

**O/734/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF A JOINT HEARING  
IN RELATION TO TRADE MARK APPLICATION NO. 3726781  
IN THE NAME OF SWIFT HEALTH SYSTEMS INC.  
TO REGISTER AS A TRADE MARK**

**INBRACE SMILE FOREVER**

**IN CLASSES 3, 10 AND 21**

**AND**

**THE OPPOSITION THERETO  
UNDER NUMBER 432400  
BY LYZIR LIMITED**

## BACKGROUND

1. On 29 November 2021, Swift Health Systems Inc. (“the applicant”) applied to register trade mark number UK3726781, for the mark shown on the cover page of this decision, in the United Kingdom, claiming priority from US Trade Mark No. 90/749,193, which has a priority date of 02 June 2021. The application was accepted and published for opposition purposes on 24 December 2021, in respect of the following goods and services:

Class 3: *Teeth whitening kit; tooth whitening preparations; dental bleaching gels; tooth whitening pastes; stain removers for teeth; oral care preparations; non-medicated mouth cleanser; oral care water additives; non-medicated oral care preparations in the nature of cosmetic preparations for the care of mouth and teeth; non-medicated dental care and oral hygiene products.*

Class 10: *Orthodontic appliances; orthodontic brackets; teeth aligners; orthodontic retainers; dental apparatus; dental instruments; water picks; dental picks; oral irrigators; tips for oral irrigators; replacement heads and attachments for use with oral irrigators.*

Class 21: *Toothbrushes; electric toothbrushes; heads for electric toothbrushes; electric toothbrush replacement handles; apparatus for cleaning teeth and gums using high pressure water; battery-operated toothbrush and oral irrigator; oral care products; teeth cleaning products.*

2. Form TM7a (Notice of threatened opposition) was filed against the application on 14 February 2022 in the name of Lyzir Limited (“the opponent”), which extended the period for the party to file an opposition by one month, with the given deadline being 24 March 2022. On 24 March 2022, a form TM7 (Notice of opposition and statement of grounds) was filed against the application in the name of Ewelina Fital, and therefore

did not match the details of the opponent recorded on the previously filed form TM7a. Further, it was unclear on which grounds the opponent was basing the opposition as several sections of the form were completed in part only. The form indicated that Section 5(2)(b), Section 5(3) and Section 5(4)(a) grounds of the Trade Marks Act 1994 (“the Act”) were being relied upon, however the information on each of these sections was incomplete. On 11 April 2022, the Tribunal wrote to the opponent stating that further information was required before matters could proceed. The letter stated as follows:

### **“Opponent details discrepancy**

In line with Rule 17(3) and 17(4) of the Trade Mark Rules 2008, the period allowed to file an opposition is two months beginning immediately after the date on which the application was published. This period can be extended to three months by the filing of a Form TM7a. The Form TM7a extends the opposition period only for the person having filed the form, or in the case of a company, a subsidiary or holding company of that company.

The Form TM7a filed on 14 February 2022 was filed with the name of the opponent as being Lyzir Limited, Capital Office, Kemp House, 152-160 City Road, London, EC1V 2NX. The opposition period was therefore extended for Lyzir Limited. However, the TM7 was filed in the name of Ewelina Fital.

Having considered the statement of case, I note that the recorded proprietor of earlier trade mark number UK00003670650 used as a basis for the above mentioned opposition is Lyzir limited, Capital Office, Kemp House, 152-160 City Road, LONDON, EC1V 2NX.

Under the legislative changes that came into force on 1st October 2007, oppositions based on Section 5 of the Trade Marks Act 1994 can only be made

by the proprietor of an earlier mark or other earlier right. As the opposition has been filed by Ewelina Fital, Lyzir Limited, Capital Office, Kemp House, 152-160 City Road, London, EC1V 2NX the opponent's details do not appear to correspond to those of the registered proprietor.

Before the registry can consider admitting the notice of opposition, you are requested to provide an explanation as to the difference in the names of the opponent on the two forms. The registry will then give a view on whether the notice of opposition can be considered. A period of 21 days from the date of this letter, that is on or before 02 May 2022 has been allowed for your response.

### **Related proceedings**

It is noted that you have stated there are proceedings related to this opposition at the IPO Registry, however you have not provided a number. Please review your answer to this question.

### **Grounds for opposition**

You have indicated that the opposition is based on Section 5(3). However, other sections of the form have also been partially completed. Please review the grounds for opposition and fully complete the relevant sections of the form.

