

o/628/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003645289

IN THE NAME OF SAMI ASGHAR AND RAFI ASGHAR

TO REGISTER THE FOLLOWING TRADE MARK:

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(SERIES OF 2)

IN CLASS 34

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 427658

BY BHOPINDER SINGH

BACKGROUND

1. On 21 May 2021, Sami Asghar and Rafi Asghar (“the applicants”) applied to register the series of 2 trade marks shown on the cover page of this decision in the UK. The applicants seek registration for the following goods:

Class 34 Cartridges for electronic cigarettes; Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; Chemical flavourings in liquid form used to refill electronic cigarette cartridges; Chewing tobacco; Devices for heating tobacco for the purpose of inhalation; Electric cigarettes [electronic cigarettes]; Electronic cigarette atomizers; Electronic cigarette boxes; Electronic cigarette cartomizers; Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Electronic cigarettes; Electronic cigarettes for use as an alternative to traditional cigarettes; Electronic devices for the inhalation of nicotine containing aerosol; Electronic nicotine inhalation devices; Flavorings, other than essential oils, for tobacco; Flavorings, other than essential oils, for use in electronic cigarettes; Flavourings, other than essential oils, for tobacco; Flavourings, other than essential oils, for use in electronic cigarettes; Liquid for electronic cigarettes; Liquid nicotine solutions for electronic cigarettes; Liquid nicotine solutions for use in electronic cigarettes; Liquid solutions for use in electronic cigarettes; Liquids for electronic cigarettes; Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; Refill cartridges for electronic cigarettes; Smokers' articles; Snus; Tobacco and tobacco products (including substitutes); Vaporizers for smoking purposes; Electronic cigarettes for use as an alternative to traditional cigarettes; Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Electric cigarettes [electronic cigarettes]; Liquid solutions for

use in electronic cigarettes; Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor.

2. The application was published for opposition purposes on 23 July 2021.

3. On 20 October 2021, National Business Register Group Ltd filed a Form TM7 (“Notice of Opposition and statement of grounds”) on behalf of Bhopinder Singh (“the opponent”) opposing the application in full on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

4. On 17 November 2021, the Registry served the TM7 on the applicants by Tracked Royal Mail signed for post and email. The registered address for the applicants’ was “Abell Morliss International Ltd, 128 Cannon Workshops, 3 Cannon Drive, E14 4AS”. I note that the Registry received a recorded delivery receipt to show that the TM7 was served successfully on 18 November 2021. Under “proof of delivery” a signature has been provided which says “XP1”, and was “Signed for by: JIM. @ CANNON”.

5. The deadline for the applicants to file their Form TM8 (“Notice of defence and counterstatement”) was 17 January 2022, 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 17 January 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.**” (original emphasis)

6. On 31 January 2022, the Registry wrote to the applicants again, stating:

“The official letter dated **17 November 2021** invited the applicant to file a TM8 and counterstatement on or before **17 January 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, **14 February 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.”

7. On 14 February 2022, the Registry received a telephone call from Sami Asghar in relation to the letter dated 31 January 2022. The applicants explained that they had not received the letter (either by email or by post) which was dated 17 November 2021. The Registry re-sent this correspondence to the applicants, and they subsequently filed a Form TM8 on the same day.

8. The TM8 included a witness statement which was not filed in the correct format. Therefore, on 25 February 2022, the Registry wrote to the applicants notifying them that the witness statement was not admissible. On 11 March 2022, the applicants

rectified this issue by filing an amended TM8 and witness statement. The witness statement provided the following reason as to why a Form TM8 had not been filed:

“I believe there has been an error on communicating the initial correspondence of 17 November 2021 in relation to opposition No. OP0000427658 in respect of Trademark No. UK00003645289 to us. We have only received a communication dated 31 January 2021 informing us, to our surprise, of a missed deadline. Such communications are usually received by our previous accountants, whom forwarded such communications to us on receipt the same day. They have confirmed to us that no previous such communication has been received by them. I have also checked via email and cannot see previous communications regarding this.”

9. In an official letter dated 19 May 2022, sent to both parties, the Registry stated:

“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. After careful consideration of the contents of the information you have provided, it is the Registrar’s preliminary view that no mitigating circumstances would appear to exist which permits the Registrar to exercise his limited discretion and admit a late filed Form TM8 into these proceedings.

