O/0619/26

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION UK00004062583

IN THE NAME OF ABDULWAHED BIN SHABIB DISTRIBUTION

FOR THE TRADE MARK:

IN CLASS 18

AND

THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO UNDER NUMBER 510022 BY SAMSONITE IP HOLDINGS S.A R.L.

AND

THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT IN DEFENCE THEREOF

BACKGROUND

1. UK trade mark number 4062583, shown on the front cover of this decision, ('the Contested Mark') stands registered in the name Abdulwahed Bin Shabib Distribution, the Registered Proprietor ('the RP'). It has a filing date of 12 June 2024 and achieved registration on 11 October 2024. The Contested Mark stands registered for the following goods:

Class 18: *Leather and imitations of leather, and goods made of these materials, namely bags for campers, bags for climbers, bags for sports, beach bags, briefcases, garment bags for travel, handbags, net bags for shopping, nose bags (feed bags), purses, re-usable shopping bags, rucksacks/backpacks, school bags, school satchels, sling bags for carrying infants, slings for carrying infants, suitcase handles, tool bags (empty), travelling bags, travelling sets (leatherware), travelling trunks, valises, wheeled shopping bags, suitcases with wheels, suitcases; animal skins; hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.*

2. On 15 January 2026, Samsonite IP Holdings S.a.r.l., the Cancellation Applicant ('the CA') applied to have the Contested Mark declared invalid pursuant to sections 47, 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 ('the Act'). I note that the application was filed without notice.[1,2]

3. All grounds of the invalidation are directed to the Contested Mark in its entirety. For the section 5(2)(b) and 5(3) grounds of the opposition, the CA seeks to rely upon two earlier registrations:[3] UK00912463576 and UK00913610233. Both earlier

[1] No invalidation notification date has been provided at part 6 of the Form TM16(I) Application to declare invalid a registration or a protected international trade mark.
[2] The CA made two attempts to file its application, with the second version deemed admissible.
[3] Both earlier registrations are comparable marks pursuant to Article 54 of the Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community (2019/C 384 I/01), also known as the 'Withdrawal Agreement', based on EUTMs which were registered prior to the withdrawal of the UK from the European Union.

registrations are subject to the proof of use provisions.[4] For the section 5(4)(a) claim, the CA seeks to rely upon its unregistered rights in the two signs of which the aforesaid earlier registrations consist, respectively:

AMERICAN TOURISTER

and

AMERICAN
TOURISTER

4. The extent to which the earlier rights are relied upon for the relative grounds of the invalidation are set out at **Annex 1** to this decision.

5. For the section 3(6) ground of invalidation, the CA claims that the RP obtained the Contested Registration in bad faith ‘as the owner’s conduct is dishonest or otherwise falls short of the standards of acceptable commercial behaviour judged by ordinary standards of honest people.’[5] It claims that the RP has used the CA’s AMERICAN TOURISTER mark on its website to promote the sale of luggage and travel bags, which are part of the CA’s core business offering.[6]

6. On 2 February 2026, the Registry served the Form TM26(I) on the RP by post and email at the addresses (both physical and email) provided by them. The letter contained the following paragraphs:[7]

> ‘[…]
>
> **<u>Your options</u>**

[4] Section 6A of the Act.
[5] CA’s Form TM26(I) Application to declare invalid a registration or a protected international trade mark, continuation sheet [5].
[6] As above.
[7] A copy of the letter was also sent to the CA.

1. Defend your registration

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 **02 April 2026.**

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

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 in accordance with Rule 41(6) of the trade mark Rules 2008:

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

[…]'

[original emphasis].

7. No Form TM8 was filed by the RP on or before 2 April 2026. On 17 April 2026, the Registry wrote to the RP, by post and email, in the following terms:[8]

'Our letter dated 02 February 2026 invited the owner to file a Form TM8 and counter-statement on or before 02 April 2026.

As no TM8 and counterstatement have been filed within the time period set, Rule 41(6) applies. Rule 41(6) states that:

"The proprietor shall, within two months of the date on which a copy of

[8] A copy of the letter was also sent to the CA.

Form TM26(I) and the statement was sent by the registrar, file a Form TM8, which shall include a counter-statement, 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."

