

BL O/0054/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 3853355
IN THE NAME OF SANDRA CAROL HORSWILL AND LUCY JANE HORSWILL
TO REGISTER THE TRADE MARK:

NAKED HORSE

IN CLASSES 3, 39, 41 AND 44

-AND-

THE LATE FILING OF DEFENCE AND COUNTERSTATEMENT
FILED IN DEFENCE OF THAT APPLICATION
IN OPPOSITION PROCEEDINGS UNDER No. 440891
BROUGHT BY ACTI GROUP LLC

BACKGROUND

1. On 25 November 2022, Sandra Carol Horswill and Lucy Jane Horswill (“**the Applicants**”) applied to register the trade mark shown on the cover page of this decision in the UK in respect of goods and services in Classes 3, 39, 41 and 44, which include, inter alia, “*aromatherapy creams, gels and lotions*” all being for humans and/or animals (Class 3); “*transportation of horses*” (Class 39); “*natural, holistic, classical horse training*” (Class 41); “*natural and holistic therapy for equines*” (Class 44).
2. No representatives were named on the application form, although the declarant name entered on the form was ‘Trade Mark Direct’, and the contact email address provided by the Applicants was ‘info@trademarkdirect.co.uk’.
3. The application was published for opposition purposes on 17 February 2023.
4. On 14 April 2023, Richard R Halstead & Co. Ltd filed a notice of threatened opposition (Form TM7a) on behalf of Acti Group LLC (“**the Opponent**”) a copy of which was emailed by the Registry to the Applicants.
5. On 17 May 2023, Richard R Halstead & Co. Ltd filed a Form TM7 Notice of Opposition and statement of grounds opposing the application on the basis of sections 5(1), 5(2)(a) and 5(4)(a) of the Trade Marks Act 1994 (“**the Act**”).
6. On 13 June 2023, the Registry wrote to the Opponent issuing a preliminary view that the TM7 required amendments, and requested that the Opponent file an amended statement of grounds by 4 July 2023. The Registry emailed a copy of that official letter to the Applicants on the same date.
7. On 13 July 2023, the Registry received an email from the Opponent’s representatives at the time i.e. Richard R Halstead & Co. Ltd, stating that they had not received any confirmation that the Opponent’s TM7 had been processed and requested that the Registry look into this. The Registry replied on 18 July 2023, forwarding a copy of its official letter dated 3 June 2023, and requested that the Opponent file an amended statement of grounds by 2 August 2023. The Registry emailed a copy of that correspondence to the Applicants on the same date.
8. The Opponent’s agent, Richard Halstead, filed the amended statement of grounds on 8 August 2023. In filing the amended statement, he referred to a telephone

conversation he had with the Registry the day before, explaining that the deadline was missed due to his ill health (on 25 August 2023, Form TM33P was filed changing the Opponent's representatives to Locke Lord LLP).

9. On 10 August 2023, the Registry served the TM7 on the Applicants by email (sent to the email address held on record for the Applicants i.e. 'info@trademarkdirect.co.uk'), and it was also served by post (to the West Sussex postal address for service held on record for the Applicants).

10. The serving letter provided the Applicants a deadline of 10 October 2023 by which to file their Form TM8 'Notice of defence and counterstatement'. The Registry's letter contained the following information (original emphasis):

"If you wish to continue with your application, you need to file a notice of defence and counterstatement by completing Form TM8 - please note the important deadline below. You will find a blank Form TM8 on the IPO website, together with brief guidance on what happens after it is filed [...].

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 10 October 2023.

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.**"

11. On 27 October 2023 the Registry wrote to the Applicant's (again sending its correspondence by email and post), stating that (original emphasis):

"The official letter dated 10 August 2023 invited the applicant to file a TM8 and counterstatement on or before 10 October 2023.

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, **10 November 2023**. 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."

12. On 7 November 2023, Trade Mark Direct Limited replied to the Registry's official letter, attaching the Applicant's TM8 and counterstatement. This was accompanied by a statement, headed 'Witness Statement' (see below), dated 7 November 2023. The statement cited an administrative error as the cause for the missed deadline. The email address from which these were sent was 'info@trademarkdirect.co.uk'. The cover email also stated that a Form TM33 was to follow.