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-challengedecision-results.htm>. “

10. In the same official letter, the parties were given until 2 June 2022 to request a hearing if they wished to challenge the preliminary view.

11. On 2 June, the applicants notified the Registry that they disagreed with the preliminary view and requested a hearing.

12. A hearing was scheduled for 28 June 2022, the details of which were sent by the Registry to both parties in an official letter dated 8 June 2022. The opponent notified the Registry that they would be in attendance on 14 June 2022. The applicants notified that Registry that they would be in attendance on the morning of the hearing.

13. On 24 June 2022, the opponent filed its skeleton argument and witness statement with exhibits MW1 to MW2. I note that the evidence mainly pertains to the recorded delivery receipt which was signed for by “JIM. @ CANNON” who the opponent believes is Mr James M Swallow, the Director of Abell Morliss International Limited.

14. On the morning of the hearing, 28 June 2022, the applicants sent the Registry evidence, in the form of an email from Mr James M Swallow, confirming that he had not signed for the letter which served the TM7.

THE HEARING

Representation

15. The hearing took place before me, via telephone, on 28 June 2022. The opponent was represented by Mr Mitchell Willmott and the applicants were represented by Ms Naz Asghar Sheikh.

16. At the hearing, Ms Sheikh submitted that the applicants filed their TM8 defence late because they had not received the notice in November, either by email or post. The earliest correspondence that they had received from the Registry was in January 2022.

17. I asked the applicants for further clarification on what was submitted within Sami Asghar’s witness statement. Firstly, I asked what was meant by “an error on communicating”. Ms Sheikh stated that it simply meant that the applicants had not received the correspondence. She also stated that “we checked through to the

correspondence address at Cannon Workshops to see if there was any sort of mistake their end, and both the director of Abell Morliss and all the secretaries have confirmed nothing actually arrived there” in November. Ms Sheikh also stated that “they searched on the background of the tracking as well, where it was signed for by XPI” by the post person. She noted that this signature was not just used “in the circumstances of Covid, they have been doing until date, where the post person would just sign for it themselves, but that does not give information where did the actual post go or get received by”.

18. Following the above, I asked whether the applicants worked at the Cannon address. It was clarified that the address is a “correspondence address” because “Abell Morliss were our previous accountants and they continued to receive correspondence on our behalf”. For clarification, I confirmed that the address, Cannon Workshops, “is where your accountants reside and that is where all of your communications go from them and then to yourselves?” to which Ms Sheikh confirmed “Yes. They open them up and they just scan them through to ourselves”. I note that it was confirmed that this address received the Registry’s letter dated 31 January 2022, which was then scanned and sent to the applicants.

19. As highlighted above, the correspondence from November 2021 was sent to both the applicants via post and email. Therefore, I also asked for further clarification on the email that the Registry has on file for the applicants. It was confirmed by Ms Sheikh that the email address “comes directly to Sami”. Ms Sheikh said that “there is no correspondences from November that we could find at all. Usually we’re very prompt at responding to any correspondence”.

20. It was then Mr Willmott’s opportunity to present the opponent’s arguments. He started with a preliminary point regarding the email from James M Swallow which was dated 28 June 2022. Mr Willmott submitted that the evidence should not be taken into account because it wasn’t received two days before the hearing and the opponent was not copied into the correspondence. At the hearing, I told the parties that I would address this matter in my decision letter.

21. Mr Willmott also argued at the hearing that the letter which contained the TM7 was received and accepted at the applicant's address at 10:22am on 18 November 2021. The post person recorded the recipient's name as "JIM @ CANNON". At exhibit MW1, Mr Willmott shows that the Royal Mail uses the signature XP1 during the pandemic to reduce the handling of hand held devices to record signatures. However, instead, they would log the name of the person accepting the item.

22. The applicants had claimed that there was no one called Jim at 128 Cannon Workshop, however, the opponent had found that the Director of Abell Morliss International Limited is called James Malcom Swallow, as exhibited at MW2. The opponent seems to heavily imply that Jim is a shortening for James, and most likely for James M Swallow.

23. However, as established by the email evidence sent in by the applicant, Mr Swallow confirmed the following:

"I am a little confused that you are being told that someone called Jim signed for a letter last November, that was sent to my office.

