

O/0216/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004107248

IN THE NAME OF AMITY ENTERPRISE LTD

FOR THE FOLLOWING TRADE MARK:



IN CLASS 7

AND

THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT

IN DEFENCE OF AN OPPOSITION

UNDER NO. 453136

BY KONECRANES GLOBAL CORPORATION

BACKGROUND

1. On 2 October 2024, Amity Enterprise LTD ('the Applicant') applied for the trade mark no. 4107248 in the UK ('the Contested Mark'). Registration is sought for the following goods:

Class 7:

Moving and handling equipment; Construction machines; Emergency and rescue machines and machine tools; Elevators [lifts]; Cranes [lifting and hoisting apparatus]; Lift operating apparatus; Control mechanisms for machines, engines or motors; Lifting apparatus; Mechanical and pneumatic hoisting apparatus.

2. On 19 March 2025, Konecranes Global Corporation ('the Opponent') opposed the application by way of filing a Notice of opposition and statement of case ('Form TM7'). The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ('the Act'). The opposition was filed with notice by way of a Form TM7A,¹ dated 19 February 2025.²
3. For both grounds of opposition, the Opponent seeks to rely upon the full specification for each of the following two earlier rights.³ The earlier marks have identical specifications. Both grounds are directed to the application in its entirety. Both earlier rights engage the 'proof of use' provisions under section 6A of the Act; and the Opponent claims that it has used its marks for their entire specifications.

(i) UK905100681

KONECRANES

¹ Notice of threatened opposition.

² The Form TM7 incorrectly states the Opposition notification date as 19 March 2025.

³ Both earlier rights are comparable marks. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EU trade mark ("EUTM"). As a result, the opponent's earlier EUTM was automatically converted into a comparable UK trade mark. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

Filing date: 10 May 2006

Date of entry in register: 4 September 2007

(ii) UK905310966

KONECRANES

Mark Description/Limitation: Colour claimed: Red

Filing date: 24 August 2006

Date of entry in register: 5 November 2007

Priority date: 22 August 2006 (Finland), from TM T200602380

Both earlier marks are registered for a number of goods and services in classes 7, 9, 12 and 37.⁴

4. On 31 March 2025, the Registry served the Form TM7 on the Applicant, accompanied by a letter in the following terms:

'Please find enclosed a copy of the notice of opposition - Form TM7 - filed against your application.

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: <https://www.gov.uk/government/publications/trade-mark-forms-andfees/trade-mark-forms-and-fees>

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

⁴ The full specification is set out at Annex 1 to this decision.

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 02 June 2025

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.**

[Original emphasis]

5. On 30 May 2025, a request for a cooling-off period was filed by way of Form TM9c. The Registrar granted the request on 6 June 2025 by way of an Official letter in the following terms:

‘I refer to the TM9c dated 30 May 2025 indicating that the parties wish to enter into a cooling off period.

In accordance with Rule 18(4) of the Trade Marks Rules 2008, this period will expire on **31 December 2025**.

The Registrar, may on request, extend the cooling off period for a further nine months where such request is filed on TM9e and with the agreement of both parties. Please note that the TM9e should be received on or before **31 December 2025**.

If no such request is made, the TM8 and counter-statement should be filed on or before **31 December 2025** or the application shall, unless the Registrar

otherwise directs, be treated as abandoned in whole or part, in accordance with Rule 18(2) of the Trade Marks Rules 2008.

If the opponent wishes at any time to terminate the cooling off period they should submit a TM9t. The applicant can terminate the cooling off period at any time by filing the TM8 and counterstatement.'

[Original emphasis]

6. No Form TM8 was filed by the Applicant on or before 31 December 2025.
7. On 2 January 2026, the Applicant requested a retrospective request for a one-day extension of time in which to file its Form TM8 by way of a Form TM9R,⁵ before filing a Form TM8 the same day. The following reasons were provided within the TM9R:

'The deadline for filing the TM8 [and] counterstatement expired on 31 December 2025. The deadline was missed due to the Christmas/New Year holiday period, including the UK bank holiday on 1 January 2026, combined with an internal administrative oversight arising from parallel, ongoing UKIPO proceedings for the same Applicant (our client) (Opposition No. OPOP000453165 [sic]). In particular, the Applicant (our client) is currently defending another opposition in which a TM8 was filed in time and evidence was prepared and submitted during the evidence round, resulting in ongoing work and costs. In the circumstances, the deadline in the present case was inadvertently not diarised and actioned in time. As soon as the omission was identified (2 January 2026), steps were taken immediately to remedy the position. The TM8 [and] counterstatement [are] being filed without delay, and this TM9R is submitted promptly to seek an extension/admission of the late filing. The delay is short (effectively one day, taking into account that 1 January 2026 was a UK bank holiday) and there is no material prejudice to the opponent. In the interests of justice and proportionality, we respectfully request that the

⁵ Request to extend a time period, where the period has already expired.

