

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION No. 2645011
IN THE NAME OF MARCOS CARS LIMITED**

-and-

**IN THE MATTER OF CANCELLATION No. 503582
BY MARCOS SPORTSCARS LIMITED**

-and-

**AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF
MR D JOHNSON DATED 21 APRIL 2022**

DECISION

1. This is an appeal from a decision of Mr Denzil Johnson, the Hearing Officer for the Registrar by the applicant for cancellation, Marcos Sportscars Ltd. In this judgment, I refer to Marcos Sportscars Ltd as “the Appellant,” and to Marcos Cars Ltd as “the Proprietor.”

Background

2. As the parties’ names suggest, they (and parties connected to them) claim certain rights to logos containing the name Marcos in connection principally with cars.¹
3. The procedural background to this appeal is of importance.

¹ This appeal relates only to trade mark 2645011. Earlier IPO proceedings between apparently related parties concerned a different Marcos logo, see BL O/611/21.

4. On 7 December 2012 application 2645011 was filed for goods in Classes 12 and 25:



The mark was registered on 10 May 2013.

5. On 21 January 2021, the Appellant filed an application for cancellation of the mark for non-use. The Form TM26(N) was sent in the usual way by the UKIPO to the Proprietor on 28 March 2021 (a) by registered post to the address recorded at the IPO as its address for service in Welshpool and (b) by email to the email address on record (which was andy.hughes@marcos-uk.com). The letter specified that the date for filing the defence on Form TM8 was 29 March 2021. The registered letter was returned to the UKIPO marked addressee 'unknown.' On the other hand, it appears from a letter dated 24 February 2021 that at that point the IPO's IT department said that the email had not been returned so it appeared to have been successfully sent.

6. Copies of the documents sent in January were sent by ordinary post to the same Welshpool address under cover of a letter dated 24 February stating:

"The correspondence sent to you by recorded delivery post has been returned by the Post Office advising the addressee was 'unknown'. The postal address used was the same as the address used when applying for the registration, therefore, the letter (with attached documents) is being re-sent to that address to maximise the chances of receipt of those documents.

Please note, according to the IT Department at the Registry, the correspondence sent by email has not been returned, therefore, it is anticipated that correspondence was received."

The letter of 24 February was not returned in the post.

7. Where no TM8 is filed in time, it is the practice of the UKIPO to write to the trade mark proprietor giving it an additional 14 day period in which to set out any reasons why the Registrar should exercise its discretion vested in him to treat the application as

defended. The UKIPO accordingly sent a letter on 20 April 2021 to the Proprietor by registered post and to the same email address for Mr Hughes, saying:

“The official letter dated 28 January 2021 informed you that if you wished to continue with your registration you should file TM8(N) and counterstatement on or before 29 March 2021.

As no TM8(N) and counterstatement have been filed within the time period set, Rule 38(6) applies. Rule 38(6) states that:

“...the registration of the mark shall, unless the registrar directs otherwise, be revoked.”

The registry is minded to treat the proprietor as not opposing the application for revocation and revoke the registration 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, **04 May 2021**. 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.”

8. The Royal Mail track and trace document shows that the letter was delivered on 21 April 2021. The signature on the form appears to consist of initials and is (to my mind) quite illegible. The Royal Mail form states that the letter was signed for by “Toms Garage.”
9. In the absence of any response to the April letter, the UKIPO sent a further letter to the Proprietor by ordinary post on 9 June 2021 stating that the mark was revoked. This was not returned in the post. The mark was then revoked on 22 July 2021.
10. It seems that the Proprietor was then informed of the revocation, possibly via the parties in the proceedings reported at BL O/611/21, although exactly how this occurred is not clear to me. On 19 August 2021, Mr Andy Hughes (whose relationship

with the Proprietor is also not known to me) emailed the UKIPO stating that he had been informed by the officers of the Proprietor that the mark had been cancelled, and was “writing to request this action is reversed. This trade mark has been in constant use since 2013... I am told the IPO has written to me, at the Welshpool office, which has not been open during the lock down period.” That was followed up by a lengthy email to the UKIPO dated 20 August from Mr Tony Brown (described by the Hearing Officer as the owner of the Proprietor company, and who is its only director), repeating that the mark had been used, and saying “as for the post and emails Neither myself or Andy Huges [sic] received any notification with regards this matter.”

