

**O/0564/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 506113  
FOR A DECLARATION THAT  
TRADE MARK REGISTRATION UK00003830642 IS INVALID**

**OWNED BY  
MR SARFRAZ MUNEER**

**AND**

**THE LATE FILING OF FORM TM8 AND  
COUNTERSTATEMENT IN DEFENCE THEREOF**

## BACKGROUND

1. On 17 May 2023, Mr Naeem Rasool, the Cancellation Applicant ('CA'), sought to have the registration UK00003830642, which stands in the name of Mr Sarfraz Muneer, the Registered Proprietor ('RP'), declared invalid pursuant to sections 5(1)(a), 5(1)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act') by way of a Form TM26(I).<sup>1</sup>
2. On 19 May 2023, the Registry wrote to the CA to inform it that more information was required before its Form TM26(I) could be admitted into proceedings. The official letter included the following paragraph:

**“Please file an amended Form TM26(I) and statement of grounds, on or before 10 July 2023.”** [Original emphasis]
3. The two further iterations of the CA's Form TM26(I), filed on 2 August and 4 September 2023, respectively, were also defective and deemed inadmissible.
4. On 13 September 2023, the Registry wrote to the CA with the preliminary view that the CA's claim would be struck out in the absence of an admissible Form TM26(I) being filed on or before 27 September 2023. The CA was given an opportunity to request a hearing if it disagreed with the preliminary view.
5. A case management conference ('CMC') was requested by the CA and took place on 12 October 2023. The official letter of 13 October 2023 from the Registry following the CMC, confirmed that the CA would be granted one further opportunity to file an admissible Form TM26(I) on or before 23 October 2023.
6. On 20 October 2023, the CA filed an amended Form TM26(I) which was admitted into proceedings and served upon the RP, by regular post and email, on 5 December 2023. The letter included the following:

“Please find enclosed a copy of an amended TM26(I), application for invalidity, filed against your registration. The amended TM26(I) filed did not fully

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<sup>1</sup> Application to declare invalid a registration or a protected international trade mark (UK).

particularise their claims under Section 3 of the Trade Mark Act and, as stated in the official letter dated 13 October 2023, the Registry has made the decision to strike out those grounds.

If you wish to continue with your 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/trademark-forms-and-fees>

Rule 41(6) 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.

**IMPORTANT DEADLINE: A completed Form TM8 MUST be received on or before 05 February 2024.**

In accordance with rule 41(6) if the TM8 and counter-statement are not filed within this period, (a period which cannot be extended), the registration of the mark shall, unless the registrar otherwise directs, be declared invalid in whole or part.

**It is important to understand that if the deadline date is missed, then in almost all circumstances, the registration will be treated as invalid in whole or part.** [Original emphasis]

7. No Form TM8 was received on or before 5 February 2024.

8. On 17 February 2024, the Registry wrote to the RP in the following terms:

“The official letter dated 05 December 2023 informed you that if you wished to continue with your registration you should file TM8(N) and counterstatement on

or before **05 February 2024**.

As no TM8(N) and counterstatement have been filed within the time period set, Rule 38(6) applies. Rule 38(6) states that:

“...the registration of the mark shall, unless the registrar directs otherwise, be revoked.”

The registry is minded to treat the proprietor as not opposing the application for revocation and revoke the registration as no defence has been filed within the prescribed period.

If you disagree with the preliminary view you **must** provide full written reasons and request a hearing on, or before, **26 February 2024**. This **must** be accompanied by a Witness Statement setting out the reasons as to why the TM8 and counterstatement are being filed outside of the prescribed period.

If no response is received the registry will proceed to issue an undefended decision on the issue of failure to comply with the Rules governing the filing of a defence.” [Original emphasis]

9. On 19 February 2024, the RP filed a Form TM8(N), together with a Witness Statement from Mr Sarfraz Maneer, dated 19 February 2024, accompanied by an email which stated the following:

“1. In your letter dated 17<sup>th</sup> Feb. you have asked to give a written reason and a request for a hearing before 26<sup>th</sup> of February.