1st Floor, 8 Bridle Close
Kingston upon Thames
KT1 2JW

7th November 2023

In the matter of UK Trade Mark No. UK00003853355
Applicant: Sandra Carol Horswill & Lucy Jane Horswill
("the Applicants")

-and-

In the matter of Opposition No.OP000440891
thereto by Acti Group LLC ("the Opponent")

WITNESS STATEMENT

Dear Sirs

The TM8 was not filed by the due deadline of 10th October 2023 in OP000441981 due to an administrative error. The TM7 was sent to the Applicants and it's unclear why our firm was not listed as representative by the Attorney first instructed on this case who is now on maternity leave. It now transpires that the TM7 was forwarded to our firm in a series of images by the applicants and the deadline for the TM8 entered into our docketing system as the 10th November by a member of staff who is no longer with the firm, and where there were other errors made on other registry deadlines.

We apologise for the delay and inconvenience caused to the registry and the Opponent in this matter.

I believe that the facts stated in this witness statement are true.

Mark Kingskey-Williams
Director
Trade Mark Direct

E: info@trademarkdirect.co.uk | W: info@trademarkdirect.co.uk | T: 0845 680 9762

13. On 7 November 2023, a Form TM33 was filed, appointing Trade Mark Direct Limited as the Applicants' representatives.

14. On 21 November 2023, the Registry issued a preliminary view to allow the late filed Form TM8 and counterstatement into the proceedings, stating that:

“The Registry is satisfied that the facts as presented appear to show a genuine administrative error and to refuse the late filed TM8 would unfairly penalise the applicant and delay resolution of the dispute in the event that another application is filed.

If either party disagrees with the preliminary view, they should request a hearing [...] on or before 5 December 2023.”

15. On 27 November 2023, the Opponent requested a hearing.

16. A hearing was scheduled for 9 January 2024, the details of which were sent by the Registry to both parties' representatives in an official letter dated 7 December 2023. In accordance with Tribunal Practice Notice 1/2004, the parties were given until 2:00pm on Friday 5 January 2024 to submit their skeleton arguments. Both parties confirmed attendance, and the Opponent's representatives filed their skeleton arguments at 1:51pm on 5 January 2024. The Applicants' representatives filed their skeleton arguments over 2 hours past the deadline, at 4:38pm on 5 January 2024, and it is noted that the correspondence was sent from 'info@trademarkdirect.co.uk'.

THE HEARING

17. The hearing took place before me via telephone conference, on Tuesday 9 January 2024. Dominic Farnsworth of Locke Lord LLP represented the Opponent and Mark Kingsley-Williams of Trade Mark Direct Limited represented the Applicants.

18. Before hearing any submissions, I sought clarification from Mr Kingsley-Williams with regard to his skeleton arguments, namely that throughout, they referred exclusively to the filing of “Form TM7” by the Applicants. I asked if he could clarify whether he meant “Form TM8” instead; he stated this was a typographical error and confirmed that it should have said “TM8”.

Opponent's submissions

19. The Opponent's submissions followed the points outlined in its skeleton arguments. Mr Farnsworth submitted that there were three points to take into consideration as to why the late filing of Form TM8 should not be accepted. He detailed these as follows:

Witness Statement does not comply with rule 64

(1) Mr Farnsworth submitted that the Applicants' 'Witness Statement' should not be accepted in evidence because it is unsigned and therefore fails to meet the requirements of rule 64 of the Trade Mark Rules 2008 ("**the Rules**"), in particular rule 64(4), which I note provides that:

- "64(4) For the purposes of these Rules, a statement of truth—
- (a) means a statement that the person making the statement believes that the facts stated in a particular document are true; and
 - (b) shall be dated and signed by—
 - (i) in the case of a witness statement, the maker of the statement,
 - (ii) in any other case, the party or legal representative of such party.

(2) He also pointed out that the name typed on the statement contains a typographical error namely, it shows 'Mark Kingskey-Williams' as opposed to 'Mark Kingsley-Williams'. He submitted that a typographical error in someone's name may be forgivable in standard correspondence but that it was not acceptable in a witness statement.

Lack of 'compelling evidence' and 'extenuating circumstances' for the Registrar to exercise discretion under rule 18(2)

(1) The Opponent contends that the administrative errors cited by the Applicants' representatives are not extenuating circumstances and considers that the Applicants' representatives have not offered any credible explanation as to

what processes they had in place to prevent the sequence of administrative errors arising in the first place. Mr Farnsworth submitted that there was nothing to “*show that a genuine exceptional error occurred, something really unusual, not a typical mistake that may happen in day-to-day handling in practice.*” The Opponent’s skeleton arguments posit that a change in personnel is not a satisfactory reason, and that when Trade Mark Direct Limited received a copy of the TM7, it should have realised that the incorrect deadline had been inputted.