11. On 25 August, Mr Hughes was informed by the UKIPO that the matter was being investigated, and he responded asking that it be expedited, “as Marcos Cars cannot continue to trade without this trade mark.” On 26 August, the UKIPO replied by email to Mr Hughes and Mr Brown at the email addresses they had used in August, setting out the procedural history, and referring them to (and setting out) Chapter 4.16 of the Manual. The email advised that a Form TM29 could be filed requesting that the decision be reversed, and provided a link to the Form. It also stated that any Form TM29 would need to be filed by 22 January 2022, and “must be accompanied by evidence in support of the application.”
12. Mr Hughes responded on 27 August saying (1) there is no such place as Tom’s Garage in Welshpool, (2) he had been to the Welshpool premises which was currently occupied by another company he works with, and they had no record of post for Marcos Cars there, and (3) the andy.hughes@marcos-uk.com address used was ‘dropped early on’ and was ‘not in use.’ He asked for copies of all of the documents, which were sent to him on the same day.
13. It was not until 20 January 2022 that Form TM29 was filed by Mr Brown. The reasons for the application were brief and handwritten: “I have enclosed a pdf file with all my information showing that this logo is and always has been in use and it was removed from use by a company that is and trying to defraud me of my company.”

14. On 14 February, a preliminary view was issued to set aside the decision of 22 July 2021:
“In reaching this preliminary view the Registrar has taken into account the reasons provided by the registered proprietor in its Form TM29, and also the fact that the Registrar cannot definitively confirm that the email correspondence issued by the Office were received by the registered proprietor.
In addition, the Registrar has taken account of the consequences for the registered proprietor if the mark remains off the register. Whilst no view is being given at this stage to whether the trade mark has been in use, the registered proprietor must be given, in the interest of natural justice, the opportunity to defend its property at the appropriate time.”
15. The Appellant contested the preliminary view and a hearing took place remotely on 28 March 2022. The Appellant was represented by Mr Tate of Maguire Boss, who had filed a witness statement in support of the Appellant’s position, and Mr Brown appeared for the Proprietor. By his written decision dated 19 April 2022, which is the decision now under appeal, the Hearing Officer upheld the preliminary view.
16. The Appellant filed this appeal on 19 May 2022 (the Grounds being amended on 20 May 2022) and on 10 June solicitors then appointed for the proprietor filed a Respondent’s Notice (also amended, on 27 June 2022)
17. The Grounds of Appeal were lengthy, but in my judgment the central point in the appeal was that the Hearing Officer had failed properly to apply Rule 43, in particular by concluding that Form TM26(N) had not been received despite the Proprietor’s failure to file any evidence to that effect with its Form TM29. The Appellant contended that in exercising his discretion under Rule 43 the Hearing Officer had been wrong to base his decision on unsworn statements (“information”), and submissions made at the hearing, instead of evidence. As a secondary point, the Appellant submitted that the Hearing Officer was wrong to find that the application under Rule 43 had been made promptly. Mr Tate, the Appellant’s trade mark attorney, filed two further witness statements in support of the appeal.

18. The Respondent's Notice filed by the proprietor stated that in light of the comments in the Grounds of Appeal about misleading statements from Mr Hughes and Mr Brown, it was "necessary to clarify the background as to why Form TM26(N) was not received" by the Proprietor. The pleaded 'background' set out a number of factual matters, including as to the occupant of the Welshpool premises and its relationship with the Proprietor/Mr Hughes. The Notice was verified by a statement of truth signed by the Proprietor's solicitor.

19. In advance of the hearing of the appeal, I directed both parties to make a formal application to adduce fresh evidence on the appeal, if that was their intention. The Appellant duly made such an application, but at the hearing of the appeal Mr Tate said that he had concluded that the Appellant did not need to rely upon his two new witness statements, so that this point fell away. No equivalent application was made by the Proprietor, and at the appeal Mr Muir Wood did not seek to rely upon the new 'information' or clarification included in the Respondent's Notice. In the circumstances, the only evidence before me was that which was available to the Hearing Officer.

Standard of appeal

20. It was common ground that this appeal is by way of review, it is not a rehearing. The relevant principles were not in dispute. They have recently been conveniently summarised by Joanna Smith J. in *Axogen Corp v AVIV Scientific Ltd* [2022] EWHC 95 (Ch), [2022] ECC 19 at [24], where she said:

"the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:

- i) The appeal is by way of a review, not a rehearing (see *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [52(i)]);
- ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a

belief that he or she has reached the wrong decision suffices to justify interference (*NINEPLUS* (O/039/21) at [14]);

iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible" (*Actavis Group* at [81]);

iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question (*REEF Trade Mark* [2003] R.P.C. 5 per at [26]). There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision" (*TT Education* at [52(ii)]), with decisions of primary fact at one end of the spectrum and multi-factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.

v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education* at [52(iv)], *REEF* at [28] and *Fine & Country* at [50]-[51]).

vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible (*Actavis Group* at [80]).

vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal" (*REEF* at [26], *Actavis Group* at [78]). Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections

simply because they might have reached a different conclusion on the facts (*Shanks* at [28] citing the warning given by Baroness Hale in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49).

viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden" (see *REEF* at [29]). The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted (*English* at [17], *Fage* at [115]). The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained (*English* at [19]).

ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account (*TT Education* at [52(vi)])."

21. Mr Muir Wood also reminded me that I have previously ruled, in BL O/372/14, *WhyHey*, that a decision under Rule 43 involves an exercise of judicial discretion. An appeal tribunal should not readily interfere with a judge's exercise of such discretion absent an error of law or serious procedural irregularity, see *Tanfern Ltd v. Cameron-McDonald* [2000] 1 WLR 1311 at [32]:

"the appellate court should only interfere when they consider that the judge of first instance has not merely preferred an imperfect solution which is different from an alternative imperfect solution which the Court of Appeal might or would have adopted, but has exceeded the generous ambit within which a reasonable disagreement is possible."

The legislative background

22. Rule 38 of the Trade Marks Rules 2008 provides

38.—(1) An application to the registrar for revocation of a trade mark under section 46, on the grounds set out in section 46(1)(a) or (b), shall be made on Form TM26(N).

(2) The registrar shall send a copy of Form TM26(N) to the proprietor.

(3) The proprietor shall, within two months of the date on which he was sent a copy of Form TM26(N) by the registrar, file a Form TM8(N), which shall include a counter-statement.

...

(6) Where the proprietor fails to file a Form TM8(N) within the period specified in paragraph (3) the registration of the mark shall, unless the registrar directs otherwise, be revoked.

23. As Mr Hobbs QC sitting as the Appointed Person noted in *Tescon trade mark* BL O/240/20, and reiterated in *Marco Polo trade mark*, BL O/681/22 (in relation to Rule 41(6), equivalent to 38(6)), the time limit for filing a TM8 defence is rigid, although it is not absolute, as discussed below. Failure to comply with that time limit will generally lead to the mark being cancelled or declared invalid, although the Rules provide the Registrar with some discretion to direct otherwise, in particular where there are extenuating circumstances or compelling reasons to do so. In *Marco Polo* at [30] he explained:

“The time limit of two months prescribed by Rule 41(6) is both rigid and jurisdictional. It operates rigidly as a result of the barrier to the granting of an extension created by the 2008 Rules: the Registrar is expressly prevented by Rule 77(6) and Schedule 1 from treating it as a “flexible time limit”. It operates jurisdictionally as a result of the barrier to the filing of a defence created by Rule 41(6). If the proprietor of the registration in issue fails to comply with the deadline, his right to oppose the invalidity application is timed-out. At that point, the invalidity application stands undefended and the registration “shall ... be declared invalid” unless the Registrar counteracts that by issuing a decision which “otherwise directs” as to what the result of the failure to comply with the time limit should be. There is a significant disciplinary dimension and none the less so because there is also a curative dimension to the exercise of the discretion

available to the Registrar under Rule 41(6) (“may treat the proprietor as not opposing the application”): *TESCON Trade Mark* BL O/240/20 (17 April 2020) at paras. [43], [44]. The discretion is generally not exercised in favour of the proprietor of the contested registration in the absence of ‘extenuating circumstances’ or ‘compelling reasons’ for doing so: *Permanent Secretary v John & Pascalis Ltd (HALLOUMI Trade Mark)* [2018] EWHC 3226 (Ch) at paras. [34] to [41] (Arnold J).”

In *Tescon*, Mr Hobbs QC had said:

“42 ...

(3) there is no general power to grant relief from sanctions in Registry proceedings under the 1994 Act and 2008 Rules: *BOSCO Trade Mark* (BL O/399/15; 21 August 2015); the Registrar is expressly prevented by rule 77(6) and Schedule 1 to the 2008 Rules from treating the time limit prescribed by rule 41(6) as a ‘flexible time limit’; and the procedural jurisprudence applicable to rule 41(6) confirms that the time limit is designed to be strictly enforced.

43. In *Barton v. Wright Hassall LLP* [2018] UKSC 18 at paragraph [8] Lord Sumption JSC observed in relation to the power to waive compliance with procedural conditions under provisions such as those in Civil Procedure Rule 3.9 that “there is a disciplinary factor in the decision whether to impose or relieve from sanctions for non-compliance with rules or orders of the court, which has become increasingly significant in recent years with the growing pressure of business in the courts.” I do not think it can be doubted that there is a significant disciplinary dimension to the power conferred upon the Registrar by rule 41(6) and none the less so because there is also a curative dimension to it.

