BL O/0192/26

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION No. WO0000001601409

ONEPLUS NORD

IN THE NAME OF
ONEPLUS TECHNOLOGY (SHENZHEN) CO., LTD

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. CA000504813
BY
NORDSEC Ltd

AND

IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY
ONEPLUS TECHNOLOGY (SHENZHEN) CO., LTD
AGAINST AN UNDEFENDED DECISION
DATED 28th JUNE 2023

MR. LEWIS HANDS (of Handsome IP Ltd)
appeared for the Appellant.

The Respondent was not represented.

APPEAL DECISION

Introduction & Background

1. IR No. 1601409 ("the IR") was protected in the UK from 6 April 2021. The Holder, OnePlus Technology (Shenzhen) Co.,Ltd. ("OnePlus") did not, at the time of designation, nominate a UK address for service ("AFS") under Rule 11 of the Trade Mark Rules 2008 (as amended) ("the Rules"). Rule 11 defines such an address as being in the "UK, the Channel Islands or Gibraltar".

2. The address of OnePlus was recorded as:

   OnePlus Technology (Shenzhen) Co., Ltd.
   18C02, 18C03, 18C04, and 18C05,
   Shum Yip Terra Building,
   Binhe Avenue North,
   Futian District,
   Shenzhen
   Guangdong
   CHINA

3. The name and address of OnePlus's appointed representative was recorded as

   Chofn Intellectual Property
   Room 1217,
   Zuoan Gongshe Plaza 12th Floor,
   68 North Fourth Ring Road W.,
   Haidian
   100080
   Beijing
   CHINA
   ("Chofn")

4. On 26 April 2022 Nordsec Limited ("Nordsec") filed an application on Form TM26 (I) for the IR to be declared invalid on relative grounds, citing earlier rights. The details are not germane to this appeal. At that time, Registry policy and practice was that applicants and proprietors of contested rights could be]served with documents by delivery to non-UK addresses. In accordance with that practice, service of the TM26 (I) was initially attempted by the Registrar by posting it to OnePlus at their address in China under cover of a letter dated 7 June 2022.

5. However, after this letter was sent, the Decision of Mr Geoffrey Hobbs KC in BL O-681-22 *MARCO POLO* was issued. The effect of this Decision was to establish that non-UK addresses are not an "address for service" and that a party could not be validly served there.

6. As a consequence, on 13 September 2022 the Registrar sent a letter to OnePlus notifying it that the proceedings had been suspended whilst the implications of *MARCO POLO* were considered.

7. At [67] of *MARCO POLO* Mr Hobbs suggested that to overcome the difficulties identified in his Decision, using the general powers of case management given to the Registrar under R. 62 (1) and 63:

   > "…there is room under these Rules for the Registrar to send a letter: informing the proprietor of a registered trade mark of the invalidity application which has been commenced in respect of it; directing the proprietor to notify the Registrar in writing whether the invalidity application is opposed and, if so, directing the proprietor under Rule 12(1) to provide a Rule 11(4) "address for service" for the purposes of the further conduct of the invalidity proceedings under Rule 11(1)(d) and Rule 41; and comprehensively specifying the consequences of failure to comply with the directions thus given."

8. As a result, the Registrar issued Tribunal Practice Notice ("TPN") 2/2023 "*Effective service in proceedings against trade marks and registered designs without a valid UK address for service"*.

The new practice in cases involving an IR where a holder had no valid UK service address was to be that a preliminary letter would be sent to the holder or, if such details had been given, to the nominated representative directing that, within a period of one month from the date of the letter, the holder should provide the Registrar with a valid UK AFS along with confirmation of its intention to oppose the application for invalidation/revocation/rectification.

9. Furthermore, the new practice stipulated that:

> "12. Where the holder fails to provide a valid UK AFS, the consequences shall be those set out in the directions under Rule 62(3. The Registrar will treat the right as it does in any other proceeding where no defence is filed i.e. a letter will be issued to the holder, confirming the Registrar's intent to treat the application as undefended and to declare the trade mark/registered design invalid or revoked. This letter will be issued to the holder, confirming the Registrar's intent to treat the application as undefended and to declare the trade mark/registered design invalid or revoked. This letter will be posted and, where possible, emailed, to the (non-UK) postal and email address(es) held on file, and the standard fourteen-day period set for reply. The holder may, within that short period, request a hearing, whilst failure to respond will result in the Registrar issuing a short decision on the undefended application."

