

O/053/21

TRADE MARKS ACT 1994

IN THE MATTER OF

INTERNATIONAL TRADE MARK NO. 1516866

IN THE NAME OF SOREMARTEC S.A.

FOR THE MARK

CHARLIE AND THE CHOCOLATE FACTORY

AND

THE LATE FORM TM8 AND COUNTERSTATEMENT

FILED IN DEFENCE OF THAT REGISTRATION

IN OPPOSITION PROCEEDINGS (UNDER NO. 420840)

LAUNCHED BY WARNER BROS. ENTERTAINMENT INC.

Background and pleadings

1. SOREMARTEC S.A. (the holder) applied to protect the International Trade Mark no. 1516866 for the mark CHARLIE AND THE CHOCOLATE FACTORY in the UK claiming a priority date of 26 July 2019. It was accepted and published in the Trade Marks Journal on 13 March 2020 in respect of the following goods:

Class 30: Pastries and confectionery; chocolate; ice creams, sorbets and other edible ices; cocoa based beverages; sugar confectionery; chocolate confectionery; chewing gum.

2. Warner Bros. Entertainment Inc. (the opponent) oppose the trade mark on the basis of Section 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act).
3. The opposition under Section 5(3) of the Act is on the basis of, amongst others, its earlier European Union trade mark no. 3482692 for the mark CHARLIE AND THE CHOCOLATE FACTORY registered for goods and services in classes 9 and 41. In addition, the opponent relies upon its UK trade mark no. 2336466 for the mark CHARLIE AND THE CHOCOLATE FACTORY on the basis of its goods in class 9.
4. The opponent submits that it holds a reputation in respect of the above earlier marks, and that the consumer will at the least make a link between its mark and the application. The opponent submits that the holder will ride on its coat tails and benefit from the power of attraction, reputation and prestige of the same. The opponent argues that the holder will benefit from the opponent's significant financial investment, leading to a marketing advantage for which it has not paid. Further, the opponent claims that poor quality goods and/or bad publicity for the holder will cause detriment to its reputation and business. The opponent claims that, without due cause, use of the later mark will dilute the distinctive character and reputation of its marks, leading to a loss of custom.

5. Under Section 5(4)(a) of the Act, the opponent firstly relies upon the unregistered mark CHARLIE AND THE CHOCOLATE FACTORY, which it claims to have been in use throughout the UK since July 2005 in respect of motion pictures, entertainment and accompanying merchandise. The opponent also relies upon a second unregistered mark under this ground, namely WILLY WONKA AND THE CHOCOLATE FACTORY, claiming this has been in use throughout the UK since June 1971, also in respect of motion pictures, entertainment and accompanying merchandise.
6. Under Section 5(4)(a) the opponent submits that it owns and controls goodwill in respect of the two claimed unregistered rights. The opponent argues that use of the mark which is the subject of the application in respect of the goods as filed would result in a misrepresentation to the public that those goods originate with, or are economically linked to, the opponent. The opponent submits this would cause damage to its goodwill due to a loss of sales and/or licensing revenue, harm caused by dissatisfaction with the holder's goods and/or as a result of dilution.
7. On 6 August 2020, the Tribunal wrote to the World Intellectual Property Organisation (WIPO) regarding the Notice of Opposition TM7 filed against the UK designation of International Registration no. 1516866. The header of the letter stated as follows:

Switzerland

Date: 06 August 2020

Please reply by **06 August 2020** quoting the International Registration number

Intl Reg No: WO0000001516866
Mark: CHARLIE AND THE CHOCOLATE FACTORY
Holder: SOREMARTEC S.A.
Class(es): 30

8. The letter went on to instruct as follows:

Please find attached a copy of the TM7 'Notice of Opposition', which includes details of any marks referred to in the statement of case, which was received by the United Kingdom Trade Mark Registry. Copies of these documents have been sent to the holder informing them of this provisional refusal.

If the holder of the International Registration wishes to file a counterstatement, they must complete the form TM8 'Notice of defence and counterstatement', which is available at ipo.gov.uk/tmforms and **return it to this office** within **two months** of the date of this letter. This period cannot be extended, except in the circumstances described below. The holder should note that failure to file a TM8 will result in the provisional refusal being upheld.

9. On 6 August 2020, the Tribunal also wrote to the holder informing them of the opposition filed against the UK designation and explaining that a copy of the documents had also been sent to WIPO. The letter went on as follows:

If you wish to continue with your international registration, 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-and-fees/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 (above). Please note both parties must agree to enter into cooling off.

IMPORTANT DEADLINE: A completed Form TM8 (or else a Form TM9c) MUST be received on or before 6 October 2020.