2. As explained over the phone, 3 out of my 4 kids were sick, due to a bug, and my family was very much upset, and my full concentration was on my family. I was totally out of my mind regarding this case.

3. On the 17<sup>th</sup> when I received this letter from you, I was shocked to see the date but when I spoke to you this morning I relaxed and felt better.

4. As promised I have attached TM8N Foam [sic], the Signed page as well as [sic] Witness Statement as advised.’

10. It is noted that the Witness Statement itself did not mention any reasons for the late filing of the Form TM8. Although not a reason for the late filing of the Form TM8, Mr Maneer highlighted that the Opponent had been given 'many' opportunities to file an admissible Form TM26(I).

11. On 20 February 2024, the Registry wrote to the RP in the following terms:

"I refer to your late filed TM8N and counterstatement, along with your Witness Statement, received on 19 February 2024. Upon review, it appears that information as to why your TM8N and counterstatement was filed late is on the Witness Statement and covering email.

A Witness Statement should be headed up to refer to the registration and proceedings number and the details of the parties, provide the details of the person making the statement, contain a statement of truth and be signed and dated. An example of a witness statement can be found on our website at <https://www.gov.uk/government/publications/filing-evidence-about-an-application-or-in-tribunal-proceedings>. It is not appropriate to have information on a covering email and not in the correct format.

A period of 14 days from the date of this letter, that is on or before **05 March 2024** has therefore been allowed for you to file a witness statement." [Original emphasis]

12. On the same day, the Registry wrote to the CA in the following terms:

"Please find enclosed a copy of the late filed TM8N and witness statement filed by the above proprietor.

Please note that the TM8N will not be examined until the issue of filing out of time has been resolved."

13. On 3 March 2024, a Form TM8N was filed by the RP, together with a Witness Statement by Mr Sarfraz Muneer, dated 3 March 2024, accompanied by an email in the following terms:

“Further to our Phone conversation [to the examiner],  
Please find enclosed

1. TM8N Foam [sic] (Duly signed)
2. Witness Statement

Please let me know if you need any more information.” [My words in parentheses].

14. I note the following from Mr Muneer’s Witness Statement of 3 March 2024:

“3. Further to my phone call with [the casework examiner] and As [sic] explained that 3 out of my 4 kids were sick, due to a bug, me and my family was [sic] very much upset, and my full concentration was on my family. I was totally out of my mind regarding this case.

Above mentioned reason is true [sic] and factual reason, [sic] you can check case history, [sic] in past I always replied within the time frame and I assure you this won’t happen again.”

15. On 18 April 2024, the Registry wrote to the RP in the following terms:

“The official letter dated 17 February 2024 advised of the preliminary view to revoke the registration following no filing of a Form TM8(N) and counterstatement. You were invited to request a hearing on or before 26 February 2024 if you disagreed with the preliminary view. You were also advised that it must be accompanied by a Witness Statement setting out the reasons as to why the TM8 and counterstatement are being filed outside of the prescribed period.

Upon review of the case, it has been noted that the letter referred to the incorrect form. The cancellation action filed against your registration was an invalidation action, and the correct form is a Form TM8, **not** a Form TM8(N). As no TM8 and counterstatement have been filed within the time period set, Rule 41(6) applies. Rule 41(6) states that:

“...otherwise the registrar may treat the proprietor as not opposing the application and registration of the mark shall, unless the registrar otherwise directs, be declared invalid.”

The registry is minded to treat the proprietor as not opposing the application for invalidation and declare the registration as invalid as no defence has been filed within the prescribed period.

If you disagree with the preliminary view, a final period of 14 days from the date of this letter, that being on or before **02 May 2024**, is provided in which you **must** provide full written reasons and request a hearing. This **must** be accompanied by a Witness Statement setting out the reasons as to why the TM8 and counterstatement are being filed outside of the prescribed period, or confirmation if the Witness Statement sent to the Tribunal Section on 20 February 2024 is to be considered. The Form TM8 and counterstatement you wish you [sic] be admitted to proceedings should also be included.

