

O/575/22

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. 03672317 BY**

VADIM GORAS

TO REGISTER THE TRADE MARK:

Xiomi

IN CLASS 12

AND

**OPPOSITION THERETO
UNDER NO. 428902
BY
XIAOMI INC.**

Background

1. On 23 July 2021, Vadim Goras (“the applicant”) applied to register trade mark number shown on the cover page of this decision in the UK. The application was published for opposition purposes on 10 September 2021. The applicant seeks registration for the following goods:

Class 12: Electrically operated scooters; Electrically powered scooters; Electrically-powered motor scooters; Scooters; Electrically powered scooters [vehicles]; Self balancing electric scooters; Electric one wheel scooters; Pedal scooters; Motor scooters; Scooters [vehicles]; Mobility scooters; Self-balancing one-wheeled electric scooters; Self-balancing two-wheeled electric scooters; Water scooters; Motorized scooters; Scooters [for transportation]; Push scooters [vehicles]; Self-balancing scooters; Baskets adapted for scooters; Non-motorized scooters [vehicles]; Motorized and non-motorized scooters for personal transportation; Motorised scooters for the disabled and those with mobility difficulties.

2. On 8 December 2021, Lane IP Limited filed form TM7 (“Notice of opposition and statement of grounds”) on behalf of Xiaomi Inc. (“the opponent”). The opposition is based on the Sections 5(2)(b), 5(3), and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and is directed against all of the goods in the application. The opponent is the proprietor of the following marks:

Trade Mark no.	WO0000001352685
Trade Mark	XIAOMI
Various goods and services relied upon in Classes 12, 14, 16, 20, 21, 25, 28, 36 & 37.	
Relevant Dates	Designation date: 16 June 2016
	Date of protection of the international registration in UK: 8 September 2017

Trade Mark no.	UK00918214857
Trade Mark	Xiaomi
Various goods relied upon in Classes 5, 7, 11, 12, 26, 30, 31 & 32.	
Relevant Dates	Filing date: 25 March 2020
	Date of entry in register: 4 October 1888

3. On 13 January 2022, the Registry served the TM7 on the applicant. The deadline for the applicant to file his Notice of defence and counterstatement ('Form TM8') was set at 14 March 2022 which was communicated by the Registry in the serving letter. The Registry's letter is reproduced as follows:

If you wish to correspond by email please reply to Tribunalsection@ipo.gov.uk and ensure your email is copied to the other party.

Dear Sirs,

Please find enclosed a copy of the notice of opposition - Form TM7 - filed against your application.

If you wish to continue with your application, you need to file a notice of defence and counterstatement by completing Form TM8 - please note the important deadline below. You will find a blank Form TM8 on the IPO website, together with brief guidance on what happens after it is filed: <https://www.gov.uk/government/publications/trade-mark-forms-and-fees/trade-mark-forms-and-fees>

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 14th March 2022.

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.**

Before you decide whether to defend your application, you may wish to refer to the guidance notes on opposition proceedings and the scale of costs which are available from the IPO website at www.ipo.gov.uk.

A Glossary of terms is available from the IPO website at <https://www.gov.uk/government/publications/trade-marks-tribunal-glossary-of-terms>

The Office actively encourages parties to mediate as a swifter and less costly alternative to litigation. If you feel that this option is of interest, the Office can either provide a member of its own team of accredited mediators, each with extensive experience of dealing with intellectual property disputes, or can provide a list of other mediation providers. For more information, please visit the IPO's website at: <https://www.gov.uk/guidance/intellectual-property-mediation>, or contact mediation@ipo.gov.uk.

4. On 5 April 2022, the Registry wrote to the applicant stating:

“The official letter dated **13 January 2022** invited the applicant to file a TM8 and counterstatement on or before **14 March 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 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, **19 April 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 5 April 2022, the applicant sent the following email to the Registry:

Hello, tm8 was sent to you and to another participant On 23.01.2022
Will attach screenshot as proof and will attach tm8 again as proof

Sincerely
Vadim Goras

6. With that email, the applicant filed the Form TM8 together with an attachment of a screenshot showing an email, dated 23 January 2022 and headed “tm8”, sent by the applicant to the email address ‘forms@ipo.co.uk’. On 6 April 2022, the Registry confirmed receipt of the email and stated:

“It is noted, you have attached a screenshot of the email confirmation. However, please note, there is an email address error contained in the document provided.

As stated in the official letter dated 5th April 2022, if you disagree with the preliminary view you **must** provide full written reasons and request a hearing, 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.

Please request a hearing accompanied by a Witness Statement on or before 13th April 2022.

If no response is received the registry will proceed to deem the application abandoned.”

7. On 18 April 2022, the applicant requested a hearing and filed a witness statement, signed by Vadim Goras, providing reasons for not filing Form TM8 by its original deadline, the contents of which are as follows:

“Can confirm that had download TM8 (Notice of defence and counterstatement for trade mark number:uk00003672317) form for

from the link you sent to me and fill up and sent on 23.01.2022, I sent form on email address which was indicated on TM8 form (FORMS@ipo.co.uk) .i send screenshoot confirming that.