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 international registration will be treated as abandoned.

10. The above letter was sent by Royal Mail and was signed for by the holder on 12 August 2020.
11. UK Intellectual Property Office (UK IPO) records show the representative for the holder called the UK IPO on 8 October 2020 and discussed the filing of a late TM8 and counterstatement following some confusion over the letter forwarded from WIPO. It was stated that a reply date of 6 August 2020 was mentioned on the letter received. The holder was advised by the Tribunal to

file its TM8 and counterstatement alongside a witness statement giving reasons for the missed deadline for consideration, should it still wish to enter a defence into these proceedings.

12. On 12 October 2020, a TM8 and counterstatement, as well as an accompanying witness statement was filed on behalf of the holder, alongside the request for Taylor Wessing LLP to be appointed as the holder's representative on record in the UK. The witness statement was filed in the name of Christopher James Benson, a solicitor at Taylor Wessing LLP, and all documents were dated 12 October 2020. The TM8 requested proof of use from the opponent, and the counterstatement denied the claims made under Section 5(3) and 5(4)(a) of the Act. The witness statement gave reasons for the late filing of the TM8, referring to an error on the letter sent to WIPO by the Tribunal.

13. In a letter dated 24 November 2020, the Tribunal wrote out to the holder acknowledging the receipt of the documents filed, and explaining it was the Registry's preliminary view that the documents could not be admitted into proceedings. The letter contained the following reasoning:

The Registry's letter dated **6 August 2020** informed the Holder that a form TM8 and counterstatement or form TM9c must be received on or before **6 October 2020** this was sent by the Royal Mail "signed for" service. In addition, the letter outlined the consequences, that the application may be deemed abandoned if either of these forms were not received within the time period specified. Although the form TM8 has now been filed, the discretion available to the Registrar when deciding whether to accept a late filed TM8, is narrow and there must be "extenuating circumstances" and "compelling reasons" sufficient to warrant the exercise of such discretion.

In this instance, you have not provided any reasons sufficient to explain the failure to file the TM8 within the set period and, therefore, the Registrar cannot proceed to exercise any discretion in the matter. You are referred to the following decisions of the Appointed Persons in this regard: Kickz AG and Wicked Vision Limited (BL-O-035/11) and Mark James Holland and Mercury Wealth Management Limited (BL-O-050/12). Copies of these decisions can be found on the IPO website at:

<http://www.ipo.gov.uk/tm/t-decisionmaking/t-challenge/t-challenge-decision-results.htm>

As a consequence of the above, it is therefore considered that there are no grounds on which to allow the exercise of the Registrar's discretion in this case.

In accordance with paragraph 10 of Tribunal Practice 2/2011, if either party disagrees with the preliminary view they should provide full written reasons and request a hearing on, or before, **8 December 2020**.

A hearing can be requested to challenge the preliminary view. However, if the Hearing Officer maintains the preliminary view, the applicant may be required to contribute to the other party's costs. This is not intended to dissuade you from requesting a hearing, but merely to inform you of the potential consequences should you be unsuccessful in overturning the preliminary view.

If no response is received within the time allowed, the preliminary view will automatically be confirmed.

14. On the 29 November 2020, a hearing was requested on behalf of the holder to challenge the preliminary view. A hearing was scheduled for 6 January 2020. Written reasons were received from the holder on 8 December 2020. A subsequent email was received from the holder requesting that the contents of the submissions filed remained confidential between the parties and the Office.
15. Following a review of the submissions filed, it was noted by the Tribunal that the contents of the submissions filed, upon which a confidentiality request had been made, constituted evidence. On 18 December 2020, the Tribunal wrote out to the holder explaining that should the holder wish for the information included within its submissions to be considered as evidence in the proceedings, it must be filed in the correct evidential format alongside a formal request for confidentiality, submissions on which may be made at the hearing of 6 January 2020.
16. On 22 December 2020, an amended copy of the written submissions was filed, removing some of the information within the same, and refiled this information in the form of a witness statement, with the remainder of the information refiled in amended submissions. A further request to keep both the amended submissions and witness statement confidential was filed, however this request was limited to the witness statement only at the hearing.

17. The amended submissions stated that due to the reply date of 6 August 2020 on the letter sent to WIPO, there had been ambiguity leading to the docketing of the deadline as 12 October 2020, the day on which the documents were filed.