### **Section 5 (3)**

It is noted that several questions appear to remain unanswered. You must provide a representation of your trade mark, exactly as it appears on the register and answer the mandatory questions.

Please file an amended statement of grounds, on or before 02 May 2022.

If you choose not to amend the statement of grounds the registry may decide to strike out any grounds which are not adequately explained.

A copy of this letter together with the statement of grounds has been sent to the applicant but the period for the applicant to file its counter-statement has not yet been set.”

3. In the meantime, due to a delay in the processing of the fee for filing Form TM7<sup>1</sup>, resulting in the opposition not being formally recorded in time, the opposed application became registered. In an official letter to the parties dated 12 April 2022, the Tribunal confirmed that under the circumstances, the Registry considered that the notice of opposition was validly filed, and therefore Rule 74 of the Trade Mark Rules 2008 (“the Rules”) was invoked to correct the irregularity, allowing the status of the application to be amended accordingly.<sup>2</sup>

4. On 12 April 2022, the applicant sent the following email:

I'm writing to point out that the filing date of the registration that the opponent is seeking to rely on (19 July 2021) postdates the priority date of my client's application (2 June 2021). Therefore, the opponent's registration does not qualify as an "earlier trade mark" under section 6 of the Trade Marks Act 1994. Any grounds for opposition seeking to rely on registration number UK00003670650 should be dismissed.

We noted from the form that the opponent has also filled in the pages at Section C but has not included a representation of the mark, or the goods or services on which the earlier right has been used and has stated the date of first use as a full year "2021". We would asked for clarification of this date as a year is not an accurate date and there is no claim for goods and services.

This email has been copied to the other side.

5. In relation to the above, and following a telephone conversation between the applicant and the Tribunal on the same day, the Tribunal wrote to the opponent on 12 April, as follows:

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<sup>1</sup> The fee for the filing of the form TM7 under multiple grounds was £200. Although the correct box was ticked on the form, the opponent only submitted a fee of £100 in the first instance. This was later rectified and the full £200 has been paid by the opponent.

<sup>2</sup> The applicant was given fourteen days to file any comments in this respect, but did not elect to respond on this issue at this stage.

“Following a telephone call from the Applicant on 12 April 2022 it has been brought to my attention that the earlier mark relied upon, UK00003670650, doesn’t appear to be an earlier right.

It is noted that you are relying on trade mark number UK00003670650. This trade mark has a filing date of 19 July 2022. As this trade mark has a later filing date than the priority date of the application you are opposing it is not possible for you to rely on this trade mark. Therefore, you will not be able to oppose the mark under Sections 5(1), 5(2) or 5(3) of the Act.

The deadline of **03 May 2022**, as detailed in the official letter of 12 April 2022 remains in place for you to fully complete the Form TM7 under Section 5(4)(a). However, it has also been highlighted that you will need to provide an exact date of use for the unregistered right in the UK at Q1 of Section C. It will not be able to proceed with the current answer of ‘2021’.

If you choose not to amend the statement of grounds the registry may decide to strike out any grounds which are not adequately explained.

A copy of this letter has been sent to the applicant but the period for the applicant to file its counter-statement has not yet been set.”

6. On 03 May 2022, the opponent responded to the official letter of 11 April 2022, by email, with the following information:

“Date: 3.05.2022

Opposition No. OP000432400

Opponent: LYZIR Limited

Re. The amended statement of grounds.

- We would like to explain that there is no difference in the names of the opponent on the two forms as "LYZIR Limited". In the second form, it was only mentioned the contact person "Ewelina Fital" as the director of the company. LYZIR Limited has the same address in both forms. We do apologise for any inconvenience that happened. We are happy to support our application with a letter of appointment showing Ewelina Fital is the director of LYZIR Limited.
- There are not any proceedings related to this opposition at the IPO registry, please accept the removal of this point of our application.
- Grounds we are opposing the trademark

I) Opposition is based on section 5(3)

LYZIR limited started the planning and design of its products under this trademark by the end of 2018, followed by active commerce in 4<sup>th</sup> January 2021, using an unregistered trademark, and applied to register it on 19<sup>th</sup> July 2021.

II) Opposition is based on section 5(4)(a)

1) Our concern that if the trademark "INBRACE SMILE FOREVER" was mature or not at the time of registration. If the tribunal found that it was not, constructive use of the priority application should not apply in that case.

2) The filing date of the trademark " INBRACE SMILE FOREVER " in The United States of America. USPTO constitutes "constructive use" of the

trademark and this date confers a "right of priority". However, after decent search we failed to find any active commerce history of this trademark.

