

**O/0766/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NO. UK3675709  
IN THE NAME OF FIFTH AVENUE ENTERTAINMENT LLC  
TO REGISTER AS A TRADE MARK**

**THE COMMODORES**

**IN CLASSES 9 AND 41**

**AND**

**THE LATE FILING OF FORM TM8 AND  
COUNTERSTATEMENT  
FILED IN DEFENCE OF THAT APPLICATION  
IN OPPOSITION PROCEEDINGS  
UNDER NUMBER 429233  
BY COMMODORE ENTERTAINMENT CORPORATION**

## BACKGROUND

1. On 30 July 2021, Fifth Avenue Entertainment LLC (“the applicant”) applied to register trade mark number UK3609321, for the mark shown on the cover page of this decision, in the United Kingdom. This application was filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union, based on its European Union Trade Mark (“EUTM”) No 013370077. The EU filing date was 17 October 2014.

2. The application was accepted and published for opposition purposes on 17 September 2021, in respect of the following goods and services:

Class 9: *Series of musical sound recordings; series of musical video recordings; downloadable musical sound recordings; downloadable music video recordings featuring music and entertainment; audiovisual recordings featuring music and entertainment.*

Class 41: *Entertainment in the nature of live performances by a musical artist.*

3. On 16 December 2021, Tomkins & Co filed form TM7 (“Notice of opposition and statement of grounds”) on behalf of Commodore Entertainment Corporation (“the opponent”). The opposition is based upon Section 5(4)(a) and Section 3(6) of the Trade Marks Act 1994 (“the Act”), and is directed against all of the goods and services in the application.

4. On 23 January 2022, the Tribunal sent a letter by email to the applicant’s then-representatives Dravya Siddhi Corporation Limited. The official letter attached a copy of the letter sent to the opponent regarding the TM7 filed against the application, which advised that the evidence filed alongside the form TM7 could not be admitted into the proceedings at this stage. The opponent was invited to file an amended TM7 and statement of grounds on or before 14 February 2022.

5. Due to a clerical error, the letter was sent directly to the opponent, rather than through the appointed representatives. On 17 May 2022, the Tribunal wrote to the

opponent through the representatives, apologising for the error, and re-setting the date for the opponent to file an amended TM7 to on or before 07 June 2022. A copy of this letter was sent directly to the applicant, Fifth Avenue Entertainment LLC, by post.

6. On 7 June 2022, the opponent's representatives filed an amended TM7, which in the accompanying email they confirmed that a copy of which "... has been sent to the recorded representative for the Applicant by post ...".

7. On 16 June 2022, the following email was sent by Beryl McClary on behalf of the applicant:

I have received the package with the documents containing the the Opposition response of Commodore Entertainment Corporation on June 8, 2022.

I am asking for an extension of time to examine the documents and to get advice and counsel from from a UK attorney in this cause. A copy of this correspondence has been sent to the opponent, Mr. Simon Gray, regarding this extension at the email address listed on the documents sent to our identified address.

Thank you for your attention to this matter.

8. On 08 July 2022, the Tribunal served the form TM7 by post upon the applicant directly to its address in Orlando, Florida, USA. The letter was sent by Royal Mail, using the "International Tracked and Signed" service. The Royal Mail confirmed that the letter had been handed to its delivery partner, being the USPS Tracking, and confirmation of delivery was confirmed as "Delivered.Left with Individual" on July 21, 2022, 12:43 p.m. The deadline for the applicant to file its form TM8 ("Notice of defence and counterstatement") was 08 September 2022, communicated by the Tribunal in the serving letter. The Tribunal's letter contained the following:

"Thank you for your email dated 16 June 2022. Please note, the opponent has filed an amended TM7 which can be admitted into proceedings. As explained below, the applicant is given a fixed two-month period in which to file a defence of its application. This period is fixed and cannot be extended. Further direction is also given below in respect of filing a UK address for service.

Please find enclosed a copy of the amended notice of opposition - Form TM7 - filed against your application.

If you wish to continue with your application, 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...

Rule 18(1) and 18(3) 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. Alternatively, if both parties wish to negotiate to resolve the dispute, they may request a “cooling off period” by filing a Form TM9c, which will extend the 2 month period in which to file a Form TM8 by up to a further seven months. Form TM9c is also available on the IPO website (above). Please note both parties must agree to enter into cooling off.