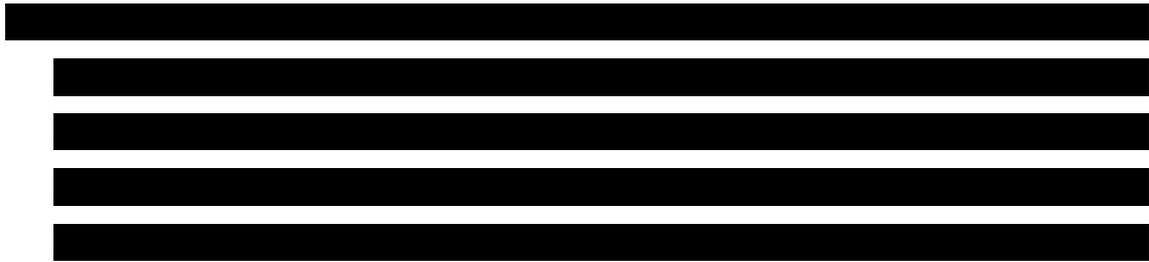
18. A Hearing took place on 6 January 2020 by telephone conference. The holder was represented by Mr Robert Hawley of Taylor Wessing LLP and the opponent was represented by Mr Peter Dawson of Wiggin LLP.

Evidence

19. Evidence was filed by the holder by way of two witness statements. The first was filed in the name of Christopher James Benson in his position as solicitor at Taylor Wessing LLP, the UK representative for the holder.

20. Within the witness statement Mr Benson stated that he had been instructed to act by representatives on record for the holder at WIPO, namely Milojevic, Sekulic and Associates (“MSA”). The witness statement does not confirm the date the instruction was given by MSA or received by Taylor Wessing LLP. Mr Benson states that MSA received from WIPO a letter from the UK IPO dated 6 August 2020. The witness statement explains there was an error letter in the letter, which stated a response was required by 6 August 2020. The witness statement goes on to detail that Mr Benson called the UK Intellectual Property Office on 7 October 2020 to inform them of the error, and that he was advised in subsequent phone calls with the UK IPO to file the counterstatement and refer to the error. Mr Benson asked within the witness statement for the counterstatement to be admitted into proceedings.

21. The second witness statement received was filed by Robert James Hawley in his role as Chartered Trade Mark Attorney and Brand Protection Practice Manager at Taylor Wessing LLP, representative for the holder.



The Rules

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

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

(2) Where the holder 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.”

24. 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 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.”

25. The holder submits that there has been an error on the part of the Office, and so I will consider Rule 77(5)(a) and 77(5)(b) in this instance.

26. If I do not find for the holder under Rule 77(5), the only other basis on which the holder may be allowed to defend the opposition proceedings is if I exercise in its favour the discretion afforded to me by the use of the words “unless the registrar otherwise directs” in Rule 18(2).

27. Guidance on the meaning of the “notification date” referenced with Rule 18(3) is set out in the Tribunal section of the Trade Marks Manual as below:

3.1.5 Serving the notice (TM7)

Rule 18 of the Trade Marks Rules 2008

The Tribunal will send the TM7 with the statement of grounds and any other documents to the holder, by recorded delivery, at their last recorded address for service. The date on which these are sent is known as the “notification date”.

CASE LAW

28. In approaching the exercise of discretion under Rule 18(2), I take into account the decisions of the Appointed Person in *Kickz AG v Wicked Vision Limited* (“*Kickz*”)¹ and *Mark James Holland v Mercury Wealth Management Limited* (“*Mercury*”)².

¹ BL/O/035/11

² BL/O/050/12

29. Sitting as the Appointed Person in *Kickz*, Mr Geoffrey Hobbs QC held that the discretion conferred by rule 18(2) can be exercised only if there are “*extenuating circumstances*”. Sitting as the Appointed Person in *Mercury*, Ms Amanda Michaels QC held that there must be “*compelling reasons*” to justify the registrar Exercising that discretion. The case law therefore dictates that under rule 18(2), I must be satisfied that there are extenuating circumstances and/or compelling reasons if I am to exercise my discretion in the holder’s favour.

30. The factors for consideration under Rule 18(2) are set out by the Court in *Music Choice Ltd’s Trade Mark (“Music Choice”)*³. These include:

- The circumstances relating to the missing of the deadline including reasons why it was missed and the extent to which it was missed;
- The nature of the opponent’s allegations in its statement of grounds;
- The consequences of treating the holder as defending or not defending the opposition;
- Any prejudice caused to the opponent by the delay;
- Any other relevant considerations such as the existence of related proceedings between the parties.

31. As well as the case law of *Mercury*, *Kickz* and *Music Choice*, the opponent has directed me to two Registry decisions, namely that of *Tescon v Praedidiad NV (Tescon)*⁴ and *Ringdale UK Limited v Anon (Ringdale)*⁵.