It is our preliminary view to treat the proprietor as not opposing the application for invalidation and to declare the registration invalid 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, **01 May 2026.**

If no response is received by this date, we will issue a written decision, declaring the registration invalid (to the extent that the application for invalidation has been made) because of the failure to file a defence.'

[original emphasis].

8. On 29 April 2026, the RP filed a Form TM8,[9] together with the Witness Statement of Mr Abdulwahed Ahmad Rashed Bin Shabib, founder and owner of the RP company, dated 29 April 2026. As to the proposed defence: the RP denies the claim against it in its entirety and puts the CA to proof in respect of all aspects thereof.

9. The relevant parts of Mr Bin Shabib's Witness Statement are reproduced here:[10]

'[5] On 28 February 2026 the USA launched airstrikes on Iran, resulting in the death of the Iranian Supreme Leader Ayatollah Ali Khamenei and many other senior political and military leaders. This led to a series of retaliatory attacks by

[9] Notice of defence and counterstatement.
[10] Witness Statement of A.A.R. Bin Shabib, [5] to [10].

Iran, mainly by way of missile and drone strikes targeting many countries in the middle east, including Dubai and Abu Dhabi.

[6] As a result of these attacks, Dubai and the UAE were affected by heightened regional tensions and security-related developments, which had a direct and material impact on normal business operations.

[7] This resulted in widespread and significant operational disruption across multiple sectors, which led to the temporary closure of major attractions and business districts. Remote working guidance was issued for employees following restrictions on access to offices and reduced operational capacity.

[8] During this period of military attack, a substantial portion of commercial activity in the region was either partially or fully suspended or significantly slowed down. This included disruptions to supply chains, business transactions and routine corporate operations. In addition, air traffic and flight schedules were affected, which further complicated coordination with clients, foreign associates, and relevant authorities across different jurisdictions.

[9] Whilst UAE Government and relevant authorities introduced various business continuity measures – such as remote working arrangements and work-from-home policies to ensure operational resilience – these measures, although helpful, required reliance on remote coordination. This inevitably affected the daily ability to process, review, and submit time-sensitive filings in the usual timely manner, particularly where multi-party approvals and cross-border coordination were required.

[10] In light of the above, we respectfully submit that the delay in filing the TM8 and counterstatement was caused by exceptional circumstances outside of our control. We ask that this be taken into consideration when considering whether to accept the late filing of our TM8 and counterstatement.'

10. On 7 May 2026, the Registry wrote to the parties giving the Preliminary View that, after consideration of the information provided by the RP, and review of the case,

it was proposed to allow the late-filed Form TM8 to proceed to be examined to determine its admissibility. A deadline of 21 May 2026 was set for either party to disagree with the Preliminary View and request a hearing. The letter concluded with the following: '**If no response is received within the time allowed, the preliminary view will automatically be confirmed and the TM8 will be examined.**' [original emphasis]

11. On 21 May 2026, the CA notified the Registry of its objection to the aforesaid Preliminary View and requested a hearing on the matter. In addition, the CA appended a letter requesting an order for Security for Costs against the RP in the sum of £4,250.

<u>The CA's request for Security or Costs</u>

12. In the instant case, the matter of Security for Costs will only arise if the Registrar exercises his discretion to allow the RP's late-filed Form TM8 to be accepted for examination. I will, therefore, defer the consideration of the CA's application for Security for Costs until I have determined the matter of the late-filed Form TM8.

THE HEARING

13. A joint hearing took place before me, by telephone conference, on 16 June 2026. Both parties attended. Mr James Appleyard, of HGF Limited, appeared for the CA; and Ms Gail Nicol, of Lincoln IP, appeared for the RP. Both parties filed Skeleton Arguments in advance of the hearing.