3) Common law in the United States gives trademark rights based on priority of use of the given trademark within a geographic location. This means that the first person to use a trademark, even if unregistered, has superior legal rights to use that trademark in a certain geographic location. Ultimately, a prior user is an individual who either began using the trademark or applied for registration before the current applicant/registrant. The Lanham Act, Section 7(c), establishes that the filing date for a federal trademark application is the owner's date of constructive use of the trademark. This establishes nationwide priority over everyone except someone who began using the trademark prior to the application date. Our trademark "Smile4ever" has been used in the same geographic location and we will appoint a lawyer in the United State of America to cancel the trade mark " INBRACE SMILE FOREVER"

4) the application for trademark "INBRACE SMILE FOREVER" shall not be allowed to harm other person's prior rights, and no preemptive application by any unfair means of a trademark which has been used by another person and has a certain influence shall be allowed for registration.

III) Opposition is based on Section 3

The trademark "INBRACE SMILE FOREVER" It should excluded from the registration because it describe the good " namely corrective braces"

IV) Opposition is based on other grounds.



Lyzir used the unregistered trade mark before them and would confuse customers in the UK

Representation of the mark

Smile4ever UK00003670650

Some goods and services:

Class 10

Dental braces, Dental prostheses, Dental implants , dental moulding devices, prosthetic instruments for dental purposes.”

(sic)

7. On 17 May 2022, the Tribunal responded to the opponent's email as follows:

“I refer to your correspondence of 03 May 2022.

I note the clarification regarding the opponent identity discrepancy between the TM7a and the TM7. Please include the correct information on a form TM7.

Further amendments are required on the Form TM7 before we proceed to the next stage:

### **Opposition based on Section 5(3)**

An opposition based on these grounds requires the trade mark that you are relying on to have an earlier filing or priority date than the application mark. UK00003670650 does not meet the criteria of being an earlier trade mark as

detailed in Section 6 of the Trade Marks Act 1994. Therefore, no opposition can be brought under this ground.

### **Section 5(4)(a)**

If you wish to oppose this mark under Section 5(4)(a) grounds please fully complete Section C on the Form TM7. You will need to provide a representation of the unregistered mark, a date of first use which must pre-date the priority date of the application you are opposing and all questions of Section C must be fully answered.

### **Section 3**

It is noted that in your correspondence of 03 May you have included a Section 3 claim that was not present in your TM7 of 04 April 2022. Please complete Section D of the TM7, answering all questions in the section and providing reasoning where required.

**Please file an amended Form TM7 including all the above requested information on or before 31 May 2022.** Please note, there is no requirement to include a fee sheet and the form can be sent directly to the above email address.

If you choose not to amend the statement of grounds the registry may decide to strike out any grounds which are not adequately explained.

A copy of this letter together with the statement of grounds has been sent to the applicant but the period for the applicant to file its counter-statement has not yet been set.”

8. On 29 May 2022, the opponent sent the following request by email for an extension of time in which to reply:

I would like to kindly request more time to produce a reply to you. I am having unexpected circumstances at the moment and would appreciate if you could move the deadline to 7th June 2022.

Ewelina Fital  
Lyzir Limited

9. The Tribunal responded on 31 May 2022, as follows:

“I refer to your correspondence of 29 May 2022.

The parties are advised that in line with paragraph 8 of Tribunal Practice Notice 2/2011, it is imperative that each party sends a copy to the other party of all correspondence sent to the Tribunal, however seemingly trivial in nature, and indicates that a copy has been sent to the other side in its communication.

<https://webarchive.nationalarchives.gov.uk/ukgwa/20140714074107/http://www.ip.o.gov.uk/pro-types/pro-tm/t-law/t-tpn/t-tpn-2011/t-tpn-22011.htm>

The requested 1-week extension of the deadline has been granted. The Registry fully expects to receive an amended Form TM7 as detailed in the Official Letter of 17 May on or before **07 June 2022.**”

10. On 07 June 2022, the opponent filed an amended form TM7. The Tribunal responded by letter dated 13 June 2022, as follows:

“I refer to the amended TM7 and statement of grounds filed against the above application on 07 June 2022.

The statement of grounds has now been considered and it is the registry's preliminary view (please see Glossary) that more information is required before any further action can be taken.

This is in line with the Tribunal Practice Notice 4/2000 which is available on the IPO website at:

<http://webarchive.nationalarchives.gov.uk/tna/20140603093547/http://www.ip o.go v.uk/pro-types/pro-tm/t-law/t-tpn/t-tpn-2000/t-tpn-42000.htm>.

