

BL O/540/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK3569618

BY PIPL LIMITED

TO REGISTER THE TRADE MARK:

NOOSPHERE

IN CLASS 35

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 600001989

BY ROMAN TARABRIN

Background

1. On 18 December 2020, PIPL LIMITED (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 30 July 2021. The applicant seeks registration for the a range of services in Class 35.

2. On 29 October 2021, Mr Roman Tarabrin (‘the opponent’) filed a Notice of Fast track Opposition and statement of ground (‘Form TM7F’) opposing the application in full on the basis of section 5(2)(b) of the Trade Marks Act 1994 (‘the Act’).

3. On 13 December 2021, the Registry served the TM7F on the applicant. The deadline for the applicant to file its Notice of defence and counterstatement (‘Form TM8’) was set at 14 February 2022 which was 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 Form TM9c) MUST be received on or before 14 February 2022.

An address for correspondence in the United Kingdom (which for the purpose of the Act includes the Isle of Man, the Channel Islands and Gibraltar) must be provided on a Form TM33 within this period. If one is not provided within this time, the application will be treated as withdrawn in whole or part.

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)

4. On 2 March 2022, the Registry wrote to the applicant stating:

“The official letter dated **13 December 2021** invited the applicant to file a TM8 and counterstatement on or before **14 February 2022**.

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 directs otherwise, 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 **30 March 2022**. 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. On 30 March 2022, the applicant filed the Form TM8 together with a witness statement providing reasons for not filing the Form TM8 by its original deadline. The reasons provided were that the applicant had engaged a Mr Steve Neil, director and senior consultant of The Trademarks Helpline, to submit the Form TM8 on their behalf. The applicant provided an email chain showing emails between them and Mr Neil with the latest email on 10 February 2022 from Mr Neil stating he would “send confirmation when we have submitted the TM8”. It was only after they had received the letter from the registry dated 2 March 2022 confirming that the application was being deemed

abandoned that the applicant realised there was an issue. The applicant attempted to contact Mr Neil and the Trademark Helpline but received no responses.

6. In an official letter dated 7 April 2022 sent to both parties, the registry stated:

“The Registrar has reviewed the evidence filed and is satisfied that the applicant showed clear intention to defend its application.

It is the preliminary view of the Registry to allow the Form TM8 and counterstatement received on 30 March 2022 into the proceedings.

7. In the same letter, the parties were given until 21 April 2022 to request a hearing if they wished to challenge the preliminary view.

8. On 21 April 2022, the opponent emailed the registry requesting a hearing in order to challenge the preliminary view.

9. A hearing was scheduled for 12 May 2022 and the details were sent to the parties in an official letter from the registry on 26 April 2022. Both parties confirmed they would be attending the hearing.

10. The opponent filed submissions/skeleton arguments on 28 April 2022 and the applicant submitted skeleton arguments on 10 May 2022.

11. The hearing took place before me via telephone, on 12 May 2022. The applicant was represented by Ms Sandra Santos of MAPA Trademarks in Spain. The opponent was present along with his colleague, Ms Olesya Verbitskaya.

Skeleton Arguments

12. The opponent's main argument against allowing the late submission of the Form TM8 was that it took the applicant 28 days to submit the form together with witness statement from when they were informed that the application was to be considered abandoned on 2 March 2022. The opponent considered this to be an 'unreasonably

prolonged period'. The opponent made further mention that they had made efforts to resolve the dispute with the applicant outside of proceedings and had proposed to apply for a cooling off period with Form TM9c in order to have a further seven months to find a solution for both parties.

13. The applicant's skeleton argument reiterated the information from the previously submitted Witness Statement as mentioned above in paragraph 5.

14. The applicant's skeleton argument goes on to address the factors from *Music Choice Ltd's Trade Mark* [2006] R.P.C. 13. It confirms that they had engaged and paid the attorney at The Trademark Helpline who then confirmed they would submit the TM8 on behalf of the applicant. The applicant became aware of the issue on receipt of the letter of 2 March 2022 regarding treating the application as abandoned. The applicant then attempted to contact the Trademark Helpline in order to find out what had happened but was unsuccessful. The applicant claims there was intention to defend the mark and that they were not at fault for the late filing.

