O/0692/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK4146508

IN THE NAME OF ASSAN PANEL SANAYİ VE TİCARET ANONİM ŞİRKETİ

TO REGSITER THE TRADE MARK

IN CLASSES 6 AND 17

AND

THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT FILED IN DEFENCE OF THAT APPLICATION

IN THE OPPOSITION PROCEEDINGS UNDER NO. 455225

BY

KINGSPAN HOLDINGS (IRL) LIMITED

BACKGROUND AND PLEADINGS

1. On 11 January 2025, Assan Panel Sanayi Ve Ticaret Anonim Şirketi ("the applicant") applied to register the trade mark shown on the cover page of this decision, namely trade mark number UK00004146508. The application was accepted and published in the UK Trade Marks Journal on 11 April 2025 for the following goods:

   Class 6
   Metal roofing panels; metal facade panels for construction purposes.

   Class 17
   Insulation, stopping and sealing materials, namely insulating paints, insulating fabrics, insulating tape and band, insulation covers for industrial machinery, joint sealant compounds for joints, gaskets, O-rings for sealing purposes (other than gaskets for motors, cylinders and washer for water taps); flexible pipes made from rubber and plastic; hoses made of plastic and rubber, including those used for vehicles; junctions for pipes of plastic and rubber; pipe jackets of plastic and rubber; hoses of textile material; junctions for pipes, not of metal; pipe jackets, not of metal; connecting hose for vehicle radiators; synthetic plastic as semi-finished products in form of foils, plates, rods, profiles, hoses, tubes, blocks.

2. On 8 July 2025, Kingspan Holdings (IRL) Limited ("the opponent") filed a Form TM7 Notice of Opposition opposing the application. The opposition is based upon Section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed against all of the goods in the application.

3. On 17 July 2025, the Tribunal served the Form TM7 on the applicant. The service letter provided the applicant with a deadline of 17 September 2025 to file its Form TM8 Notice of Defence or a request to enter into a cooling off period in Form TM9C.

4. A Form TM9C was filed by the applicant's representative on behalf of the parties on 16 September 2025. The Tribunal confirmed receipt of the Form TM9C by way

of official letter dated 20 September 2025 and notified the parties that, in accordance with Rule 18(4) of the Trade Marks Rules 2008, the cooling off period would expire on 17 April 2026. In the same letter to the parties, the Tribunal confirmed the following:

> "The Registrar, may on request, extend the cooling off period for a further nine months where such request is filed on TM9e and with the agreement of both parties. Please note that the TM9e should be received on or before **17 April 2026**.
>
> If no such request is made, the TM8 and counter-statement should be filed on or before **17 April 2026** or the application shall, unless the Registrar otherwise directs, be treated as abandoned in whole or part, in accordance with Rule 18(2) of the Trade Marks Rules 2008."

5. Neither a Form TM9E nor a Form TM8 were filed by the parties prior to the cooling off period expiring. Accordingly, the Tribunal wrote to the parties by way of official letter dated 27 April 2026 confirming the same and with a preliminary view that the application should be treated as abandoned. Specifically, the letter stated the following:

> "Our letter dated 20 September 2025 invited you to file a Form TM8 and counterstatement on or before 17 April 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, **11 May 2026.**
>
> If no response is received by this date, the application will be treated as abandoned (i.e. it will be withdrawn)."

6. On 11 May 2026, the applicant responded to the preliminary view by filing a Form TM8, Explanation of Grounds and Witness Statement signed by Ms Hale Tamankaradeniz, in her capacity as legal representative for the applicant. These documents were filed alongside a request by the applicant that the Tribunal exercise its discretion pursuant to Rule 18(2) of the Act to admit these documents and "permit the proceedings to continue on their merits."

7. The applicant's request and its corresponding documents were considered by the Tribunal, and by way of official letter dated 15 May 2026 the request was refused on the basis that the Tribunal considered there to be "no 'compelling reasons' or 'extenuating circumstance'" that would permit the exercise of the Tribunal's very limited discretion under Rule 18(2) of the Trade Mark Rules 2008. Accordingly, the Tribunal allowed the applicant a period of 14 days (namely, until 29 May 2026) to request a hearing on this matter. The Tribunal's letter further stipulated the following:

> "Please note if the Hearing Officer maintains the preliminary view, the applicant may be required to contribute to the other party's costs. This is not intended to dissuade you from attending a hearing, but merely to inform to you of the potential consequences should you be unsuccessful in overturning the preliminary view.