As you mentioned that it is wrong email address I can sent it to Tribunalsection@ipo.gov.uk as well.” (sic)

8. A hearing was scheduled for 30 June 2022 and the details were sent to the parties in an official letter from the Tribunal on 14 June 2022. Both parties confirmed they would be attending the hearing, and the applicant filed skeleton arguments on 27 June 2022.

Skeleton Arguments

9. The applicant’s skeleton arguments reiterated the information from the previously submitted witness statement as mentioned previously, but in a more detailed manner:

“Me Vadim Goras as applicant, filled up TM8 form which I sent it on 23.01.2022 via email on FORMS@ipo.co.uk. This email is indicated on TM8 form that need to be send on. Unfortunately On 05.04.2022 I got an email where it says that no TM8 and counterstatement has been filed within the time period set which was 14.04.2022 last day. As I was following instructions on TM8 form I think that it was sent on time and on right email Adress. Want to specify that tm8 form was downloaded from gov official site.” (sic)

The Joint Hearing

10. The hearing took place before me, via telephone conference, on Thursday, 30 June 2022. The applicant, Mr Vadim Goras, was a litigant in person, and Mr Matthew McAleer of Lane IP Limited represented the opponent.
11. At the hearing, I explained to both parties that the purpose of the hearing was to consider whether the late filed defence should be admitted into the

proceedings. I also highlighted that the TM8 deadline is a non-extendible time limit, pursuant to the relevant case law and Trade Mark Rules 2008 (“the Rules”). However, there is a narrow window of discretion that I have to extend that deadline provided there are compelling reasons or extenuating circumstances.

12. The applicant’s submission was foreshadowed in his skeleton argument. Mr Goras explained that he did not file the Form TM8 late, but instead he sent it to the wrong email address, which he claimed he found on the Form TM8. In this respect, he stated that:

“I submit the TM8 form before deadline but it was -- how I understand it, it was on the wrong e-mail address, but I sent on what I found on that form. It was saying to send this form to that e-mail address and I double it to Opponent as well, to their e-mail as well, in January.” (sic).

Lastly, the applicant further clarified that he emailed the Form TM8 to two email addresses, i.e. ‘forms@ipo.co.uk’, copying in the opponent, before confirming that he had nothing else to add.

13. Turning to Mr McAleer, he drew my attention to Rule 18(2) and that the applicant had a window to file a counterstatement but failed to do so. He then submitted that it is irrelevant whether this is done via email address or otherwise. Mr McAleer stated that despite the clear instructions on the Form TM8, the applicant “sent it to the wrong email address so it has not been communicated to the Registry as is required”. Furthermore, Mr McAleer stressed that the applicant has submitted no witness statement or evidence and that the applicant’s email containing evidence was not in the correct format, “so it should not be admitted into these discussions”. He also added that the opponent would be prejudiced if the late filing of the TM8 is allowed “spending thousands of pounds into proceedings in opposition”. Mr McAleer added that the opponent should not be prejudiced because of the applicant’s decision to represent himself. Mr McAleer concluded by stating that “[...] the counterstatement was not served to the

address on the form as required within the timeframe and therefore the late counterstatement should not be accepted.”

14. At the hearing, I reserved my decision. In making my decision, I have reviewed all of the papers on file, the applicant’s skeleton arguments, and both parties’ submissions, which I take into account.

Decision

15. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by Rule 18 of the Rules, which provides as follows:

“(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”. (Emphasis added)

16. 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 rules 77(5)(a) and (b) which provide that:

“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.”

17. It was not disputed that the late filing of the Applicant’s TM8 in this instance was not because of an irregularity, default, omission or other error on the part of, inter alia, the Registrar. Therefore, my consideration is restricted to the limb of the discretion contained in the words “unless the registrar otherwise directs” under Rule 18(2).
18. 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.
19. 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

20. As noted above, the stipulated deadline for the filing of the applicant’s Form TM8 and counterstatement was 14 March 2022. The deadline was missed because the applicant has used an incorrect email address, namely ‘forms@ipo.co.uk’ instead of ‘forms@ipo.gov.uk’. The applicant’s explanation as to why the deadline was missed has been delineated above. The applicant accepted at the hearing that he used the incorrect email address.

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

21. The opposition is brought under Sections 5(2)(b), 5(3), and 5(4)(a) 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

22. If the applicant is permitted to defend the opposition, the proceedings will continue with the parties given an opportunity to file evidence, and the matters will be determined on their merits. However, if the applicant is not allowed to defend his application, it will be treated as abandoned, and the applicant's mark will lose its filing date of 23 July 2021. Nevertheless, 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

23. The opponent has not identified any prejudice other than costs. Based on the fact that the applicant is an unrepresented party, this should not cause prejudice to the opponent.