### **Section C**

I note that under Section C of the form, you have listed goods and services under 5 different classes, but you have not added the representation of your mark i.e. What the actual unregistered sign on which you are basing the opposition looks like, whether that is a word, a logo, or a combination of both word and logo. The reference to the classes should be removed from this field and the sign (unregistered mark) added in its place.

Please be advised that under Section 5(4)(a) only UK use is relevant.

Under question 2 of this section, you have listed goods in class 10 only as being the goods that the sign has been used on. It is unclear whether you wish to rely on only these goods or whether you are saying that the sign has been used on all the goods and services in the 5 classes mentioned previously.

Under question 3 of this section please select which part of the application you are opposing, either 'all goods and services' OR 'some goods and services' and list which specification items of the application you are opposing.

Question 4 appears to provide detail regarding priority.

Should the opposition proceed to the next stages, you will need to prove that:

- the mark is yours
- you've built up goodwill associated with the mark
- you've been harmed in some way by the other person's use of the mark

Please review your answer to this question.

## **Section D**

I note that you have also completed Section D of the form TM7, which relates to opposition under Section 3 of the Trade Marks Act 1994. While I note the comments made under this section, you have not clearly explained how the opposed trade mark does not meet the requirements to be registered under section 3(1)(a), nor how the opposed mark consists exclusively of a sign that is either descriptive of the goods and services [3(1)(c)] or has become customary in trade [3(1)(d)].

Additionally, the form has not been signed in the declaration.

**Should you still wish to proceed with the opposition, please file an amended form TM7 addressing the above or removing any grounds that are not relevant, on or before 20 June 2022.**

**If the correct information is not received by the above date, any grounds that have not been adequately explained will be struck out, and this may lead to the opposition being struck out in its entirety.”**

11. The opponent responded on 20 June 2022, by email as shown below, requesting another extension to the deadline for filing an amended form TM7:

Dear Sir / Madam,

In line with a letter sent on 14.06.2022, and the requested information.

The deadline is too short, about 3 working days.

I would kindly request an extension to this deadline as I am struggling to comply with it.

I am working on the requested information and will send them on or before 04.07.2022.

Thanks

Ewelina Fital

Lyzir Limited

12. The Tribunal responded on 20 June, denying the request for more time, stating

“I refer to your correspondence of 20 June 2022 in which you request a further extension to the deadline to file an amended Form TM7.

Due to the time period already elapsed for this matter this request is denied.

**Should you still wish to proceed with the opposition, please file an amended form TM7 addressing the above or removing any grounds that are not relevant, on or before 20 June 2022.** Full details of what is required can be found in the official letter of 13 June 2022.

**If the correct information is not received by the above date, any grounds that have not been adequately explained will be struck out, and this may lead to the opposition being struck out in its entirety.”**

13. On 20 June, the opponent submitted the following information by email in place of an amended TM7, to which was attached a single replacement page for the TM7 bearing the requested signed declaration:

Hi ,

I have tried to manage to reply to your comment while I am away and do not have access to my office.

please find replies in Red.

#### Section C

I note that under Section C of the form, you have listed goods and services under 5 different classes, but you have not added the representation of your mark i.e. What the actual unregistered sign on which you are basing the opposition looks like, whether that is a word, a logo, or a combination of both word and logo.

The representation of the unregistered mark was Smile4ever

The reference to the classes should be removed from this field and the sign (unregistered mark) added in its place.

Not clear what do you mean.

Please be advised that under Section 5(4)(a) only UK use is relevant.

Under question 2 of this section, you have listed goods in class 10 only as being the goods that the sign has been used on. It is unclear whether you wish to rely Intellectual Property Office is an operating name of the Patent Office on only these goods or whether you are saying that the sign has been used on all the goods and services in the 5 classes mentioned previously.

The sign has been used for all the 5 classes mentioned

Under question 3 of this section please select which part of the application you are opposing, either 'all goods and services' OR 'some goods and services' and list which specification items of the application you are opposing.

Opposing class 10 products listed as Orthodontic appliances; orthodontic brackets; teeth aligners; orthodontic retainers; dental apparatus; dental instruments; water picks; dental picks; oral irrigators; tips for oral irrigators; replacement heads and attachments for use with oral irrigators.

Question 4 appears to provide detail regarding priority. Should the opposition proceed to the next stages, you will need to prove that: • the mark is yours • you've built up goodwill associated with the mark • you've been harmed in some way by the other person's use of the mark Please review your answer to this question.