14. Mr Appleyard's submissions can be summarised as follows:

(i) The essence of the CA's argument is that:

- whilst the USA's military attacks on Iran were impactful on a global scale, the RP had, on its own account, acknowledged that the UAE authorities had put in place alternative working arrangements such as remote working;[11]

and

- 'it is not conceivable that the [RP] would have been unable to communicate by email or even telephone to provide instructions to prepare and file the TM8 and counterstatement by the original deadline'.[12]

(ii) It was further submitted that the RP had a UK-based representative which would have been well-placed to file a Form TM8 and counterstatement to preserve the RP's position in case of difficulty in communicating with its client.[13]

(iii) It was submitted that it could be demonstrated that the RP was conducting normal business operations between 28 February and 2 April 2026 by way of:[14]

in-person walk-in hiring events at the RP's office in Dubai on 15 and 29 March 2026;

and

a further in-person hiring event on 6 April 2026, which, although post-dating the 2 April 2026 deadline, would likely have required preparation.[15]

(iv) Mr Appleyard also made the point that the RP 'was aware of the Cancellation Action from at least 2 February 2026' and queried the

[11] CA's Skeleton Argument, [17]
[12] As above, [19].
[13] CA's Skeleton Argument, [20].
[14] At the hearing, I directed the CA to file a Witness Statement setting out these details; this is discussed later in this decision.
[15] CA's Skeleton Argument, [21].

pleadings on 9 February 2026.[16] He has suggested that this shows that the RP had ample time to prepare and file the Form TM8 before the military attack on Iran.[17]

15. It is appropriate to address (ii) and (iv) at this point in my decision. As to (ii), I respectfully reject this argument on the basis that it would be improper for a legal representative to simply file a Form TM8 on behalf of its client without having been first instructed to do so. This submission need not be addressed any further.

16. I now consider (iv). A party against whom an admissible invalidation action has been instituted is given a period of two months in which to file a Form TM8. It does not matter how close to the deadline the Form TM8 is filed, if the deadline is met. Mr Appleyard's argument seems to be an invitation to criticise a party for possibly electing to prepare a Form TM8 later in the two-month period rather than sooner. In my view, the fact that the RP sought clarification of the CA's pleading on 9 February 2026 is immaterial to the question of why the deadline was missed, and I shall say no more about it.

17. Ms Nicol's submissions can be summarised as follows:

- that, despite the alternative arrangements put in place for businesses in the UAE due to the military strikes, the RP's business was not functioning to its full capacity. Although some manufacturing activities continued, regular office operations were suspended, and the legal department was not fully operational;

- that the military strikes were such a global event that they had been chronicled to a worldwide extent;

[16] As above, [18].
[17] CA's Skeleton Argument, [18].

- that the RP's representative did not have direct contact with the RP but received instructions via 'a local firm of attorneys based in Dubai, who would likely have been similarly affected by the military attacks';[18]

  and

- Ms Nicol clarified that the 'walk-in' events to which Mr Appleyard had referred in his Skeleton Argument had been organised well in advance of the military strikes.

18. I propose to address the parties' arguments more particularly as I consider the relevant factors set out at [27] to [41].

19. At the end of the hearing, I directed the CA to set out its account of the RP's alleged 'walk-in' events, said to have occurred in March and April 2026, in the form of a Witness Statement, to be filed by 4pm on 22 June 2026.

POST-HEARING

20. On 18 June 2026, the CA filed the Witness Statement of James Richard Appleyard, of the CA's representative, accompanied by exhibits JRA1 and JRA2. I will refer to these to the extent necessary in my decision.

DECISION

21. The filing of a Form TM8 and counterstatement in invalidation proceedings is governed by Rule 41(6) of the Trade Marks Rules 2008 ('the Rules'). The relevant parts read as follows:

   > '(6) The proprietor shall, within two months of the date on which a copy of Form TM26(I) and the statement was sent by the registrar, file a Form TM8, which shall include a counter-statement, otherwise the registrar may treat the

[18] RP's Skeleton Argument, [11].

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

22. The combined effect of rules 77(1), 77(5) and Schedule 1 of the Rules means that the time limit in Rule 41(6) 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.'

23. There is no suggestion that there has been an irregularity on the part of the Tribunal. Consequently, the only basis upon which the RP may be allowed to defend the cancellation 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 41(6).

24. Mr Appleyard drew my attention to the *TESCON*[19] case, from which I note the following dicta of Mr Hobbs Q.C. (as he then was), sitting as the Appointed Person:

'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

[19] Decision BLO 0/240/20.

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].

25. In making my assessment as to whether to exercise my discretion to admit the RP's defence 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.