32. *Tescon* is a Registry decision concerning the late filing of a TM8 and counterstatement within invalidation proceedings. The deadline to file the defence was missed by 9 calendar days due to an error on the part of the proprietor’s representatives. The hearing officer refused to grant relief for the holder, on the basis that the human error and administrative anomaly did not

³ [2005] RPC 18

⁴ BL O/193/19

⁵ BL O/727/19

suffice as extenuating circumstances or compelling reasons to exercise her discretion in that instance.

33. I note also, although I have not been directed to do so by the opponent, that the decision of Tescon was appealed to the appointed person under *Praesidiad NV v Tescon Sicherheitssysteme Schweiz GMBH*, BL O/240/20. Within the appeal the appointed person (Mr Geoffrey Hobbs QC) ultimately upheld the decision, finding that “it was open to [the hearing officer] in point of law and in point of fact to find that the Proprietor had not established a sufficient basis for the discretion conferred by that rule to be exercised in its favour”⁶. However, within the decision Mr Geoffrey Hobbs QC also expressed that human error itself “is not necessarily inconsistent with the existence of extenuating circumstances or compelling reasons”. Although this matter concerned invalidation proceedings, this is nonetheless applicable here.

34. *Ringdale* was a decision issued by the Registry concerning an unrepresented party who missed the deadline to file its TM8 by 44 calendar days. The reasons given in the decision were multifaceted, from travelling in areas with limited signal, to receiving an excess of junk mail, to a basic lack of understanding of Tribunal procedures. The hearing officer ultimately did not find extenuating circumstances or compelling reasons in order to exercise her discretion in the holder’s favour in that case. The opponent has submitted that the cases flagged are “instructive”, but in respect of this matter in particular, I find there are few parallels to be drawn. I note also that the hearing officers decision in Tescon, whilst arguably more similar, has been decided upon its own particular set of facts, which is what I must do in this case, although I note, and will refer back to the useful guidance regarding cases of human error set out by the appointed person within the appeal.

35. Within the hearing, Mr Hawley for the holder also directed me to a further Registry decision, namely that in *Caviar Holdings Inc. V Roof Deck Entertainment LLC*, BL O/488/17 (*Caviar Holdings*). I will not describe this

⁶ Paragraph 32 of BL O/240/20

Late TM8

40. Prior to taking submissions from the parties on the late TM8, I confirmed to the parties that I had read the files, and the skeletons, and that I noted there was a discrepancy that I need to address prior to proceeding. I explained that the letter dated 24 November 2020 sent by the Tribunal, mentioning the holder's filing date of 13 October 2020, was incorrect. I informed the parties that having now viewed the covering documents, I could confirm that the holder's Form TM8, counterstatement and witness statement in the name of Mr Christopher Benson was in fact received by the Office on 12 October 2020.

41. I noted that Mr Dawson mentions the date of 13 October 2020 in his skeleton arguments, and I asked if he therefore required any time to consider this information. I confirmed that if he did, we may adjourn the hearing. Mr Dawson confirmed he did not require time to consider this, as it did not have a material impact on his arguments.

42. As the party requesting the discretion and the hearing, Mr Hawley began with submissions on behalf of the holder.

43. Mr Hawley submitted that the starting point for the missed deadline was the error in the letter from the UK IPO to WIPO dated 6 August 2020, which requested a response date of 6 August 2020. Mr Hawley confirmed that this led to Taylor Wessing as the representative for the holder to docket the deadline of 12 October 2020 as the deadline on its system, two months from the WIPO notification date and date of the WIPO letter.

44. Mr Hawley submitted that the TM8 form itself was acceptable, and that the witness statement of Mr Benson had stated that the UK IPO letter contained an error, which still stands. [REDACTED]

[REDACTED]

[REDACTED]

45. Mr Hawley submitted that the TM7 document was not properly served on the holder due to the error in the letter to WIPO of 6 August 2020 and the lack of clarity, which caused uncertainty in the office regarding the deadline date. Mr Hawley also referred me to rule 18(3) of the Rules, stating that this confirms a response is required within two months of the notification date. Mr Hawley submitted that for International Registrations, it is inequitable for the date of notification to be taken from the UK IPO notification date as it delays the serving of the TM7 and gives parties less time to file a defence. Mr Hawley submitted that under Rule 18(3) of the Rules, I should take the deadline as being 12 October 2020, the day on which the documents were filed and two months from the notification date listed on the documents from WIPO.