If no response is received by the deadline, the Tribunal will confirm the preliminary view on the issue of failure to comply with the Rules governing the filing of a defence and the application will be deemed abandoned."

8. The applicant formally requested a hearing by way of an email dated 29 May 2026 and invited "the Hearing Officer not to determine the matter on the basis of the preliminary view alone".

9. A hearing was scheduled for Tuesday 23 June 2026, and both parties filed their respective skeleton arguments on 19 June 2026.

THE HEARING

10. The hearing took place before me, via Microsoft Teams as an audio call, on Tuesday 23 June 2026. Ms Hale Yamankaradeniz of Destek Patent Ltd appeared on behalf of the applicant, and Mr Neil Ritchie of Tomkins & Co appeared on behalf of the opponent.

11. During the hearing Ms Yamankaradeniz began by highlighting the parties' ongoing settlement discussions and the parallel EUIPO proceedings between the parties. Ms Yamankaradeniz submitted that this was not a case of simple inattention or administrative oversight, and Ms Yamankaradeniz further submitted that the applicant has not failed to engage, nor had it disregarded the proceedings or intended to abandon the application. By contrast, Ms Yamankaradeniz noted that the parties had jointly entered into a cooling-off period for the purpose of exploring settlement negotiations. In support of these submissions, Ms Yamankaradeniz referred me to the following decisions which she submitted all demonstrate that the existence of parallel proceedings, ongoing settlement discussions, procedural misunderstanding arising within a broader dispute, and the absence of material prejudice are all factors capable of bearing upon the exercise of the Tribunal's discretion to allow an extension of time for filing a Form TM8 and Counterstatement:

a. *HiLife Music Entertainment Ltd v HiLife Music Limited* (O/498/21);
b. *Pollen Capital Ltd v Velocity Technology Solutions, Inc.* (O/771/18); and
c. *PTLL Limited v Smiths News Trading Limited* (O/511/18).

12. Ms Yamankaradeniz further submitted that the applicant had not sought to benefit from the late filing and submitted that there would be "no material prejudice" to the opponent, whereas, by contrast, the prejudice to the applicant in refusing the admission of the Form TM8 would be "severe" and "disproportionate". Ms Yamankaradeniz also submitted that the "interest of justice favoured allowing this matter to proceed on the basis of merits".

13. Despite the above initial submission, it should be noted that during the hearing Ms Yamankaradeniz admitted that, whilst the parties had entered into a cooling off period, neither party had sent any correspondence during that period in an attempt to facilitate settlement discussions.

14. Further, despite her initial submission that this was not a case of simple "administrative oversight", later on in her submissions, Ms Yamankaradeniz conceded that the reason the Form TM8 was filed late (and the request for an extension was not filed until 3 weeks after the deadline for the filing of the Form TM8 had expired) was because there was a "misunderstanding" over this deadline and the deadline for the expiry of the cooling off period in the EUIPO proceedings.

15. In response, Mr Ritchie submitted that the applicant had failed to provide any "compelling reasons" or extenuating circumstances that would justify the granting of the extension of time. Specifically, Mr Ritchie highlighted the following:

    a. That the Form TM8 had been filed 24 days late, so the applicant had failed to act promptly;
    b. The witness statement signed by Ms Yamankaradeniz makes clear that the applicant had received all correspondence in this matter and was therefore aware of the deadline for filing the Form TM8;

c. Despite Ms Yamankaradeniz's submissions, there have been no settlement discussions/communications between the parties; and
d. Whilst there are parallel EUIPO proceedings which were still subject to a cooling off period, these were separate proceedings, and it should not have been assumed that this deadline would be extended because of these EUIPO proceedings.