44. The structure of the rule as I have described it in paragraph [4] above points to the importance of the disciplinary dimension. As I have said, the procedural jurisprudence applicable to rule 41(6) confirms that the time limit it prescribes is designed to be strictly enforced. Many decisions can be found to support that proposition. Prominent among them is the decision in the HALLOUMI Trade Mark case where a certification trade mark registration held by the

Permanent Secretary, Ministry of Energy, Commerce and Tourism, Republic of Cyprus was declared invalid under rule 41(6) consequent upon the failure of the proprietor to file a Form TM8 and Counterstatement by the notified date of 26 March 2018. Rose LJ noted the gravity of this for the Republic of Cyprus in her Order of 6 June 2019 rejecting the trade mark proprietor's application to re-open Floyd LJ's refusal of permission to appeal to the Court of Appeal. Paragraphs [12] and [46] of the Judgment of Arnold J reflect the stringency of the requirement to comply with the time limit prescribed by the rule:

[12] The [Registry's] letter of 26 January 2018 was received by the Ministry at the latest on 9 February 2018. The Ministry's evidence is that the letter was read by at least two officials in the Ministry on 9 February 2018 and that, on or shortly after that date, a third official instructed a fourth official to forward the letter to the Law Office of the Republic of Cyprus; but that instruction was not actioned, and so no Form TM8 or counterstatement was filed. ...

[46] ... I have summarised in paragraph 12 above the explanation which is given by the Ministry in the further evidence. That evidence simply demonstrates that the Ministry was the author of its own misfortune. The Ministry's internal procedures were so disorganised that the letter enclosing the Application was passed from official to official after receipt on 9 February 2018, but no action was taken. In my judgment this evidence fails to establish any extenuating circumstances for the Ministry's failure to meet the statutory deadline. In those circumstances the other aspects of the further evidence cannot provide a sufficient basis for the exercise of the rule 41(6) discretion in the Ministry's favour."

24. As a result of the stringency of the Rules as to timeous service of a TM8, and the limits on the applicability of (in this case) Rule 38(6), there are many cases, like *Halloumi*, in which the absence of sufficient extenuating circumstances or compelling reasons for failure to file a TM8 by the deadline set by the Rules has led to the loss of a registered mark.

25. However, Rule 77 (5) provides that even an inflexible time limit may be extended at the Registrar's discretion where:

“(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.”

26. In addition, Rule 43 provides a limited fail-safe mechanism where the failure to defend was due to a failure to receive the proceedings, in this case the Form TM26(N):

“43.—(1) This rule applies where—

...

(b) the registration of a mark is revoked under rule 38(6) or rule 39(3);

...

and the applicant or the proprietor (as the case may be) claims that the decision of the registrar to treat the application as abandoned or revoke the registration of the mark or declare the mark invalid (as the case may be) (“the original decision”) should be set aside on the grounds set out in paragraph (3).

(2) Where this rule applies, the applicant or the proprietor shall, within a period of six months beginning immediately after the date that the application was refused or the register was amended to reflect the revocation or the declaration of invalidity (as the case may be), file an application on Form TM29 to set aside the decision of the registrar and shall include evidence in support of the application and shall, in the cases referred to in paragraph (1)(a) to (c), copy the form and the evidence to the other party to the original proceedings under the rules referred to in paragraph (1).

(3) Where the applicant or the proprietor demonstrates to the reasonable satisfaction of the registrar that the failure to file Form TM8 or the derogation notice within the period specified in the rules referred to in paragraph (1) was due to a failure to receive Form TM7, Form TM26(N), Form TM26(O), Form TM26(I) or notification from the registrar under rule 43(4)(b) that the comparable trade mark (EU) will be revoked or declared invalid to the same extent as the corresponding EUTM (as the case may be), the original decision may be set aside on such terms and conditions as the registrar thinks fit.

(4) In considering whether to set aside the original decision the matters to which the registrar must have regard include whether the person seeking to set aside the decision made an application to do so promptly upon becoming aware of the original decision and any prejudice which may be caused to the other party to the original proceedings if the original decision were to be set aside.”

27. Mr Hobbs QC considered the operation of Rule 43 in BL O/035/11, *KIX*. There the TM26 had been served by registered post and had been signed for by someone whose identity had not been established. The proprietor was unable to explain what became of the letter after it had been received. Mr Hobbs QC held that a failure to read the letter/Form was not the same as a failure to receive it. There had been no ‘failure to receive’ the proceedings and in the circumstances Rule 43 did not apply so as to save the trade mark.
28. The Hearing Officer in this case also referred to my decision in *Wheyhey, supra*, a case in which the Form TM26 had been served at the address for service, but it was accepted that it had not been received by the proprietor. I said:
- “7. Whilst the 2008 Rules broadly consolidated the much-amended Trade Mark Rules 2000, Rule 43 was a new provision designed to cater for cases in which a trade mark or trade mark application was lost because the proprietor was unaware that it was under attack, usually as a result of the ineffective service of the application to oppose/cancel it. The UKIPO’s Consultation Paper of March 2008 on the proposed new rules indicated that the majority of such cases arose because the applicant or proprietor had not kept his address for service up to date. Prior to Rule 43 coming into effect, there was no rule enabling such a proprietor belatedly to contest the removal of his trade mark due to his failure to respond to a properly addressed notice delivered to the recorded address for service. The new Rule 43 was intended to permit parties who had lost their mark in such circumstances to apply for the decision to refuse the application/cancel the registration to be set aside “subject to rules on timeliness and equity.” The Rule thus seeks to balance the interests of the proprietor who has lost his mark and the applicant for invalidity.