46. Mr Hawley submitted that under Rule 62(1) that there is a wide range of circumstances under which I may exercise my discretion. Mr Hawley then took me through the *Music Choice* factors. I have detailed Mr Hawley's initial submissions on the first factor above, namely the circumstances surrounding why the deadline was missed. In respect of the extent to which it was missed, Mr Hawley submitted that Mr Benson had called the Office only one day after the deadline, namely on 7 October 2020. Mr Hawley also directed me to the Registry decision of *Caviar Holdings* (and apologised that it was not foreshadowed in his skeleton) explaining that this decision found that a period of 8 days and 22 days not to be an undue delay. Mr Hawley went through the rest of the *Music Choice* factors, and I will refer to his submissions on these factors as appropriate in the relevant sections below. Ultimately, Mr Hawley argued that there were extenuating circumstances and compelling reasons sufficient for me to exercise my discretion in the holder's favour.

47. During his submissions, Mr Hawley made reference to the letter of 24 November 2020 received from the UK IPO containing its preliminary view. Mr Hawley stated that the letter caused further confusion, as it was said in that letter that the letter of 6 August 2020 stated the deadline of 6 October 2020

and was sent by recorded delivery and signed for on 12 August 2020. He stated that the letter of 6 August 2020 was sent to WIPO, and that this didn't make sense on that basis. At the end of his initial submissions, I explained to Mr Hawley that there was a second letter sent directly to the holder on 6 August 2020, and that UK IPO records show this was received by the holder and signed for on 12 August 2020. I explained this second letter contained the correct deadline. I asked Mr Hawley if he would like to make any further submissions on this, and he stated that this letter had "never been brought to the attention of Taylor Wessing", confirming he had not had sight of this second letter, and that he can only speculate that the holder, not being an English company, having been sent a letter directly from the UK IPO in English may not have understood this or may have simply disregarded this.

48. Mr Dawson began his submission on behalf of the opponent by submitting that the law pertaining to rule 18(2) is that the discretion available to the Registrar is a narrow one. He referred me to the cases referenced in his skeleton arguments, and particularly to *Tescon*, stating that although not binding, it is instructive, as it showed that an anomaly in the record system, an error by the fee earner and a misunderstanding did not reach the high bar required for exercising the discretion under Rule 18(2). Mr Dawson also referred to *Ringdale* explaining that leniency was not even given to an unrepresented party in that instance.

49. Mr Dawson submitted that reference to a reply date of 6 August 2020 was clearly a typographical error, and that the reasonable thing to do would be to consult the UK IPO or consult the rules in that instance. Mr Dawson highlighted that this was a simple case of human error, and whilst [REDACTED]. Mr Dawson submitted that docketing the deadline incorrectly did not constitute compelling reasons or extenuating circumstances.

50. With regards to Mr Hawley's submissions on the interpretation of Rule 18(3) in respect of International Registrations, Mr Dawson submitted that this constitutes a request to change the Registry practice, and that this is not

something that other holders of International Registrations have benefitted from. Mr Dawson submitted that the comment made by Mr Hawley with reference to the second letter, regarding the holder's language barrier "doesn't hold very much water", as the document had been correctly served.

51. Mr Dawson went on to address the other factors in Music Choice, and also referred me to the points made in his skeleton arguments. I will refer to his further submissions in this respect where appropriate below. Mr Dawson confirmed he had no additional submissions regarding costs, but confirmed that as stated in his skeleton arguments, should the late documents not be accepted, the opponent wished to claim scale costs for attending the hearing, in addition to the scale costs regarding the opposition which will have succeeded.

DECISION

52. The first aspect of the submissions made by that parties that I feel I must address is Mr Hawley's reference to the broad discretion available to me under Section 62(1) of the Rules. I do not feel the need to comment on this extensively, other than to confirm that the non-extendable deadline for filing a TM8 and counterstatement in opposition (and the narrow discretion available in instances where those deadlines are missed) is governed by the Rules set out in paragraphs 23 & 24 of this decision, alongside the relevant case law.

Rule 18(3)

53. Having heard the submissions from both parties, I have considered firstly if it is open to me, as submitted by Mr Hawley for the holder, to interpret Rule 18(3) as setting the deadline for the holder to file its TM8 and counterstatement as 12 October 2020, and, as also submitted by Mr Hawley, and if it is fair for me to do so. I have considered Mr Hawley's submissions regarding the unfairness of the additional delay to serving the documents that holders of International Registrations designating the UK will experience, and how this means I should take the deadline as running from the WIPO