16. Mr Ritchie also noted that the extension requests for all of the case law referenced in paragraph 11, above, were granted not simply on the basis that there was a misunderstanding as a result of parallel proceedings, but also as a result of a number of other factors. In that regard, I do appreciate that the decisions in opposition numbers O/498/21 and O/771/18 both also occurred as a result of their being a misunderstanding following a change of representation. The decision in opposition number O/511/18 was also a result of a misunderstanding caused by workload pressures following the handover of the global trade mark portfolio and the parties were engaged in discussions regarding a wider commercial settlement.

17. Mr Ritchie further submitted, as a result of the admission that has been made by Ms Yamankaradeniz referenced in paragraph 14 above, that the applicant now appeared to be pleading that the deadline had been missed as a result of human error. Mr Ritchie therefore referred me to the decision of *Praesidiad Nv v Tescon Sicherheitssysteme Schweiz GMBH* (0/240/20), in which Geoffrey Hobbs QC (as he then was) stipulated that there must "be a fact specific evaluation for the purpose of determining whether the particular error in question should or should not be treated as excusable in the circumstances of the case at hand", and Mr Ritchie submitted that it should not in this instance.

DECISION

18. As a preliminary point, and as discussed briefly above, both parties have referred to various previous decisions of the Tribunal which they consider to be similar to the circumstances of the case before me and therefore applicable to this matter. Whilst I have considered all of the case law presented by the parties, it should be

noted that decisions like this, which involve the determination of whether the Tribunal should apply its discretion, are to be decided on a case-by-case basis, and each case turns on its own particular set of facts.

19. The rules relating to extensions of time are contained in rules 77(1) and (5) and Schedule 1 of the Rules. The combined effect of these rules means that the time limit in rule 18, which sets the period in which the defence in opposition proceedings must be filed, is non-extendable 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."

20. The combined effect of rules 77(1), 77(5) and schedule 1, mean that the time limit specified in Rule 18 is not extendable other than in the circumstances identified in rules 77(5)(a) and (b), and, as there is no suggestion in this case that there has been any irregularity on the part of the Tribunal, these clearly do not apply in these proceedings.

21. However, that is not the end of the matter, as the wording of rule 18(2) includes the following:

"… unless the registrar otherwise directs, be treated as abandoned."

22. This rule, therefore, clearly provides the Tribunal, in appropriate circumstances, with the discretion not to treat an application as abandoned in circumstances

where the applicant fails to file a Form TM8 and Counterstatement within the relevant period. The question, of course, is how this discretion should be exercised.

23. Sitting as the Appointed Person in *Kickz*,[1] Mr Geoffrey Hobbs QC (as he then was) held that the discretion conferred by Rule 18(2) can be exercised only if there are "extenuating circumstances".

24. Further, sitting as the Appointed Person in *Mark James Holland and Mercury Wealth Management Limited* (BL-O-050-12) ("*Mercury*"), Ms Amanda Michaels KC held that there must be "compelling reasons" to justify the Registrar exercising that discretion. In considering relevant factors, Ms Michaels referred to the criteria established in *Music Choice Ltd's Trade Mark* [2006] R.P.C. 13 ("*Music Choice*"), which provides guidance applicable by analogy when exercising the discretion under rule 18(2). I will consider each of these factors identified by Ms Michaels in turn below:

(i) <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>

25. The applicant's main reason for the late filing of the Form TM8 appears to be the parallel EUIPO proceedings (which involved the same parties and same mark), and the applicant's belief that the parties were looking to engage in settlement discussions. Having said that, whilst the applicant initially submitted that the parties were engaged in active settlement discussions, this does not appear to be an accurate representation of the position. The parties had agreed to enter into a cooling off period in order to engage in settlement discussions, but once the cooling off period began, no attempt was ever made by either party to engage in settlement discussions.

[1] *Kickz AG v Wicked Vision Limited* (Case BL O/035/11)

26. It appears to me, therefore, that the reason the deadline was not met was because of a misunderstanding on the part of the applicant over the deadline as a consequence of the parallel EUIPO proceedings which were also in a cooling off period, which was not due to expire until 4 July 2026 (i.e., after the deadline for the expiry of the cooling off period in the UK IPO proceedings). In that regard, I also note that this was admitted on behalf of the applicant by Ms Yamankaradeniz at the hearing.