10. Following this new practice, on 20 March 2023 ("the March Letter") the Registrar wrote to both OnePlus and Chofn, using tracked mail:
    a) lifting the suspension of the proceedings
    b) Setting aside previous attempts at service of the TM26 (I)
    c) Enclosing a copy of the TM26 (I) and, as per TPN 2/2023, stipulating a 1-month deadline of 20 April 2023 for the filing of a valid UK address for service; and
    d) notifying them of the consequences of a default.

11. There was no response to either letter, so on 7 May 2023 ("the May Letter") the Registrar wrote again to Chofn, as per the above practice, notifying it that:

> "…the Registrar is minded to treat the holder as not opposing the application and the protection of the trade mark shall be declared invalid in relation to the contested goods and services.
>
> If you disagree with the above you must provide full written reasons and request a hearing on, or before, 23 May 2023. This must be accompanied by a Witness Statement setting out the reasons why a valid address for service has not been filed.

> If no response is received, the Registrar will issue a decision on the failure to comply with these Rules. This will result in the [registration] or [protection] of the trade mark being declared invalid in relation to the contested goods and services."

12. Again, no response was received so on 3 July 2023 the Mr. Raoul Colombo, Hearing Officer for the Registrar, issued a Decision declaring the IR invalid. After summarising the background and correspondence history the Hearing Officer determined as follows:

> "The official communication sent to OnePlus Technology (Shenzhen) Co.,Ltd on 20 March 2023 was returned by Royal Mail delivery service marked 'Refused'.
>
> The official communication sent to Chofn Intellectual Property was assigned with the Royal Mail tracking reference RF 6287 3077 4GB. Royal Mail's website confirms this was delivered on 03 April 2023.
>
> Pursuant to Rule 62(1) of the Trade Marks Rules 2008, the letter instructed the registered proprietor that it should confirm whether it intends to defend these proceedings and, if so, that it should file a valid UK address for service by 20 April 2023.
>
> On that date, no response had been received. As a result, the Registrar issued a second letter providing the proprietor with an opportunity to file a witness statement presenting reasons for non-response. The letter was sent to the address presented above for Chofn Intellectual Property, again using Royal Mail's 'International Tracked & Signed' service under tracking reference RF 6287 3389 0GB. This tracking confirms the letter was delivered on 24 May 2023.
>
> At the time of writing, the Registrar has not received any response to either its initial letter of 20 March 2023 or the further letter of 07 May 2023. Neither party has requested a hearing or provided written submissions.
>
> No reasons have been advanced as to why invalidation should not take place, or as to why I should exercise discretion in favour of the Registered Proprietor and I therefore decline to do so.
>
> As the registered proprietor has not responded to the allegations made, I am prepared to infer from this that they are admitted. Therefore, in accordance with Section 47(6) of the Act, the international registration for classes 9 and 42 is declared invalid and I direct that it be removed from the register and deemed never to have been made."

13. In due course the World Intellectual Property Office was notified that the IR had been declared invalid. This in turn came to the attention of Chofn in December 2023, apparently for the first time. Chofn wrote to the IPO on 19 February 2024 notifying the Registrar of their surprise at the invalidation and seeking details. Subsequently, Handsome IP was appointed as the OnePlus's UK representative.

14. I pause to note here that there is correspondence in the Registry file from Nordsec's then representatives, Bird & Bird LLP, indicating that they had sent a copy of the TM26 (I) to Mr Hands of Handsome IP on

31 May 2022. There is nothing in the file to say why this was done and Handsome IP were not OnePlus's recorded representatives for this case at the time. The matter was not addressed further before me and I have ignored it in reaching my decision.

15. On 28 May 2024 Handsome IP invoked R. 43 of the Rules and filed Form TM29 in a bid to have the Decision set aside. R. 43 is entitled *"Setting aside cancellation of application or revocation or invalidation of registration; (Form TM29)"*.

16. Under R.43 (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."

R. 43 (2) sets the period for filing a request to set a Decision aside at 6 months. It therefore gives a Respondent a limited window to set aside a Decision.

