

O/0454/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004213120

IN THE NAME OF ULTAHOST

FOR THE FOLLOWING TRADE MARK:

UH **Ultahost**

IN CLASSES 42 AND 45

AND

THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT

IN DEFENCE OF AN OPPOSITION

UNDER NO. 456766

BY ULTA BEAUTY, INC

BACKGROUND

1. On 3 June 2025, Ultrahost ('the Applicant') applied for the trade mark no. 4213120 in the UK ('the Contested Mark'). Registration is sought for the following services, with the opposed terms marked in underline:

Class 42:

Website hosting services; Domain name search services; Software as a service (SAAS) services featuring software for hosting software application; Creating, hosting, and maintaining {e-commerce.} websites for others; IT integration services; Technology consultation in the field of cybersecurity; hosting of websites.

Class 45:

Domain name registrar services.

2. On 16 September 2025, Ulta Beauty, Inc ('the Opponent') opposed the application by way of filing a Notice of opposition and statement of case ('Form TM7'). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The opposition was filed with notice by way of a Form TM7A,¹ dated 18 August 2025.
3. The Opponent seeks to rely upon the earlier right detailed below. As noted at [1], the opposition claim is directed to part of the application.

UK00003949997

ULTA

Filing date: 25 August 2023

Date of entry in register: 15 December 2023

¹ Notice of threatened opposition.

Registered for a variety of goods and services in classes 3, 9, 35, 41, 42 and 44, the following relied upon:

Class 42:

Creating and hosting an online community website for users to access, create, publish, and experience the virtual world; creating and hosting websites featuring non-downloadable software for the design, development, management, use, manufacture, sell, purchase, collection, advertising, storage and creation of virtual goods, namely, cosmetics, makeup preparations, hair care preparations, hair accessories, skin care preparations, perfumes and personal fragrances, cosmetic brushes and makeup brushes; providing non downloadable software, in the nature of services, for the design, development, management, use, manufacture, sell, purchase, collection, advertising, storage and creation of virtual goods.

4. On 22 September 2025, the Registry served the Form TM7 on the Applicant, by both email and regular post, to the recorded representative at that time (Mr Derek Onochie).² The serving letter included the following:

'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 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

² The Applicant later appointed a different legal representative. This is noted at paragraph [12] of this decision.

(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 24 November 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. No Form TM8 (or Form TM9c) was filed on or before the stipulated deadline.
6. On 15 December 2025, the Registry wrote to the Applicant, by both email and regular post, in the following terms:

‘Our letter dated **22 September 2025** invited the applicant to file a Form TM8 and counter-statement on or before **22 November 2025**

As no Form TM8 and counter-statement has been filed within the time period set, Rule 18(2) applies. Rule 18(2) states:

“[sic] “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.”

It is our preliminary view that the application should be treated as abandoned because no defence was filed by the deadline referred to above.

If you disagree with the preliminary view, you **must** file the Form TM8 and counter-statement **and** a witness statement setting out the reasons for the failure to meet the deadline on, or before, **05 January 2026**.

If no response is received by this date, the application will be treated as abandoned (i.e. it will be withdrawn) in respect of:

[the opposed terms]

and the application will proceed to registration for the remaining goods and/or services.’

[Original emphasis. My text added in square parentheses.]

7. On 5 January 2026, the Applicant filed a Form TM8 via the Applicant’s then-recorded representative, Mr D. Onochie. This was accompanied by a Witness Statement, dated 5 January 2026, from Vladyslava Husak, Executive Assistant at the Applicant company. The content of the Ms Husak’s Witness Statement can be summarised as follows:

- The deadline was missed ‘due to an exceptional and unforeseen communication failure’ by way of ‘an internal systems issue affecting the receipt and escalation of official correspondence’.³
- The aforesaid systems issue meant that Ms Husak was unaware that the deadline was running, and ‘did not have a proper opportunity to take timely instructions or prepare and file the TM8’.⁴
- Ms Husak became aware of the systems issue on 2 December, at which point she discovered that the deadline had been missed.⁵
- She took ‘immediate steps’ to address the oversight, including: investigating the systems failure/communication breakdown; seeking

³ Witness Statement of V. Husak, [3].

⁴ As above, [4].

