

O/0090/23

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION UK00003473350

IN THE NAME OF RENUE STUDIO LTD

FOR THE TRADE MARK

RENUE

IN CLASS 25

AND

THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO

UNDER NUMBER 505258 BY ITOCHU CORPORATION

AND

THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT

IN DEFENCE THEREOF

BACKGROUND

1. Renue Studio Ltd ('the Proprietor') applied to register the trade mark RENUÉ (no. UK00003473350) in the UK on 9 March 2020. It was registered on 10 August 2020 for various goods in class 25.
2. On 5 August 2022, Itochu Corporation ('the Cancellation Applicant') applied to have the contested mark declared invalid under section 47 of the Trade Marks Act 1994 ('the Act') by way of filing an Application to declare invalid a registration or a protected international trade mark (UK) ('Form TM26(l)'). The application is based upon section 5(2)(b) of the Act and is directed against all of the goods in the Proprietor's specification.
3. On 23 August 2022, the Registry served the Form TM26(l) on the Proprietor by post and email at the addresses (both physical and email) provided by them. That letter contained the following paragraphs:

"Rule 41(6) 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.

IMPORTANT DEADLINE: A completed Form TM8 MUST be received on or before 24 October 2022.

In accordance with rule 41(6) if the TM8 and counter-statement are not filed within this period, (a period which cannot be extended), the registration of the mark shall, unless the registrar otherwise directs, be declared invalid in whole or part. **It is important to understand that if the deadline date is missed, then in almost all circumstances, the registration will be treated as invalid in whole or part.**"

4. On 24 August 2022, the above-mentioned correspondence was shown as delivered and signed for according to the Royal Mail 'Track and Trace' website.

5. No Form TM8 was filed by the Proprietor on or before 24 October 2022. On 14 November 2022, the Registry wrote to the Proprietor, by post and by email, as follows:

“The official letter dated 23 August 2022 informed you that if you wished to continue with your registration you should file TM8 and counterstatement on or before 24 October 2022.

As no TM8 and counterstatement have been filed within the time period set, Rule 41(6) applies. Rule 41(6) states that:

“...otherwise the registrar may treat the proprietor as not opposing the application and registration of the mark shall, unless the registrar otherwise directs, be declared invalid.”

The registry is minded to treat the proprietor as not opposing the application for invalidation and declare the registration as invalid 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, **28 November 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. If no response is received the registry will proceed to issue an undefended decision on the issue of failure to comply with the Rules governing the filing of a defence.”

6. On 16 November 2022, the above-mentioned correspondence was shown as delivered and signed for according to the Royal Mail ‘Track and Trace’ website.
7. Neither correspondence nor a Witness Statement was filed by the Proprietor on or before 28 November 2022.

8. On 30 November 2022, the Proprietor emailed the Registry stating that a 'clerical error' had led to the deadline being missed, enclosing a Witness Statement and a completed Form TM8. The Witness Statement included the following:

"1. I, Muhammad Abbas, of Trademark Brothers Ltd., with an address at 71-75 Shelton Street, Covent Garden, London, WC2H 9JQ am the director of Trademark Brothers Ltd., a position which I have held since 2016. The facts in this statement come from the capacity of being the representative on behalf of RENUE STUDIO LTD ('Renue') in all trade mark matters and come from my personal knowledge and I am duly authorised to speak on Renue's behalf in the cancellation of the registered mark.

2. Renue Studio Ltd has been using the mark 3473350 'RENUE' since March 2020 and continue using it extensively in the United Kingdom in commerce. The mark is being used in the clothing sector and the cancellation that has been brought forward is only very recent news, given we have not had any correspondence sent to us in relation to this matter previously.

3. As mentioned, the mark has been registered for some time, the party cancelling the mark filed a mark, which Renue has filed an opposition against. We had not received any correspondence in relation to the cancellation.

4. I request the UKIPO to allow for a grace period to allow Trademark Brothers to file necessary documentation in relation to this matter, including extensive evidence in [sic] how the mark is being used and how it would be detrimental to the Renue if this mark were to be formally cancelled.

5. The fact [sic] in this witness statement are true to the best of my knowledge and belief."

9. On 9 December 2022, the Registry wrote to the Proprietor by email in the following terms:

“I acknowledge receipt of your email dated 30 November 2022, which included a witness statement and late form TM8.

The case has been given consideration and it is the Registrar’s preliminary view that a TM8 cannot be admitted into the proceedings as it was not received within the prescribed non-extendable period.

The Registry’s letter dated 23 August 2022 informed you that a form TM8 and counterstatement or form TM9c must be received on or before 24 October 2022. In addition, the letter outlined the consequences, that the application may be deemed abandoned if either of these forms were not received within the time period specified. The discretion available to the Registrar when deciding whether to accept a late filed TM8, is narrow and there must be “extenuating circumstances” and “compelling reasons” sufficient to warrant the exercise of such discretion.