17. On 25 June 2024 the Registrar responded refusing the Form TM29 as follows:

> "I confirm the TM29 filed cannot be considered. This is because a request to set aside an invalidation filed on TM29 is only applicable in circumstances set out under Rule 43(1):
> 43.—(1) This rule applies where —
> (a) an application for registration is treated as abandoned under rule 18(2);
> (b) the registration of a mark is revoked under rule 38(6) or rule 39(3);
> (c) the registration of a mark is declared invalid under rule 41(6); or
> (d) the registration of a comparable trade mark (EU) is revoked or declared invalid to any extent under rule 43A(6),
>
> It is noted that the above registration was deemed partially invalid as a specified consequence of not following directions issued under Rule 62. This process is in line with practice under TPN 2/2023 at paragraphs 7-9 with the consequences of non-compliance detailed at paragraph 12.

As the provisions of Rule 43(1) are not activated, Form TM29 cannot be considered.

18. R. 41 (6) operates where a Respondent has been validly served, stating:

> "The proprietor shall, within two months of the date on which a copy of Form TM26(I) and the statement was sent by the registrar, file a Form TM8, which shall include a counter-statement, otherwise the registrar may treat the proprietor as not opposing the application and registration of the mark shall, unless the registrar otherwise directs, be declared invalid."

19. However, as established in *MARCO POLO,* R. 46 (1), and in consequence the set-aside procedure of R. 43 is only engaged where the Proprietor has been validly served. That was not the case here, as no AFS had been provided. Instead, as the Registrar explained, the Decision was based not on R. 41 (6) but on a failure to comply with the Direction to provide a UK address for service given under R. 62 (1) and (3), following the Practice set out in TPN 2/2023.

20. This was not quite an end to the matter, since on 17 June 2024 the Registrar notified the parties that the service of the original Decision had been technically deficient with the result that, ultimately, it was re-issued setting a new appeal deadline. However, that did not affect the Decision's underlying reasoning.

21. It should be noted that both Chofn and OnePlus deny ever having received any of the UK IPO correspondence, despite the tracking records.

22. Finally, a Notice of Appeal was filed on 26 November 2024.

The Grounds of Appeal

23. The basis for the appeal is:

> *" TPN 2/2023 has the effect that if a proprietor already has an address for service in the UK and does not defend a cancellation action because they do not receive the IPO's letters, they have an opportunity to request the Decision to be set-aside, but if the proprietor does not have an address for service in the UK and does not defend a cancellation action because they do not receive the IPO's letters, they are denied the opportunity to request the Decision to be set-aside.*
>
> *As it is not uncommon for proprietors of international registrations (UK), who are based outside the UK, to not have an address for service in the UK, the procedure being applied under TPN 02/23 appears to be biased against overseas based proprietors.*
>
> *The current case demonstrates that, by no fault of a proprietor without a UK address for service, a registration can be invalidated without their knowledge, without the opportunity to defend the action, and without the right to request the decision to be set aside, once they become aware of the decision; such right, conversely, being afforded to proprietors who do have a UK address for service."*

24. The Appeal appears, therefore, to be directed generally to an alleged bias/inequality of treatment within the operation of TPN 2/2023 itself that undermines the Decision and at its heart it appears to suggest it should include some form of "set-aside" procedure, equivalent to that in R43 (3), for persons without a UK AFS.

The Registrar's Observations

25. Because the Appeal raised the question of bias/inequity, and as such goes to matters which are liable to affect the day-to-day conduct of business within the Trade Marks Registry, in the exercise of my inherent powers[1] I invited the Registrar to submit observations on the operation of TPN 2/2023.

26. These were provided by Mr Nathan Abraham, Tribunal Deputy Director, on 31 July 2025. I am grateful to him for his input. Mr Abraham said, in particular:

> "Background to Tribunal Practice Notice 2/2023
> 04. The practice set out in the TPN acknowledges the Appointed Person's comments in *Tradeix Ltd v New Holland Ventures Pty Ltd* (BL O-681/22) whilst also providing the Registrar with a means to dispose of inter partes proceedings involving parties who have failed to provide a valid address for service of the TM26(I).
>
> 05. In that decision, the Appointed Person concluded that (i) rule 41(5) does not empower the registrar to effect service of invalidity proceedings outside the jurisdiction (see paragraph 59), and (ii) service cannot be validly effected without a rule 11(4) AFS being on record (see paragraph 61).
> 06. Without the mechanisms subsequently documented in the TPN, the tribunal has no means of bringing a proprietor within the scope of rule 11(1)(d) and, therefore, with the requirements for a valid AFS at rule 11 and the steps/consequences in the event of a failure to provide an AFS at rule 12. Without a valid address, the registrar could theoretically be left with little option but to proceed with a potentially infinite amount of attempts to secure an AFS simply in order to commence (and then resolve) proceedings.
> ……..
>
> 13. According to rule 43(1)(c), the setting-aside of an invalidation decision is permitted *only* in scenarios where the decision to invalidate is based on rule 41(6).