⁵ Witness Statement of V. Husak, [5].

professional advice; and preparing the Witness Statement and Form TM8.⁶

8. On 24 February 2026, the Registry wrote to the parties to confirm receipt of the Applicant's late-filed Form TM8 of 5 January 2026 and gave the preliminary view to 'admit the Form TM8 and counterstatement into the proceedings'. A deadline of 10 March 2026 was set to allow either party to disagree with the preliminary view and request a hearing on the matter.
9. On 5 March 2026, the Opponent emailed the Registry to request a hearing to challenge the aforesaid preliminary view. However, due to an administrative oversight, this email was not flagged to the relevant team until 13 April 2026.
10. On 31 March 2026, at which point, the relevant team had not had sight of the Opponent's email of 5 March, the Registry wrote to the Applicant, by both email and regular post, in the following terms:

'I acknowledge receipt of the Form TM8 and counterstatement received on 5 January 2026. A copy of the form has been sent to the opponent. I can also confirm that no response was received in response to the preliminary view to accept the late filed TM8, as a result it has been admitted into proceedings. Please note the below.

In accordance with Rule 19 of the Trade Marks Rules 2008 and Tribunal Practice Notice 3/2007, the Hearing Officer has considered whether it is appropriate to issue a preliminary indication as to whether the opposition based upon section 5(1) and/or 5(2) is likely to succeed. Having taken into account the particulars of this case the Registrar has decided to issue the following preliminary indication:

Having considered the statement of grounds and the counterstatement, I am of the view that the similarity between the respective marks, together with the

⁶ Witness Statement of V. Husak, [6].

identity or similarity between the services at issue, is sufficient to result in a likelihood of confusion.

As the preliminary indication is that all of the goods and/or services⁷ should be refused registration, if the applicant wishes to proceed it must file a notice of intention to proceed on a form TM53 within one month of the date of this letter, that is on or before **30 April 2026**, otherwise it shall be deemed to have withdrawn its application. Please note that any person submitting a form TM53 must, at the same time, send a copy to all other parties to the proceedings (Rule 19(6) of the Trade Marks Rules 2008 refers).

The preliminary indication is not binding and, should the proceedings continue, a different hearing officer will make the final decision.'

[Original emphasis in bold. My underlining added].

11. Given the administrative oversight noted at [9], the underlined sentence in the first paragraph of the aforesaid letter was included in error. The Registry acknowledged the oversight in a letter sent to the parties on 23 April 2026, which also included the following:

'The applicant currently has a deadline of **30 April 2026** in which to file a TM53 if they wish to proceed with the application. In the event that one is filed a case management hearing will be arranged to discuss the decision to allow the late TM8 as requested on 5 March 2026.

As outlined in the official letter dated 31 March 2026 in the event that a TM53 is not filed by the applicant the application will be deemed withdrawn.'

[Original emphasis]

⁷ The use of the word 'all' was erroneous given that the opposition action is against part of the applied for specification. However, ultimately, nothing turns on this.

12. On 27 April 2026, the Applicant filed a Form TM53,⁸ together with a Form TM33⁹ notifying the Registry that United Legal Experts had been appointed as the new representative of the Applicant.

13. A hearing was arranged for 15 May 2026, at the request of the Opponent.

THE HEARING

14. A hearing took place before me, by telephone conference, on 15 May 2026, attended by both parties. Ms Fiona McBride, of Withers & Rogers, appeared for the Opponent; and Mr Shahzaib Amin Malik, of United Legal Experts, appeared for the Applicant. Both parties filed Skeleton Arguments in advance of the hearing.

15. Ms McBride's principal arguments can be summarised as follows:

- That the Applicant has failed to demonstrate that there were extenuating circumstances or compelling reasons to allow the Registrar to exercise his discretion in the Applicant's favour.
- That the Applicant has failed to adequately substantiate its claim that the deadline was missed due to a communications failure. No explanation has been provided on: the correct working of the Applicant's internal systems; what exactly went wrong; how long the issue persisted; and how widespread the issue was.

16. Mr Malik's submissions can be summarised as follows:

- That, in September and October 2025, the Applicant's internal system for receiving and escalating official correspondence 'suffered an unforeseen and intermittent failure'.¹⁰ This failure prevented the Registry's letter of 22

⁸ Request to proceed to evidence rounds.

⁹ Appointment or change of representative for TM owner.

¹⁰ Applicant's Skeleton Argument, [11].

September 2025 from being escalated to the relevant individual in time to observe the stipulated deadline.¹¹

- That the failure to receive and/or escalate the official letter was first discovered on 2 December 2025; and was ‘remedied with all due expedition’.¹²

17.I propose to address the parties’ arguments more particularly as I consider the relevant factors set out at [23] to [36].

DECISION

18.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.’

19.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:

¹¹ Applicant’s Skeleton Argument, [11].

¹² As above, [14].

