reasons for the request were set out in paragraph 8 of the continuation sheet that accompanied the second request for an extension. Mr Marsden proceeded to explain the background of this matter and discussed, briefly, the events prior to the applications for invalidation being made that included pre-action discussions/correspondence with the proprietor.
15. Moving to the reasons for the request, Mr Marsden set out that he was not in a position as at 7 September 2021, being the initial deadline, to file the evidence necessary. He further explained that the COVID-19 pandemic has had an effect (including a continued requirement for home working for Mr Marsden personally), as well as both his client contact at the applicant and himself going on holiday during the period evidence was being compiled. Mr Marsden further explained that he is the person with sole input in this matter within the applicant's representative meaning that there was no one available to progress the matter while he was away. Finally, Mr Marsden confirmed that during this time, he was required to self-isolate due to COVID-19.
16. Mr Marsden then went on to discuss the evidence. He set out that there was various information that the applicant wished to file and that he had already obtained a lot of this. However, he was still looking into dates and enquiring about further information that was required. Again, he states that a lot of the information has already been provided but that there was a lot that still needed to be finalised. He stated that he was confident that he would be in a position to file the evidence

by 29 October 2021. During the CMC, Mr Marsden gave examples of the type of evidence he was finalising and I note that these include the following:

- a. Evidence regarding the stockists of the applicant's products and the date that those stockists were appointed;
- b. Evidence regarding the applicant's appearance on the BBC's 'Dragon's Den' television show; and
- c. Further research regarding the copyright claim.

17. Mr Marsden wished to point out that the applicant has not just been 'sitting around' during this time but that it has been trying to get its business back to normal during this difficult time. Further, it has experienced ongoing staffing issues as a result of the ongoing COVID-19 pandemic.

18. I enquired with Mr Marsden as to the impact that my decision would have on the applicant in the event that I upheld the preliminary view. Mr Marsden explained that the applicant considers this an extremely serious matter and that the applications must continue. He also explained that the applicant cannot afford for the request to be refused because the evidence wasn't filed on time. Further, he set out that the applicant would be estopped from continuing with this matter. As for the copyright aspect of these proceedings, being the 5(4)(b) grounds, Mr Marsden claimed that he had the copyright assignment and also a lot of evidence in respect of the passing off claim, being the 5(4)(a) grounds and that it would not be in the interest of justice if the matter was thrown out on a technicality. Finally, Mr Marsden pointed out that the proprietor has not made any objection to the extension.

19. As set out above, I reviewed the applicant's second request at the conclusion of the CMC. While the contents of the request mirror the submissions given orally at the CMC, they do expand upon the additional evidence that the applicant is still compiling. In addition to the evidence that I have referred to at paragraph 16 above, the applicant is also currently in the process of collating the following:

- a. Companies house details and accounts information;

- b. Domain name registration details;
- c. Social media details and posts/adverts;
- d. Website screenshots taken from the internet archive, 'The Wayback machine';
- e. Evidence of sales invoices and turnover figures;
- f. Advertising and marketing details;
- g. Details of awards that the applicant has received;
- h. Online reviews;
- i. Press coverage including adverts in Vogue, Forbes and Bazaar; and
- j. A review of the situation in the North West of the UK when the 'OD' signs of each party were created and used.

20. Further, I note that the second request sets out that Mr Marsden was on holiday from 23 to 27 August 2021. It also confirms that most of the evidence has been obtained but some information is still being compiled and retrieved from archive records. Additionally, the witness statement that the applicant expects to file still needs to be finalised, approved and signed by the applicant.

DECISION

21. Rule 42 of the Trade Mark Rules 2008 sets out the procedure for evidence rounds in invalidation proceedings. It also details the instances in which the filing of evidence is mandatory and the consequences of a failure to file such evidence. The relevant parts are set out below:

42. -

(1) Where the proprietor has filed Form TM8, the registrar shall send notice to the applicant inviting the applicant to file evidence in support of the grounds on which the application is made and any submissions and to send a copy to all the other parties.

(2) [...]

(3) Where –

(a) [...];

(b) the application or part of it is based on grounds other than those set out in section 5(1) or (2);

(c) [...],

the applicant shall file evidence supporting the application.

(4) Where the applicant files no evidence under paragraph (3), the applicant shall be deemed to have withdrawn the application to the extent that it is based on—

(a) the matters in paragraph (3)[...](b); [...]

(b) [...]