[1] *Corgi Trade Mark* [1999] RPC 549 per Mr. Geoffrey Hobbs KC at p. 562 "Annex"

14. As drafted, rule 43 has no interplay with rules 11 or 12. The latter are not subject to any discretion on the part of the registrar, which reflects the legislature's will to impose conditions regarding address for service that are rigid and mandatory in all circumstances. By comparison, the former provides additional protection, at the registrar's discretion, for those proprietors able to show that the relevant claim form sent under rule 41(5) was never received, and whose rights are otherwise subject to invalidation under rule 41(6). Had the legislature intended to provide comparable protection for a party who fails to provide an AFS, it could have done so.

15. Regarding the alleged inequality between parties with and without a valid AFS, it should be noted that rule 43 is applicable solely to scenarios in which the registered proprietor has failed to provide a Form TM8 and counterstatement within the permitted period. The presence (or otherwise) of a recorded valid AFS is not material to the consideration. For example, a party that had previously qualified for service and filed its Form TM8 only to then remove its AFS and become subject to the requirements and consequences of rules 11 and 12 would *also* be denied any opportunity to utilise rule 43 and seek the registrar's discretion. To that extent, all parties who fail to provide a valid AFS for proceedings are treated equally.

16. In summary, extending rule 43 to scenarios which are not explicitly referenced would undermine both the purpose of the legislation in limiting circumstances in which the registrar's decision to invalidate can be set aside, and the rigid requirements and consequences related to providing a valid AFS in proceedings as set out in rules 11 and 12."

Assessment of the Appeal

27. At the Hearing before me, Mr. Hands effectively accepted (correctly in my view) that given the absence of any response from or on behalf of OnePlus to the Registrar's communications, the Decision of Mr Colombo was unimpeachable. The only basis for the appeal is, in essence, that the underlying process behind that Decision – TPN 2/2023 – is inherently biased.

28. I do not agree that the Practice followed by the Registrar is biased against overseas parties with no AFS. On the contrary, it gives all persons, wherever they are, a fair and reasonable opportunity to nominate an AFS within the scope of the Rules.

29. R. 43 gives the Registrar a power to revoke an otherwise final Decision in a very limited set of circumstances. The nub of the Appellant's complaint is that the Registrar should provide, under TPN 2/2023, and in the interests of equity, a mechanism under which it could have taken advantage of the "set aside" provisions of R. 43. However, it is not open to the Registrar to apply R. 43 to situations other than those set out in R. 43 (3), which are exceptions limited to:

> (a) an application for registration is treated as abandoned under rule 18(2);
> (b) the registration of a mark is revoked under rule 38(6) or rule 39(3);
> (c) the registration of a mark is declared invalid under rule 41(6); or (d)45 the registration of a comparable trade mark (EU) is revoked or declared invalid to any extent under rule 43A(6).

30. The Registrar's powers are prescribed by the Act and Rules. As per Mr Hobbs KC in *MARCO POLO* at [48]:

> "The Registrar must act within the scope of the powers conferred upon him by the 1994 Act and the 2008 Rules. In doing so, he has an interstitial power to regulate procedure before him in a way that neither creates a substantial jurisdiction where none exists, nor exercises that power in a manner inconsistent with the express provisions conferring jurisdiction upon him: *Permanent Secretary v John & Pascalis Ltd (HALLOUMI Trade Mark)* (above) at para. [28] (Arnold J) citing *Pharmedica GmbH's Trade Mark Application (FRISKIES Trade Mark)* [2000] RPC 536 at p. 541 (Pumfrey J).

31. Thus, it is not open to the Registrar to create an additional "set aside" power over and above that contained in R. 43, outside the Rules. As Mr. Abraham, for the Registrar observed:

> "Had the legislature intended to provide comparable protection for a party who fails to provide an AFS, it could have done so."

32. Further, TPN 2/2023 is simply a procedural code for an administrative/postal mechanism, including Standard Directions, giving effect to the rules. I agree with the Registrar's comments above, particularly at [6], that there must be some means of limiting the extent to which the Registrar must pursue a party for an AFS.

33. Mr Hands submitted that the Practice failed to take into account the fact that in some countries, China included, postal deliveries are unreliable, saying:

> "My argument would be that the IPO, as I say, this TPN 2/2023 is not providing adequate procedure for all situations and it is inequitable for at least China, and I suspect a lot of other countries in the world, where the air mail service is not very good"
>
> And that

"14 days is just inadequate for international service."