'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.'

20. 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.

21. I must also consider whether there has been a failure in communication services under Rule 76, which states:

'(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.

(2) Any extension under paragraph (1) shall be-

(a) made after giving the parties such notice and

(b) subject to such conditions,

As the registrar may direct.

(3) In this rule "communication service" means a service by which documents may be sent and delivered and includes post, facsimile, email and courier.'

22. Ms McBride drew my attention to the following cases:

(i) The *TESCON*¹³ case in which Mr Hobbs Q.C. (as he then was), sitting as the Appointed Person, said the following:¹⁴

'I readily accept that human error is not necessarily inconsistent with the existence of extenuating circumstances or compelling reasons for permitting invalidity proceedings to be defended in the exercise of the discretion conferred by rule 41(6). [...] It is nonetheless clear that the test to be applied cannot be taken to permit or require all human errors to be treated as excusable for the purposes of rule 41(6). There must, in other words, be a fact specific evaluation for the purpose of determining whether the particular error in question should or should not be treated as excusable in the circumstances of the case at hand.'
[My underlining added].

(ii) Decision O/0538/23¹⁵ of this tribunal in which the Hearing Officer found that there was insufficient detail provided in evidence to support a finding that the deadline was missed due to a failure in a communications system.

(iii) Decision O/0938/25¹⁶ of this tribunal in which the Hearing Officer observed that the filing of a Form TM8 is relatively simple task, even where the Applicant is not legally represented.¹⁷

23. 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.

¹³ Decision BLO 0/240/20.

¹⁴ As above, at [32]; whilst *TESCON* concerned invalidation, the principle applies equally to late-filed defences in opposition proceedings.

¹⁵ *Roger Aoun v Kitslimy Beaudelab Ltd.*

¹⁶ *University of Warwick v Warwick Econometrics.*

¹⁷ As above, [49].

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

24. The explanation provided by the Applicant is that the deadline was missed because of intermittent failure of the Applicant's own internal docketing system 'in September and October 2025', which affected the receipt and escalation of the official letter of 24 September 2025. During the hearing, Mr Malik submitted that the Applicant operates as a hosting company and web domain service provider and that it uses its own IT systems for managing correspondence. He submitted that the Applicant had tried to investigate 'why they [the Applicant] could not receive letters from the agent' (i.e. Mr D Onochie). Mr Malik also made a general observation that challenges can arise 'with the advancement of new AI technologies' that companies are implementing into their systems.

25. The Form TM8 was filed on 5 January 2026, some six weeks after the prescribed deadline of 24 November 2025.

26. The Applicant has stated that it first became aware that the deadline had been missed on 2 December 2025. The period between the Applicant having *knowledge* of the missed deadline and *filing* the Form TM8 was, therefore, just over one month.

27. Ms Husak has stated that, upon discovering the systems issue, she took immediate steps to address the situation by: investigating the systems/communications failure; seeking professional advice; and preparing the Form TM8 and her Witness Statement.¹⁸

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

28. The claim against the Applicant is an opposition pursuant to section 5(2)(b) of the Act, which is directed against part of the Applicant's specification. The Opponent seeks to rely upon one earlier mark, which achieved registration on 15 December

¹⁸ Witness Statement of V. Husak, [6].

2023. Because the earlier mark had not been registered for more than five years on the filing date of the application, the 'proof of use' provisions¹⁹ are not engaged. I note that the Applicant has erroneously requested proof of use in respect of the earlier mark. Without giving any view on the *admissibility* of the Applicant's Form TM8 (the instant matter concerns the question of whether to allow it to *proceed to be examined* in order to determine its admissibility), a mistaken request for proof of use, without more, is not a fatal defect.

29. 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.

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

31. 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.

32. If, however, the Applicant is not allowed to defend the opposition, the Application will be deemed abandoned in respect of the opposed services in class 42. The application will proceed to registration in respect of the unopposed terms. It will remain open to the Applicant to re-file its application for the previously opposed terms, which may, in turn, be opposed again by the Opponent (or any other party).

33. Ms McBride, in her Skeleton Argument, seems to suggest that the fact that the Registry gave a preliminary view in the Opponent's favour might, should the late-filed TM8 be refused, deter the Applicant from re-filing another application anyway.²⁰ Whilst noted, this argument is speculative and not particularly compelling; for the reason that the preliminary view is not binding on the Hearing Officer who ultimately determines the case should it progress to the decision stage.

¹⁹ Section 6A of the Act.

²⁰ Opponent's Skeleton Argument, [23].