If no response is received the registry will proceed to issue an undefended decision on the issue of failure to comply with the Rules governing the filing of a defence.”

16. On 2 May 2024, the RP filed a Form TM33<sup>2</sup>, together with a Form TM8<sup>3</sup>, and Witness Statement from Mr Muneer, dated 30 April 2024, accompanied by an email in which it was confirmed that Indelible IP Limited had been appointed as the RP’s legal representative. I note the following from Mr Muneer’s Witness Statement:

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<sup>2</sup> Appointment or change of representative for TM owner.

<sup>3</sup> Notice of defence and counterstatement

- “2. I received the notification from the UK Intellectual Property Office (“UKIPO”) that a cancellation application number CA000506113 (“the Cancellation”) by the Cancellation Applicant had finally been admitted after much correspondence and that I had a deadline to respond. [sic]
3. If you check the case history, from day one, I have always promptly responded in time to all correspondence from the UKIPO and it is only through my focus, because 3 out of my 4 kids were ill and as a dedicated father my priority was my family. As a result, my focus was diverted from my business and the need to respond to the correspondence from the UKIPO. February 2024 deadline was missed.
4. As stated above, I am the father of four children, three of whom, aged 12, 9 and 4, became very ill during January 2024 and through into early February. My 12 year old went to hospital once, whilst my 4 year old was treated by our GP with prescriptions from the pharmacy. However, my 9 year old had suffered very seriously with the viral infection that has affected all three children. In the end he went to hospital four times, two of those by ambulance, due to chest pains and difficulty breathing. As you can imagine this was a very stressful time and my focus was entirely on the wellbeing of my children.
5. As we moved further into February matters eased and my children thankfully started to recover. At that time I received notification from the UKIPO on 17 February 2024 that I had missed the deadline of 5 February 2024. Concerned that I needed to defend my trade mark I promptly undertook the action I understood to be necessary and filed what I believed to be the correct paperwork on 19 February 2024. I was then sent a further letter dated 20 February suggesting that a different form was needed, and I also promptly completed this. When I then received a further letter on 18 April 2024, what was needed had become so unclear that I reached out to CITMA and now Indelible IP Limited to assist me on this matter.

6. I have always promptly responded to all correspondence from the UKIPO and it is only through focus, as a dedicated father, on the serious illness of my children that the 5 February 2024 deadline was missed. As soon as the missed deadline became apparent I promptly submitted what I believed to be the correct paperwork, and have continued to engage with the UKIPO to try and resolve the matter meeting all deadlines set.”

17. On 22 May 2024, the Registry wrote to the RP in the following terms:

“I acknowledge receipt of your correspondence dated 02 May 2024, including:

- a Form TM8 (notice of defence and counterstatement)
- a witness statement providing information as to why the form was filed late and requesting that the registry admit the defence into the proceedings.

The Registry’s letter dated 05 December 2024 emphasised that the deadline date for filing of a Form TM8 in these proceedings was 05 February 2024. The same letter also made clear that if the deadline date is missed at all, then in almost all circumstances, the application will be treated as abandoned.

Trade mark appeal authorities have established that it is only in cases where there are “extenuating circumstances”, or “compelling reasons” that the Registrar is able to exercise his discretion to admit into proceedings a Form TM8 filed outside the stipulated period. I draw your attention in particular to the appeal decisions in *Kix*: BL Number O/035/11 and *Mercury*: BL Number O/050/12, which provide further guidance on this type of issue. Those decisions can be found on the IPO website <https://www.ipo.gov.uk/t-challenge-decision-results.htm>.

After careful consideration of the contents of the papers you have provided, it is the **preliminary view** of the Registrar that the reasons given are not sufficient to exercise his limited discretion and admit a late filed Form TM8 into these

proceedings. Therefore **the Registrar's preliminary view is that this application is to be treated as abandoned.**

**If [sic] is noted a CMC was requested on your email dated 02 May 2024. This will take place on Wednesday 05 June at 10:30."**

18. All of the above-mentioned official letters from the Registry were sent to both parties.

19. On 23 May 2024, email correspondence was received by the Registry from Indelible IP Ltd confirming that it no longer represented Mr Muneer and that he would be representing himself.

