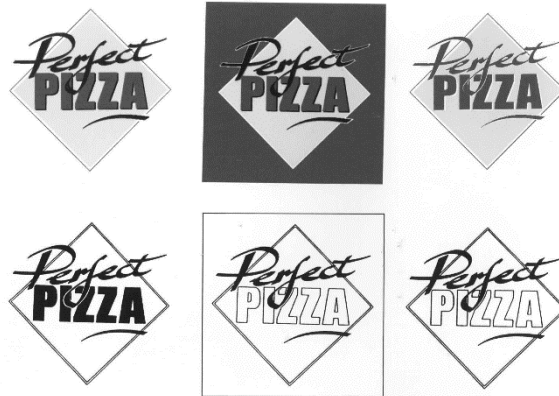


O-0153-23

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION
NO. UK00003746480
BY ZAMIR HUSSAIN
TO REGISTER



AS A TRADE MARK
IN CLASSES 30, 39 AND 43
AND OPPOSITION THERETO
UNDER NO. OP000434719
BY JATINDER SINGH WASU

BACKGROUND AND PLEADINGS

1. On 23 January 2022, Zamir Hussain (“the applicant”) applied to register the trade mark shown on the cover page of this decision.
2. The application was published for opposition purposes on 1 April 2022 for the following goods and services:

Class 30 Preparations made from cereals; Bread; Cakes; Pizza;
 Preparations made from cereals; Puddings; Sandwiches;
 Sauces; Pasta; Pies.

Class 39 Transport and delivery of food and drink; Transport and
 delivery of goods.

Class 43 Bar services; Catering for the provision of food and drink;
 Take away food services; Restaurant services;
 Preparation of food and drink.
3. Jatinder Singh Wasu (“the opponent”) opposed the application, his Form TM7 being received on 26 July 2022. The opposition is based on sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”).
4. On 29 July 2022, the Registry served the Form TM7 on the applicant by email, allowing him until 29 September 2022 to file a notice of defence and counterstatement (“Form TM8”) or request a cooling off period using Form TM9C. The serving letter contained the following paragraphs:

“Rule 18(1) and 18(3) of the Trade Marks Rules 2008 require that you must file your notice of defence and counterstatement (Form TM8) within **two months** from the date of this letter. Alternatively, if both parties wish to negotiate to resolve the dispute, they may request a “cooling off period” by filing a Form TM9c, which will extend the 2 month period in which to file a

Form TM8 by up to a further seven months. Form TM9c is also available on the IPO website (above). Please note both parties must agree to enter into cooling off.

IMPORTANT DEADLINE: A completed Form TM8 (or Form TM9c) MUST be received on or before 29 September 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.”

5. On 23 September 2022, the applicant filed a Form TM9C by email. The first email that was sent said, “Please see attached Form TM9c.” However, the Forms department wrote back to say that “it appears that it appears that the TM9C is not attached to your email.” Mr Hussain then sent another email, this time with the Form TM9C attached, again saying, “Please see attached Form TM9c.”
6. On 12 October 2022, the Registry wrote to the parties to confirm receipt of the Form TM9C.
7. On 24 October 2022, the opponent’s representatives wrote to the Registry by email as follows:

“Please provide us with a copy of the TM9c. We were not contacted by the Applicant regarding entering the cooling off period and to our knowledge the Opponent was not directly contacted either. Accordingly we believe that the TM9c has been filed with a false declaration. We wish to see the TM9c to try to

clarify what has happened but we anticipate that we will then be asking for the granting of the cooling off period to be rescinded and for the application to be refused due to failure to file a TM8.”

8. Having been furnished with a copy of the Form TM9C on 26 October 2022, the opponent wrote again to the Registry by email on 27 October 2022 as follows:

“Please note that we were not contacted by the Applicant with a request to enter the cooling off period. We have also checked with the Opponent who has confirmed they had no contact from the Applicant.

Accordingly, the TM9C filed by the Applicant contained a false declaration that the other party (Opponent) had agreed to the request for a cooling off period.