26. 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;

27. By way of a general observation on Mr Bin Shabib's Witness Statement, I note that it is couched entirely in general terms without a single mention of how the events, said to have prevented the timely filing of the Form TM8, actually affected the RP's business. By way of an example, one of the narrative statements reads 'During this period of military attack, a substantial portion of commercial activity in the region was partially or fully suspended or significantly slowed down'.[20] The following narrative statement strikes me as the most particularised detail provided, although it is still expressed in very general terms:[21]

[20] Witness Statement of A.A.R. Bin Shabib, [8].
[21] As above, [9].

‘[9] Whilst the UAE Government and relevant authorities introduced various business continuity measures – such as remote working arrangements and work-from-home policies to ensure operational resilience – these measures, although helpful, required reliance on remote coordination. This inevitably affected the ability to process, review, and submit time-sensitive filings in the usual and timely manner, particularly where multi-party approvals and cross-border coordination were required.’
[my underlining]

28. I bear in mind that Ms Nicol has tried, as best she can, to further particularise the effect of the military strikes on the RP’s business. Ms Nicol’s oral submission that the RP was only maintaining essential functions, to my mind, indicates that the RP must have made a decision that certain activities were more important than others and should, therefore, be maintained. In my view, the RP’s decision to suspend regular office operations with the consequence that the legal department was not fully operational, indicates that appropriate priority was not given to the protection of its intellectual property rights at this time. With the availability of remote working arrangements, the electronic preparation and filing of the Form TM8 by the due date should have been possible.

29. On the matter of the ‘walk-in’ interview event, raised by Mr Appleyard, the CA has provided an excerpt from the website ‘Cazajobz’ featuring a number of listings for sales-related roles with the RP, with walk-in interviews scheduled for Sunday 15 March 2026 between 10AM and 1PM.[22] A screenshot of an ‘Instagram’ post promoting the aforesaid event has also been provided.[23]

30. The Form TM8 was filed on 29 April 2026, some 27 days after the statutory deadline of 2 April 2026.

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

[22] Witness Statement of J. R. Appleyard, [4]; Exhibit JRA1.
[23] As above.

31. The invalidation action is based on sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Act. The CA seeks to rely upon two earlier registrations for its 5(2)(b) and 5(3) grounds. Should the invalidation action proceed, then the CA would be required to adduce evidence to substantiate its claims of, respectively, genuine use, reputation, goodwill, and bad faith.

32. Whilst it is not for the present decision to determine the merits of the substantive claim, it is sufficient to note for the purposes of the criteria under consideration that there is an arguable case to be determined.

<u>The consequences of treating the RP as defending or not defending the invalidation;</u>

33. If the RP is allowed to defend the invalidation action, the proceedings will continue with the parties given an opportunity to file evidence and the matter will be determined on its merits. Furthermore, it will be necessary for me to determine the CA's application for Security for Costs against the RP.

34. If, however, the RP is not allowed to defend the action against it, the RP will lose the filing date of the registration, and the registration will be declared invalid in its entirety and deemed never to have been made. It will remain open to the RP to re-file an application for its mark, which may, in turn, be opposed by the CA (or another party), with the inevitable adverse commercial and financial consequences of losing a trade mark registration. The CA's application for Security for Costs will fall away.

<u>Any prejudice caused to the CA by the delay</u>

35. Mr Appleyard submitted that the delay in filing the Form TM8 had caused the CA difficulty in allocating its time and resources, due to the uncertainty over whether the instant case would be defended.[24] Whilst this is noted, it is difficult to see how the CA's period of uncertainty *after* 2 April 2026 would have been any different

[24] CA's Skeleton Argument, [28].

from the necessary uncertainty experienced up to the point when a *timely* defence is filed, which could be any time within a two-month window.

36. I nevertheless recognise that it is typically the case in legal proceedings that any delay will cause some level of prejudice to the other party in terms of costs.

<u>Any other relevant considerations such as the existence of related proceedings between the parties</u>

37. The CA has identified a selection of cases involving the same parties.[25] I note these in the following table:[26]

<table>
<tr><td>Case details:</td><td>Status/other matters of note:</td></tr>
<tr><td>Opposition OP450610 against UK4073465</td><td>In the absence of a defence being filed, the contested application was deemed undefended, and subsequently withdrawn pursuant to Rule 18(2).</td></tr>
<tr><td>Opposition OP447424 against UK4014275</td><td>Application UK4014275 was refused registration following third party observations concerning use of State emblems.</td></tr>
<tr><td>Opposition OP447432 against UK4014271</td><td>Evidence rounds have concluded and the case is awaiting listing for a hearing.</td></tr>
<tr><td>Opposition OP449897 against UK4062562</td><td rowspan="2">For each of these oppositions, the substantive case has been heard, and respective decisions will be issued in due course.</td></tr>
<tr><td>Opposition OP450339 against UK4062562</td></tr>
</table>

38. Of the cases listed above, two have been disposed of, and a further two are awaiting decisions after substantive hearings. Only OP447432 is pending.