Section D I note that you have also completed Section D of the form TM7, which relates to opposition under Section 3 of the Trade Marks Act 1994. While I note the ~~comments~~ made under this section, you have not clearly explained how the opposed trade mark does not meet the requirements to be registered under section 3(1)(a), nor how the opposed mark ~~consists~~ exclusively of a sign that is either descriptive of the goods and services [3(1)(c)] or has become customary in trade [3(1)(d)].

~~consists of, or reproduces in its essential elements, an earlier plant variety denomination registered as mentioned in subsection~~

~~3(1)(a), nor how the opposed mark consists exclusively of a sign that is either descriptive of the goods and services [3(1)(c)] or has become customary in trade [3(1)(d)].~~

Additionally, the form has not been signed in the declaration.

~~Declaration copy signed and attached~~

~~Ewelina Fital~~

~~Lyzig Limited~~

14. On 27 June 2022, the Tribunal wrote to the opponent, responding as follows:

“I acknowledge the amendments to the TM7 filed on 20 June 2022.

The extent of the opposition was clarified, the form was signed and the representation of the mark for Section C was given. However, no further information was provided to explain the grounds under Section 3 and Section 5(4)(a), as requested.

As stated in the official letter of 13 June 2022, any grounds that have not been adequately explained will be struck out.

It is the registry's preliminary view that no grounds have been adequately explained and therefore the opposition should be struck out in its entirety.



If either party disagrees with the preliminary view they should request a hearing within 14 days from the date of this letter that is on or before 11 July 2022.

If no response is received within the time allowed, the preliminary view will automatically be confirmed.”

15. The opponent responded to the preliminary view that the opposition should be struck out in its entirety in an email dated 10 July 2022:

We disagree with the primary outcome of Opposition No: OP000432400 on 27<sup>th</sup> June.

As we requested extra time to provide an adequate explanation on the grounds, our request was declined.

We believe we have strong grounds to succeed with this opposition.

Please, advise on the next stage and when/ to whom we should submit the requested information.

Thanks

Ewelina Fital

Lyzir Limited

16. The Tribunal issued the following response in an official letter dated 13 July 2022:

“In the official letter of 13 June it was clearly explained the steps you needed to follow in order to proceed, i.e to file an amended form TM7 addressing the outstanding issues under Section C and Section D by the given deadline of 20 June 2022.

However, as explained in the official letter of 27 June 2022, the grounds of opposition under Section 3 and Section 5(4)(a) of the Act have still not been adequately explained.

While I note that in your email of 10 July you state that you disagree with the preliminary view that the opposition be struck out in its entirety, you have not requested a hearing as directed in the official letter of 27 June 2022.

The deadline to submit further information has now passed. Should you wish to request a hearing in relation to the preliminary view to strike out the opposition, this must be received within 7 days from the date of this letter, that is on or before 20 July 2022. **If no request is received within the given time, the opposition will be struck out in its entirety.**”

17. The opponent duly requested a Hearing in an email dated 20 July 2022.

18. A hearing was scheduled for 8 August 2022, the details of which were sent by the Tribunal to both parties in an official letter dated 25 July 2022. Both parties confirmed attendance, and the applicant filed its skeleton arguments on 04 August 2022.

## **THE JOINT HEARING**

19. The hearing took place before me, via Microsoft TEAMS telephone conference, on Monday 8 August 2022. Mr Mohammed Elbehiry of Lizyr Limited (“Lyzir”) attended for the opponent, and Ms Iram Zaidi of Zacco UK Ltd represented the applicant.

20. At the hearing, I explained to both parties that the purpose of the hearing was to consider whether, and on what basis, the preliminary view that the opponent’s pleadings are inadmissible and that the opposition be struck out in its entirety should be upheld or overturned. I clarified that the purpose of the hearing was not to consider evidence or submissions on the merits of any pleaded grounds, however, should the decision be that the opposition may proceed, then there would be an opportunity for this later in the proceedings. I further confirmed that I had received the skeleton arguments from the applicant, and that I had read all the documents relevant to the case before me.

21. Mr Elbehiry explained that Lyzir is a family company, run by himself and his wife, Ms Fital. All previous correspondence on behalf of the opponent had been handled by Ms Fital. For the sake of ease, as the opponent is unrepresented, I will refer to it as “they” and “them” when recalling Mr Elbehiry’s submissions relating to himself and Ms Fital as the opponent.