Under the circumstances we request that the granting of the cooling off period is rescinded and that the application be refused due to failure to file a TM8. Furthermore, given that the Applicant is experienced in procedure before the UKIPO in view of other disputes with the Opponent and has filed a false declaration we trust that no discretion will be exercised to allow for the TM8 to be filed late.”

9. On 3 November 2022, the Registry wrote to the applicant as follows (a copy of the letter being sent to the opponent):

“I refer to the email from the Opponent dated 27 October 2022 in which they state they did not agree to enter the cooling off period. The cooling off period has now been rescinded.

The official letter dated 29 July 2022 invited the applicant to file a TM8 and counterstatement on or before 29 September 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, **17 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 deem the application abandoned.”

10. In emails on 7 November 2022 and then again on 10 November 2022, the opponent’s representatives expressed their concerns at the Registry’s failure to comment on the applicant’s “false declaration” when filing his Form TM9C.

11. On 17 November 2022, the applicant filed a Form TM8 and a counterstatement, both dated 23 September 2022.

12. The Registry’s subsequent letter in reply, dated 22 November 2022, dealt with two matters. First, it addressed the opponent’s concerns in relation to

the applicant's Form TM9C by confirming that the cooling off period had been rescinded. Second, it acknowledged receipt of the applicant's Form TM8, but informed the applicant that:

“in order for the Registry to consider admitting a late filed TM8 and counterstatement into the proceedings, it will be necessary for you to a) request a hearing and b) file a witness statement explaining why the form was not received in time.

You are allowed a final period of 7 days, i.e. on, or before, **29 November 2022**, to request a hearing and file an admissible witness statement explaining why the TM8 form was not received in time.”

13. On 29 November 2022 the applicant sent in his Form TM9C and his Form TM8 again along with a witness statement and a covering letter. The witness statement essentially restated the applicant's counterstatement, but the covering letter contained a statement of truth. The covering letter explained that the applicant intended to attach the Form TM8 and counterstatement at the time that the Form TM9C was submitted on 23 September 2022. He said that he didn't know how he missed the other attachments.
14. The applicant apologised and asked that the Registry “accept the Form TM8 - TM9c with counterstatement” and requested a hearing.
15. On 5 December 2022, the Registry issued a letter confirming receipt of the documents sent in on 29 November and stating the following:

“After careful consideration of the contents of the papers you have provided, it is the **preliminary view** of the Registrar that the reasons given are not sufficient to exercise his limited discretion and admit a late filed Form TM8 into these proceedings.

Therefore, **the Registrar's preliminary view is that this application is to be treated as abandoned.**

In line with The Manual of Trade Marks Practice, if either party disagrees with a preliminary view, they may, within fourteen days from the date of this letter, that is, on or before **19 December 2022**, express an objection and request a hearing.”

16. The applicant duly requested a hearing.

THE HEARING

17. A joint hearing took place before me, via Microsoft Teams as an audio call, on Thursday 12 January 2023.

18. Both parties filed skeleton arguments.

19. The applicant, Mr Hussain, attended the hearing as a litigant in person.

20. The opponent was represented by Graham Johnson from Appleyard Lees IP LLP.

21. In dealing with the main points of his skeleton argument, Mr Hussain said that he intended to file his Form TM8 and counterstatement at the same time as his Form TM9C. He didn't know how, but he neglected to attach the Form TM8 and counterstatement. This was human error. He drew a parallel with the Registry sending him some papers from a different case in error and then apologising and sending the correct papers.

22. Mr Hussain apologised for the delay and asked that his “Form TM8 - TM9c” be admitted. He said that he was inexperienced and “without any professional or specialized knowledge” of the IPO, whereas his opponent was professionally represented. He indicated that in a previous dispute with the opponent, both parties had sought to settle the matter and that they had agreed upon and resolved it.