## **THE HEARING**

20. A joint hearing took place before me, by telephone conference, on Wednesday 5 June 2024. The RP attended in person. Mr Muhammed Nadeem, of Lincoln Solicitors, attended on behalf of the CA. Both parties filed written submissions in advance of the hearing.

21. The essence of the RP's submission was that three of his four children were very ill with a viral infection at the start of 2024, and that his youngest son became seriously ill with breathing difficulties, necessitating two emergency ambulance trips; some time in the final week of January and the first week of February. The RP explained that his attention was therefore diverted from the matter of the late Form TM8 because his focus had been on his family. When I asked Mr Muneer to clarify the particular dates when the ambulances were called, he was unable to cite specific dates. I invited Mr Muneer to provide more detail, in his own words, about precisely why he was prevented from filing the Form TM8 within the prescribed deadline, but he did not elaborate. The RP further submitted that he considered that it would be unfair to refuse his Form TM8 when the CA had had several opportunities to file a correct Form TM26I.

22. The main thrust of Mr Nadeem’s submission was that the explanation provided by the RP for the late filing of his Form TM8 was insufficient to justify exercise of the Registrar’s discretion. He argued that to allow the RP’s late-filed Form TM8 to be examined would be procedurally unfair and cause undue prejudice to the CA given that the CA had complied with the statutory requirements.

23. I will address the parties’ particular submissions in so far as they relate to the relevant factors that I must consider when making my decision, below at [29] – [36].

## **DECISION**

24. The filing of a Form TM8(N) and counterstatement in revocation proceedings is governed by rule 38 of the Trade Marks Rules 2008 (‘the Rules’). The relevant parts read as follows:

“(3) The proprietor shall, within two months of the date on which he was sent a copy of Form TM26(N) by the registrar, file a Form TM8(N), which shall include a counter-statement.

(4) [...]

(5) [...]

(6) Where the proprietor fails to file a Form TM8(N) within the period specified in paragraph (3) the registration of the mark shall, unless the registrar directs otherwise, be revoked.”

25. 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-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.”

26. While it is noted that the Registry, in its letter of 17 February 2024, erroneously referred to a Form ‘TM8N’ when it should have referred to a Form ‘TM8’, it is my view that this administrative oversight ultimately made no material difference to the circumstances of the RP’s late-filing of its Form TM8. This is because, at the time when the prescribed deadline of 5 February 2024 had passed, the RP had not filed *anything* by way of a Defence and would have been oblivious to the aforementioned administrative oversight anyway. If the RP *had* filed the erroneously-mentioned Form TM8N within the prescribed deadline, although this would have been the incorrect form, the Registry, in those circumstances, would have had the discretion to simply explain that the incorrect form had been requested and invite the RP re-file its Defence in the Form TM8. Provided that the Form TM8 was admissible, the Registry would have been able to extrapolate the filing date of the Form TM8N to the subsequently filed Form TM8. I am satisfied that the Registry’s error was not the cause of the RP missing the prescribed deadline. Consequently, the only basis upon which the RP may be allowed to defend the invalidation proceedings is if I exercise in the RP’s favour the discretion afforded to me by the use of the words ‘unless the registrar otherwise directs’ in Rule 18(2).

27. In making my assessment as to whether to exercise my discretion to allow the defence to be considered in the instant case, I will take into account the decisions 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) i.e. I must be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the RP’s favour.

28. 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;

29. As noted above, the Form TM26I was served on the RP on 5 December 2023 by both physical post and email. There has been no suggestion from the RP that this correspondence was not received. Further, I note that prior to the Form TM26I being served upon the RP, the series of official letters sent by the Registry to the CA regarding its four previously-filed defective Forms TM26I, were also sent to the RP. The first Form TM26I filed, on 17 May 2023, indicated that the RP had been notified of the impending proceedings against him on 3 May 2023.