22. Mr Elbehiry began by stating the background to the case as he understood it, from the first filing of Lyzir’s application to register the trade mark and the subsequent notice issued by the Registry to inform the opponent of the publication of the opposed mark, causing them to file the opposition under Section 5(2)(b). However, the criteria of being an earlier trade mark was not met, due to the priority date of the contested mark, leaving the opponent to rely on the other grounds (as outlined previously in this decision) and which were considered insufficiently pleaded. Mr Elbehiry went on to explain that they had submitted some of the requested information clarifying the pleadings by email, which the Registry had deemed inadmissible. They then requested a (second) extension of time to submit an amended form TM7, which due to personal circumstances where a close family member was in hospital meant that Mr Elbehiry and Ms Fital were away from the office and had no access to a computer. This request was refused. Mr Elbehiry continued that because of these circumstances, it was very difficult to provide the required information, leading to the preliminary view that the opposition be struck out. He added that as they had provided the information by email, rather than on the amended form, he considered that the applicant was aware of the grounds being pleaded.

23. Turning to Ms Zaidi, she stated that while she understood that the provision of the skeleton argument was not to rehash the processes that all sides were aware of, she felt it important to illustrate exactly how much time the other side have exhausted. She continued that the opponent had been aware of the opposed application since December (2021), but did not elect to file form TM7a (the Notice of Threatened Opposition) until 14 February 2022, with a further month from this date allowed for

the filing of the form TM7. In the interim, because of the issues with the applicant's fees for the filing of the form TM7, the applicant received the registration certificate, which it then had to destroy. Ms Zaidi continued that the opponent had been given several opportunities to follow the prescribed procedures, that almost eight months had passed since the opponent became aware of the contested application, and that in spite of several communications in an attempt to correct the opposition, the applicant is still none the wiser as to exactly what the opponent is relying on. She added that although the opponent had been asked for clarification of the section 3 grounds which were added into the opposition, the opponent had not actually followed the formal procedure for adding a ground to an opposition. Ms Zaidi stated that as the applicant's representative, she had to review the correspondence between the parties and the Tribunal and advise the client accordingly, therefore this process is costing the client "quite a lot". She submitted that the UKIPO have been explicit in advising the opponent on what corrections were needed, and repeated that the grounds on which the opponent is relying are still unclear. Therefore, due to the unnecessary delay, and the costs that any further delay would cause her client, any further requests for an extension of time should be rejected, and that the preliminary view to strike out the opposition be upheld, and a ruling on costs in favour of the applicant should be made.

24. Following on from Ms Zaidi's point that the Tribunal had explained in earlier correspondence what was needed from the opponent in order to submit an admissible TM7, I raised my concerns with Mr Elbehiry that the response from the official letter dated 13 June indicated that they were still unclear as to what was required of them.

25. Mr Elbehiry repeated that due to personal circumstances there was not enough time to submit the information on the Form TM7 rather than by email, for which he apologised, but he added that they now knew exactly what was expected and asked for one more opportunity to submit the necessary information on an amended form.

26. In response, Ms Zaidi said that while she sympathised with the opponent's position regarding having to take time for hospital visits, she felt that a lot of leniency had been directed towards the opponent. She reiterated that her client has been incurring costs, and said that she felt that the preliminary decision that the opposition be removed should be upheld and the issue of costs should be looked at closely, with the applicant entitled to a greater award of costs. She added that in the event the preliminary view was overturned, and the opposition went on to succeed, then costs in the applicant's favour should also be factored in to the equation.

27. Before terminating the hearing, I confirmed that I would reserve my judgment and that my decision would be issued in writing in due course.

## **DECISION**

28. As outlined at 1.8 of the Manual of trade marks practice ("the Manual"), the Tribunal adheres to the same overriding objective as the court for dealing with cases justly. This is set out in rule 1.1 of the Civil Procedure Rules 1998 (as amended) and includes, so far as is practicable:

(2) (a) Ensuring that the parties are on an equal footing

(b) Saving expense

(c) Dealing with the case in ways which are proportionate –

(i) to the amount of money involved (ii) to the importance of the case (iii) to the complexity of the issues and (iv) to the financial position of each party

(d) Ensuring that it is dealt with expeditiously and fairly and

(e) Allotting to it an appropriate share of the court's resources, while taking into account the need to allot resources to other cases.

29. Section 38 of the Act states as follows:

“38 Publication, opposition proceedings and observations.

(1) When an application for registration has been accepted, the registrar shall cause the application to be published in the prescribed manner.

(2) Any person may, within the prescribed time from the date of the publication of the application, give notice to the registrar of opposition to the registration.