Any prejudice caused to the Opponent by the delay

34. 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.

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

36. I was not made aware of any other relevant considerations by either party.

Conclusions

37. 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 partial opposition will succeed in full, and the Applicant will lose its filing date in respect of the class 42 terms that have been opposed (with the application proceeding to registration only in respect of the unopposed terms). I further recognise that it may be that the Applicant may simply re-file its application for the previously opposed terms 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.

38. 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.

39. Whilst I have no reason to question the integrity of the Applicant's explanation for the deadline being missed, my view is that the detail provided is insufficiently granular to enable me to understand precisely how it was that a problem with the Applicant's internal systems prevented the Applicant's compliance. The description

of the systems issue provided in Ms Husak's Witness Statement is unfortunately general and vague. The description given of 'an internal systems issue affecting the receipt and escalation of official correspondence' is so general that it could cover a range of scenarios. The Applicant has not provided an account, in basic terms, of how its internal system for managing official correspondence works when it is operating smoothly. No explanation has been given of, inter alia: the cause of the systems issue; how it was discovered; when the issue impacted the official letter of 22 September 2025. Although the Applicant has indicated a time-frame of 'September and October 2025' within which 'intermittent' problems with the system were experienced, it has not specified the particular date when the Registry's letter was affected. Perhaps unsurprisingly, I found Mr Malik's submissions to be unhelpfully vague. Mr Malik touched on some details that had not been foreshadowed by Ms Husak's Witness Statement. For example: the use of AI being an operative factor in the systems issue; and his submission that the Applicant had tried to investigate why '[the Applicant] could not received the letters from the agent'. This leads me to my next observation.

40. The Applicant's recorded representative until 27 April 2026 was a Derek Onochie, at an address in Surrey, UK. The official letter of 22 September 2025 (and, also, the official letter of 15 December 2025) was sent both by email and by regular post. Whilst I note that neither party has addressed the matter of what, if anything, happened to the hard copy letter sent to the Applicant, it remains the case that the Applicant has failed to observe the prescribed deadline despite the letters being sent via two modes of delivery, i.e. electronic mail and regular mail.

41. The Form TM8 was not filed until 6 weeks after the prescribed deadline. Whatever circumstances caused the statutory deadline to be missed in the first place cannot be to blame for the further month-or-so delay in filing the Form TM8 from the 2 December 2025 when the Applicant became aware of the oversight. Mr Malik's suggestion that the Christmas and New Year periods somehow delayed the eventual filing of the Form TM8 has no relevance to the matter of the missed deadline. Given the foreseeability of the festive holidays, I do not consider it to be a mitigating factor in the month-or-so delay after the Applicant was alerted to the missed deadline. Ms McBride rightly emphasised that the completion and filing of

a Form TM8 is a fairly straightforward task, even for a party without legal representation.

42. I agree with Ms McBride's criticism of the sufficiency of the Applicant's evidence; and I find Mr Hobbs' dicta from the *TESCON* case, noted above at [22], to be apposite here. Following *TESCON*, I find that the Applicant has failed to substantiate the 'internal systems issue' with sufficient clarity and precision to enable me to find that the internal systems issue caused the Applicant's failure to observe the statutory deadline for filing a defence.

43. 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 to reach the standard of 'exceptional circumstances' or 'compelling reasons'. I have borne in mind that the opposition claim was foreshadowed by a Form TM7A on 18 August 2025, putting the Applicant on notice that a claim from the Opponent was imminent. Whilst I have no reason to question the integrity of the Applicant's evidence, or to doubt that the Applicant has a genuine intention to defend its application, in the absence of sufficient detail to demonstrate the systems failure that occurred, I am unable to exercise my discretion under Rule 18(2).

Outcome

44. 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 24 February 2026, to allow the late-filed TM8 and counterstatement to proceed to examination, is reversed and the Application will be deemed undefended in respect of the following terms, which are opposed:

Class 42:

Website hosting services; Software as a service (SAAS) services featuring software for hosting software application; Creating, hosting, and maintaining {e-commerce.} websites for others; hosting of websites.

45. The application may proceed to registration in respect of the following terms, which are unopposed:

Class 42: Domain name search services; IT integration services; Technology consultation in the field of cybersecurity;
Class 45: Domain name registrar services.

Costs

46. 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	£100
Preparing the Statement of Case	£250
Preparing for and attending the hearing of the matter of the late filing of a defence	£350
Total	£700

47. I therefore order Utahost to pay to Uta Beauty, Inc the sum of £700 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 28th day of May 2026

N. R. MORRIS

For the Registrar