The only male employed here is myself, and I am always known as Malcom, and specifically would only ever sign for papers using my formal name of JM Swallow".

24. Lastly, Mr Willmott submitted that it is "clear that the Registrar is in no way in default in this matter. It has not made any omission or any other error that has caused the applicants to miss the deadline date. The fault lies clearly with the applicants in not putting in place a system or procedure for checking and dealing with registered letters. It is obvious that the official notification has been mislaid because the minimum degree of vigilance required to prevent that from happening has not been exercised". Mr Willmott also highlighted that the applicants were fully aware, following the filling of their application, that a notice of threatened opposition could be filed against their trade mark, "and the Registrar's letter accompanying the TM7A explained to the applicant that the opposition period had been extended to three months from the publication date". Therefore, the preliminary view to refuse the late TM8 into proceedings was correct.

EMAIL EVIDENCE

25. As highlighted above I notified the parties that I would address the applicant's evidence in my decision letter.

26. I consider that the email evidence provided by the applicant is acceptable. Albeit the evidence was submitted in the morning of the hearing, Ms Sheikh confirmed that "the correspondence from the director of Abell Morliss is confirming that he is actually not Jim at Cannon by email of today, was only received today". I take that into account and also consider that this evidence is relevant to the proceedings and, therefore, has been considered in this instance.

DECISION

27. 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."

28. 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.”

29. In this instance there has been no irregularity in procedure by the Registry, accordingly, I need not consider the provisions of Rule 77(5) further.

30. I must also consider the possibility of a failure in a communication service. In this regard, Rule 76 of the Rules provides the following:

(1) The registrar shall extend any time limit in these Rules where the registrar is satisfied that the failure to do something under these Rules was wholly or mainly attributed to a delay in, or failure of, a communication service.

(2) ...

(3) In this rule “communication service” means a service by which documents may be sent and delivered and includes post, facsimile, email and courier.

31. I note that the correspondence dated 17 November 2021, which served the form TM7 on the applicants, was served via recorded delivery and via email at the Registry’s recorded address for the applicants. Whilst a multi occupancy building lends itself to difficulties with the receipt of ordinary post, it does not explain the difficulties with a letter having been sent by email or recorded delivery. The Registry did not receive the normal notification I would have expected when a letter failed to be served, namely the original letter being returned to sender, or the email being returned as undelivered. There is physical proof that the TM7 serving letter was signed for, albeit by an unrecognised name to the applicants, but it was clearly served at the correct address. I note that the applicant had only stated that they did not receive the notice in November, but had received the correspondence and emails from January 2022 onwards, all of which were sent to the same address, both physical and email, which were also responded to by the applicants. Ms Sheikh did not notify me of any difficulty

with the applicants' post at the correspondence address. Ms Sheikh also clarified at the hearing that the email address which has been used throughout the proceedings is used and accessed directly by the applicants. I further note that the further emails sent to the applicants' email address had been forwarded onto other email addresses which then were used to respond to the Registry.

32. Taking all of the above into account, I do not consider that the applicants have established there was a delay or a failure in the communication services used to deliver the relevant documents and accordingly I need not consider the provision of Rule 76 any further.

33. It is clear that the applicants are relying upon the registrar to exercise its discretion under Rule 18(2) to allow the filing of the form TM8, which would otherwise be non-extendable.

34. 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 applicants' favour.

35. 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;

36. As noted above, the stipulated deadline for the filing of the applicants' Form TM8 and counterstatement was 17 January 2022. The Form TM8 and counterstatement was filed by the applicants on 14 February 2022. Therefore, the deadline was missed

by 4 weeks. The applicants' explanation as to why the deadline was missed is due to not receiving the TM7 serving letter which was dated 17 November 2021.

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

37. 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;

38. If the applicants are 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 applicants are not allowed to defend, their application will be treated as abandoned and the applicants' mark will lose its filing date of 21 May 2021.

Any prejudice caused to the opponent by the delay;

39. No submissions were made by either party regarding prejudice to the opponent.

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

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

CONCLUSIONS

41. In reaching my decision, I recognise that if the discretion is not exercised in the applicants' favour, the application will be treated as abandoned and the applicants will lose the filing date for their mark. I further recognise that it may be that the applicants will simply re-file their 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, at least not in isolation. I must consider the specific circumstances at hand.