**IMPORTANT DEADLINE: A completed Form TM8 (or Form TM9c) MUST be received on or before 08 September 2022.**

Rule 18(2) of the Trade Marks Rules 2008 states that “*where an applicant fails to file a Form TM8 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 important to understand that if the deadline date is missed, then in almost all circumstances, the application will be treated as abandoned.**” (original emphasis)

9. The applicant did not file a TM8 by the deadline, and so, on 09 October 2022, the Tribunal wrote to the applicant again (sent by post to the US address). In the letter, the Tribunal stated that:

“The official letter dated **08 July 2022** invited the applicant to file a TM8 and counterstatement on or before **08 September 2022**.

As no TM8 and counterstatement has been filed within the time period set, Rule 18(2) applies. Rule 18(2) states that the application:

“.....shall, unless the registrar otherwise directs, be treated as abandoned.”

The registry is minded to deem the application as abandoned 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, **07 November 2022**. 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 deem the application abandoned.”

10. On 25 October 2022, the following was sent by email by Beryl McClary on behalf of the applicant:

*Fifth Avenue is in receipt of your correspondence.*

*The question is, can Fifth Avenue file a response directly without UK counsel?*

*Thank you.*

11. On 06 December 2022, the Tribunal responded accordingly:

“Thank you for your letter dated 25 October 2022. As per the Registry’s official letter dated 08 July 2022, the applicant requires a UK address for service for all matters pertaining to the above proceedings.

I refer to the above proceedings and the official letter dated 09 October 2022.

The Registry intends to suspend any further action in this matter whilst it considers Mr Geoffrey Hobbs decision dated 16 August 2022 ....

Further correspondence will be issued in due course.”

12. On 10 January 2023, form TM33 was filed appointing Thomas McClary as representative to the applicant, confirming a UK address for service, the recordal of which was confirmed by the Tribunal in a letter dated 17 February 2023.

13. On 21 February 2023, Mr McClary filed form TM8 on behalf of the applicant.

14. On 27 March 2023, the Tribunal wrote to Mr McClary to advise that following the official letter dated 06 December 2022 advising that the matter was suspended, following the publication of Tribunal Practice Notice 2/2023, the case could now proceed. It further stated as follows:

“The Registry notes that the Form TM7 was served to the applicant before appeal decision BL O/681/22 was issued. Therefore, in this instance, the original defence deadline of 08 September 2022 remains valid. It is noted that a TM8 and counterstatement was not filed on or before this deadline.

I acknowledge receipt of the late TM8 filed on 21 February 2023. Please note, before we can consider the admission of the TM8, you must file a Witness Statement setting out the reasons as to why the TM8 and counterstatement were filed late, that is outside of the two-month period we had initially given you.

...

Should you proceed to file a Witness Statement, we will consider whether the reasons for lateness given are sufficient to enable the TM8 to be admitted into proceedings. **However, failure to provide a Witness**

**Statement, along with the requested reasons for lateness, will result in application UK00003675709 being deemed abandoned in its entirety in line with Rule 18(2) of the Trade Marks Rules 2008.**

A further period of two weeks, that is on or before **10 April 2023**, is allowed in which for you to file a Witness Statement which provides reasons for the late- filing of the Form TM8.”

#### WITNESS STATEMENT

1. I, Thomas McClary, of [REDACTED] Orlando, Florida [REDACTED] I am the managing member of Fifth Avenue Entertainment, LLC, a position that I have held since 2007. The facts in this statement come from my personal knowledge, and I am duly authorized to speak on my company's behalf in the prosecution of this application.

2. The circumstances relating to the missing the deadline is due to the: I was not aware of correspondence from your office being sent to me on July 8, 2022, until I received correspondence from your office that was dated October 9, 2022, which references the delivery of correspondence from your office to my residence dated July 8, 2023. Upon receipt of the mail correspondence dated October 9, 2022, I immediately contacted your office on or about October 25, 2023, via email and requested permission to represent myself in this matter and to submit a counterstatement (Form TM8).

3. The consequence(s) of not being allowed into proceeding is that my group and I will be prohibited from continuing to work and being booked under the trademark name Commodores that we own in the EU and perform under that name.

4. Any prejudice caused to the opponent by the delay is none.

5. Any other relevant consideration, there are no related proceedings of the parties in the UK.

I affirm that the facts stated in this witness statement are true and correct.

16. On 14 July 2023, the Tribunal wrote to the applicant to acknowledge receipt of the Witness Statement and to give the preliminary view that the late-filed TM8 should not be admitted into the proceedings:

“I acknowledge receipt of your Witness Statement detailing the reasons for the late-filing of the Form TM8 filed in these proceedings.