The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.” (my emphasis)

30. Rule 17 of the Rules states:

“17.—(1) ... Any notice to the registrar of opposition to the registration, including the statement of the grounds of opposition, shall be filed on Form TM7.

...

(7) Where the opposition is based on an unregistered trade mark or other sign which the person opposing the application claims to be protected by virtue of any rule of law (in particular, the law of passing off), there shall be included in the statement of the grounds of opposition a representation

of that mark or sign and the goods and services in respect of which such protection is claimed.

(8) The registrar shall send a copy of Form TM7 to the applicant and the date upon which this is sent shall, for the purposes of rule 18, be the “notification date”.

31. Rule 62 of the Rules, so far as is relevant, provides:

“62.—(1) Except where the Act or these Rules otherwise provide, the registrar may give such directions as to the management of any proceedings as the registrar thinks fit, and in particular may —

(a) require a document, information or evidence to be filed within such period as the registrar may specify;

...

(e) allow a statement of case to be amended, provided that –

(i) Where an application is made to add grounds of opposition other than under section 5(1) or (2) of the Act, the application shall be made on Form TM7G;

...

(3) When the registrar gives directions under any provision of these Rules, the registrar may—

(a) make them subject to conditions; and

(b) specify the consequences of failure to comply with the directions or a condition.”

32. Tribunal Practice Notice (“TPN”) 1/2018 states:

**“Examination of pleadings based on earlier marks**

1. The purpose of pleadings is to set out the party’s legal case with sufficient clarity so that the other side can make an informed decision about whether to defend their trade mark, and in which respects. The pleadings filed in trade mark oppositions and invalidation proceedings do not always meet this standard.

2. The registrar has a duty to ensure that the system is fair to both parties and that, so far as is reasonably practical, those without legal representation and/or of limited means, are given equal access to justice.

...

**Failure to Follow Directions**

11. Failure to comply with directions under Rule 62 may have the following consequences:

(i) an increase in costs awarded against the offending party, if it is unsuccessful, or a reduction in costs to that party, if it is successful;

(ii) the registrar selecting the earlier marks which appear to represent the party’s best case and directing under Rule 62 that the evidence and arguments be limited to those marks;



(iii) where the basis of the claimed similarity between the respective goods/services remains non-apparent, and has not been explained, the decision maker is likely to find dissimilarity;

(iv) where there is a serious risk of unfairness to, or oppression of, the other party, directions will be made subject to the condition (per Rule 62(3) that failure to comply with them will result in the opposition/application being struck out in whole or in part.”

33. Section 4.1 of the Manual states:

#### **“4.1 Amendment of pleadings**

As parties will, as first instance, be expected to file focused statements of case and counterstatements, the Tribunal will consider requests to amend these documents later in the proceedings. Amendments may include:

- adding or removing a ground of opposition/revocation/invalidity
- adding or removing an earlier mark or right or
- correcting, clarifying or supplementing information contained therein.

If an amendment becomes necessary parties should seek leave to make the amendment at the earliest opportunity. When seeking leave to amend, full details of the amendment together with the reasons for the amendment should be submitted.

Whilst each request to amend will be considered on its merits, the Tribunal will aim to give favourable consideration to such requests on the basis that it is likely to avoid a multiplicity of proceedings and thus help resolve the dispute between the parties more quickly and at less cost. Whether to allow the amendment is matter of discretion. In making its decision the Tribunal will

consider, in particular, any inconvenience or prejudice suffered by the other side, and whether the party seeking amendment could reasonably have been expected to have fully particularised their case at an earlier stage. In other words, a party seeking amendment will have to dispel any suspicion of abuse of process.” (my emphasis)

34. I begin by noting the guidance set out in TPN 1/2018, which states that pleadings must be set out with sufficient clarity in order to allow the other side to make an informed decision about whether to defend the case. Having reviewed the Form TM7s filed to date, it is my view that none are admissible in their current format. In the three months that passed between the filing of the TM7 and the preliminary view to strike out the opposition, in spite of the direction given on multiple occasions by the Tribunal to the opponent in relation to the outstanding requirements, a TM7 which is considered sufficiently pleaded and able to be served on the applicant has not been forthcoming.

35. Following the first (granted) request for an extension of time on 29 May 2022, a second extension of time was requested on 20 June 2022, which was subsequently denied. At the hearing, Mr Elbehiry detailed the difficult family circumstances which involved hospital visits which lead to this second request. Had such reasons been fully explained at the time of the request, then this would have been factored in to the decision on whether the extension should be allowed, and the outcome of the request may have been different. However, the Tribunal was not made aware of any mitigating circumstances at the time of the request, with the correspondence simply stating that the deadline was too short and that they were struggling to comply with it.