23. I had three questions for Mr Hussain. Why had he intended to submit both a Form TM9C and a Form TM8 when the letter from the Registry made it clear that he was to submit one or the other, not both? On what basis did he think that the parties had mutually agreed to a cooling off period? Given that it was apparent from the opponent's skeleton arguments that the parties had been engaged in a previous case before the IPO, in what sense was the applicant inexperienced in relation to IPO procedures?
24. Mr Hussain's answers to these questions were not particularly satisfactory. The best construction that can be put on his comments is that he filed the Form TM9C as a way of saying that he would like to enter a cooling off period. The intended Form TM8 and the counterstatement were to be utilised in the event that the other side did not agree to enter a cooling off period.
25. Mr Hussain claimed that in the previous case involving the parties, a cooling off period had been agreed to. However, that was not Mr Johnson's understanding. His understanding was that there was mutual agreement as to an extension of time during the evidence rounds, but there had been no agreed cooling off period.
26. On the question of his knowledge of IPO procedures, Mr Hussain simply reiterated that he was an "ordinary person" without specialised knowledge. As such, he did not really address the argument that having previously gone through the full process of a case before the Registry he should have been equipped with a knowledge of IPO procedures.
27. For Mr Johnson's part, his client's position was, to quote from the skeleton arguments: "The Applicant has considerable experience of Registry procedure having conducted case **O/891/21** before the Registry before appeal to the Appointed Person."
28. Overall, the opponent argued that the late Form TM8 should not be admitted and that the application should be treated as abandoned: "It is quite clear that there were not "extenuating circumstances" and there are not "compelling

reasons” as required for the Registrar to exercise discretion to admit into proceedings a Form TM8 filed outside the stipulated period.”

DECISION

29. The filing of a Form TM8 in opposition proceedings is governed by rule 18 of the Trade Mark 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.

(3) Unless either paragraph (4), (5) or (6) applies, the relevant period is the period of two months beginning immediately after the notification date.

(4) This paragraph applies where—

(a) the applicant and the person opposing the registration agree to an extension of time for the filing of Form TM8;

(b) within the period of two months beginning immediately after the notification date, either party files Form TM9C requesting an extension of time for the filing of Form TM8; and

(c) during the period beginning on the date Form TM9C was filed and ending nine months after the notification date, no notice to continue on Form TM9t is filed by the person opposing the registration and no request for a further extension of time for the filing of Form TM8 is filed on Form TM9e,

and where this paragraph applies the relevant period is the period of nine months beginning immediately after the notification date.”

30. The combined effect of Rules 77(1), 77(5) and Schedule 1 of the Rules means that the time limit in rule 18, which sets the period in which the defence must be filed, is non-extensible other than in the circumstances identified in 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.”

31. Mr Hussain’s reference to the Registry sending him some papers from a different case in error and then apologising and sending the correct papers had no bearing on the matter at hand. Therefore, there is no relevant irregularity on the part of the Registry in this case.

32. Sitting as the Appointed Person in *Kickz AG and Wicked Vision Limited* (BL-O-035-11) (“*Kickz*”) Mr Geoffrey Hobbs KC held that the discretion conferred by Rule 18(2) can be exercised only if there are “extenuating circumstances”. And sitting as the Appointed Person in *Mark James Holland and Mercury Wealth Management Limited* (BL-O-050-12) (“*Mercury*”) Ms Amanda Michaels KC held that there must be “compelling reasons” to justify the Registrar exercising that discretion. In considering relevant factors, Ms Michaels referred to the criteria established in *Music Choice Ltd’s Trade Mark* [2006] R.P.C. 13 (“*Music Choice*”), which provides guidance applicable by analogy when exercising the discretion under rule 18(2). The factors are as follows:

The circumstances relating to the missing of the deadline including reasons why it was missed and the extent to which it was missed

33. The deadline for filing the Form TM8 was 29 September 2022. The Form TM8 was received by the Registry on 17 November 2022. Mr Hussain says that it was his intention to file the Form TM8 at the same time as he filed the Form TM9C on 23 September 2022. He says that his failure to do so was due to human error.

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

34. The opposition is brought under sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Act. There is nothing to suggest that the opposition is without merit.

