

O/0681/24

TRADE MARKS ACT 1994

IN THE MATTER OF A JOINT HEARING HELD IN RELATION TO
UK TRADE MARK NUMBER 3845660
REGISTERED IN THE NAME OF THE UNIVERSITY OF BOLTON
IN RESPECT OF THE FOLLOWING TRADE MARK:

Greater Manchester 
Business School

IN CLASSES 9, 16, 35, 41 AND 42

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NUMBER 506748
BY THE UNIVERSITY OF MANCHESTER

BACKGROUND AND PLEADINGS

1. Trade mark number UK00003845660 for the mark shown on the cover page of this decision (“the registration”) stands registered in the name of The University of Bolton (“the proprietor”). It has a filing date of 3 November 2022 and a registration date of 27 January 2023. The contested mark is registered for goods in Classes 9 and 16 and services in Classes 35, 41 and 42.

2. On 1 December 2023, The University of Manchester (“the applicant”) applied to have the registration declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”). In pursuit of the invalidation, the applicant relies on section 5(4)(a) of the Act.

3. On 20 December 2023, the Tribunal served the TM26(l) on the proprietor, by post (via Royal Mail’s “Signed for” service) and by email. The postal and email addresses used in the letter were those given by the proprietor in its application for the trade mark. The letter was returned by Royal Mail marked as “Address inaccessible”. The letter was reissued on 11 January 2024 via Royal Mail standard post (as well as by email) and the period allowed for the proprietor to file its Form TM8 (Notice of defence and counterstatement) (“TM8”) was reset. The deadline for the proprietor to file its TM8 was 11 March 2024, communicated by the Tribunal in the reissued serving letter.

4. The proprietor did not file a TM8 by the deadline and so, in an official letter dated 23 March 2024, sent by post and by email, the Tribunal advised both parties of its preliminary view to declare the registration invalid. Either party, if it disagreed with the preliminary view, was to provide full written reasons and request a hearing by 8 April 2024. The request, if made by the proprietor, was to be accompanied by a witness statement containing reasons for the late filing of the TM8.

5. The proprietor wrote to the Tribunal, by email, on 25 March 2024 expressing its surprise at having missed the TM8 deadline and notifying the Tribunal that the error would be “rectified forthwith”. The proprietor also notified the Tribunal of it having appointed Eversheds Sutherland LLP (“Eversheds”) as its representatives. The Tribunal replied, by email, on 3 April 2024 advising the proprietor to file a Form TM33

to appoint its representatives and reminding it of the deadline of 8 April 2024 (referred to in my paragraph 4, above).

6. On 8 April 2024, the proprietor filed a Form TM33, its TM8, written reasons for the late filing and the witness statement of Sue Duncan. The reason for the late filing is, essentially, that due to the sheer volume of active proceedings involving the proprietor (109 in total), when the proprietor sent the documentation relating to all 109 sets of proceedings to Eversheds (via the web-based file transfer service 'ZendTo'), the documentation relating to three invalidity applications (this one included) were inadvertently missed. This was known by neither the proprietor nor Eversheds until the Tribunal's correspondence of 23 March 2024.

7. In correspondence dated 15 May 2024, sent by email, the Tribunal issued an updated preliminary view to admit the late filed TM8 into the proceedings. The parties were given until 29 May 2024 to request a hearing if they disagreed. The applicant subsequently requested a hearing.

THE HEARING

8. The hearing took place before me on 24 June 2024. The proprietor was represented by Michael Bloch of Counsel, instructed by Eversheds. The applicant was represented by Lee Curtis of HGF Limited.

9. Whilst they have been carefully considered, I will not reproduce the entirety of the submissions that were made but will highlight those which are pertinent.

10. Mr Bloch referred to the multiple sets of proceedings involving the proprietor, and to the system put in place for managing the deadlines in each of them, including the TM8 deadlines. He confirmed that there was an error when uploading the case files for each set of proceedings to be sent to Eversheds, and that the documents relating to the invalidity applications did not upload, unbeknown to the proprietor and to Eversheds. In his submission, there is no real prejudice to the applicant in admitting the TM8, and the proceedings should be resolved on the merits of the case; on the other hand, the prejudice to the proprietor in not admitting the TM8 is that their mark

will be considered never to have existed. Finally, Mr Bloch referred to the narrow discretion afforded to me by Rule 18(2) (the equivalent Rule in invalidity proceedings is Rule 41(6)) but stressed that the circumstances in these proceedings constitute extenuating circumstances, on the basis of which I can exercise my discretion.

11. Mr Curtis pointed out that the proprietor is admitting that the invalidity application was filed and that they were aware of the TM8 deadline. He suggested that the circumstances constitute human error, and that the proprietor should have been diligent to ensure the correct documents were transferred to Eversheds. However, Mr Curtis submitted that this is not a case of one human error being made, but a series of errors, which do not constitute extenuating circumstances: the result being that I am unable to exercise my discretion to admit the late filed TM8. In regard to any prejudice, Mr Curtis submitted that the loss of priority is a natural consequence of missing the TM8 deadline and that it is open to the proprietor to re-file its trade mark application.

12. In reply, Mr Bloch agreed that the proprietor was aware of the invalidity application and the TM8 deadline, which is why, along with the other sets of proceedings, a system was put in place to manage effectively the entire caseload. Mr Bloch denied that the error was a human error, but rather an uploading error with the file transfer service. He submitted that the proprietor had put in place an appropriate system, which subsequently failed. He suggested that it is not proportionate to have to put in place an additional system for checking the first system. Mr Bloch reiterated that the circumstances in these proceedings are sufficient to allow me to exercise my discretion.