15. The applicant then goes on to claim that the opponent's mark is subject to proof of use, which it believes the opponent will fail on and that the services are dissimilar and therefore, there is an arguable case which requires the filing of evidence.

16. Next, the applicant claims that the consequence of not allowing the late TM8 is that its application will be deemed abandoned which is 'clearly a serious consequence'. Alternatively, if allowed, then the applicant will have opportunity to defend its mark and the parties will be allowed to file evidence.

17. Regarding any prejudice to the opponent by the delay, the applicant states that it does not believe that there was any and comments that the opponent had actually proposed a cooling off period to allow further time for negotiations.

18. Finally, the applicant states that there are no other related proceedings and it does not believe that there are any other considerations.

Hearing discussion

19. In the hearing the applicant further commented that it had engaged Mr Steve Neil as attorney to submit the Form TM8 and counterstatement and were shocked at receiving the letter from the registry of 2nd March confirming that matter was to be considered abandoned. The applicant explained that it had tried several times to contact Mr Neil and the Trademark Helpline but to no avail. I asked whether the applicant had since heard from Mr Neil and the applicant confirmed it had not.

20. The applicant explained that it noted the submissions of the opponent that it took 28 days from the notification letter of 2nd March to the 30th March for the applicant to submit the Form TM8 but that the date of 30th March was given to it by the registry as a timeframe to submit the form and witness statement.

21. The applicant moved on to say that it does not believe that the opponent faces any prejudice if the Form TM8 is admitted after the original date and that the applicant will be more prejudiced as it will lose the application. It stated that the applicant will have to file the application again and the opponent will have to oppose again which will waste time and money.

22. The opponent stated that they were not aware of the new deadline of 30 March that was given to the applicant. I clarified that rather than it be an immediate extension of the deadline it was an opportunity for the applicant to file the Form TM8 along with providing reasons as to why it was late, it was a procedural pathway that led us to having this hearing so we could assess whether there were indeed a reasonable excuse for the late filing.

23. The applicant claimed that it did not believe the opponent's mark had been used and therefore, were requesting proof of use which is a key part of their defence. It was also mentioned that in the event the Form TM8 was not admitted, the applicant would likely re-file the trademark and opposition proceedings would likely come about again.

24. I further remarked after comments from both parties that this is indeed just a procedural hearing with the merits of the cases to be looked at later on should the late

TM8 be allowed into proceedings. I confirmed to both parties that I was reserving judgement in order to review the transcript of the hearing and the submissions of both parties and that a written decision would be sent to both parties in due course.

Decision

25. The filing of a Form TM8 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 counterstatement.

(2) Where the applicant fails to file a TM8 or counter-statement within the relevant period, the application for registration, insofar as it related to the goods and services in respect of which the opposition is directed, shall, **unless the registrar otherwise directs**, be treated as abandoned.”

26. 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.”

27. There is no suggestion that there has been any irregularity on the part of the Registry. Therefore, the only basis on which the applicant may be allowed to defend the opposition proceedings is if I exercise in its favour the discretion afforded to me by the use of the words “unless the registrar otherwise directs” in Rule 18(2).

28. When approaching the exercise of discretion here, I must take into account the decision 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) where it is set out that I have to be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the applicant's favour.

29. 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;

30. As mentioned above, the deadline for filing the Form TM8 was 14 February 2022. The form was subsequently submitted together with witness statement on 30 March 2022. This means that the deadline was therefore missed by 44 days. The main reason for missing the deadline was that the applicant had instructed legal representatives to complete and submit the form on its behalf and that this was not carried out by the representatives. The applicant then spent time trying to contact the representatives, to no avail, and then moved to prepare and submit the documents themselves. It submitted several times that it then abided by the time limit given by the Registry to submit the TM8 with the witness statement.

31. The applicant provided screenshots of an email chain between themselves and The Trademark Helpline/Mr Steve Neil. These are dated 10 February and Mr Neil states:

“...we can file a TM8 by the deadline on your behalf...”

This is followed by an email from Ms Santos for the applicant stating she had sent payment and attaching a screenshot. Mr Neil replies with thanks and stating he will send confirmation once submitted.