Registrar exercises discretion to admit the late TM8 and allow the proceedings to continue on their merits rather than by procedural default, especially taking into account the parallel proceedings (OPOP000453165 [sic]), where the Applicant (our client) duly submitted its TM8 and actively engaged in the evidence rounds in a timely manner.'

8. On 5 January 2026, the Registry wrote to the Applicant in the following terms:

'I acknowledge receipt of the Form TM8 and counterstatement and the Form TM9R requesting a retrospective extension of time filed in these proceedings on 02 January 2025.

The Form TM8 and counterstatement filed on 02 January 2025 has been filed out of time. It is not possible to request a retrospective extension of time to file a Form TM8 and counterstatement on a Form TM9R, and a refund will be issued in due course.

The Tribunal has only a limited discretion to allow a late filed Form TM8 and counterstatement into the proceedings. Before the Tribunal can consider a request to allow a late filed defence into the proceedings, you will need to provide the details as to why the form was filed late, in the form of a Witness Statement.

[...]

A period of seven days from the date of this letter, that is on or before **12 January 2026** has therefore been allowed for you to file a Witness Statement.'

[Original emphasis]

9. On 12 January 2026, the Applicant filed a Witness Statement, dated 12 January 2026, in the name of Igor Demcak. Mr Demcak's Witness Statement, essentially, repeated the reasons set out in the Form TM9R. These have been noted above at

[7]. However, Mr Demcak has elaborated on the 'internal administrative oversight' as follows:

- He stated that an 'internal digital docketing system error' occurred 'whereby an incorrect deadline was stored and subsequently relied upon, also arising from parallel, ongoing UKIPO proceedings for the same Applicant'.⁶
- 'During the period leading up to the end of December 2025, substantial internal attention was directed toward the ongoing conduct of the parallel proceedings and associated workstreams for the same client, including evidence preparation and procedural management'.⁷

10. On 15 January 2026, the Registry wrote to the Applicant with the Preliminary View that, in the light of the information provided in the Witness Statement, the Registrar would 'accept the late-filed Form TM8 and counterstatement into the proceedings'. It is helpful to clarify that this does not mean 'admitting' the Form TM8 into proceedings, but, rather, allowing it to proceed to be examined to determine its admissibility. A deadline of 29 January 2026 was set for either party to disagree with the preliminary view, provide written reasons and request a hearing.

11. On 29 January 2026, the Opponent filed an objection to the Preliminary View. The reasons provided can be summarised as follows:

- That the Christmas/New Year holiday period is foreseeable and not an extenuating circumstance. Furthermore, the New Year bank holiday is immaterial given that it occurred after the prescribed deadline.
- That the 'internal digital docketing system error' has not been substantiated. No detail has been provided as to what the error was (i.e. what date was erroneously recorded), how it occurred or who was responsible for it. In this connection, the Opponent has referred to *TESCON*,⁸ in which Mr Hobbs Q.C. (as he then was), sitting as the Appointed Person, gave the example

⁶ Witness Statement of I. Demcak, [11].

⁷ As above, [14].

⁸ Decision BLO 0/240/20.

of an incorrect date being input due to an ‘unnoticed keystroke error’ as a circumstance which could potentially justify exercise of the Registrar’s discretion.⁹ However, Mr Hobbs found that, in the absence of ‘evidence and materials of sufficient clarity and precision to substantiate’ the administrative oversight, there was ‘no satisfactory explanation for the default which occurred’.¹⁰

- That the ‘parallel proceedings’ (i.e. related opposition OP453165) to which the Applicant has referred are not genuinely parallel because they involve a different Opponent; with the only overlap being the fact that both oppositions are directed to the same trade mark application.
- That the instant case is weaker than that in *Nestlé*,¹¹ in which Ms Amanda Michaels, sitting as the Appointed Person, found that the Registrar was entitled to decline to exercise his discretion even though there were genuinely parallel proceedings to which attention had been diverted which had caused the non-extensible deadline to be missed.
- That the Applicant has been aware of the stipulated deadline since 6 June 2025, given that it had expressly agreed to the cooling-off period that was granted on that date, which ‘fixed’ the deadline for 31 December 2025.