30. The reason cited by the RP for the late-filing of his Form TM8 is that his children were very ill, one of whom was so seriously unwell that he was transported to hospital by emergency ambulance on two occasions; on a date in the final week of January 2024 and on another date in the first week of February 2024. The RP was unable to refine the dates any further and did not elaborate on what, in practical terms, prevented him from filing the Form TM8 on or before 5 February 2024. For example, he offered no information on the duration of his son's illness nor did he elaborate on the precise obstacles preventing him from observing the prescribed deadline.

31. The RP filed his Form TM8(N) on 20 February 2024, 15 days after the deadline set by the Registry. As noted above at [26], the fact that the incorrect form was filed is immaterial to the matter.

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

32. The application for a declaration to declare the RP's registration UK00003830642 to be invalid is based upon sections 47(1), 47(2)(a) and 47(2)(b) of the Act. The CA seeks to rely upon two earlier registrations and one earlier unregistered right. If the late-filed Form TM8 were to be allowed to proceed to examination and subsequently be admitted into proceedings, then the CA would be required to adduce evidence in support of its section 47(2)(b) claim. While it is not for me to consider the merits of the substantive claim in the present hearing, there is nothing to suggest that it is without merit.

The consequences of treating the RP as defending or not defending the request for invalidation:

33. If the RP is allowed to defend the invalidation action against it, the proceedings will continue with the parties given an opportunity to file evidence and the matter will be determined on its merits.

34. If, however, the RP is not allowed to defend the invalidation action, the registration:

- will be declared invalid in respect of the contested terms, i.e. deemed never to have been registered in the first place;
- will be allowed to remain on the register in respect of the uncontested terms only.

Any prejudice caused to the CA by the delay

35. Mr Nadeem submitted that the CA had been prejudiced by the delay in the RP filing his Form TM8, although he did not elaborate. However, I recognise that it is often the case in litigation that delays result in ongoing costs and continuing legal uncertainty.

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. In reaching my decision, as noted above, I recognise that if the discretion is not exercised in the RP's favour, the invalidation action will succeed in its entirety and the RP's mark will be deemed never to have been registered for the contested terms, registration remaining only for the uncontested terms. Further, I recognise that the RP may file another application for the same mark, which may, in turn, be contested by the CA (or another party). However, the loss of part of the RP's registration and the possibility of further proceedings are often the consequences of a failure to comply with the non-extensible deadline to file a Form TM8. Therefore, these factors are not, in my view, particularly compelling.

38. I have considered the submissions of both parties carefully. While I have sympathy for the RP given the difficulties that he has experienced in his family life, it is my view that the reasons provided for the late-filing of the Form TM8 do not amount to 'exceptional circumstances' or 'compelling reasons' to justify the exercise of my discretion in the RP's favour. I have no doubt that dealing with the serious illness of one's children must be very stressful. However, it is my view that, based on the information provided to me by the RP, and in the absence of any detail as to the particular dates when his difficulties arose, the duration of those difficulties and an explanation of how he was prevented from observing the prescribed deadline, the RP has failed to demonstrate exceptional circumstances or provide compelling reasons.

## **Outcome**

39. In the light of the foregoing, it is my view that it would be inappropriate for me to exercise the discretion available under Rule 18(2) in favour of the RP. Subject to any successful appeal, the preliminary view to refuse to admit the late filed TM8 and counterstatement is confirmed and registration UK00003830642 will be declared invalid for all contested terms, remaining registered for the uncontested terms only.

## Costs

40. Given that my decision terminates proceedings, I must consider the matter of costs. The CA 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	£300
Preparing for and attending the hearing of the matter of the late filing of a defence	£300
<b>Total</b>	<b>£800</b>

I have awarded a sum in respect of preparation for and attendance at the hearing below the minimum threshold because the CA's written submissions were brief (and not strictly required).

41. I therefore order Mr Sarfraz Muneer to pay to Mr Naeem Rasool the sum of £800 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 19<sup>th</sup> day of June 2024**

**N. R. MORRIS**

**For the Registrar**

**the Comptroller-General**