It is noted that you state within your witness statement that you did not receive any correspondence regarding the cancellation. However, the Royal Mail Tracking service shows that the serving letter was delivered to you and signed for. A copy of the Track and Trace information from the Royal Mail is attached for your reference.

In view of the above, the reasons you have provided are not deemed sufficient for the Registrar to exercise any discretion in the matter.

If you disagree with the preliminary view you **must** request a hearing on, or before, **23 December 2022**. If no response is received the registry will proceed to deem the Registration as undefended.

Before requesting a hearing to challenge a preliminary view, you should bear in mind the following points:

- the deadline for filing a counter-statement on Form TM8 is not a flexible time limit (see Trade Mark Rule 77(6) and Schedule 1 to those rules);

- the legal constraints on the exercise of discretion by the Registrar in these circumstances; and
- that in the event that the hearing officer upholds the preliminary view, there may be costs implications arising from the hearing against the party who requested the hearing.

The above information is not intended to dissuade you from requesting a hearing, but merely to inform you of the potential consequences should you be unsuccessful in overturning the preliminary view.

If no response is received within the time allowed, the preliminary view will automatically be confirmed and an undefended decision will be issued.”

10. On 19 December 2023, the Proprietor emailed the Registry to request a hearing.

THE HEARING

11. A joint hearing took place before me, by telephone conference, on 24 January 2023. Mr Muhammed Abbas, of Trademark Brothers Ltd., attended on behalf of the Proprietor. Ms Rebecca Campbell and Ms Kate O'Rourke attended on behalf of the Cancellation Applicant.

12. Mr Abbas submitted that the Proprietor was a small operation and that, due to illnesses, the Form TM8 had not been filed on time. I therefore asked Mr Abbas why the matter of illness had not been mentioned in the Witness Statement, or any other correspondence to date. Mr Abbas submitted that he was not able to give any further detail on the illness and that it was a 'personal' matter. I asked Mr Abbas whether he was able to give any dates when the illness occurred. He was not able to give any details on the matter.

13. Ms Campbell submitted that the Cancellation Applicant agreed with the Registry's preliminary view that the late-filed Form TM8 be declared inadmissible. In summary, she argued that the Proprietor has not provided compelling reasons or

demonstrated exceptional circumstances to justify the Tribunal exercising its discretion by allowing the defence to be admitted into the proceedings. Ms Campbell submitted that, despite the statement by the Proprietor that it had not received any correspondence relating to the action against it, the Proprietor nevertheless knew to expect correspondence because the Cancellation Applicant had informed it by email in July 2021 of the impending cancellation action against its mark. Ms Campbell submitted that the delay caused by the Proprietor had caused the Cancellation Applicant prejudice in terms of costs. She submitted that the Cancellation Applicant was based in Japan and that the ongoing delay was causing additional costs to be incurred for translation of the relevant legal documents and correspondence between the parties.

14. Mr Abbas conceded that the parties had been in correspondence with respect to the then impending cancellation proceedings. He further submitted that there were 'sensitivities' as to what he was able to report with respect to the late filing of the Form TM8, but did not elaborate further. On the matter of the Royal Mail 'Track and Trace' indicating that the relevant correspondence had been delivered to the Proprietor, Mr Abbas submitted that the postal address used by the Proprietor was not in fact its business address and that, although mail may be signed for, it was not always delivered to the Proprietor. I asked Mr Abbas what detriment, if any, the Proprietor would suffer if the late-filed defence were refused to be admitted. Mr Abbas replied that the Proprietor was a small sustainable fashion brand and that to deny it the opportunity to defend its mark would have a detrimental effect on the amount of goodwill that it had built up in respect of its brand.

DECISION

15. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by rule 41(6) of the Trade Marks Rules 2008 ('the Rules'). The relevant parts read as follows:

“(6) The proprietor shall, within two months of the date on which a copy of Form TM26(1) and the statement was sent by the registrar, file a Form TM8, which shall include a counter-statement, otherwise the registrar may treat the

proprietor as not opposing the application and registration of the mark shall, unless the registrar otherwise directs, be declared invalid.”

16. The combined effect of rules 77(1), 77(5) and Schedule 1 of the Rules means that the time limit in Rule 41(6) which sets out the period within 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.”

17. There is no suggestion that there has been an irregularity on the part of the Tribunal. Consequently, the only basis upon which the Proprietor may be allowed to defend the cancellation proceedings is if I exercise in his favour the discretion afforded to me by the use of the words ‘unless the registrar otherwise directs’ in Rule 41(6).

18. In making my assessment as to whether to exercise my discretion to admit the Proprietor’s defence in the instant case, I will 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 must 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 the discretion should be exercised in favour of a party in default. That is the approach that I will adopt.