notification date. I have also considered Mr Dawson's submission that Mr Hawley is requesting I change the Office practice for the benefit of the holder only. I agree with Mr Dawson that what Mr Hawley has requested would be a change of Office practice, and I find it is not appropriate for me to contemplate this within this decision. It is clear that the Rules, (the correct interpretation of which is clearly explained within the Trade Mark Manual), must apply to all. I do not suggest that there would never be a case where a considerable undue delay to the serving of a TM7 results in an admission of a late defence. Indeed, I do not even suggest that the misunderstanding or misinterpretation of this Rule should never result in permitting the late defence into proceedings. However, it is my view that these scenarios are both matters to be decided within the discretion afforded to the Registrar under Rule 18(2) with proper consideration of all the facts, and that this should not be achieved as a result of the bending or reinterpreting the Rules with which it is my duty to abide. Further, in respect of the question of fairness posed by Mr Hawley, I note that the WIPO notification was sent to the holder's representatives on 12 August 2020. On the same day, the letter sent directly to the holder by the UK IPO arrived with them. It is my view that there has been no unfairness caused by sending one letter directly to the holder, to arrive in the same time period as it would have, had the holder filed an application directly at the UK IPO, and also sending a second letter via the International Registration system which may have incurred an additional delay of what I can only assume would be a matter of days (no receipt date has been given by the holder in this instance).

54. In summary, I do not find that I may view the deadline for filing the TM8 and counterstatement as 12 October 2020 under Rule 18(3) and allow the documents into proceedings on that basis.

Rule 77(5)

55. Next, I will consider whether in my view there is an irregularity attributable to the Office or International Bureau, and whether it is my view that this error

should be rectified by way of allowing the holders defence into these proceedings within Rule 77(5).

56. The representative for the holder has not made specific reference to Rule 77(5), but as an error on the part of the Office has been referenced as part of the reason for the missed deadline, I will consider if Rule 77(5) should apply.

57. Firstly, I note that the error that is claimed by the holder is indeed present in the letter sent to WIPO by the Office on 6 August 2020. This letter requests at the top, a response by 6 August 2020. Being that this is the same date as the date of the letter itself, I agree with the opponent that it would be very difficult to interpret this as anything other than a typographical error. I also note that no specific mention of “deadline” is made here, and it was not the incorrect date that was considered by the holder’s representative to be the deadline. Whilst it therefore may have been the intention of the Tribunal to request a response by 6 October 2020 at the top of the letter, I do not find that the reply date of 6 August 2020 prevents the contents of the letter from conveying to its recipient the correct deadline. The reason for this is that the letter clearly states within its contents that the holder must return the documents requested within “two months from the date of this letter”. The letter was correctly dated 6 August 2020, and so it is my view that the deadline date is simple to grasp if the letter is read with even a basic level of care.

58. I also note that a further letter was sent to the holder from the Office via recorded delivery on 6 August 2020. This letter was received and signed for by the holder on 12 August 2020, and clearly and specifically conveyed the correct deadline and the consequences associated with not meeting the same to the holder.

59. As I do not find the administrative error made by the Tribunal made a material difference to the information regarding the correct deadline that was conveyed to the holder, it is my view that although there has been an error on the part of the Office, this was not the cause of the irregularity under Rule 77(5)(a), and I do not find that any further action to rectify this error is required under Rule

77(5)(b). I therefore see no reason to allow the holder's TM8 and counterstatement into these proceedings under Rule 77(5).

Rule 18(2)

60. I will therefore move on to consider if I may exercise my discretion under Rule 18(2). Firstly, I will consider in turn the factors as set out in *Music Choice*.

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

61. The deadline itself was missed by the holder by six calendar days, or four working days. As I see it, the circumstances surrounding the missed deadline, are that two letters were sent to notify the holder regarding the deadline, one to the holder and one to WIPO, the second of which was forwarded to the holder's representative at WIPO (MSA), who in turn passed this to Taylor Wessing LLP, the holder's present UK representative. Both letters included details of the correct deadline, but only the letter to the holder specifically referenced this. The letter to the holder's representative provided information to calculate the correct deadline (two months from the date of the letter), but also included a reply date (in error) of 6 August 2020. The holder's representatives never had sight of the letter sent directly to the holder, and incorrectly docketed deadline of 12 October 2020, instead of 6 October 2020, based on a calculation from the wrong date. The holder contacted the Office to discuss the error on 7 & 8 October 2020, by which time the deadline had been missed. The holder's representatives filed the late documents on 12 October 2020.

62. As outlined above, the opponent has submitted that these circumstances are simple human error and a case of incorrect docketing of the clearly communicated deadline, and do not constitute extenuating circumstances or compelling reasons. The holder's representative submits on the contrary, that this constitutes extenuating circumstances and compelling reasons sufficient for me to exercise my discretion.