8. It is clear that Rule 43 does not provide an unlimited right to seek to set aside an adverse decision made due to a failure to file a TM8, in terms either of the time when or the circumstances in which the application to set aside can be made. Two conditions must be satisfied before a proprietor whose mark has been invalidated may rely upon the Rule:

(a) the application must be made within six months after the register has been amended to reflect the declaration of invalidity - Rule 43(2);

(b) the proprietor must demonstrate to the reasonable satisfaction of the registrar that his failure to file a Form TM8 in time was because he did not receive Form TM26(I) - Rule 43(3).

See case BL O/035/11, *KIX*, an appeal to the Appointed Person heard by Mr Geoffrey Hobbs QC, in which failure to satisfy the registrar of 'failure to receive' the TM26 led to the rejection of the application to set aside.

9. Subject to satisfying those two points, it may be seen from the wording of Rule 43(3) that the registrar has a discretion ("as the registrar thinks fit") whether to set aside the original decision, and if so whether to impose conditions."

I added:

"24. ... Rule 43(4) does not fetter the Hearing Officer's discretion further than to require him to take into account the two particular matters mentioned in that sub-rule; it is clear from the wording of the sub-rule that the Hearing Officer will take other matters into account, and the potential prejudice to the party making the application under Rule 43 must surely be one such matter, whatever the weight to be given to it.

...

26. If the applicant for invalidity will suffer any particular prejudice as a result of setting aside the decision, the Hearing Officer ought to take that into account and give it due weight. However, any such particular prejudice needs to be identified and evidence is likely to be needed to make good the submission of prejudice."

29. Service by post is not governed directly by the TM Rules, but by section 7 of the Interpretation Act 1978. This was discussed by Mr Hobbs QC in the *Marco Polo* case

at paragraphs 39 to 45. I do not need to repeat that passage in full, as the important point is the content of section 7 itself, which provides

“Where an Act authorises any document to be served by post (whether the expression ‘serve’ or the expression ‘give’ or ‘send’ or any other expression is used) then, unless the contrary intention appears, the service is deemed to be effected by properly addressing, pre-paying and posting a letter containing the document and, unless the contrary is proved, to have been effected at the time at which the letter would be delivered in the ordinary course of post.”

It is not, therefore, necessary for service of UKIPO proceedings to be made by registered post or for there to be proof of delivery. Once the letter containing the Form has been properly addressed, prepaid and posted to the appropriate address, service is deemed to have been effected, unless the contrary is proved.

30. As for service by email, in BL O/874/22, *MySmile*, decided after the decision under appeal was handed down (and after the hearing of the appeal), Mr Hobbs QC held that Rule 79, which relates to electronic communications by the Registrar, does not enable an email address to be used by the Registrar for service. He said:

“7. The prevailing view (albeit subject to criticism and pressure for modernisation) is that an email address does not, as such, qualify for recognition as an “address for service” because it does not, as such, designate any particular premises at which papers intended for a particular person can with confidence be physically delivered c.f. *Axnoller Events Ltd v Brake* [2022] EWHC 1162 (Ch) at paras. [16] to [19] (HHJ Paul Matthews sitting as a Judge of the High Court).

8. Electronic service needs to be an organised — rather than an ad hoc — process for the reasons identified by Lord Sumption JSC in *Barton v Wright Hassall LLP* [2018] UKSC 12 at para. [17]:

“There are, moreover, particular problems associated with electronic service, especially where it is sought to be effected on a solicitor. A solicitor must have his client’s authority to accept service of originating process. If he has that authority, it will in practice normally cover any mode of service. But a solicitor’s office must be properly set up to receive formal electronic communications such as claim forms. As the Law Society’s Practice

Guidance on electronic mail (May 2005) points out, “email presents new problems, because it can arrive unperceived by other members of staff”. The volume of emails and other electronic communications received by even a small firm may be very great. They will be of unequal importance. There must be arrangements in place to ensure that the arrival of electronic communications is monitored, that communications constituting formal steps in current litigation are identified, and their contents distributed to appropriate people within the firm, including those standing in for the person primarily responsible for the matter when he is unable to attend to such communications as they arrive.”