12. A hearing was arranged for 26 February 2026.

THE HEARING

13. A hearing took place before me, by telephone conference, on 26 February 2026. Only the Opponent attended; with Mr Richard May, of Osborne Clarke LLP, appearing on its behalf. The Applicant is represented by Trama Legal s.r.o.; and filed written submissions in lieu of the hearing.

⁹ Decision BLO 0/240/20, [32].

¹⁰ As above, [33].

¹¹ Decision BLO 0/1223/24.

14. The parties' respective written and oral submissions essentially reflected the points already made in Mr Demcak's Witness Statement and in the Opponent's correspondence of 29 January 2026. I have already summarised the parties' positions above at [9] and [11]. I propose to address their arguments more particularly as I consider the relevant factors later at [19] to [29].

DECISION

15. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by Rule 18 of the Trade Marks Rules 2008 ('the Rules'). The relevant parts read as follows:

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

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

(3) Unless either paragraph (4), (5) or (6) applies, the relevant period shall begin on the notification date and end two months after that date.'

16. The combined effect of rules 77(1), 77(5) and Schedule 1 of the Rules means that the time limit in Rule 18, which sets out the period within which the defence must be filed, is non-extendable other than in the circumstances identified in Rule 77(5), which states:

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

(a) the irregularity or prospective irregularity is attributable, wholly or in part, to

a default, omission or other error by the registrar, the Office or the International Bureau; and

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

17. There has been no suggestion of any irregularity on the part of the Tribunal. Consequently, the only basis upon which the Applicant 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). I must be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the Applicant’s favour.

18. In *Music Choice Ltd’s Trade Mark* [2005] RPC 18, the Court indicated that a consideration of the following factors (underlined below) is likely to be of assistance in reaching a conclusion as to whether or not the discretion should be exercised in favour of a party in default. That is the approach that I will adopt.

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

19. The explanation provided by the Applicant is that the deadline was missed by the Applicant’s representative due to a combination of the following: the festive holiday period and associated reduced staffing; an administrative oversight in the internal docketing system; and efforts being directed to another opposition action against the Contested Mark, albeit from another party.

20. I note that the Form TM8 was filed on 2 January 2026, two days after the prescribed deadline of 31 December 2025. Mr Demcak has emphasised that the oversight was inadvertent and that it was sought to be corrected once identified.¹²

¹² Witness Statement of I. Demcak, [8].

21. In the hearing, Mr May submitted that the Applicant's comment (made after Mr Demcak's Witness Statement) according to which it was fully aware that the related opposition OP453165 was instituted by another party defeats its argument that the aforesaid case contributed to the docketing error. He argued that the Applicant could not now credibly argue that engagement in OP453165 contributed to or caused a docketing failure in the instant case.

22. Mr May further submitted that Mr Demcak had given a contradictory account of the nature of the docketing error by way of initially stating that an incorrect date was input/stored before subsequently stating that 'the deadline in the present case was inadvertently not diarised and actioned in time'.¹³ [my emphasis added]. Whilst Mr May's argument is noted, my view is that what Mr Demcak is really saying – although it could have been better drafted - is that *the* deadline, i.e. 31 December 2025, was not diarised. Given Mr Damcak's two clear references to an 'incorrect deadline' being stored (at [11] and [16] of his Witness Statement), my view is that the apparently contradictory wording at paragraph [15] of the Witness statement is likely down to inelegant drafting.

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

23. The claim against the Applicant is an opposition pursuant to sections 5(2)(b) and 5(3) of the Act, directed against the Applicant's entire specification. The Opponent seeks to rely upon two earlier registrations, both of which engage the 'proof of use' provisions.¹⁴ I note that the Applicant has requested the aforementioned proof in its late-filed Form TM8.

24. Whilst it is not for the present hearing to determine the merits of the case, for the purpose of the criteria under consideration, it is sufficient to note that there is an arguable case to be determined.

¹³ Witness Statement of I. Demcak, [15].

¹⁴ Section 6A of the Act.

The consequences of treating the Applicant as defending or not defending the opposition;

25. If the Applicant is allowed to defend the opposition, the proceedings will continue with the parties given an opportunity to file evidence and the matter will be determined on its merits. The Opponent will be required to provide evidence of use of its two earlier registrations, as well as to substantiate its claim pursuant to section 5(3) the Act.

26. If, however, the Applicant is not allowed to defend the opposition, the entire application will be deemed abandoned and the filing date of 2 October 2024 will be lost. The related opposition action OP453165 against the Contested Mark would, therefore, also fall away. It will remain open to the Applicant to re-file its application, which may, in turn, be opposed again by the Opponent (or any other party).