[25] CA's Skeleton Argument, [27] and [29].
[26] As at the time of drafting this decision.

39. Mr Appleyard has made no mention in his Skeleton Argument of what relevance, if any, the above proceedings have to the instant matter of the late-filed Form TM8. In his oral submissions, he suggested that the CA had had ample opportunity to file its Form TM8 in time because it could have simply adapted its Form TM8 filed in respect of OP450339. I do not find this argument to be particularly helpful given that OP450339 is based on different earlier rights and concerns a different contested specification.

40. Whilst case OP447432 (awaiting listing for a hearing) involves reliance on the same earlier rights as the instant case, the opposed mark and its specification are different. Furthermore, OP447432 is at a very late stage. Should the late-filed Form TM8 for the instant case be accepted, the cases would unlikely be consolidated.

Conclusions

41. In reaching my decision, as noted above, I recognise that if the discretion is not exercised in the RP's favour, the RP will be treated as not opposing the invalidation action, and the registration of the Contested Mark shall be declared invalid. I recognise that this is a serious consequence. I further recognise that it may be the case that the RP may simply re-file an application for its mark and that this may be opposed by the CA (or another party) in proceedings arising at some time in the future. However, as the invalidation of the registration and possibility of further proceedings, on much the same basis, is often the consequence of a failure to comply with the non-extensible deadline to file a Form TM8, these are not factors that, in my view, are particularly compelling.

42. Having considered the RP's Witness Statement and submissions, I am not satisfied that the RP has demonstrated that the failure to meet the prescribed deadline was *caused* by the events described. Whilst I fully accept Mr Bin Shabib's account of the general and widespread disruption to businesses in the UAE, no detail is included to say *how* the events affected the RP's business in particular. Mr Bin Shabib has stated that remote working was one of the measures imposed by the UAE Government. However, the RP has not explained how this restriction affected its ability to file its Form TM8 in time. The argument that remote working

arrangements somehow hampered the ability 'to process, review and submit time-sensitive filings in the usual timely manner, particularly where multi-party approvals and cross-border coordination were required',[27] is not particularly compelling. The vast majority of legal documents in proceedings before this Tribunal are prepared and submitted electronically; and it is difficult to see how a remote working policy might have prevented the RP from liaising with its UK-based representative in preparing and filing its Form TM8 on time.

43. Furthermore, Ms Nicol's oral submission that the RP had scaled down its activity by, for example, suspending regular office operations with the consequence that its legal department was not fully operational, to my mind, demonstrates a decision by the RP to prioritise certain activities over others. The RP was clearly able to operate on some level, but, apparently, chose not to direct resources to the matter of the invalidation claim against it.

44. I agree with Mr Appleyard that the *TESCON*[28] case is apposite here. The generality of the RP's explanation, in my view, renders it insufficiently clear and precise to enable me to conclude that the events described caused the deadline to be missed.

45. Having carefully considered all of the circumstances of the case, I am not satisfied that the RP's evidence is sufficient to demonstrate extenuating circumstances or compelling reasons that prevented compliance with the 2 April 2026 deadline. My view is that it would, therefore, be inappropriate for me to exercise the very limited discretion afforded to me to admit the late-filed Form TM8 into these proceedings.

Outcome

46. My decision is not to exercise the discretion available under Rule 41(6) in favour of the RP. It is, therefore, not necessary for me to consider the CA's application for Security for Costs against the RP. Subject to appeal, the invalidation action against

[27] Witness Statement of A.A.R. Bin Shabib, [9].
[28] Decision BLO 0/240/20 ('TESCON'), [32].

UK00004062583 will be deemed undefended, and the aforesaid registration will be declared invalid and deemed never to have been registered.