Consequences of treating the proprietor as opposing or not opposing the application

35. If the applicant is allowed to defend the opposition, the proceedings will continue, and the matter will be determined on its merits. If, however, the applicant is not allowed to defend the opposition, his application will be deemed abandoned and the applicant will lose his filing date of 23 January 2022. It may remain open to the applicant to re-file his application. However, the opponent contends that the current application is identical to a previous one which "was refused registration by the Appointed Person in **O/891/21** for reasons including that that application was made in bad faith [I note that on appeal the case reference is O/929/22]."

Any prejudice caused to the opponent by the delay

36. The opponent has not identified any prejudice caused to itself other than costs. The applicant has made no comment on this subject.

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

37. While there are no current related proceedings between the parties, the opponent has drawn my attention to the fact there was a previous case between the parties, O/891/21, which on appeal was O/929/22.
38. Having addressed each of the relevant factors as proposed in *Music Choice*, I must now decide whether the applicant's statement of truth and subsequent comments at the hearing reveal extenuating circumstances or compelling reasons that would enable me to exercise the discretion to admit the late-filed Form TM8.
39. After carefully considering the expected detriment to the applicant in the event that discretion is not exercised in his favour, I find that the loss of a filing date and the possibility of further proceedings on much the same basis is often the consequence of a failure to comply with the non-extensible deadline for filing a Form TM8. These factors are not, therefore, particularly compelling.
40. I am not persuaded by Mr Hussain's claim that it was his intention to file the Form TM8 at the same time as the Form TM9C. At no time did he make reference to the Form TM8 when emailing the Registry on 23 September 2022. Even when the Registry pointed out that he had failed to attach the Form TM9C to his email, this did not serve to jog his memory and remind him that he also intended to attach the Form TM8 and the counterstatement.
41. Even if I was to accept that it was Mr Hussain's intention to file the Form TM8 and the fact that he failed to do so was down to human error, that is not a sufficiently extenuating circumstance or compelling reason for not filing the form on time.
42. If I am to be charitable and interpret the filing of the Form TM9C as an expression of a desire to negotiate with the opponent with a view to settling the case, that is an improper use of the Form TM9C. The form clearly states

at the top: “**Use this form** only if both sides agree to a cooling off period, otherwise we will not grant the request.”

43. The improper filing of the Form TM9C certainly led to unnecessary delays in the processing of this case.
44. As for Mr Hussain’s claim that as a litigant in person he is inexperienced in the procedures of the IPO, I am mindful of the decision of Mr Geoffrey Hobbs KC in BOSCO where he maintained that “being a litigant in person with no previous experience of legal proceedings is not a good reason for failing to comply with the rules.”¹ I also note that Mr Hussain has in fact had previous dealings with the IPO.
45. Having considered all of the applicant’s reasons for its failure to file a TM8 by the deadline set, I find no single reason or combination of reasons sufficient to enable me to exercise my discretion to admit the late-filed TM8 into these proceedings.

CONCLUSION

46. The late-filed Form TM8 is not to be admitted into the proceedings. Subject to appeal, the application is treated as abandoned.

COSTS

47. As my decision terminates the proceedings, I must consider the matter of costs.
48. In his skeleton arguments, the opponent makes the following request:

“We request that the costs award reflects the fact that the Opponent has been put to the additional cost of this hearing. We request also that, to the extent that it is possible to do so, the costs award reflects the fact that UK00003746480 is identical to UK00003405720 which was refused

¹ BL-O-399-15

registration by the Appointed Person in O/891/21 [O/929/22 on appeal] and in relation to which the costs award remains unpaid.”

49. I award the opponent costs in line with Tribunal Practice Notice 2/2016. This costs award reflects the fact that the preparation of the opponent’s statement was a relatively complex exercise and that the opponent was required to prepare for and attend the joint hearing. I am not in a position to award additional costs based on the fact that the applicant has previously attempted to register the same mark and that the costs award in relation to that case has not been paid. I award the following:

Preparing a statement:	£350
Official fee:	£200
Preparing for and attending the joint hearing:	£500
Total:	£1050

50. I order Zamir Hussain to pay Jatinder Singh Wasu the sum of £1050 as a contribution towards his 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 9th day of February 2023

John Williams
For the Registrar