36. I note Ms Zaidi’s submissions on the cost the delays have caused her client. I also acknowledge that due to the delay in processing the opponent’s fee, whereby the correct fee box of £200 had been ticked for filing the form TM7, but a payment of only £100 was initially submitted, the opposed application became registered in error and was subsequently rescinded, which I do not doubt caused unwarranted distress to the applicant. In response to Ms Zaidi’s submission that the formal procedure for adding

extra grounds in regard to Section 3 of the Act was not followed, I recognise that this was not done by way of filing a form TM7G. However, the original form TM7 relied on grounds other than under section 5(1) and 5(2), and the fee of £200 had by then been paid. Consequently, I consider that had the grounds been adequately particularised on the TM7 which had not yet been served on the applicant, then this would have been deemed acceptable. I therefore do not find that the lack of a TM7G to be a relevant factor in this matter. Rather, it is the lack of an adequately particularised TM7 that I consider to be the issue in this instance. As with the other grounds on which the opponent relies, the pleadings under Section 3 were insufficiently explained and form part of the considerations of this overall decision on whether the preliminary view to strike out the opposition should be upheld.

## **Conclusions**

37. I am conscious that the Tribunal has a duty to ensure that proceedings are dealt with efficiently and fairly, and that it will use its discretion to set time periods as it sees necessary, which may be less than the further time which the party has requested.<sup>3</sup> In my view, the opponent has been given ample opportunity and guidance by way of the respective correspondences on the correct manner of filing form TM7 by the given deadlines. In particular, the official letter from the Tribunal dated 13 June 2022 clearly set out the outstanding requirements to enable the opponent to submit an admissible form. While the opponent has not elected to be legally represented, I am mindful of the guidance given in TPN 1/2018, and I consider that the opponent has been given equal access to justice. I acknowledge that opposition proceedings may be somewhat confusing to those unfamiliar with the process. However, the filing of form TM7 is a relatively straightforward task, and the Tribunal receives many oppositions from litigants in person who successfully oppose later trade mark applications in a timely manner without professional representation.

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<sup>3</sup> See 4.9.1 of the Manual.

38. I further acknowledge that at the Hearing, Mr Elbehiry stated that they now know exactly what is expected. Nonetheless, there seems to me to be an obvious lack of understanding of opposition proceedings on the part of the opponent. I concede that it is possible that if I were to allow the opponent a further opportunity to file another amended Form TM7, there would perhaps be one or more adequately pleaded grounds set out within the same. However, I am not confident that this would be the case, as from the submissions made it appears doubtful that the case would be able to proceed without case management direction or further delay.

39. The registrar has a duty to ensure that the system is fair to both parties. I am conscious that during the time between the first (inadmissible) TM7 being filed in March 2022 and the preliminary view given in June 2022 that the opposition be struck out in its entirety, the applicant has suffered a great deal of inconvenience, as well as uncertainty on the outcome of its application, leading to incurred costs from such long delays, in addition to those costs incurred in relation to representation at the hearing itself.

40. I have carefully considered the factors outlined above. While I sympathise with the opponent's familial circumstances, it is my view that the opponent has exhausted its opportunities to file an amended TM7. Given the length of time that has passed since the proceedings were first initiated, with consideration to the lack of certainty that proceedings would indeed move forward swiftly should a further period of time be allowed, while keeping in mind the necessity of equality between the parties, the public interest in resolving disputes efficiently, and allowing that the Tribunal has a duty to allocate its resources fairly, I consider that the preliminary view to strike out the opposition should be upheld.

41. I decline to exercise my discretion under Rule 62, and I therefore do not allow the opponent a further attempt to file an amended Form TM7. Accordingly, the opposition is struck out in its entirety.

## **OUTCOME**

42. Subject to any successful appeal against this decision, the application will proceed to registration.

## **COSTS**

43. Given that the outcome of this decision has terminated the proceedings, the applicant is entitled to a contribution towards its costs, based on the scale published in TPN 2/2016. In the circumstances, I find it appropriate to issue the applicant with a contributory cost award of £300 in respect of its professional representation at the joint hearing before me.

44. I therefore order Lyzir Limited to pay Swift Health Systems Inc. the sum of £300. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 26th day of August 2022**

**Suzanne Hitchings**  
**For the Registrar,**  
**the Comptroller-General**