Having considered the reasoning set out in the Witness Statement, it is the preliminary view of the Registry that the request to admit the late TM8 into proceedings should be refused.

The Registry's official letter dated 08 July 2022, serving the notice of opposition, set out the course of action required if you wanted to defend your application. The letter clearly explained the consequences of not filing a notice of defence if the parties did not enter the 'cooling off' period. A copy of this letter was sent to you by Royal Mail international tracked service. Royal Mail have confirmed delivery of this letter.

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. Whilst the Registrar acknowledges your comments in the witness statement, the reasons provided for the failure to file the defence on time are not deemed to be compelling, nor do there appear to be mitigating circumstances which permits the Registrar to exercise his limited discretion and admit a late filed Form TM8 into these proceedings.

...

It is noted that a hearing was requested alongside the Witness Statement. Accordingly, the Registry will contact you regarding arrangements for an oral hearing in due course."

17. A hearing was scheduled for 02 August 2023, the details of which were sent by the Tribunal to both parties in an official letter dated 18 July 2023. The opponent disagreed with the applicant's request to delay the date of the hearing by 60 days in order to prepare, and the request was duly refused by the Tribunal citing that the reasons given were not considered sufficient to warrant such a delay. Both parties subsequently confirmed attendance on the given date, with the opponent filing its skeleton arguments and the applicant filing its submissions on 31 July 2023.

## THE JOINT HEARING

18. The hearing took place before me, via Microsoft TEAMS telephone conference, on Wednesday 02 August 2023. Beryl McClary of Fifth Avenue Entertainment LLC represented the applicant, and Simon Gray of Tomkins & Co represented the opponent.

19. I explained to both parties that the purpose of the hearing was to consider whether the late filed defence should be admitted into the proceedings. I further confirmed that I had received the skeleton arguments and submissions from the respective parties, and that I had read all the documents relevant to the case before me.

20. The applicant's submissions included an introduction and background to the issues at hand, and, inter alia, it outlined the circumstances relating to the missed deadline, and the consequences of not allowing the defence.

21. The opponent's skeleton arguments comprised eight pages, outlining the facts of the case and the arguments of the opponent, and included references to particular sections of the Trade Mark Manual, to the Trade Mark Rules 2008, and made reference to what it considered to be relevant case law, before providing a conclusion.

22. At the hearing, Ms McClary began by stating that at the time the TM7 was served upon the applicant, being July 2022, the recorded address for service at the UKIPO should have been that of the representatives Dravya Siddhi Corporation Limited ("Dravya") in Guernsey. However, for reasons unknown to the applicant, the UKIPO instead sent the pivotal notice which contained the deadline for filing the TM8 and counterstatement to the applicant's Orlando address. Ms McClary maintained that this communication was never received, stating that the address to which the notice was sent is a gated community, and, albeit that the Royal Mail and USPS have confirmed delivery, no signature of the individual recipient has been provided.

23. Ms McClary continued that once the applicant realised in October 2022 that there had been missed correspondence, it immediately tried to file documents from the US address, however, she said that the UKIPO stated this address was not acceptable,

notwithstanding that the UKIPO itself had tried to serve the notice of opposition to the same address. She questioned how, if the US address was not considered a valid address for service, how could it be considered a valid address to serve correspondence to. Ms McClary added that the UKIPO had also erred by previously sending correspondence directly to the opponent, rather than to its recorded representatives, for which it had apologised. She stated that the applicant had received no such apology for the error made by the UKIPO in sending the correspondence at issue directly to the applicant and not to its representatives.

24. Turning to Mr Gray, he submitted that essentially, the applicant claimed that the Registrar was at fault in writing to the Florida address, however, he argued that the Registrar is allowed to correspond with any address which it deems to be appropriate, and that by issuing the letter to the applicant, it had followed proper procedure and that any omission or error was on the part of the applicant and not the UKIPO. He further submitted that the deadline for filing form TM8 was missed by close to six months, but that the Witness Statement of Mr Thomas McClary which outlined the reasons for missing the given deadline was very brief and did not show exceptional circumstances for the late filing. He added that both Royal Mail and the US postal service had provided tracking systems which confirmed delivery of the communications in question to the US zip code for the applicant.