(5) The registrar may, at any time give leave to either party to file evidence upon such terms as the registrar thinks fit.

22. There is no dispute that the period for filing evidence is a period which may be extended or that the applicant filed the requisite form and paid the appropriate fee. However, there is no automatic right to an extension of time for filing evidence. I note that the applicant's representative pointed out at the CMC that the proprietor has not objected to its requests. However, this is a matter of discretion which will only be exercised in exceptional cases, taking into account all relevant factors. Firstly, I do not consider the proprietor's silence on this matter as confirmation that it accepts that the extensions should be granted. Secondly, the applicant, as the party seeking the extension, has the burden of justifying it and the reasons for the extension should be strong and compelling.¹

¹ A.J and Levy's Trade Mark (1999) RCP 292

23. In considering the request for an extension of time, I bear in mind the comments made in *Siddiqui's Application*, BL O/481/00, where the Appointed Person stated:

“In a normal case this will require the applicant to show clearly what he has done, what he wants to do and why it is that he has not been able to do it. This does not mean that in an appropriate case where he fails to show that he has acted diligently but that special circumstances exist an extension cannot be granted. However, in the normal case it is by showing what he has done and what he wants to do and why he has not done it that the Registrar can be satisfied that granting an indulgence is in accordance with the overriding objective and that the delay is not being used so as to allow the system to be abused.”

24. In accordance with *Siddiqui*, I must consider what the applicant has done, what it wants to do and why it has not been able to do it. In respect of these questions, I note that (1) the applicant has compiled most of the evidence, (2) there was still some to be finalised and that it is continuing to compile and retrieve evidence from archive records and (3) it has been unable to file the evidence as a result of annual leave taken by both the applicant and its representative, a period of self-isolation by the applicant's representative and due to the ongoing COVID-19 pandemic causing disruptions to the working patterns of the applicant's legal representative and difficulties with the applicant's business. I must now consider whether I am satisfied that granting the extension would be in line with the overriding objective and that the delay is not being used so as to allow the system to be abused.

25. On the face of it, I do not consider the fact that a party to proceedings or its legal representative being on holiday is a reasonable excuse to warrant the granting on an extension. Firstly, the timeframe provided to the parties is two months, being a sufficient amount of time within which to compile, review and file the necessary evidence. Secondly, these proceedings are reliant upon grounds that are solely evidential, meaning that, at the outset, it was an expectation of the applicant that such evidence would need to be furnished. I appreciate the fact that the applicant may not have wanted to begin incurring the legal costs associated with preparing

witness evidence until the proprietor filed its defence and counterstatement. However, I do not consider it unreasonable to expect the applicant to at least be aware of what evidence is required and to perhaps begin taking steps to obtain and compile the same. Finally, these proceedings are invalidation applications and are not, therefore, subject to strict deadlines within which a party must bring them in the same way opposition proceedings are. The applicant was, therefore, free to bring these proceedings at any time it wished to do so. In bringing these proceedings, it is reasonable to expect that the applicant would have had an approximate idea as to the timetable of these proceedings, including when the evidence rounds will commence. If holidays over the summer period were to be expected, the applicant could have chosen to either file the applications at an earlier or later date so as to avoid the evidence rounds falling during that period.

26. Moving on to the issues regarding the COVID-19 pandemic, I appreciate the difficulties surrounding this for both the applicant and its representative. However, I note that these same issues (such home working and self-isolation periods, as argued here) have been experienced by many in this country during the COVID-19 pandemic. In my experience, deadlines before this Tribunal have, for the most part, continued to be met. This is particularly the case given that we are now some 20 months into the pandemic with restrictions having been reduced greatly in recent months.

27. I note that Mr Marsden set out that the applicant would suffer in that it would be estopped from making further applications for cancellation in the event that the preliminary view is upheld and the second request for an extension is refused. While it would be the case that it would be estopped from making further applications reliant upon the same grounds in the event that the grounds at issue are determined fully by way of a substantive decision, the same does not apply for an application that has been deemed withdrawn for failure to file evidence.