42. Firstly, the applicants confirmed that they had received the correspondence dated 31 January 2022 which notified them that no TM8 was received, their application was being treated as abandoned and therefore they had until the 14 February 2022 to disagree with this preliminary view. It took the applicants' until the last day, 14 February, to respond to this. It therefore took them 14 days to respond to this communication which shows no urgency or haste to rectify this problem. I consider that this could also indicate the fact that the "system" they have in place, for their accountants to open and send their correspondence, may not be totally effective. Notwithstanding the email evidence presented by the applicants, which points towards the applicants post being signed by someone (JIM@CANNON) who is not connected to themselves, there is nothing to suggest that the email correspondence wasn't received. All of the correspondence sent to the applicants was always sent in email form also. Ms Sheikh confirmed at the hearing that this email is used and frequently accessed by the applicants. The email address which has been used to correspond with the applicants appears to be functioning because every letter which was sent after the original TM7 serving letter was responded to and received by the applicants via email. It therefore seems implausible that only one email to the same email address did not successfully send. I also note that there is nothing in the Registry's system which confirms that the TM7 serving letter in email form was returned as undelivered.

43. I also note that it is a requirement that a party provides an up to date address and that the onus is on the party to ensure that they have a method in place to receive post if the address provided is not one which they are residing at. In this instance, it is clear the address provided is only a "correspondence address". The onus is, therefore, on the applicants' to have a mechanism in place for the delivery and collection of the applicants post. Ms Sheikh notified myself at the hearing that the accountants open the applicants' post and forward it via email and then via post. It is not clear who is allocated this specific responsibility within the office at Cannon Workshops. It is also not clear as to why the applicants do not use their own residential address to receive such important correspondence. Ms Sheikh paints a picture of a haphazard and

relatively relaxed process, with no checks and balances in place for the receipts of post or the recording of important deadlines. As highlighted by the opponent, once you register a mark, the party is fully informed that a notice of threatened opposition could be filed against their application. Ms Sheikh did not highlight that the applicants made their accountants aware of such potential important post that may be received and how this should be prioritized.

43. This is not the case where the procedure in place broke down or failed as a result of human error (for example the deadline being erroneously recorded) or other extenuating circumstances; it failed as a result of there being a lack of an adequate formal procedure being in place. As highlighted above, Ms Sheikh did not provide me with any evidence or detailed submissions as to what procedures have been put in place by the accountants who check and forward their post. Therefore the responsibility of monitoring the post falls squarely on the applicants. In this regard I find that they are the authors of their own misfortune.¹

44. Having considered the matter, noting the comments by both representatives at the hearing and taking into account the factors as set out by the caselaw in *Kickz*, *Mercury* and *Music Choice* I see no compelling reasons or extenuating circumstances which would justify the use of the Registry's discretion as provided by Rule 18(2).

45. The applicants' late filed TM8 is therefore not admitted into proceedings and 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

46. As my decision terminates the proceedings, I must consider the matter of costs. The opponent has requested that off-scale costs be awarded on the basis that it "didn't believe that the applicants had any real chance of succeeding in this appeal".

47. Rule 67 of the Trade Marks Rules 2008 provides:

¹ Para 15 *Kix Trade Mark O/035/11*

“The registrar may, in any proceedings under the Act or these Rules, by order award to any party such costs as the registrar may consider reasonable, and direct how and what parties they are to be paid.”

48. Tribunal Practice Notice (“TPN”) 4/2007 indicates that the Tribunal has a wide discretion when it comes to the issue of costs, including making awards above or below the published scale where the circumstances warrant it. The TPN stipulates that costs off the scale are available “to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour”.

49. On reflection, I do not consider that the opponent’s reasoning for requesting off-scale costs to be sufficient to warrant the award of off-scale costs in this instance.

50. The relevant scale is contained in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£800** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Official fee for filing the Form TM7	£100
Preparing the statement of case	£200
Preparing for and attending the hearing, Including filing of a witness statement	£500
Total	£800

51. I therefore order Sami Asghar and Rafi Asghar, jointly and severally, to pay Bhopinder Singh the sum of £800. This sum is to 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 25th day of July 2022

L FAYTER

For the Registrar