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

32. The opposition is brought 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;

33. If the Form TM8 is admitted into proceedings and the applicant is therefore allowed to defend its mark, the proceedings will continue and the parties will be able to file evidence and submissions as necessary and the matter will be determined on its merits. There is also the proof of use element for the opponent's mark that will be determined. Alternatively, if the applicant is not allowed to defend its mark then the application will be treated as abandoned and the applicant will lose its 18 December 2020 filing date.

Any prejudice caused to the opponent by the delay;

34. The applicant submitted in its skeleton argument and submissions at the hearing that the opponent would not face any prejudice by the delay in admitting the Form TM8 and that this is supported by the fact that the opponent proposed Form TM9C to be signed in order to enter into a cooling off period for negotiations.

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

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

Conclusions

36. Considering the specific circumstances in this matter, the reason for missing the initial deadline for the filing of the Form TM8 was down to the representatives that had been paid by the applicant simply never filing the form. The applicant has shown the email chain between themselves and the Trademark Helpline where they ask them to complete and file the form on their behalf. The return emails show confirmation that this will be done by the deadline and provision of an invoice for the works to be completed. The applicant is then shown to have provided proof of payment with further confirmation then received from Mr Steve Neil of the Trademark Helpline.

37. It is reasonable for the applicant to have relied on the assurances from the Trademark Helpline that they would file the Form TM8 prior to the deadline on their behalf and this clearly shows that the applicant had every intention of defending their mark. What is more difficult to justify is why the applicant did not attempt to check with the attorney after the deadline date to make sure the TM8 form had been sent. This would have meant that they may have become aware of the deadline being missed sooner and prior to the Registry's letter determining the application to be abandoned.

38. The next thing to consider is the length of time it subsequently took the applicant to file the TM8 and witness statement. They confirmed that they were surprised to receive the Registry's letter of 2 March 2022 confirming that the Form TM8 had not been received and therefore the application was being deemed abandoned. It subsequently submitted the Form TM8 together with witness statement and supporting evidence on 30 March. This date was given to them as a deadline within the letter dated 2 March. This is 28 days or 21 working days later. I consider the applicant's actions of first trying to make contact with the Trademark Helpline in order to ascertain what had happened with regards to the filing of the Form TM8 to be reasonable. This length of time however, could have been shortened had the applicant made efforts to check with the Trademark Helpline that the Form TM8 had been sent

39. Whilst I acknowledge that the filing of the Form TM8 is a relatively simple task, the applicant also needed to file its witness statement and supporting evidence and it did then abide by the timescale given to them by the Registry.

40. I recognise that if I do not exercise the discretion afforded to me in the applicant's favour, the application will be treated as abandoned and the filing date lost. It is also possible that the applicant could simply re-file the application for the mark and it may once again face opposition by the opponent- in fact this was indeed mentioned by the applicant. This will bring us full circle back to this point in proceedings once more.

41. I am sympathetic to the applicant's position of having relied upon a representative to carry out the filing of the Form TM8 on their behalf only for this not to occur. However, given the importance of filing the Form TM8 in these proceedings, it is difficult to see why the applicant did not check with the Trademark Helpline that the work had been carried out. This would have brought to their attention much sooner that the TM8 had not been filed in time and the applicant could have contacted the Registry much sooner.

42. On balance, the initial missing of the deadline was not the fault of the applicant and they are able to show intention to file a defence. I do believe they could have acted sooner to rectify matters. I am aware that the applicant will likely re-file their application and we would most likely end up with duplicity of proceedings which will lead to increased costs and time for both parties. Therefore, on this occasion, I am exercising the discretion provided under rule 18(2) in the applicant's favour.

Outcome

43. The consequence of the above finding is that the applicant's Form TM8 and counterstatement will be admitted into the proceedings and assessed accordingly. Providing no anomalies are identified, it will then be formally served upon the opponent and a timetable will be set for filing evidence.

Costs

44. As I have admitted the applicant's defence into the proceedings, and the opposition is allowed to continue, costs will be considered at the final determination of the case.

Dated this 22nd day of June 2022

L NICHOLAS

For the Registrar