Costs

47. The invalidation action was instituted without notice. The following paragraph of Tribunal Practice Notice ('TPN') 1/2023 makes it clear that costs are not ordinarily awarded against a party against whom a claim is instituted if the late-filed Form TM8 is refused and the claim, therefore, deemed undefended:

> '**Costs in undefended actions**
> 7. Unless factors exist which suggest otherwise, costs will not be awarded against parties who do not defend an action which has been brought against them without prior notice. It should be noted that in trade mark proceedings, the filing of a Form TM7A will usually be considered as giving the trade mark applicant prior notice.
>
> 8. If a case is withdrawn after it has been defended, costs will continue to be assessed up until the point of that withdrawal.'

48. Consequently, I make no order for costs.

Dated this 17th day of July 2026

N. R. MORRIS
For the Registrar
Comptroller-General

Annex 1 – Earlier rights sought to be relied upon for the grounds of invalidation pursuant to section 47 and based on 5(2)(b), 5(3) and 5(4)(a) of the Act.

The 5(2)(b) claim

Earlier registration (1):

UK00912463576 AMERICAN TOURISTER Filing date: 23 December 2013 Date of entry in register: 1 August 2014 Registered for the following goods and services, those relied upon underlined: Class 9: *Carrying cases, protective sleeves, protective cases, holders, and stands for portable electronic devices, portable computers, laptop computers, handheld computers, tablet computers, cellular telephones, personal data assistants, portable global positioning systems, satellite-aided navigation systems, MP3 players, and music players; rolling cases especially adapted for holding portable computers and laptop computers; bags and backpacks especially adapted for holding laptop computers and tablet computers; electric current wattage converters; electric current wattage adapters; electric current wattage converter and adapter sets; binoculars and binocular cases; eyewear; eyewear cases; carrying cases for photographic, video, and audio equipment; camera bags; neck and shoulder straps for photographic and video equipment; tripods for photographic and video equipment; battery-operated motion actuated theft alarms for luggage; scales; batteries and battery chargers; cell phone battery chargers; solar battery chargers; computer mouse; computer travel kits comprised of a USB hub, a key pad, a computer mouse, earphone, electronic memory card reader, and a zippered pouch; computer travel kits comprised of a USB hub, a computer mouse, and a USB cable; webcams.* Class 16:

Paper, cardboard; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); printers' type; printing blocks; lunch bags; agendas; diaries, pencils, pens, notebook cases, pocket secretaries, calendars, desk sets, passport holders, checkbook holders, checkbook cases, passport covers, passport cases, address books, stationery-type portfolios, money clips, pencil cases, expanding files made of fabric and plastic, packing paper, plastic bags for packing, writing pads, pen holders.

Class 18:

Leather and imitations of leather; animal skins and hides; parasols and walking sticks; whips, harness and saddlery; <u>luggage; all-purpose carrying bags; suitcases</u>; trunks [luggage]; <u>duffle bags; wheeled duffle bags; carry-on bags; sport bags; tote bags; traveling bags; rucksacks; knapsacks; valises;</u> book bags; school bags; <u>backpacks; backpacks with rolling wheels;</u> attaché cases; brief cases; messenger bags; boston bags; luggage straps; <u>luggage tags</u>; wallets; security pouches; billfolds; purses; change purses; clutch purses; <u>shoulder bags;</u> hand bags; credit card cases; key cases; waist packs; toiletry kits sold empty; toiletry organizers sold empty; <u>toiletry cases sold empty</u>; shaving kits sold empty; overnight cases; <u>cosmetic cases sold empty</u>; lingerie cases sold empty; leather key chains; clothing and jewelry organizers for travel; garment bags for travel; umbrellas; shoe bags primarily for travel; diaper bags; shoulder pads for luggage straps sold as a component of luggage; luggage inserts, namely, packing cubes; waterproof carry-all bags; travel gift sets, containing eye mask, ear plugs, neck pillow, and pouch of textile; travel gift sets containing eye mask and pouch of textile; pouches in the nature of purse organizers; fitted protective covers for luggage; drawstring pouches; luggage handles; telescopic handles; luggage wheels; belt bags; traveling sets (leather goods); finished linings for traveling bags and luggage.