28. In reaching a conclusion, I bear in mind that the consequence of a refusal of the applicant's request for additional time will, in this case, result in the applications being deemed withdrawn under Rule 42 above. I am also mindful of the fact that a

refusal may ultimately lead to the same applications being brought by the applicant on the same basis. Notwithstanding these factors which mitigate against a refusal, I am not prepared to allow the applicant further time to file its evidence. Accordingly, **the preliminary view is upheld and the request for a further extension of time is refused.** I bear in mind that an apparent lack of diligence by a party does not necessarily mean that an extension cannot be granted, however, the Tribunal has an overriding objective to ensure that all proceedings are completed within a reasonable timeframe, avoiding unnecessary expense and delays. I am of the view that if I was to grant an extension, in these proceedings, it will lead to unnecessary delays and be prejudicial to the proprietor, particularly given the lack of exceptional reasons for the applicant's delays. Further, if I had allowed the first extension request, it would not have been enough time for the applicant to file its evidence. In these circumstances, even if I were to consider the second request, I do not consider the reasons provided would have been sufficient enough to warrant the granting of a further extension.

CONCLUSION

29. As per Rule 42(3)(b), the applicant's applications are based on grounds other than those set out in section 5(1) or 5(2) of the Act. Given that the deadline to file evidence has now passed and the requested extension has been refused, in accordance with Rule 42(4)(b), the applications are deemed to have been withdrawn.

COSTS

30. Given that the outcome of this decision has terminated the proceedings, I am required to consider costs. With the applications being deemed withdrawn, the proprietor is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. While I appreciate that the proprietor was required to defend two invalidation applications, I note that the counterstatement provided with the TM8 were identical. I have taken this into account.

31. In the circumstances, I award the proprietor the sum of £500 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Consideration the applicant's invalidation applications (x2): £300.00

Preparing a defence and counterstatement: £200.00

Total: £500.00

32. I therefore order Owen Drew Luxury Candles Limited to pay ODolls Collection Limited the sum of £500. 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 conclusion of the appeal proceedings.

Dated this 19th day of October 2021

**A COOPER
For the Registrar**

ANNEX

The proprietor's first mark

Class 25

CLOTHING; clothing and associated accessories including buckles and labels for men women and children; Clothing for men, women and children; Articles of clothing; Articles of clothing for theatrical use; Articles of clothing made of hides; Articles of clothing made of leather; Articles of outer clothing; Articles of sports clothing; Athletic clothing; Babies' clothing; Babies' pants [clothing]; Baby layettes for clothing; Bandeaux [clothing]; Beach clothing; Belts (Money -) [clothing]; Belts [clothing]; Belts for clothing; Boas [clothing]; Bodies [clothing]; Bottoms [clothing]; Boys' clothing; Bra straps [parts of clothing]; Braces for clothing; Braces for clothing [suspenders]; Capes (clothing); Cashmere clothing; Casual clothing; Chaps (clothing); Children's clothing; Childrens' clothing; Collar liners for protecting clothing collars; Collars [clothing]; Corsets [clothing, foundation garments]; Corsets [foundation clothing]; Cowls [clothing]; Cyclists' clothing; Dance clothing; Denims [clothing]; Drawers [clothing]; Drawers as clothing; Ear muffs [clothing]; Embroidered clothing; Fabric belts [clothing]; Figure skating clothing; Fingerless gloves as clothing; Fishing clothing; Foulards [clothing articles]; Furs [clothing]; Gabardines [clothing]; Garments for protecting clothing; Girls' clothing; Gloves [clothing]; Gloves as clothing; Golf clothing, other than gloves; Gussets [parts of clothing]; Gussets for bathing suits [parts of clothing]; Gussets for footlets [parts of clothing]; Gussets for leotards [parts of clothing]; Gussets for stockings [parts of clothing]; Gussets for tights [parts of clothing]; Gussets for underwear [parts of clothing]; Handwarmers [clothing]; Hats (Paper -) [clothing]; Headbands [clothing]; Headbands for clothing; Hoods [clothing]; Infant clothing; Infants' clothing; Jackets (Stuff -) [clothing]; Jackets [clothing]; Jackets being sports clothing; Japanese traditional clothing; Jerseys [clothing]; Jogging bottoms [clothing]; Jogging sets [clothing]; Kerchiefs [clothing]; Knee warmers [clothing]; Knitted clothing; Knitwear [clothing]; Ladies' clothing; Layettes [clothing]; Leather (Clothing of -); Leather (Clothing of imitations of -); Leather belts [clothing]; Leather clothing; Leisure clothing; Linen clothing; Linings (Ready-made -) [parts of clothing]; Maternity clothing; Men's clothing; Mitts [clothing]; Money belts [clothing]; Motorcyclists' clothing; Motorcyclists' clothing of leather; Motorists' clothing; Mufflers [clothing]; Muffs [clothing]; Nappy pants [clothing]; Oilskins [clothing]; One-piece clothing for infants and