Any prejudice caused to the Opponent by the delay

27. I bear in mind that it is typically the case in any legal proceedings that non-compliance with deadlines results in some level of prejudice in terms of costs. If the late-filed Form TM8 is allowed to proceed to be examined and deemed admissible, then the Opponent will be required to continue with its opposition claim that, but for the Applicant's own default, would be treated as undefended.

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

28. As noted, opposition OP453165, instituted by another party, is currently pending against the Contested Mark. Although this is a related case to the extent that it is directed against the same application, this cannot be said to be a *parallel* case. OP453165 involves different parties, relying on entirely different earlier marks, pleading a different set of grounds.

29. The Applicant has submitted that, if the Form TM8 were refused, it would suffer 'particularly disproportionate' prejudice given the time and costs incurred filing

evidence and submissions in the related opposition OP453165. The Applicant has argued that its 'active engagement in both matters demonstrates its consistent intention to defend its trade mark interests before the UKIPO and to comply with procedural obligations'.¹⁵

Conclusions

30. I have carefully considered the parties' respective written and oral submissions, and all of the case papers available to me. In reaching my decision, as noted above, I recognise that if the discretion is not exercised in the Applicant's favour, the opposition will succeed in full, and the Applicant will lose its filing date. I recognise that this would result in the related opposition, OP453165, for which the Applicant has already filed evidence, also falling away. I further recognise that it may be that the Applicant may simply re-file its application and that this may, once again, be opposed by the Opponent, (or indeed any other party) resulting in opposition proceedings arising at some point in the future.

31. However, I remind myself that the loss of filing date and possibility of further proceedings on much the same basis are often the consequence of a failure to comply with the non-extensible deadline to file a Form TM8.

32. The fact that the Applicant has expended resources on the related opposition, OP453165, is unfortunate. In my view, the Applicant's failure to observe the prescribed deadline in the instant opposition, together with Mr Demcak's explicit statement that 'internal attention' had been directed toward OP453165, undermines the argument that it has demonstrated a consistent intention to defend its application. To my mind, it would not be appropriate to extrapolate defensive conduct in respect of the related opposition to the instant case. This is particularly so given that OP453165 was instituted by a different party, relying on different earlier rights and pleading different grounds.

¹⁵ Applicant's written submissions in lieu of a hearing, dated 17 February 2026.

33. I appreciate that the Form TM8 was filed just two days late, and I have borne in mind that the Applicant promptly sought to mitigate the oversight.

34. Mr May referred me to the *Nestlé*¹⁶ case in which a Form TM8 was filed one day after the deadline. In that case, there were several related proceedings between the same parties (which were expected to be consolidated, whether including the action to which the late-filed defence related or not), and the relevant deadline had been overlooked because the legal representative's attention had been focused on a task for a related case. The Registrar declined to exercise his discretion; a decision which was upheld by the Appointed Person on appeal. Mr May argued that to exercise the discretion in the instant case when it was refused in *Nestlé* - a case involving multiple 'genuinely parallel' proceedings with competing deadlines on the same day - would be inconsistent given the Applicant's comparatively weaker case.

35. I agree with Mr May's argument. I also find Mr Hobbs' dicta from the *TESCON* case, noted above at [11] to be apposite here. I consider the Applicant's explanation of the 'internal digital docketing system error' to be somewhat vague. Mr Demcak has not detailed the following: the date that was erroneously input and stored in the docketing system; the date relating to opposition OP453165 and its relevance to the date incorrectly recorded. Following *TESCON*, it is my view that the Applicant has failed to substantiate the administrative oversight with sufficient clarity and precision.

36. I consider the matter of the festive bank holidays to be the least compelling of the Applicant's reasons, given their foreseeability, and I agree with the Opponent's submissions on this point.

37. Having carefully taken all of the relevant circumstances into account, my view is that the explanation provided by the Applicant is insufficient to justify exercising my narrow discretion to allow the late-filed form TM8 to proceed to be examined. I do not consider any of the reasons (or combination thereof) provided by the Applicant

¹⁶ Decision BLO 0/1223/24.

to reach anywhere near the standard of ‘exceptional circumstances’ or ‘compelling reasons’. Whilst I accept that the knock-on effect by way of the loss of the opportunity to defend the related case is unfortunate, it remains the case that the Applicant’s representative, for whatever reason, directed resources to OP453165 but did not demonstrate the same level of diligence with respect to the instant case. I consider the Applicant to be ‘the author of its own misfortune’.¹⁷

Outcome

38. In the light of the foregoing, it is my view that that it would be inappropriate for me to exercise the discretion available under Rule 18(2) in favour of the Applicant. Subject to any successful appeal, the Preliminary View, of 15 January 2026, to allow the late-filed TM8 and counterstatement to proceed to examination is reversed and the Application will be deemed undefended.