27. Having said that, I note that the deadline for the filing of the Form TM8 (and or Form TM9E) in these opposition proceedings was clearly communicated to the applicant by way of official letter dated 20 September 2025. There has been no suggestion that this correspondence was not received by the applicant and, it is also important to note that the applicant is legally represented.

28. It is also noted that the request for an extension of time for the filing of the Form TM8 was not made by the applicant until 3 weeks after the expiry of the deadline, and this is despite the fact that the Tribunal wrote out to the parties two weeks prior (i.e., on 27 April 2026) with a preliminary view that the application should be treated as abandoned as no Form TM8 or Form TM9E had been received prior to the expiry of the cooling off period.

(ii) <u>The nature of the opponent's allegations in its statement of grounds</u>

29. The opposition at hand (proceedings number OP000455225) has been brought under section 5(2)(b) of the Act in respect of the applicant's trade mark number UK00004146508. Whilst it is not for me to determine the merits of the case at present, there is nothing to suggest that the opposition is without merit.

(iii) <u>The consequences of treating the applicant as defending or not defending the opposition</u>

30. If the applicant is permitted to defend the opposition, the proceedings will continue and matters will be determined on their merits.

31. If, however, the defence is not admitted into the proceedings, there would be serious consequences for the applicant as its application will not be able to proceed to registration. Though, there are always consequences when the Tribunal makes an adverse decision because of a failure to file a defence in time. There is also nothing to stop the applicant from re-filing its application. However, I appreciate that this will result in the applicant incurring further costs and losing its original filing date.

(iv) <u>Any prejudice caused to the opponent by the delay</u>

32. Aside from highlighting the additional costs the opponent has incurred in responding to the applicant's request for an extension of time in filing its Form TM8 and Counterstatement, the opponent has not identified any prejudice caused by the delay in receiving the applicant's defence. Whilst these costs implications are appreciated, I am unable to identify any further prejudice that would be caused to the opponent beyond the 3-and a half week delay in receiving the Form TM8 and Counterstatement.

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

33. It was confirmed during the hearing and in the relevant parties' skeleton arguments that the same parties have been engaged in parallel EUIPO proceedings relating to their trade marks. I have not been provided with detailed submissions on these parallel proceedings. I am not therefore aware of what impact the outcome of these proceedings may have on any other proceedings between the parties. However, it appears that the applicant would have an interest in defending the application. Therefore, it should have come as no surprise to the opponent that the applicant intended to defend the application.

CONSIDERATIONS

34. Having addressed each of the relevant factors as proposed in *Music Choice*, I need to decide whether the applicant's skeleton argument and subsequent comments at the hearing revealed extenuating circumstances or compelling reasons that would enable me to exercise my discretion to allow the proceedings to continue.

35. In reaching my decision, I consider that if discretion is not exercised in the applicant's favour, the application will be treated as abandoned, and the application will not proceed to registration. I also recognise that the applicant may elect to re file its application which may again be opposed by the opponent, resulting in further opposition proceedings in the future, with further cost implications. However, as the loss of filing date and the possibility of further proceedings on much the same basis are often the consequences of a failure to comply with the non-extendable deadline to file Form TM8, these factors are not particularly compelling.

36. In the official letter dated 20 September 2026, the applicant was provided with clear instructions and given a clear deadline by which it was required to file an official Form TM8 and counterstatement, should it wish to defend its application. The letter informed the applicant that failure to file a defence within the prescribed period would result in the application being treated as abandoned. I am also conscious that the applicant has been legally represented throughout these proceedings and, in the circumstances, I do not consider that the applicant's misunderstanding over the deadline caused by one set of parallel EUIPO proceedings to be a sufficient basis for granting the Tribunal's limited discretion for extending the deadline in this instance. I also agree with Mr Ritchie's submission that the case law referenced by the applicant in support of its request all involved multiple reasons for granting the Tribunal's discretion. In that regard I note that, in this instance, both parties' legal representatives have confirmed that there were no settlement discussions between the parties, and there has been no

change in legal representation that may have resulted in the deadline being missed.

37. I am also reminded that in dismissing the appeal in *Kickz*, Geoffrey Hobbs Q.C. (as he then was), sitting as the Appointed Person, found that the applicant “had been the author of his own misfortune”. Insofar as the applicant failed to adhere to the statutory deadline set by the Tribunal in this instance, I find that to also be true of the applicant in the case before me.