- (2) The Opponent’s skeleton arguments contain the following submissions and information which Mr Farnsworth referred to at the hearing:

“15. [...] There are related proceedings between the parties where the Applicant is seeking to invalidate two prior registrations of the Opponent for marks containing/consisting of NAKED HORSE. The Applicant sent a letter before action to the Opponent on the 6 February 2023 and there has been ongoing correspondence as well as the two invalidations and this opposition since that date. This dispute, and the existence of the opposition is therefore front of mind in both parties. The Witness Statement states that a previous attorney was responsible for this application. However, as it is part of a wider dispute with the Applicant which is being managed by Mark Kingsley-Williams, it would be reasonable to expect that he should have had oversight and awareness of the timelines of the related disputes.”

- (3) Mr Farnsworth further submitted that Trade Mark Direct Limited is neither a firm of solicitors nor a regulated trade mark attorney firm, however “*there is no reason why such a business that seeks to provide trade mark services as a paid service to third parties should be permitted to exercise a lower standard of service that would be expected from a firm of solicitors or a regulated trade mark attorney firm.*”

Counterstatement does not comply with rule 18

- (1) Mr Farnsworth submitted that if the late filing of the TM8 and counterstatement is allowed, then the Opponent nonetheless submits that they are not valid,

pointing out that the date on the counterstatement is marked as 8 November 2023, yet it was submitted on 7 November 2023.

- (2) On the point of any prejudice which may occur if the Applicants' TM8 is not accepted, Mr Farnsworth reiterated his submissions laid out in his skeleton arguments, namely that *"the Applicant will suffer no material prejudice as it is able to refile a further trade mark should it wish to do at minimal cost"*, adding at the hearing that *"they are not exceptional circumstances which would override a strict adherence to the Rules"*.

20. On the issue of costs, Mr Farnsworth submitted that since the hearing had been necessitated by an error of the Applicants, the Opponent asks for full costs in its favour.

Applicants' submissions

21. The Applicants' skeleton arguments are, in their entirety, as follows:¹

1. The applicant always intended the required TM7 be filed by their representative.
2. Due to a series of unfortunate and compounding administrative errors on the part of the applicant's representative the due date was wrongly docketed.
3. The TM7 was subsequently filed, and the statement accepted by the examiner.
4. Any fault in the late submission of the TM7 lies with the applicant's representative, and the applicant's rights in this matter should not be adversely affected.

22. At the hearing Mr Kingsley-Williams submitted that his firm was approached by the Applicants towards the end of 2022 *"to assist in supporting their applications, being aware of the other marks already being on the register."*

23. I have reproduced Mr Kingsley-Williams' full submissions below:²

"the case was being handled by [my colleague]. [My colleague is] qualified as a solicitor and as a trade mark attorney previously through examination. We are not

¹ Bearing in mind that any reference to 'TM7' should be 'TM8', as confirmed by Mr Kingsley-Williams at the hearing.

² For the purposes of these proceedings, I have omitted the name of Mr Kingsley-Williams' colleague.

charging the clients for our work on this in advance. [My colleague] then went on maternity leave at around Easter last year and the case was handed over to other members at Trade Mark Direct, and it is in that handover process that the issue around the TM33 not having been filed must have happened. It is not clear why the TM33 had not been filed previously and then the other subsequent docketing error which was made by a former employee of Trade Mark Direct who was highly experienced and had qualified and taken the trade mark paralegal qualifications, then led to the date being mis or wrongly entered. Mr. Farnsworth mentions that we included in the witness statement notes that other dates had been wrongly entered but that only became apparent as a result of missing this particular deadline and that is the background to that.

[...] to repeat the points made in the skeleton arguments that the faults lie with our firm and that late submission of the TM8 should not affect adversely the applicants' rights in this matter."

24. At the hearing I asked Mr Kingsley-Williams if he could confirm that, irrespective of whether Trade Mark Direct Limited were on record or not, they were always the Applicants' representatives. He confirmed that was correct. I note that this correlates with Mr Farnsworth's submission that Trade Mark Direct Limited are representing the Applicants in related invalidation proceedings, which I note were commenced the day before the filing of the opposition (i.e. 16 May 2023).

25. I also pointed out that for a hearing to discuss the late filing of a Form TM8, that not only did his skeleton arguments contain multiple errors (previously mentioned), they were also filed late (i.e. they were filed after the 2:00pm deadline on 5 January 2024). Mr Kingsley-Williams acknowledged this was not acceptable.

