O/0559/26

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK4238926

IN THE NAME OF GO2 TELECOM LTD

FOR THE TRADE MARK:

IN CLASS 40

AND

THE LATE FILING OF FORM TM8 AND

COUNTERSTATEMENT

FILED IN DEFENCE OF THE ABOVE REGISTRATION

IN OPPOSITION PROCEEDINGS

UNDER NO. 457918

BY O2 WORLDWIDE LIMITED

Background

1. On 24 July 2025, Go2 Telecom Ltd ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 1 August 2025. The applicant seeks registration for 'recycling of waste materials' in class 40.

2. On 3 November 2025, O2 Worldwide Limited ("the opponent") filed Form TM7 (Notice of opposition and statement of grounds) opposing the application in full on the basis of sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ('the Act').

3. On 24 November 2025, the Registry served the Form TM7 on the applicant. The deadline for the applicant to file its Notice of defence and counterstatement (Form TM8) was set at 26 January 2026 which was communicated by the Registry in the serving letter. The Registry's letter included the following:

> "This letter is to inform you that your trade mark application has been opposed. Please find enclosed a copy of the notice of opposition - Form TM7.
>
> The opponent has been informed under Section 5(2)(b) of the Trade Marks Act 1994, there can be no likelihood of confusion without a finding of similar goods and services. It is noted that the Form TM7 indicates that the earlier rights under section 5(2)(b) relies upon some of its goods and services covered by the marks, however, it is considered that there are aspects to the pleaded case which do not appear to have any prospect of success under Section 5(2)(b).
>
> However, given the early stage of proceedings, the Form TM7 will be served on the applicant. That being said, the Registry directs, under Rule 62 of the Trade Mark Rules 2008, that the opponent indicates its best case at the filing of its evidence, making clear submissions as to which particular goods/services in each class are similar to the applicant's specification. Failure to do so may result in an adverse costs award.
>
> **Your options**

1. Defend your application

Complete and send to us Form TM8 and counter-statement.

This must be filed (i.e. received by us) within **two months** from the date of this letter; that is **on or before 26 January 2026.**

When completing the counter-statement you must admit (agree) or deny (disagree) each of the grounds of opposition.

It is important to understand that if the deadline date is missed then, in almost all circumstances, the application will be treated as abandoned in accordance with Rule 18(2) of the trade mark Rules 2008: "where the applicant fails to file a Form TM8 and 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."

[…]"

(original emphasis)

4. The applicant did not file a Form TM8 by the deadline and so, on 3 February 2026, the Tribunal wrote to the applicant again. In the letter, the Tribunal stated that:

"Our letter dated 24 November 2025 invited you to file a Form TM8 and counterstatement on or before 26 January 2026.

As no Form TM8 and counter-statement has been filed within the time period set, Rule 18(2) of the Trade Mark Rules 2008 (as amended) applies. Rule 18(2) states:

"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, 17 February 2026**.

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

[…]”
(original emphasis)

5. The applicant sent an email dated 3 February 2026 stating that they had not received any correspondence regarding this matter and asking for the Registry to advise on what the next steps were. The Registry responded on 5 February setting out the dates of the previous correspondence and reminding the applicant of the deadline of 17 February to file their Form TM8 and accompanying witness statement. The applicant subsequently filed their Form TM8 and witness statement on 13 February 2026.

6. The witness statement was by Yvonne Ahearn, the finance manager of the applicant, dated 13 February 2026. The witness statement confirms that the reasons for the missed deadline were that the original letter dated 24 November 2025 was received at the applicant’s warehouse when Ms Ahearn was on annual leave. The document was left in the warehouse and not passed to Ms Ahearn upon her return. Further, the email containing the Form TM7 sent on the same date was therefore also received whilst Ms Ahearn was on leave and, upon her return, she wrongly assumed that the letter had been dealt with by a director (and the director was then overseas, which exacerbated the breakdown in communication).

The Tribunal wrote to the parties on 25 February 2026 giving a preliminary view that the reasons provided in the witness statement were not sufficient to permit the discretion to allow the late filed Form TM8.

7. A hearing was appointed on 2 April 2026, and the details were sent to the parties in an official letter on 13 March 2026. Both parties confirmed their attendance at the hearing. The opponent filed a skeleton argument on 31 March 2026.

8. The hearing took place before me via telephone on 2 April 2026. Yvonne Ahearn attended on behalf of the applicant; and Blake Robinson and Jed Fagan, of Stobbs, attended on behalf of the opponent.

Skeleton Argument

9. The crux of the opponent's argument was that the applicant had provided no extenuating circumstances or compelling reasons which would be sufficient for the Tribunal to exercise its discretion and allow the filing of the late TM8.