[REDACTED]

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

64. As mentioned previously, the opposition has been filed on 5(3) and 5(4)(a) of the Act, based on two earlier registered rights in which the opponent claims to have a reputation, and two earlier unregistered rights. Mr Hawley for the holder submitted that as these are both grounds that require substantiation through the filing of evidence, they have indeterminate merit. Mr Dawson on the contrary, claims that the claims made have merit.

65. Whilst it is not for the present decision 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 requiring the filing of cogent evidence.

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

66. If the holder is permitted 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.

67. If, however, the holder is not allowed to defend the opposition, its application will be deemed abandoned and it will lose its priority filing date of 26 July 2019 in respect of the UK designation of its International Registration. Mr Hawley for the holder submitted that this will allow the opponent to succeed on unsubstantiated claims, which is inequitable. Mr Dawson submitted that

the consequences for the holder will be no more significant than the normal consequences that result from a failure to file a defence.

68. I agree with Mr Dawson, and I also note it will remain open to the holder to refile its application which may, in turn, be opposed again by the opponent. However, I also note the holder's original priority date goes back nearly a year and a half, which is not an insignificant amount of time.

Any prejudice caused to the opponent by the delay;

69. It was submitted on behalf of the holder prior to the hearing that there will be no prejudice to the opponent caused by the delay if the holder's defence is to be allowed into proceedings. At the hearing, Mr Hawley for the holder added that there will be no significant prejudice to the opponent if the opposition is treated as defended, as this would only result in the opponent having to file its evidence, which would have been anticipated when the opposition was filed.

70. Mr Dawson submitted for the opponent that prejudice to the opponent would be caused due to the additional significant delay and expense associated with that delay.

71. It is my view that the only prejudice caused to the opponent in this instance will be a relatively small procedural inconvenience which would not impact on the opponent's ability to run its case.

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

72. Both parties submitted at the hearing that there are proceedings running between them outside of the UK, but neither party submitted that these require particular consideration in this decision. Both parties agreed they are of little relevance to the matter in hand.

73. Having considered all the factors set out above, I remind myself of the requirement for extenuating circumstances and compelling reasons to be present for me to exercise the narrow discretion I have available under this rule.

74. As set out above, the opponent has argued that the reason for the missed deadline is simply one of human error and that “docketing the wrong deadline is not an extenuating circumstance or compelling reason”. The opponent referred me to the “instructive” Registry decision of *Tescon*, and I find it necessary to again address at this stage the appeal of *Tescon* to the appointed person⁷, and the comments of the appointed person within that appeal. Mr Geoffrey Hobbs QC stated:

32. “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). I would, for example, regard it as appropriate for the discretion to be exercised in favour of permitting a claim for invalidity to be defended in circumstances where it was clearly established that the failure to comply with a filing deadline of (say) **12 February 2020** was the result of an unnoticed keystroke error which caused the due date to be incorrectly entered in an otherwise reliable record keeping system as (say) **21 February 2020**. 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.”

⁷ BL O/240/20

75. I find, therefore, that the answer in this instance is not as simple as the opponent suggests, namely that reasons of human error including a docketing error cannot constitute extenuating circumstances or compelling reasons.
76. I consider here that there are multiple factors that have occurred and either directly or indirectly contributed towards the missed deadline. Firstly, there is the error made on the letter sent to WIPO by the Office. Although this does not, in my view, prevent the letter from portraying the deadline to the holder (or its representative), it is my view that this, under certain circumstances, may weigh in favour of me exercising my discretion under Rule 18(2).
77. I consider the holder's submission that response date of 6 August 2020 "caused ambiguity and led to the holder missing the deadline" and that it caused uncertainty regarding the deadline in the office. Although in my view, the letter clearly communicates the deadline date to the representative, I do not disbelieve this submission. However, I also note that the importance of meeting this deadline was stressed to the representative for the holder in the letter to WIPO. I also cannot find, even giving the holder's representatives the benefit of the doubt, that if there was ambiguity about the deadline, one reading of "within two months from the date of this letter" would not have been at least considered as 6 October 2020. If, upon viewing the error in the letter, the representative found the deadline even remotely open for interpretation, it would have been fully open to them to correspond with the UK IPO to double check this prior to docketing the incorrect deadline, and prior to the date falling "two months from the date of this letter", namely 6 October 2020.
78. When questioned about the second letter of 6 August 2020, Mr Hawley submitted that had not been brought to the attention of Taylor Wessing. I note the letter received by Taylor Wessing of 6 August 2020 explained that another copy of the documents was sent directly to the holder, but it is clear from the submissions that there was no attempt by the representative to get in touch with the holder to seek the additional letter, and that little attention was paid to this.