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

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

Conclusions

25. Considering the specific circumstances in this matter, the reason for missing the initial deadline for the filing of Form TM8 was down to the use of the incorrect email address. During the hearing the applicant claimed that copy of the Form TM8 was sent to the opponent, but the opponent did not confirm that. Although the applicant admitted that he used the wrong email address, no explanation was provided on how he came to this error.

An excerpt showing the relevant instructions, including the email address and information, in Form TM8 is reproduced as follows:

Email your form to us:	If you cannot email your form, post to:
Send your form, saved as a PDF to: forms@ipo.gov.uk For help saving your form as a PDF see: https://www.gov.uk/government/publications/how-to-file-documents-with-the-intellectual-property-office/how-to-file-documents-with-the-intellectual-property-office	Intellectual Property Office Trade Marks Registry Concept House Cardiff Road Newport South Wales NP10 8QQ

This clearly shows that the email address provided with the Form TM8 is 'forms@ipo.gov.uk' and not 'forms@ipo.co.uk' as the applicant claimed throughout these proceedings. In addition, as shown in paragraph 3 of this decision, with the Registry's letter, dated 13 January 2022, a clear instruction was provided to the applicant to reply to 'Tribunalsection@ipo.gov.uk', but the applicant failed to do so. That said, the applicant clearly intended to defend the opposition and file the Form TM8 in time, but he inadvertently used the incorrect domain extension, namely 'forms@ipo.co.uk' instead of 'forms@ipo.gov.uk'. Although it may be reasonable for the applicant to rely on the sole fact that he filed the Form TM8 within the given time period, in reality, the Form TM8 was not received, and, thus, the application was deemed abandoned.

26. Although Mr McAleer mentioned that the applicant submitted no witness statement, I note that the applicant filed a witness statement on 18 April 2022, which briefly confirmed what he said at the hearing while referring to the evidence attached with his email on 5 April 2022. The opponent has not been prejudiced by not receiving the witness statement beforehand as it purely outlined the position set out at the hearing, namely that the applicant accepted that the Form TM8 had been sent to the wrong email address. The same applies to the evidence, which has been accepted by the Registry, and, in any event, this simply confirms the error in the email address.

27. From the applicant's explanation it is clear that a single critical error was made resulting in the failure to file the Form TM8 and counterstatement in time. In *Praesidiad NV v Tescon Sicherheitssysteme Schweiz GMBH* ("Tescon"), BL O/240/20, Mr Geoffrey Hobbs Q.C. as the appointed person stated at paragraph 32 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 the 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). There must, in other words, be a fact specific evaluation for the purpose of determining whether the particular error in question should or should not be treated as excusable in the circumstances of the case at hand."

28. Although *Tescon* concerned an application for invalidity, the same assessment is relevant to the late filing of a Form TM8 and counterstatement in opposition proceedings. Moreover, while, ultimately, the decision not to admit the Form TM8 into proceedings was upheld in *Tescon*, Mr Hobbs acknowledged that human errors can constitute extenuating circumstances or compelling reasons sufficient for the exercise of discretion, where the specific facts of the case merit it.

29. Whilst this can be considered a human error, the applicant does not appear to have exercised the "minimal degree of vigilance"¹ required to ensure the correct email address of the Registry. It is unfortunate that due to this human error the applicant has been driven to believe that he successfully filed a Form TM8; instead, he "had been the author of [his] own misfortune."²

¹ See *Kickz AG v Wicked Vision Limited*, BL-O-035-11, in paragraph 15.

² *Ibid.*

30. Considering all the factors above, I do not find that the necessary reasons have been made out. While it is clear that the applicant had an intention to defend the opposition, it is clear from the case law mentioned earlier in this decision that Rule 18(2) provides only a narrow discretion that I may exercise in the applicant's favour. I have some sympathy with the position in which the applicant has found himself, from the reasons I described above, however, it does not appear that there exists an extenuating circumstance or a compelling reason to exercise such discretion as provided by Rule 18(2).
31. I recognise that the application, if re-filed, is likely to be opposed by the opponent in a new opposition proceeding. However, such consequences are most likely in circumstances where there is a failure to comply with a non-extensible deadline.
32. **The late Form TM8 is not to be admitted into the proceedings. Consequently, as the opposition against the application at hand is deemed as undefended the application will, subject to any appeal, be treated as abandoned.**

Costs

33. As my decision terminates the proceedings, I must consider the matter of costs. Awards of costs are set out in Tribunal Practice Notice ("TPN") 2/2016. Using the guidance set out in the TPN, I award the opponent costs on the following basis:

Official opposition fee	£200
Preparing a statement and considering the counterstatement	£200
Preparing for & attending the hearing	£300
Total	£700

34. I order Vadim Goras to pay Xiaomi Inc. the sum of £700. This sum is to be paid within two months of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of July 2022

**Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General**