26. On the issue of costs, Mr Kingsley-Williams confirmed he had no submissions to make.

DECISION

27. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by rule 18 of the Rules. The relevant parts read as follows:

“18. (1) The applicant shall, within the relevant period, file a Form TM8, which shall include a counter-statement.

(2) Where the applicant fails to file a TM8 or counter-statement within the relevant period, the application for registration, insofar as it relates to the goods and services in respect of which the opposition is directed, shall, **unless the registrar otherwise directs**, be treated as abandoned.”

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

“A time limit listed in Schedule 1 (whether it has already expired or not) may be extended under paragraph (1) if, and only if—

(a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the registrar, the Office or the International Bureau; and

(b) it appears to the registrar that the irregularity should be rectified.”

29. There is no suggestion that there has been any irregularity on the part of the Registry. Consequently, the only basis on which the Applicants may be allowed to defend the opposition proceedings is if I exercise in their favour the discretion afforded to me by the use of the words “*unless the registrar otherwise directs*” in rule 18(2).

30. In approaching the exercise of discretion in these circumstances, I take into account the decisions in *Kickz AG v Wicked Vision Limited* (“*Kickz*”)³ and *Mark James Holland v Mercury Wealth Management Limited* (“*Mercury*”)⁴ i.e. I have to be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the Applicants’ favour.

³ BL O/035/11

⁴ BL O/050/12

31. In *Music Choice Ltd's Trade Mark ("Music Choice")*,⁵ the Court indicated that a consideration of the following factors (underlined below) is likely to be of assistance in reaching a conclusion as to whether or not discretion should be exercised in favour of a party in default. That is the approach I intend to adopt, referring to the parties' submissions to the extent that I consider it necessary to do so.

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

32. As noted above, the stipulated deadline for the filing of the Applicants' Form TM8 and counterstatement was **10 October 2023**. The Form TM8 and counterstatement was filed by the Applicants' representatives on **7 November 2023**. Therefore the deadline was missed by 28 days.

33. The Applicants' explanation as to why the deadline was missed is summarised above, i.e. a series of administrative errors made by the Applicants' representatives.

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

34. The opposition is brought under sections 5(1), 5(2)(a) and 5(4)(a) of the Act. There is nothing to suggest that the opposition is without merit.

The consequences of treating the applicant as defending or not defending the opposition

35. If the Applicants are permitted to defend the opposition, the proceedings will likely be suspended pending the outcome of the related proceedings (which I have referred to below in paragraphs 37 and 38). If the proceedings eventually continue, the parties will be given an opportunity to file evidence and the matters will be determined on their merits. However, if the Applicants are not allowed to defend their application, it will be treated as abandoned, and the Applicants' mark will lose its filing date of 25 November 2022.

⁵ [2005] RPC 18

Any prejudice caused to the opponent by the delay

36. No submissions were made by either party regarding prejudice to the Opponent.

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

37. I note that in their counterstatement, the Applicants request that the opposition be suspended pending the outcome of related invalidation proceedings they have brought against the Opponent's marks,⁶ including the mark relied upon in this opposition.

38. If the discretion is not exercised in the Applicants' favour, I see no apparent adverse effect on the related invalidation proceedings and those proceedings will be able to continue regardless.

39. I note that there do not appear to be any other relevant considerations.

CONCLUSIONS

40. In reaching my decision, I recognise that if the discretion is not exercised in the Applicants' favour, the application will be treated as abandoned and the Applicants will lose the filing date for their mark. I further recognise that it remains open to the Applicants to re-file an application and that this may, once again, be opposed by the Opponent, resulting in opposition proceedings arising at some point in the future. However, as the loss of priority and the possibility of further proceedings on much the same basis are often the consequences of a failure to comply with the non-extendable deadline to file Form TM8, these are not factors that are particularly compelling, nor do they constitute extenuating circumstances sufficient to permit the Registrar to exercise its discretion. I must instead consider the specific circumstances at hand.

41. Whilst I acknowledge the reasoning set out in Mr Kingsley-Williams' "witness statement" dated 7 November 2023, I must also note that it has not been signed, and therefore, as correctly noted by Mr Farnsworth, does not comply with rule 64 of the Trade Mark Rules 2008. As a consequence, I am not able to assign it the same weight as a properly executed witness statement. Regardless, the information contained

⁶ Consolidated invalidation actions, numbers CA506108 and CA506109 – CA506109 relates to the Opponent's trade mark number 3733133.

within it was originally considered by the Registry when issuing its preliminary view, and I note that it includes the following information: *“the TM7 was sent to the Applicants and its unclear why our firm was not listed as the representative by the Attorney first instructed on the case who is now on maternity leave”*. I further note that this was followed by other administrative errors including the deadline for the Form TM8 being entered into their docketing system as the 10 November 2023 instead of 10 October 2023.