25. Mr Gray continued that this matter had been ongoing for 18 months since the original opposition was filed, and accordingly, the opponent has been prejudiced by the long delays. He stated that there are ongoing proceedings between the parties in the US and other jurisdictions, and if these proceedings are delayed again, it will cause prejudice and inconvenience in time and cost to the opponent. He argued that the applicant was “the author of its own misfortune” due to the failure to follow the right procedures, and that it had not put in place any appropriate systems or procedures to manage this opposition. He stated that with regard to the address for service, the applicant had acted independently of the representatives and had in essence acted as their own representative. He concluded that he did not believe there to be any failing on the part of the UKIPO and that there were no extenuating circumstances to extend the deadline, therefore the defence should not be admitted to the proceedings.

26. Prior to bringing the hearing to a close, I asked Ms McClary to confirm if Dravya were still being paid to represent the applicant on 16 June 2022, being the date that she sent an email to the UKIPO acknowledging receipt of documents from the opponent and requesting an extension of time to seek advice from a UK attorney. Ms McClary confirmed that this was the case, and she clarified that upon receipt of the copy of the amended TM7 filed on 7 June 2022, which was copied to the applicant by the opponent and sent to the US address, she queried with Dravya why it had been sent directly to the applicant. She stated that Dravya had confirmed that they had not received anything from either the UKIPO or the opponent, and she added that as Dravya were retained as representatives to the applicant, she assumed that having brought it to their attention, that they would then “take care of it”. However, from that point on, having heard nothing from Dravya, Ms McClary said that she just “did what she thought she was supposed to do”.

27. At the conclusion of the hearing, I confirmed that I would reserve my judgment to allow myself time to give due consideration to the submissions of both parties, and that my decision would be issued in writing in due course.

## **DECISION**

28. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by rule 18 of the Trade Marks Rules 2008 (“the Rules”). The relevant parts read as follows:

“18. (1) The applicant shall, within the relevant period, file a Form TM8, which shall include a counter-statement.

(2) Where the applicant fails to file a 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.”

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

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

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

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

30. The applicant has suggested that there has been an irregularity on the part of the Tribunal by it serving the TM7 directly to the applicant at the Florida address rather than to its appointed representatives in Guernsey. In such circumstances, the Registrar may invoke Rule 74(1) of the Trade Marks Rules (2008) in order to correct the irregularity:

**“Correction of irregularities in procedure**

**74.—**(1) Subject to rule 77, the registrar may authorise the rectification of any irregularity in procedure (including the rectification of any document filed) connected with any proceeding or other matter before the registrar or the Office.

(2) Any rectification made under paragraph (1) shall be made—

(a) after giving the parties such notice; and

(b) subject to such conditions,

as the registrar may direct.”

31. I may also exercise in the applicant's favour the discretion afforded to me by the use of the words "unless the registrar otherwise directs" in Rule 18(2).

32. 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 have to be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the applicant's favour.

33. In *Music Choice Ltd's Trade Mark* [2005] RPC 18, the Court indicated that a consideration of the following factors (shown below in bold and underlined) 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:**

34. As noted above, the stipulated deadline for the filing of the applicant's Form TM8 and counterstatement was 08 September 2022. The Form TM8 and counterstatement was filed by the applicant on 21 February 2023. Therefore, the deadline was missed by 166 days. The applicant's written explanation as to why the deadline was missed, i.e. that the correspondence was never received, is summarized above. During the hearing discussions, it was further considered that the opponent's TM7 was erroneously served directly to the applicant, rather than to what should have been the applicant's recorded representative, and thus was judged by the applicant to be an irregularity on the part of the UKIPO.

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

35. The opposition is brought under section 5(4)(a) and section 3(6) of the Act. There is nothing to suggest that the opposition is without merit.

**The consequences of treating the applicant as defending or not defending the opposition;**

36. If the applicant is permitted to defend the opposition, the proceedings will continue with the parties given an opportunity to file evidence and the matters will be determined on their merits. However, if the applicant is not allowed to defend its application, it will be treated as abandoned and the applicant's mark will lose its filing date, based on the EUTM filed on 17 October 2014. Nevertheless, it will remain open to the applicant to re-file its application, which may, in turn, be opposed again by the opponent.

**Any prejudice caused to the opponent by the delay;**

37. The opponent submits that it has been prejudiced by the long delays, and that it has been 18 months since the original notice of opposition was filed and the matter has not progressed, and that further delays to these proceedings will cause prejudice and inconvenience both in time and cost to the opponent. However, I note the inevitable costs and additional time associated with delays of this type will affect both parties.

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

38. Both parties confirmed that while there are ongoing proceedings between the parties in other jurisdictions, there are no related proceedings in the UK.

**CONCLUSIONS**

39. In reaching my decision, I recognise that if the discretion is not exercised in the applicant's favour, the application will be treated as abandoned and the applicant will lose the filing date for its mark. I also recognise that the applicant may elect to re-file the 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 priority 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.