10. They submitted that the matter was similar in nature to another case before the Registry, being BL O/0351/25, in which the Hearing Officer found that the reasons were not enough to constitute extenuating circumstances. The opponent submits that the applicant has been the "author of its own misfortune", as was found in the above-mentioned case, and that it had not put in place sufficient measures for handling correspondence.

Hearing discussion

11. At the hearing, Ms Ahearn reiterated the points from her witness statement and said that the company have now put measures in place to avoid post being misplaced in the warehouse. Further, she said that this was all down to human error and asked the Registry to be lenient in these circumstances.

12. Mr Robinson responded for the opponent and started by saying that it was clear that both forms of communications from the Registry had been received by the applicant. He explained that it was, therefore, fundamentally a fairly simple case given its similarities to the case they had provided within their skeleton argument. He went on to say that the only reason the opposition was not acted upon was due to poor communication and slipping through the gaps. He said that no further information had been provided that would mean the original decision not to allow the Form TM8 and counterstatement into proceedings should be changed.

13. Ms Ahearn did not have anything by way of reply, save to reiterate the request for leniency; and to emphasise that they are a small business and that not allowing the Form TM8 into proceedings would impact significantly on the business.

Decision

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

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

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

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

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

16. There is no suggestion that there has been any irregularity on the part of the Registry. Therefore, the only basis on which the applicant 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).

17. When approaching the exercise of discretion here, I must take into account the decision of the Appointed Person in *Kickz AG v Wicked Vision Limited* (BL O-035-11) and *Mark James Holland v Mercury Wealth Management Limited* (BL O-050-12) where it is set out that I have to 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 discretion should be exercised in favour of a party in default. That is the approach I intend to adopt, referring to the parties' submissions to the extent that I consider it necessary to do so.

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

19. As mentioned above, the deadline for filing the Form TM8 was 26 January 2026. The form was subsequently submitted, together with a witness statement, on 13 February 2026. This means that the deadline was, therefore, missed by 18 days. The main reasons for missing the deadline were: that the physical letter was received by the warehouse part of the company and misplaced; Ms Ahearn was on annual leave at the time of arrival of both the letter and email; and she had believed that one of the directors had dealt with the email whilst she was on leave, but the aforesaid director was subsequently on leave themselves upon her return.

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

20. The opposition is brought under sections 5(2)(b) and 5(3) of the Act. There is nothing to suggest the opposition is without merit.

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

21. If the Form TM8 is admitted into proceedings and the applicant is therefore allowed to defend the mark, the proceedings will continue and the parties will be able to file evidence and submissions as necessary and the matter will be determined on its merits. Alternatively, if the applicants are not allowed to defend their mark, then the application will be treated as abandoned and the applicants will lose their filing date.

Any prejudice caused to the opponent by the delay

22. The opponent did not submit reasons as to how they would be caused prejudice by the delay nor can I see anything that would suggest there would be such prejudice.

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

23. There do not appear to be any other relevant considerations.

Conclusions

24. The applicant has admitted that the delay in filing the Form TM8 and counterstatement was down to two administrative oversights by them: firstly, the mishandling of the post within their warehouse; and, secondly, the miscommunication of who had responded to the email to which the Form TM7 was attached.

25. Neither of these reasons (nor the combination of the two) amount to being extenuating circumstances as set out in the above caselaw which would enable me to

allow the late filing of the TM8 and counterstatement. As per the *Kickz AG* case (referred to by the opponent), failure to adhere to any system or procedure for checking and dealing with registered letters was determined to mean that the applicant had been 'the author of its own misfortune'. This case very similarly has failings on the applicant's postal and email processes which meant the Form TM7 went unanswered. Whilst I understand Ms Ahearn's statement that the abandonment of the application will have a significant impact on their business, the failure to file the Form TM8 on time lies solely in their hands.

26. In reaching my decision, I have carefully considered the seriousness of the resulting impact if discretion is not exercised in the applicant's favour i.e. the application will be deemed abandoned and withdrawn and the filing date lost. However, as this is a consequence of the failure to comply with the non-extendable deadline to file form TM8, I do not consider this to be a compelling factor or extenuating circumstance sufficient to justify me exercising my discretion in the applicant's favour. I have also considered that, were the applicant to refile its application, it may well be that the refiled application is again opposed by the Opponent resulting in further opposition proceedings arising at some point in the future.

Outcome

27. The preliminary view is upheld and the late form TM8 and counterstatement are not to be admitted into the proceedings. Subject to any appeal, the opposition will be deemed undefended and the application treated as abandoned.

Costs

28. As my decision terminates the proceedings, I must consider the matter of costs. The opponent is entitled to a contribution towards its costs, based on the scale published in the TPN 1/2023. I therefore assess the costs as follows:

Official fee	£200
Preparing the statement of case:	£300

Preparing for and attending the hearing:	£300

29. I therefore order Go2 Telecom Ltd to pay O2 Worldwide Limited the sum of £800. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 30th day of June 2026

Laura Nicholas
For the registrar