...

14. The present case demonstrates the need recognised in the references I have given in paras. [8] to [10] above for electronic service to be an organised — rather than an ad hoc — process. At this point it is sufficient for me to say that I am not satisfied that r.79 enables an email address to be used by the Registrar as an address for service in the manner suggested by the Applicants”

The decision under appeal

31. The Hearing Officer set out in some detail the background facts which I have summarised above, and then set out the parties' respective arguments. He also set out at paragraph 28 some of the submissions which were made by Mr Brown on behalf of the proprietor at the remote hearing before him. I have looked at these in the transcript of the hearing below, and note that these included submissions that

- “at the particular time of these letters being sent out in the post, the office that we were using in Welshpool at the time was unoccupied due to the Covid virus and all the staff were told to stay home, so people were working from home. Any letters that came to that property were immediately sent back not received. That is one point that the IPO office had commented on that the letters were returned ...” But later in the hearing he said “the place was closed and any registered letters would not be signed for”

- "This took a few weeks into months before we had all confirmation back from the IPO office. That led to a delay in me filing the form. I was then in talks again with the IPO and they advised me to fill out the form, a TM26 [sic]" and
- "we did try to go for legal advice but due to Covid and people working from home I had a lot of problems trying to find an IPO solicitor local to me ... Therefore, I could not get a representative to represent me today..."

32. At paragraph 32, the Hearing Officer considered the question "*Has the Registered Proprietor demonstrated to the reasonable satisfaction of the Registrar that its failure to file form TM eight within the period specified in the Rule was due to a failure to receive Form TM26(N)?*" He said:

"32. The information before the Tribunal is mutually consistent: the Registry's correspondence (sent via Royal Mail's signed-for tracking service) was returned to the Registry or delivered to an entity independent of the Registered Proprietor (which the Proprietor submits, does not exist); no account could reliably be made of service attempted by ordinary post; and the IPO's IT department could not confirm that the relevant email correspondence was delivered. The Registered Proprietor contends that he did not receive any of the correspondence (postal or electronic); that the email address (then) on record was inoperable; the company's registered address had changed; and at all material times its office was out of commission due to the Covid-19 pandemic. Therefore, I find that the Registered Proprietor has demonstrated to a reasonable satisfaction that his failure to file Form TM8 within the relevant period was due to a failure to receive the Form TM26(N)."

33. The Hearing Officer then considered whether the application had been made promptly:

"33. To all appearances, it seems that Mr Tate's arguments are well-founded: "it took the Proprietor from 19 August 2021 all the way to 20 January 2022" to file a Form TM29, which essentially consisted of "a single sentence"; and in such circumstances, he could not be said to have acted with all reasonable celerity.

However, I also consider the Proprietor's submissions: that he has a disability, for which he requires assistance to process and respond to written language; time was spent in talks with the IPO on the question of whether he had in fact received the TM26(N); and that he had made attempts (to no avail) to engage legal representation. In these circumstances, it would be unreasonable for me to conclude that the TM29 application plainly could/should have been made well before it was."

34. In paragraphs 34-36, the Hearing Officer considered the prejudice to the Appellant if the preliminary decision was set aside and rejected this because the decision to reinstate the mark put the parties in the position they would have been had the proprietor received the cancellation application.

35. In conclusion, the Hearing Officer said:

"37. In reaching a conclusion, I have borne in mind all of the considerations set out in *WHEYHEY* and the stipulations of the relevant Rules, as well as the circumstances surrounding service of the cancellation application, leading, on a balance of probabilities, to Mr Brown not being notified of the action at the material time. I have also considered Mr Brown's submissions as to his actions prior to his filing of the TM29 and balanced the potential prejudice both parties may suffer if the original decision is or is not set aside. Having done so, I am satisfied that in all the circumstances described above fairness and justice entail that the preliminary view (to set the original decision aside) must be upheld. This would also allow for the substantive issues in this dispute to be resolved on the basis of evidence rather than a technicality."

Merits of the appeal

36. The Appellant's first complaint related to the finding as to non-receipt of the documents. It seems to me that the way in which the Hearing Officer phrased the central findings of his decision, in paragraph 32, is important. He referred to the "information" before the tribunal being mutually consistent. He was, therefore,

consciously taking into account matters or materials which were not in evidence. In particular, it is clear that he took into account the UKIPO's own records of documents which had been sent to the proprietor, and what appears to have become of them. All of the factors which he took into account in the first sentence of paragraph 32 were known to him from the Registry's records, and apparent from the documents on file; they were not points made by the Proprietor. However, in my judgment, the Hearing Officer was entitled to take those matters into account, and indeed it would have been wrong of him to ignore those records.