79. It appears to me in the absence of further explanation, that the holder's representative did feel the referenced error was worth raising with the Office, considering the seemingly unprompted phone calls of 7 October 2020 and 8 October 2020 that took place, in order to highlight and discuss this error. However, being that the response date and the letter date quoted was "6 August 2020", considering that the holder's representative was aware it was dealing with a strict two month deadline, and considering that the letter requested a response within two months of the date of the letter, in my view it was entirely nonsensical and showed a lack of basic vigilance on the part of the holder's representative to wait until 7 October 2020, the day after "two months from the date of the letter" had passed, to consult the UK IPO on this error and to clear up any ambiguity and uncertainty they felt existed at the time that the letter was received.

80. I note also the holder's submission that Rule 18(3) of the Rules uses the wording "notification date" and that the WIPO notification date was 12 August 2020. However, I find again that the wording of the UK IPO letter received should have led the representative to at least question if its interpretation of the Rules was correct, particularly as it will be well versed in the calculation of deadlines for its clients from these Rules. The correct interpretation of "notification date" is clearly explained in the Trade Marks Manual, and it is my view this could have easily been reaffirmed prior to the expiry of the deadline.

81. I also consider the second letter of 6 August 2020, which as far as I am aware, contained no errors of any sort, and specifically confirmed the deadline of 6 October 2020 to the holder. This letter received little attention from either party in this matter. This letter was sent to the holder via recorded delivery and signed for by the holder. There has been no real explanation as to what happened to this letter other than the speculation from Mr Hawley to which I attribute little weight. It is my view that if I were to only have this letter to consider, which in the case of national applications filed would be the case, I would find no basis on which to exercise my discretion. The question I find myself asking therefore, is if the existence of a second letter, the contents of which it is claimed caused ambiguity about the deadline, amounts to

extenuating circumstances or compelling reasons, despite the holder being in receipt of an entirely correct letter which it appears never reached its current representative for reasons that are unclear.

82. I note that the existence of two letters may, in normal circumstances, have the logical effect of the holder not offering, and the representative not asking the holder for the first letter. I also consider that, in the mind of the holder, its representative had these matters under control. However, I cannot help but again refer back to the “ambiguity” and “uncertainty” claimed by the holder’s representatives, and I view this second letter as another missed opportunity for any ambiguity or uncertainty to have been easily resolved with only a small amount of diligence on the part of the holder’s representatives.

83. Based on the above, I do not, therefore, see the docketing errors that have occurred in this instance in the same light as those which are identified as possibly permissible within the appointed persons appeal of *Tescon*. It is my view that the scenario described by Mr Geoffrey Hobbs QC is one where, despite reasonable efforts and an attempt to docket the correct deadline, a near unconscious “human error” occurs due to a slip of the fingers. I do not claim that the scenario set out by Mr Geoffrey Hobbs QC is the only one which would be admissible, in fact I find on the contrary it stated clearly that there must “...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”⁸. However, I find in these circumstances that the “human error” of failing to take reasonable and appropriate steps as a legal representative to resolve any uncertainty and record the correct deadline, which in my view had been clearly reported in two letters of 6 August 2020, despite the acknowledged ambiguity surrounding the same, does not constitute compelling reasons or extenuating circumstances, even with consideration to the typographical error featured in the “reply date” in one of the two letters sent.

⁸ See paragraph 32 BL O/240/20

[REDACTED]

85. I weigh into my evaluation the additional factors I have considered as established by *Music Choice*, and I consider the early filing date of 26 July 2019, which will be lost by the holder should I not exercise my discretion. I also consider the relatively short delay in filing the late Form TM8 and counterstatement, and the entirely evidence based grounds. However, I do not find these, or any of the *Music Choice* factors to be capable of overriding or swaying my view that the lack of extenuating circumstances or compelling reasons mean I cannot exercise my discretion under Rule 18(2) in this instance.

Final Remarks

86. The result of the above is that the late TM8 and counterstatement will not be allowed into proceedings. The opposition will therefore be considered as successful on the basis that no defence has been filed. Subject to appeal, the designation will be treated as refused

COSTS

87. The opponent has been successful both at the hearing and in respect of the opposition filed and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £800 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

| | |
|---------------------------------|------|
| Official fee for the opposition | £200 |
|---------------------------------|------|

| | |
|---------------------------------------|-------------|
| Preparing the statement of grounds | £200 |
| Preparing for & attending the hearing | £400 |
| Total | £800 |

88. I therefore order SOREMARTEC S.A. to pay Warner Bros. Entertainment Inc. the sum of £800. The above 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 20th day of January 2021

**Rosie Le Breton
For the Registrar**