DECISION

Statutory provisions

13. The filing of a TM8 in invalidity proceedings is governed by Rule 41 of the Trade Marks Rules 2008 (“the Rules”). The relevant parts read as follows:

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

14. The combined effect of Rules 77(1), 77(5) and Schedule 1 of the Rules mean that the time limit in Rule 41, 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.”

15. There is no suggestion that there has been any irregularity on the part of the Tribunal and so I need not consider the provisions of Rule 77(5) further.

16. Rule 76 of the Rules relates to delays in communication services and states:

“76. (1) The registrar shall extend any time limit in these Rules where the registrar is satisfied that the failure to do something under these Rules was wholly or mainly attributed to a delay in, or failure of, a communication service.

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

(a) made after giving the parties such notice; and

(b) subject to such conditions,

as the registrar may direct.

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

17. I do not consider that there has been a failure in communication and so I need not consider the provisions of Rule 76 further.

18. Consequently, the only basis on which the proprietor may be allowed to defend the invalidity 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).

19. In approaching the exercise of discretion in these circumstances, I 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 proprietor’s favour.

20. 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.

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

21. The TM8 was due by 11 March 2024; it was received by the Tribunal on 8 April 2024. The deadline was, therefore, missed by 28 days. The reasons given were those discussed earlier in this decision, i.e., that the proprietor put in place a system to manage the 109 sets of proceedings and that, in transferring to Eversheds the documents for all proceedings, three sets of invalidity proceedings (this one included) were not uploaded to the file transfer service and the TM8 deadlines were subsequently missed.

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

22. The applicant relies upon grounds under section 5(4)(a) of the Act. Whilst the ground is reliant upon evidence, which has not yet been filed, there is nothing to suggest that the invalidity application is without merit.

The consequences of treating the proprietor as defending or not defending the invalidity application

23. If the proprietor is allowed to defend the invalidity application, the proceedings will continue with the parties given an opportunity to file evidence, and the matter will be determined on its merits.

24. If, however, the proprietor is not allowed to defend the invalidity application, its registration will be declared invalid and deemed never to have been made. Though it will remain open to the proprietor to re-file its application, there are inevitable adverse commercial and financial consequences of losing a trade mark registration.

Any prejudice caused to the applicant by the delay

25. Whilst I keep in mind the slightly increased costs the applicant is likely to suffer (for preparing for and attending a hearing to discuss the late TM8), any delay and uncertainty in these proceedings, solely as a result of the late filing of the TM8, is unlikely. It is anticipated that all 109 sets of related proceedings will run simultaneously. The case management of the related proceedings has yet to be confirmed and so none of the proceedings have progressed beyond the admittance of the respective TM8s. Consequently, even if the TM8 had been filed on time, the proceedings would not yet have progressed beyond that point.

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

26. There are, in total, 109 sets of related proceedings to which the proprietor is party. The applicant is party to 30 of those 109 proceedings.

Conclusions

27. In reaching my decision, as noted above, I recognise that if the discretion is not exercised in the proprietor's favour, the invalidity application will succeed and the proprietor will lose its registration in respect of all its goods and services (since the invalidity application is directed against the registration in full).

28. I have already found that there has not been any irregularity on the part of the Tribunal and that there has been no failure in a communication service. I therefore have to be satisfied that there are extenuating circumstances which justify the exercise of discretion in the proprietor's favour. The circumstances are, essentially, that given the substantial number of sets of proceedings, it was not noticed that not all relevant documents were transferred from the proprietor to Eversheds. That meant that the proprietor proceeded on the basis that Eversheds had all necessary documents and would file the defences to each of the proceedings by their respective deadlines. Eversheds, however, were unaware of three sets of invalidity proceedings given that the related documents did not form part of the file transfer. Consequently, the TM8 deadlines on two of those invalidity proceedings (this one included) were missed.

29. In my view, the management of 109 sets of Tribunal proceedings at once is undoubtedly unusual. It is clear that the proprietor had a system in place to manage the caseload and that an error occurred, the details of which are unknown, which meant that the documents relating to three of 109 sets of proceedings were not uploaded to the file transfer service that was used to send the documents from the proprietor to Eversheds. This went unnoticed. Whilst I somewhat agree with Mr Curtis that a more thorough check of the files that were transferred may have identified the missing invalidity actions, it seems a credible argument that amongst hundreds of documents, relating to 42 trade mark applications, the omission of those relating to three of 109 sets of proceedings is not beyond the realms of possibility.

30. Considering the limited prejudice to the applicant (which is possible of being accounted for in costs) set against the significant prejudice to the proprietor of losing its registration, I am minded to exercise my discretion to admit the late filed TM8.

Weighing all the factors considered thus far, it is my view that the present circumstances are to be considered extenuating, and admitting the TM8 into the proceedings is justified for all the reasons I have discussed in this decision.

Outcome

31. The consequence of the above conclusion is that the proprietor's TM8 will, following scrutiny by the casework examiner, be admitted into the proceedings. It will then be formally served upon the applicant and, subject to case management discussions regarding the related proceedings, the invalidity action will proceed and a timetable will be set for the filing of evidence.

COSTS

32. Costs will be determined at the conclusion of the proceedings.

Dated this 17th day of July 2024

MRS E FISHER
For the Registrar