Costs

39. Given that my decision terminates proceedings, I must consider the matter of costs. The Opponent has been the successful party and is entitled to a contribution to its costs based on the published scale at TPN 1/2023, calculated as follows:

Official fee for filing Form TM7	£200
Preparing the Statement of Case	£250
Preparing for and attending the hearing of the matter of the late filing of a defence	£200
Total	£650

40. I have awarded a sum in respect of preparation and attendance at the hearing below the minimum threshold for the following reasons:

- (i) the Opponent’s oral submissions, essentially, repeated matters set out in the written comments already filed;

¹⁷ *Kickz AG and Wicked Vision Limited* (BL- O-035-11), paragraph 15.

and

(ii) there was no particular complexity to the procedural issue at stake.

41.I therefore order Amity Enterprise LTD to pay to Konecranes Global Corporation the sum of £650 as a contribution to its costs. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 13th day of March 2026

N. R. MORRIS

For the Registrar

Annex 1 – Full specification for earlier rights UK905100681 and UK905310966:

Class 7:

Hoists, cranes, winches, lifting equipment and machine tools; load manipulators; grab unloaders; rubber tired gantry cranes, rail mounted gantry cranes, straddle carriers, automated stacking cranes, ship-to-shore gantry cranes, goliath gantry cranes, jib cranes, shipboard gantry cranes; motors, drives, transmission components, gears and end carriages for cranes, hoists, lifting equipment and machines for storage purposes; hooks and forks for cranes and hoists; metal frames being parts of hoists and cranes; brake components for cranes and hoists; compressed air hoists; machines for storage purposes; mechanical handling installations for storage purposes; installations for the loading of materials into storage containers and units; installations for the unloading of materials from storage containers and units; parts and components for the aforementioned goods.

Class 9:

Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; data processing equipment and computers; electronic remote and speed controls; electronic instruments for measuring load capacity of cranes, hoists, machine tools, lifting equipment, machines for storage purposes and storage containers and units; electronic instruments for measuring the service lives on cranes, hoists, machine tools, lifting equipment, machines for storage purposes and storage containers and units; limit switches; cards for use as data carriers [encoded or magnetic]; electronic cards; computer software for controlling and monitoring cranes, hoists, machine tools, lifting equipment, machines for storage purposes and storage containers and units; computer software for the operational management of electronic cards; computer software and data processing equipment for container handling; power supplies and batteries for cranes, hoists, machine tools, lifting equipment, machines for storage purposes and storage containers and units; electronic instruction manuals; computer software for container positioning and gantry crane steering; electronic distance measuring apparatus; computer software for distance measuring; sensors and sensor emulators for cranes, hoists, machine tools, lifting equipment, machines for storage

purposes and storage containers and units; computer software and mobile software applications for collecting, preparing, composing, storing, processing, acquiring, analysing, monitoring and controlling data and information concerning cranes, hoists, machine tools, lifting equipment, machines for storage purposes and storage containers and units; optical, measuring and signalling apparatus and instruments for collecting, preparing, composing, storing, processing, acquiring, analysing, monitoring and controlling data and information concerning cranes, hoists, machine tools, lifting equipment, machines for storage purposes and storage containers and units; parts and components for the aforementioned goods.

Class 12:

Lift trucks, forklift trucks, reach stackers, empty container handlers, gantry trucks, toploaders and wheeled carriers; parts and components for the aforementioned goods.

Class 37:

Installation, maintenance, repair and modernization of cranes, hoists, machine tools, lifting equipment, machines for storage purposes and storage containers and units; consultation relating to installation, maintenance, repair and modernization of cranes, hoists, machine tools, lifting equipment, machines for storage purposes and storage containers and units; inspection of cranes, hoists, machine tools, lifting equipment, machines for storage purposes and storage containers and units prior to maintenance; remote diagnosis services for ascertaining the cause of malfunctions in cranes, hoists, machine tools, lifting equipment, machines for storage purposes and storage containers and units; remote diagnosis services for monitoring the condition and function of cranes, hoists, machine tools, lifting equipment, machines for storage purposes and storage containers and units; leasing and rental of cranes, hoists, machine tools and lifting equipment, machines for storage purposes and storage containers and units.