38. Having considered the applicant’s explanation as to why it failed to file a counterstatement within the prescribed period, I find that it is neither sufficient to constitute extenuating circumstances, nor does it offer any other reasonable basis upon which I would be satisfied that my intervention was justified.

CONCLUSION

39. For the reasons outlined above, the preliminary view is upheld. The applicant’s Form TM8 and Counterstatement are not to be admitted into the proceedings. Subject to any successful appeal, the application is treated as abandoned in respect of all of the goods applied for.

COSTS

40. Given that the decision reached above effectively terminates the proceedings, I must now turn to the matter of costs. In this regard, I return to the opponent’s request for costs to be awarded off the scale set out in Tribunal Practice Notice (“TPN”) 1 of 2023. The reasoning behind the opponent’s request was provided in submissions at the hearing and can be summarised as follows:

    a. The opponent has incurred more costs than it should have in preparing for and attending hearing; and

b. The applicant failed to provide any evidence (despite being invited to do so by the opponent ahead of the hearing) to justify why the hearing should take place.

41. Examples of circumstances where the Hearing Officer may consider awarding costs off-scale are provided in the TPN referred to above. It reads:

> "**Off-scale costs**
>
> 5. Notwithstanding the published scale, the Tribunal retains the discretion to award costs "off the scale" to deal proportionately with unreasonable behaviour. It is not possible to set out all the circumstances in which a Hearing Officer might depart from the scale. It is worth clarifying though that just because a party has lost, this in itself is not indicative of unreasonable behaviour. Some examples of what might constitute unreasonable behaviour include a party seeking an (avoidable) amendment to its statement of case which, if granted, would cause the other party to have to amend its statement or would lead to the filing of further evidence. Other examples include behaviour designed to delay, frustrate or unreasonably increase the costs/burden on the other party and/or repeated breaches of procedural rules. Off-scale costs may also be awarded if a losing party unreasonably rejected efforts to settle a dispute before an action was launched or a hearing held, or unreasonably declined the opportunity of an appropriate form of Alternative Dispute Resolution.
>
> 6. The level of off-scale costs will, generally speaking, be commensurate with the extra expenditure a party has incurred as a result of the unreasonable behaviour. Any claim for costs approaching full compensation or for "extra costs" will need to be supported by a bill itemizing the actual costs incurred. There may be some circumstances where costs below the minimum indicated by the published scale are awarded. For example, a party who does not follow a suggestion from

the Hearing Officer as to the most efficient means of managing the case, may only be entitled to whatever award they would have received if they had followed the Hearing Officer's suggestion."

42. To my mind, the present circumstances are not compatible with any of the examples set out above. Whilst such examples may not be intended to be exhaustive, I do not consider the justification provided by the opponent to be particularly compelling. It was open to the applicant to challenge the Tribunal's preliminary view and, in light of its intention to defend its application (to which it has attested), it is hardly surprising that it elected to do so. As to whether the applicant's reasoning for requesting the extension of time for filing its Form TM8 and counterstatement (and, therefore hearing) were justified and supported with evidence, whilst I have indeed found that the justification was insufficient having applied the relevant case law, I do not consider this to be a sufficient basis for awarding off the scale costs. Further, as for the additional costs the opponent has been put to in challenging the applicant's request, to my mind such expenditure does not surpass any normal expectation as to what would be incurred in the present circumstances. The applicant has not, in my view, acted unreasonably in seeking the extension of time for filing its Form TM8 and Counterstatement. In short, I am not satisfied that the circumstances before me justify an award of off-scale costs in the opponent's favour.

43. The opponent is, however, entitled to a contribution toward its costs in line with the usual scale. Applying the guidance set out in TPN 1/2023, I award the opponent costs as follows:

Filing a Notice of Opposition:	£250
Official fee:	£100
Preparing for and attending the hearing, including filing a skeleton argument:	£400
Total:	**£750**

44. I therefore order Assan Panel Sanayi Ve Ticaret Anonim Şirketi to pay Kingspan Holdings (IRL) Limited the sum of £750. 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 31st day of July 2026

Mrs B Hartland
For the Registrar