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 Form TM26(l) was served by post and by email 23 August 2022. The reason provided by the Proprietor in its Witness Statement was that no correspondence on the proceedings had been received. Ms Campbell submitted that the parties had been corresponding prior to the cancellation proceedings being commenced and that the Proprietor was aware that an application for invalidation against its mark was imminent. Mr Abbas accepted this. Mr Abbas' submission that the address used by the Proprietor to receive its post is that of a third party and not the actual business address of the Proprietor is of little weight. In the case of *Kickz AG v Wicked Vision Limited* (BL O-035-11), it was held that the Applicant had been 'the author of its own misfortune' in its failure to adhere to any system or procedure for checking and dealing with registered letters. It is my view that this applies to the instant case. The onus is on the Proprietor to ensure that it has a system or procedure in place to deal with registered letters. In any event, the pieces of correspondence in question were also sent by email and there was nothing to indicate that the emails were not received by the Registered Proprietor's servers.
21. The matter of illness was raised by Mr Abbas for the first time at the hearing. The fact that it has not been addressed in the Proprietor's Witness Statement is unhelpful. Whilst I appreciate that there may be sensitivities around such matters, without knowing the dates when the illness affected the Proprietor, and how it prevented the timely filing of a Form TM8, I do not consider this submission to be persuasive. The sole reason for the missed deadline put forward by the Proprietor in its Witness Statement was that the relevant correspondence was not received. The Proprietor could and should, in my view, have addressed the illness to the extent that information was provided merely as to when and how the illness prevented the timely filing of the Form TM8. In my view, this could likely have been done without divulging the 'sensitivities' to which Mr Abbas referred in his submissions.

22. The Proprietor filed its Form TM8 on 30 November 2022, just over one month after the prescribed deadline of 24 October 2022 set by the Registry.

The nature of the Opponent's allegations in its Statement of Grounds;

23. The Application for Invalidation is based upon section 5(2)(b) of the Act and is directed against the Proprietor's goods in class 25 i.e. the entirety of its specification. I note that the proof of use provision is not engaged.¹ The nature of the allegations is such that neither party is required² to adduce evidence. Whilst it is not for the present decision to determine the merits of the substantive claim, it is sufficient to note for the purposes of the criteria under consideration that there is an arguable case to be determined.

The consequences of treating the Proprietor as defending or not defending the Opposition;

24. If the Proprietor is allowed to defend the Application for Invalidation, the proceedings will continue with the parties given an opportunity to file evidence and the matter will be determined on its merits.

25. If, however, the Proprietor is not allowed to defend the action against it, the Proprietor will lose its filing date of the registration and the registration will be declared invalid in its entirety. It will remain open to the Proprietor to re-file an Application for its mark, which may, in turn, be opposed by the Cancellation Applicant.

Any prejudice caused to the Cancellation Applicant by the delay

26. As already noted, Ms Campbell submitted that the Cancellation Applicant had been prejudiced by way of costs, particularly in relation to the necessary translation of

¹ Section 6A of the Act.

² Although a party may elect to file evidence.

documents and correspondence due to the Cancellation Applicant being based in Japan.

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

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

Conclusions

28. In reaching my decision, as noted above, I recognise that if the discretion is not exercised in the Proprietor's favour, the Proprietor will be treated as not opposing the Application and registration of the mark shall be declared invalid. I recognise that this is a serious consequence. I further recognise that it may be that the Proprietor will simply re-file an Application for its mark and that this may be opposed by the Cancellation Applicant in proceedings arising at some time in the future. However, as the invalidation of the registration 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.

29. Having considered the Proprietor's Witness Statement and oral submissions, I am not satisfied that the Proprietor has demonstrated extenuating circumstances or compelling reasons. The matter of illness was raised for the first time at the hearing and, it is my view that, the Proprietor has had ample opportunity to provide sufficient information to enable the Tribunal to consider how the illness might have hampered the Proprietor's efforts to meet the prescribed deadline, without necessarily divulging the 'sensitivities' to which Mr Abbas referred. It would not, in my view, have been particularly onerous for the Proprietor to have provided the dates when the illness had an impact, for example. The submission that the Proprietor did not receive any correspondence regarding the cancellation proceedings against it is not particularly compelling, either. In my view, it would

therefore be inappropriate for me to exercise the very limited discretion afforded to me to admit the late-filed Form TM8 into these proceedings.

Outcome

30. My decision is not to exercise the discretion available under Rule 41(6) in favour of the Proprietor. Subject to appeal, the registration UK00003473350 will be declared invalid.

Costs

31. As my decision terminates the proceedings, I must consider the matter of costs. The Proprietor being treated as not defending Application, the Cancellation Applicant is entitled to a contribution towards its costs, based upon the published scale³, calculated as follows:

Official fee for filing Form TM26(l)	£200
Preparing the Statement of Case	£200
Preparing for and attending the hearing	£400
Total	£800

32. I order Renue Studio Ltd to pay Itochu Corporation the sum of £800 as a contribution towards its costs. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 30th day of January 2023

N. R. MORRIS

For the Registrar, the Comptroller-General

³ <https://www.gov.uk/government/publications/tribunal-practice-notice-22016/tribunal-practice-notice-22016-costs-in-proceedings-before-the-comptroller>