37. As I have said, the Form TM26(N) was sent to the Proprietor by the UKIPO in January 2021 both by post to its recorded address for service and by e-mail. This was done under cover of a letter which spelled out in the usual way the date by which the TM8 had to be filed (29 March 2021) and the consequences of failure to comply with that time limit. The letter which had been sent by registered post was, as the Hearing Officer noted, returned to the Registry, marked 'unknown.' It is clear that the attempt to serve by registered post was ineffective.
38. The Hearing Officer was concerned that there may not have been good service by email in January 2021, having been told by Mr Hughes that the email address on record (andy.hughes@marcos-uk.com) was 'not in use.' In paragraph 32 he said that the IPO's IT department could not confirm that the email correspondence had been delivered, although the letter of 24 February suggested that at that stage the IT department thought that it had, so I am not sure why the doubt about this was raised in the preliminary view and in the decision below.
39. However, regardless of the issues about the email address for Mr Hughes which was used in January 2021, in the light of Mr Hobbs' decision in *MySmile* the attempt to serve by email was also ineffective. *MySmile* was decided after the decision in this appeal and so this point was not before the Hearing Officer. Nevertheless, in my judgment, the Hearing Officer was right to discount the attempt at service by email as well as by registered post, even though the reason he gave for dismissing the attempt to serve by email was not based on the point identified by Mr Hobbs QC.

40. On 24 February, the Registry re-sent the same documents by ordinary post. I have set out the terms of the covering letter above. It was not returned through the post. Therefore, the letter would have been served effectively under s 7 of the Interpretation Act unless the contrary was proved. The Hearing Officer decided in paragraph 32 that “no account could reliably be made of service attempted by ordinary post” that is to say, by the letter of 24 February. It is unfortunate that he did not (so far as I can see) explain why he considered that such service was not effective.
41. The Hearing Officer noted that Mr Brown had asserted that the Welshpool office was closed throughout due to Covid and that all post was “immediately sent back not received” although he later corrected this to say that registered post would have been sent back. Closure of the premises would not have affected the effectiveness of service made by ordinary post, although if the premises were unoccupied in February 2021, the February letter might well not have been ‘received’ by the Proprietor at that time. Certainly, a period of lockdown was imposed in January 2021 and the Hearing Officer may well have taken that into account, as a matter of judicial notice, although he did not say that this was his concern.
42. Alternatively, it seems to me that it may be that the Hearing Officer was concerned about the terms of the covering letter of 24 February and, in particular, by the fact that the letter did not reset the time for service of the TM8 to two months from the date of the February letter.
43. Rule 38(3) provides a prescribed period for filing a Form TM8 Defence of two months, which must be calculated by reference to the date when the proprietor is sent the copy of Form TM26(N) by the registrar. Given the unsuccessful attempt at service by registered post and email in January 2021, it seems to me that the January letter cannot be said to have been ‘sent’ to the Proprietor. There was no actual service, nor was there deemed service pursuant to s 7 of the 1978 Act, as proof to the contrary had been provided to the Registry by Royal Mail. In those circumstances, it seems to

me that the two month period for filing the defence set by that letter did not run from 28 January 2021 and elapse on 29 March 2021, as stated in the letter of that date.

44. It is clear that the period prescribed by the Rules for filing the TM8 cannot be set to run from a date prior to the date on which the claim for revocation is sent to the trade mark proprietor. It can only run from the date the claim is sent. Hence, the letter of 24 February should have set a fresh date for the defence to be filed, calculated by reference to the date when the February letter and the copy documents sent with it were sent to the Proprietor. The failure to set time running afresh was, in my judgment, a failure to do what the Rule required in order to set a valid deadline. That was a substantial irregularity, and one which risked causing substantial unfairness to the Proprietor. Moreover, the irregularity of the February letter in failing to set a fresh date for the TM8 was compounded by the Default Notice sent on 20 April, which referred again to the date for filing the TM8 being 29 March 2021, and suggested that the time for filing the TM8 had elapsed by the date of that default notice. For the reasons I have given, it had not elapsed at that date.
45. In the circumstances, in my judgment the Hearing Officer was entitled and indeed right to adopt the position that “no account could reliably be made of [the 24 February] service attempted by ordinary post.” Given the stringency of the Rules relating to the filing of a TM8, it is particularly important that accurate guidance is provided by the UKIPO to the recipient of such an application, and the Office’s standard form letter which is sent with such applications is carefully worded so as to make it absolutely clear to the recipient that the defence must be filed by a particular date, and to inform it of the potential consequences of failure to file in time. But the letter of 24 February would have misled or confused the Proprietor as to the date by which the TM8 should have been filed, and as to the impact of the failure to file it.
46. As I have said, the Hearing Officer did not set out his reasoning as to why he considered that no account could be taken of the letter sent on 24 February, save that he said in paragraph 37 that the “circumstances surrounding service of the cancellation application” led on a balance of probabilities, to the Proprietor “not being notified of

the action at the material time,” but in my view there were valid grounds for him to have exercised the Registrar’s statutory discretion so as to prevent the irregularity I have described above from operating, unfairly, to the detriment of the Proprietor.