34.. That may be so, but the Registrar cannot be expected to investigate and provide for different postal standards around the world, nor should a party in one country be entitled to a greater indulgence than a party in another simply because of postal performance.

35. As for the response periods set out in the Directions themselves, these are all entirely consistent with and derived from the rules, including . Thus, the March letter stipulated a period of 1 month for an AFS to be nominated. This accords with R.12 (2). The May letter gave a period of 14 days to give reasons for the Registrar not to treat the Invalidity application as unopposed, and seek a hearing, consistent with R. 63 (2) (and, as noted in TPN 2/2023, this is a "standard" period).

36. Regarding Mr. Hands' submission on the 14-day period set out in the May Letter, it ignores the period of one month already given by the March Letter, which taken together totalled a six-week period. In any event, notwithstanding that the tracking service showed delivery of the May letter to Chofn (albeit one day after the 14-day period expired) their own position throughout was that it was not in fact received at all. The sufficiency of the 14-day period is irrelevant, since on their own case they still would not have known of the matter.

37. More fundamentally Chofn could have mitigated any risk by appointing a UK AFS voluntarily when, or at any time after, designating the UK under the IR. I take the view that OnePlus, or certainly its attorneys on their behalf (who, as a professional international firm. no doubt represent very many trade mark owners for whom they handle significant volumes of international post daily) must have been well aware of those risks through their own experience, and of the benefits of appointing a local address for service especially if they were not fully acquainted with UK IPO rules and practices. Indeed, their positive case was that the local postal system was unreliable,so they cannot have been unaware of the risks. Designating a local AFS is, or is virtually, universal for national applications and whilst it is not mandatory for International Registrations designated under the "Madrid" system, it is certainly prudent to do so for the communication/process reasons highlighted by this case. By not appointing a UK AFS OnePlus, through Chofn, were taking an informed risk.

38. The position was neatly summed up Arnold LJ in the *HALLOUMI* case at [32] where he said:

> "As counsel for the Registrar pointed out, however, it would be burdensome for the IPO to have to give parties different time limits for responding to official communications such as the April Letter depending on their address for service. If parties choose to give

addresses for service outside the UK, then they must accept the consequential delays in receiving such communications."[2]

39. Thus, I dismiss the appeal on the ground that the process followed under TPN 2/2023 is somehow inequitable or biased against overseas proprietors. It, and the directions given under it, are entirely consistent with the Rules and treat every party without an AFS equally. The additional benefits of the set-aside procedure are only available to a Proprietor which has filed an AFS and the failure to do so results from the Proprietor's (or its Representatives') choice, a risk they must accept. Any difference in treatment arises from their own choice.

40. Finally, although it was not foreshadowed in the Appeal, Mr Hands submitted at the Hearing that I should grant OnePlus an extension of time under R. 76 (1) on the basis that there was a failure or delay in a communication service. R. 76 (1) provides:

> "76.—(1) The registrar shall extend any time limit in these Rules where the registrar is satisfied that the failure to do something under these Rules was wholly or mainly attributed to a delay in, or failure of, a communication service."

41. It is not open to me to grant such an extension, which is a power reserved to the Registrar. My powers are reserved to deciding an appeal from any decision of the Registrar to grant or refuse such an extension and, as Mr Hands fairly accepted, the Registrar would no doubt take the position, the Decision having been issued, that it was *functus officio*. Again, in *HALLOUMI,* Mr. Justice Arnold (as he then was) said at [29] of the Registrar's more general powers to extend time under Rule 77:

> "… it is implicit in rule 77 that the Registrar only has the power to extend time in proceedings which are still extant in the sense that no final decision has yet been taken. Once a final decision has been taken, the Registrar is *functus* and the only remedy open to a party adversely affected by that decision (other than an application under rule 43) is to appeal pursuant to rule 70(1).

42. I can see no reason why the same principle should not apply to R. 76 given that, at some point, there must be finality.

Conclusion

43. For the reasons given above, the Appeal fails.

[2] Permanent Secretary, Ministry of Energy, Commerce And Tourism & Anor v John & Pascalis Ltd [2018] EWHC 3226 (Ch)

Costs

44. Nordsec took no part in the proceedings so I decline to make any award of costs.

Philip Harris
Appointed Person

10 March 2026