toddlers; Outer clothing; Paper clothing; Paper hats [clothing]; Paper hats for use as clothing items; Party hats [clothing]; Playsuits [clothing]; Plush clothing; Pocket squares [clothing]; Pockets for clothing; Quilted jackets [clothing]; Rainproof clothing; Ready-made clothing; Ready-made linings [parts of clothing]; Ready-to-wear clothing; Roll necks [clothing]; Sailing wet weather clothing; Short sets [clothing]; Shorts [clothing]; Shoulder straps for clothing; Shoulder wraps [clothing]; Shoulder wraps for clothing; Silk clothing; Slipovers [clothing]; Slips [clothing]; Sports clothing; Sports clothing [other than golf gloves]; Stuff jackets [clothing]; Thermal clothing; Thermally insulated clothing; Three piece suits [clothing]; Ties [clothing]; Tops [clothing]; Triathlon clothing; Trunks being clothing; Underarm gussets [parts of clothing]; Veils [clothing]; Visors [clothing]; Water-resistant clothing; Waterproof clothing; Clothing; Weather resistant outer clothing; Weatherproof clothing; Windproof clothing; Women's clothing; Woolen clothing; Woven clothing; Wraps [clothing]; Wristbands [clothing]; Clothing for leisure wear; Clothing for men, women and children; Babies' clothing; Beach clothing; Girls' clothing; Hats (Paper -) [clothing]; Headbands [clothing]; Headbands for clothing; Infants' clothing; Jackets [clothing]; Jerseys [clothing]; Jogging sets [clothing]; Ladies' clothing; Leather (Clothing of imitations of -); Leisure clothing; Men's clothing; Money belts [clothing]; Sports clothing; Ties [clothing]; Clothing; Weatherproof clothing; Women's clothing; Clothing for men, women and children; Clothing; Clothing for men, women and children.

Class 26

Clothing (Fastenings for -); Clothing buckles; Belt buckles [clothing accessories]; Belt buckles [for clothing]; Belt buckles for clothing; Belt buckles of precious metal [for clothing]; Bindings for hemming clothing; Birds' feathers [clothing accessories]; Borders and edgings for clothing; Borders for hemming clothing; Bows for clothing; Brooches [clothing accessories]; Brooches for clothing; Buckles [clothing accessories]; Buckles for clothing; Buckles for clothing [clothing buckles]; Buckles of precious metal [clothing accessories]; Buttons for clothing; Clasps for clothing; Clips for clothing; Cloth patches for clothing; Cords for clothing; Edgings for clothing; Embroidered patches for clothing; Eyelets (Non-metallic -) for clothing; Eyelets for clothing; Eyelets of metal for clothing; Fastenings for clothing; Feathers [clothing accessories]; Frills for clothing; Loops for clothing; Name tags of textile for identifying clothing; Name tags of textile for marking clothing; Name tapes of textile material for

identifying clothing; Name tapes of textile material for marking clothing; Orsedew [trimmings for clothing]; Ostrich feathers [clothing accessories]; Patches for clothing; Patches for use in the repair of clothing; Reinforcing tapes for clothing; Shoulder pads for clothing; Snap buttons for clothing; Snap hooks [fasteners] for clothing; Spangles for clothing; Studs for clothing; Tinsels [trimmings for clothing]; Trimmings for clothing; Twisted cords for clothing; Whalebones for clothing; Clothing (Fastenings for -); Clothing buckles; Belt buckles [for clothing]; Belt buckles of precious metal [for clothing]; Name tags of textile for identifying clothing; Clothing buckles; Clothing buckles.

The proprietor's second mark:

Class 3

Skin care preparations; make-up; moisturisers; body cleaning and beauty care preparations; cosmetics and cosmetic preparations; cosmetic kits; compacts containing make-up; sunscreen creams; hair treatment preparations; soaps and gels; perfumery and fragrances; nail polish; eyelashes; deodorants and antiperspirants; dentifrices and mouthwashes.

Class 18

Leather and imitations of leather; trunks and travelling bags; bags; luggage; holdalls; handbags; rucksacks; purses; wallets; umbrellas, parasols and walking sticks; saddlery, harness, whips and apparel for animals; parts and fittings for all the aforesaid goods.

Class 25

Clothing; footwear; headgear.