40. In sending the notice serving the TM7 upon the applicant, the Tribunal used the Royal Mail “International Tracked and Signed” service. While the tracking receipt from the Royal Mail and its delivery partner, being the USPS, show delivery to the given address, no signature of the individual to whom it was handed is available, being the postal service’s normal practice, as shown in Exhibit C submitted by the applicant, and is something for which the Tribunal cannot be held responsible. While that in itself does not constitute a failure of the communication service pursuant to Rule 76, the Tribunal, however, erred by sending the notice directly to the applicant at its US address, rather than to what should have been its recorded representative in Guernsey.

41. It is unclear why this has happened, however, it is clear that Dravya were notified of the TM7 filed on 16 December 2021, having been sent a copy of the letter from the Tribunal to the opponent dated 23 January 2022 which outlined that an amended TM7 would need to be filed on or before 14 February 2022. Following the request for an update in the status of the opposition from the opponent’s representatives, it came to light that this letter had mistakenly been sent directly to the opponent, rather than to its representatives Tomkins & Co. On 17 May 2022, the Tribunal wrote to the opponent’s representatives acknowledging the error, and resetting the date for an amended TM7 to be filed on or before 7 June 2022. A copy of this letter was also sent directly to the applicant in the USA. It appears that sometime between the letter dated 23 January 2022 and the letter dated 17 May 2022, Dravya were erroneously removed as representatives to the applicant on the UKIPO’s electronic filing system, and as such the applicant’s address for service would have defaulted to the applicant themselves at the given address in the USA.

42. While I would have expected Dravya to also have followed up on the status of the opposition against their client, I accept that an irregularity has occurred on the part of the Tribunal. I also acknowledge that on receipt of the preliminary view to deem the application abandoned, which was also sent to the applicant in the USA, Ms McClary confirmed at the hearing that the applicant had called the UKIPO for clarification. In

a follow-up email sent on 25 October 2022, Ms McClary on behalf of the applicant asked if it could file a response directly without UK counsel. The Tribunal responded on 06 December 2022 to say that proceedings were suspended pending consideration of the impact of the appeal decision of Mr Geoffrey Hobbs in relation to an appropriate address for service in UK proceedings.

43. On 10 January 2023, the applicant filed form TM33 appointing Thomas McClary as representative to the applicant, with a UK address for service. Within four days of the confirmation letter from the Tribunal that Mr McClary had been recorded accordingly, which also attached a copy of all the opposition documents and correspondence issued in these proceedings, Form TM8 and a counterstatement were filed by the applicant.

44. I understand the frustrations of both parties caused by the delays to these proceedings. I note Mr Gray's comments that in his view, there has been no irregularity on the part of the UKIPO who he says were entitled to serve the form to the applicant's US address, and that when the applicant phoned the UKIPO in October 2022, it clearly showed that they were acting on their own directly with the UKIPO and were not relying on the representatives in Guernsey, therefore in essence acted as their own representatives. However, I must take into account the mitigating circumstances which led to the late filing of the applicant's defence of the opposition to its application. Given that the Tribunal had reset the deadline for the opponent to file an amended TM7 following the error which resulted in the correspondence being sent directly to the opponent rather than to its representatives, in view of the analogous circumstances, it would be inconsistent and unfair not to afford the same courtesy to the applicant.

45. Having considered the applicant's reasons for its failure to file a TM8 by the deadline given, notwithstanding that the TM8 was filed some 166 days late, I find that the combination of reasons, including the part played by the UKIPO in mistakenly removing the applicant's representatives from its electronic records, which I consider to constitute an irregularity under Rule 74, and pursuant to Rule 77(5) and Rule 18(2), is sufficient to constitute extenuating circumstances and compelling reasons which

enable me rectify the irregularity and to exercise my discretion to admit the late-filed TM8 and counterstatement into these proceedings.

## **OUTCOME**

46. The consequences of the above finding is that, subject to any successful appeal, the applicant's late filed form TM8 and counterstatement may be admitted into the proceedings and assessed accordingly. Provided no anomalies are identified, it will be formally served upon the opponent and a timetable will be set for the filing of evidence.

## **COSTS**

47. As I have admitted the applicant's defence into the proceedings and therefore the opposition is allowed to continue, costs will be considered at the final determination of the case.

**Dated this 11th day of August 2023**

**Suzanne Hitchings**  
**For the Registrar,**  
**the Comptroller-General**