47. The issues raised as to whether the letters sent on April and June 2021 were received by the Proprietor seem to me to be irrelevant, as neither letter ‘sent’ the Form 26(N) to the Proprietor.
48. As a result, the reasonable points made by the Appellant as to the inadequacy of the Form TM29 filed by the Proprietor and its lack of appropriate supporting evidence seem to me to fall away. Once the Hearing Officer had rightly concluded that the cancellation proceedings had not been effectively sent to the Proprietor, he had to conclude that the Proprietor’s failure to respond within the original 2 month time limit arose from failure to receive the documents.
49. The second limb of the Appellant’s case was to say that the Hearing Officer was wrong to find that the Proprietor made its application to set aside the decision promptly on becoming aware of it. It is clear that by 27 August 2021 the Proprietor had been supplied with a full explanation of the position as it then appeared to the UKIPO, namely that it had missed the date for filing its TM8 and needed to make an application under Rule 43. The UKIPO had sent it the text of Chapter 4.16 of the Manual and a link to access Form TM29 online. In August 2021, Mr Hughes emphasised the urgency of the matter to the Proprietor. Yet it took the Proprietor from 27 August 2021 to 20 January 2022 to complete the Form TM29. On the face of it, as the Appellant had submitted and the Hearing Officer accepted, this did not show that the Proprietor had acted promptly, rather the contrary.
50. In finding that the application was made sufficiently promptly, the Hearing Officer took into account Mr Brown’s dyslexia, and his comments about time spent in talks with the IPO and his ineffective attempts to engage a solicitor.

51. The Respondent's Notice cited *EDF Energy Customers Ltd v Re-Energized Ltd* [2018] EWHC 652 (Ch), a case in which HHJ Matthews helpfully summarised a number of earlier decisions on the extent of any leeway which a court should extend to a litigant in person, including in particular *Barton v Wright Hassall LLP* [2018] UKSC 12. HHJ Matthews' helpful distillation of the principles reads:

- “1. There is a general duty on tribunals to assist litigants, depending on the circumstances, but it is for the tribunal to decide what this duty requires in any particular case and how best to fulfil it, whilst remaining impartial.
2. The fact that a litigant is acting in person is not in itself a reason to disapply procedural rules or orders or directions, or excuse non-compliance with them.
3. The granting of a special indulgence to a litigant in person may be justified where a rule is hard to find or it is difficult to understand, or it is ambiguous.
4. There may be some leeway given to a litigant in person at the margins when the court is considering relief from sanctions or promptness in applying to set aside an order.”

52. The decisions discussed and applied in *EDF* relate to aspects of the Civil Procedure Rules, which do not apply to proceedings before the Registrar of Trade Marks. Nevertheless, those decisions provide guidance as to the approach which should be taken by all tribunals when dealing with a litigant in person. The Appellant submitted that excessive leeway had been granted to the Proprietor in this case. It is plainly right that the Hearing Officer granted some leeway to the Proprietor, as Mr Muir Wood conceded at the hearing of the appeal, especially as I agree with the Appellant that the points which the Hearing Officer relied upon do not individually carry a great deal of weight. However, it does not seem to me that it is possible to say that the Hearing Officer made an error of law or perpetrated a serious procedural irregularity so that I may find that he erred in the exercise of his discretion. In my view, he was entitled to look at the various points raised by the Proprietor explaining its delay in making the application, and it is clear that he weighed them up in the exercise of his discretion. I conclude that on this aspect of the case also, it was open to him on the materials before him to come to the conclusion he did for the reasons he gave.

53. In the circumstances, the appeal is dismissed and the Appellant's claim for cancellation of the Mark is remitted to the Registrar for further processing.
54. I consider that the usefulness of the proceedings before me is from a practical point of view liable to depend on the outcome of the proceedings as a whole. I therefore direct that the costs of the Appeal be treated as costs incurred in the cancellation proceedings and dealt with by the Registrar in the usual way at the conclusion of the claim.

Amanda Michaels
The Appointed Person
16 January 2023

David Tate of Maguire Boss appeared for the Appellant

Dr Jamie Muir Wood, instructed by **Capital Law** appeared for the Respondent/Proprietor