Class 35:

Advertising, business management, and business administration; retail store services in respect of luggage, travel related items and accessories, bags, and *outdoor gear; online retail luggage store services in respect of luggage, travel related items and accessories, bags, and outdoor gear; franchising services, namely, offering business management assistance in the establishment and/or operation of retail luggage, travel accessory, bag and outdoor gear stores; customer loyalty services and customer club services, for commercial, promotional or advertising purposes; organization of exhibitions and trade fairs for business and promotional purposes.*

Class 41:
Education; providing of training; entertainment, sporting and cultural activities; arranging and conducting of contests; providing online computer games; providing electronic online, non-downloadable publications; publication of online publications and online brochures.

Earlier registration (2):

UK00913610233

AMERICAN
TOURISTER

Filing date: 29 December 2014
Date of entry in register: 6 May 2015
Registered for the following goods and services, those relied upon underlined:

Class 9:
Carrying cases, protective sleeves, protective cases, holders, and stands for portable electronic devices, portable computers, laptop computers, handheld computers, tablet computers, cellular telephones, personal data assistants, portable global positioning systems, satellite-aided navigation systems, MP3 players, and music players; rolling cases especially adapted for holding portable computers and laptop computers; bags and backpacks especially adapted for holding laptop computers and tablet computers; electric current wattage converters; electric current wattage adapters; electric current wattage converter and adapter sets; binoculars and binocular cases; eyewear; eyewear cases; carrying cases for photographic,

video, and audio equipment; camera bags; neck and shoulder straps for photographic and video equipment; tripods for photographic and video equipment; battery-operated motion actuated theft alarms for luggage; scales; batteries and battery chargers; cell phone battery chargers; solar battery chargers; computer mouse; computer travel kits comprised of a USB hub, a key pad, a computer mouse, earphone, electronic memory card reader, and a zippered pouch; computer travel kits comprised of a USB hub, a computer mouse, and a USB cable; webcams.

Class 18:

Leather and imitations of leather; animal skins and hides; parasols and walking sticks; whips, harness and saddlery; luggage; all-purpose carrying bags; suitcases; trunks [luggage]; duffle bags; wheeled duffle bags; carry-on bags; sport bags; tote bags; traveling bags; rucksacks; knapsacks; valises; book bags; school bags; backpacks; backpacks with rolling wheels; attaché cases; brief cases; messenger bags; boston bags; luggage straps; luggage tags; wallets; security pouches; billfolds; purses; change purses; clutch purses; shoulder bags; hand bags; credit card cases; key cases; waist packs; toiletry kits sold empty; toiletry organizers sold empty; toiletry cases sold empty; shaving kits sold empty; overnight cases; cosmetic cases sold empty; lingerie cases sold empty; clothing and jewelry organizers for travel; garment bags for travel; umbrellas; shoe bags primarily for travel; diaper bags; shoulder pads for luggage straps sold as a component of luggage; luggage inserts, namely, packing cubes; waterproof carry-all bags; travel gift sets containing pouch of textile; pouches in the nature of purse organizers; fitted protective covers for luggage; drawstring pouches; luggage handles; telescopic handles for luggage; luggage wheels; belt bags; traveling sets (leather goods); finished linings for traveling bags and luggage.

The 5(3) claim

For both earlier registrations (1) and (2), the CA claims a reputation for the class 18 goods underlined above, i.e. *luggage; all-purpose carrying bags; suitcases; duffle bags; wheeled duffle bags; carry-on bags; sport bags; tote bags; traveling bags; rucksacks; knapsacks; valises; backpacks; backpacks with rolling wheels; luggage tags; shoulder bags; toiletry cases sold empty; cosmetic cases sold empty*

The 5(4)(a) claim

The Opponent seeks to rely upon its unregistered rights in the following signs:

<table>
<tr><td>(1) AMERICAN TOURISTER

Date used: ‘at least as early as 2014’</td><td>(2)
AMERICAN
TOURISTER

Date used: ‘at least as early as 2019’</td></tr>
<tr><td colspan="2">The CA claims to have used each of these two signs in respect of the class 18 goods underlined above, i.e. luggage; all-purpose carrying bags; suitcases; duffle bags; wheeled duffle bags; carry-on bags; sport bags; tote bags; traveling bags; rucksacks; knapsacks; valises; backpacks; backpacks with rolling wheels; luggage tags; shoulder bags; toiletry cases sold empty; cosmetic cases sold empty</td></tr>
</table>