42. After having checked the Registry’s records, including the filing receipt of the Applicants’ trade mark application (3853355), I note that no representative information was provided. This is the reason why Trade Mark Direct Limited were not listed as the representatives. However, as previously noted, the declarant name entered on the application was ‘Trade Mark Direct’, and the contact email address provided by the Applicants was ‘info@trademarkdirect.co.uk’.

43. This email has since been used by the Registry to send all correspondence to the Applicants, including the TM7 serving setter sent to the Applicants dated 10 August 2023, and the official letter of 27 October 2023 reminding the Applicants to file their TM8, counterstatement and accompanying witness statement by 10 November 2023. Furthermore, this email address was provided in the Form TM33 which was filed by Trade Mark Direct Limited; it is also listed on the headed paper used for the 7 November 2023 statement (as shown in paragraph 12 above); and has since been used by Trade Mark Direct Limited to correspond with the Registry throughout these proceedings.

44. The email address ‘info@trademarkdirect.co.uk’ is, therefore, clearly functional and being used by Trade Mark Direct Limited. On this basis, Trade Mark Direct Limited would have received all of the official correspondence and documentation via the ‘info@trademarkdirect.co.uk’ email address since the beginning of these proceedings, including the TM7 emailed on 10 August 2023. Irrespective of whether Trade Mark Direct Limited were the representatives on record or not, as I have already noted, they were being sent the Registry’s correspondence, and therefore the administrative error essentially boils down to a human error of Trade Mark Direct Limited having entered the deadline incorrectly into their docketing systems.

45. Whilst I acknowledge human error can occur, this is hardly a compelling reason, especially as Trade Mark Direct Limited are professional representatives, therefore they should have been aware of the opposition process, and that if an application is opposed there is a strict statutory two month deadline to file a Form TM8 to defend the application. Furthermore, it is made patently clear on the Registry's letter what that statutory deadline is. I note that no reason has been presented to me as to why the error was not noticed sooner, particularly when taking into consideration that Trade Mark Direct Limited would have been sent a copy of the TM7 at least twice (once by email from the Registry; and once by the Applicants – as per Mr Kingsley-Williams' statement). Furthermore, I have not been provided with any evidence or submissions with regard to what, if any, safeguarding measures were in place, or which may have been implemented by Trade Mark Direct Limited, to ensure that standard statutory deadlines are not inputted incorrectly in their internal systems and/or not missed.

46. The filing of a Form TM8 is a relatively simple task, capable of being successfully carried out, irrespective of whether an applicant is represented or not. The deadline for filing a TM8 is a statutory one, and applicants are made fully aware of the consequences if they fail to comply.

47. Whilst I am sympathetic to the Applicants' position, taking all of the above into account, I am not satisfied that any compelling reasons have been provided as to why the Form TM8 and counterstatement were filed late. The Applicants' representatives should have been aware of the opposition since the first serving letter dated 10 August 2023, which was sent to their email address being 'info@trademarkdirect.co.uk'. The Applicants themselves would also have been aware of the deadline, having been served the TM7 by post, which was, as highlighted by Mr Kingsley-Williams' statement, forwarded onto Trade Mark Direct Limited by the Applicants. Trade Mark Direct Limited then filed the Applicants' TM8 and counterstatement a week and a half after the Registry sent its letter dated 27 October 2023 notifying them that the deadline had been missed. The deadline was therefore missed by essentially one month. Consequently, I find that the Applicants and their representatives, Trade Mark Direct Limited, were clearly the authors of their own misfortune.⁷

⁷ See *Kickz*, paragraph 15.

OUTCOME

48. The Applicants' late filed TM8 and counterstatement are therefore not admitted into proceedings and consequently the opposition against the application is deemed as undefended. Trade mark application number 3853355 will, subject to any appeal, be treated as abandoned.

COSTS

49. Given that the outcome of this decision has terminated the proceedings, the Opponent is entitled to a contribution towards its costs. In the circumstances, I award the Opponent the sum of £800, based on the scale set out in TPN 1/2023, as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee	£200
Preparing the statement of grounds	£250
Preparing for and attending a procedural hearing, including filing skeleton arguments	£350
TOTAL	£800

50. I therefore order Sandra Carol Horswill and Lucy Jane Horswill to pay Acti Group LLC the sum of **£800**. 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 January 2024

Daniela Ferrari
For the Registrar