

O/0797/26

TRADE MARKS ACT 1994

**IN THE MATTER OF THE REQUEST BY PROJECT EADEN GMBH FOR
PROTECTION IN THE UK OF THE FOLLOWING**

INTERNATIONAL REGISTRATION NO. 1771769:

Project Eaden

IN CLASSES 7, 40, 42 & 45

AND

**THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT FILED IN
DEFENCE OF AN OPPOSITION THERETO UNDER NO. 448509**

BY THE EDEN TRUST

Background and pleadings

1. Project Eaden GmbH (“the holder”) is the holder of the International Registration (“the IR”) shown on the cover page. The IR was registered on 14 November 2023. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR. The holder seeks protection in the UK for the following goods and services:

Class 7: Machines, machine tools and power-operated tools and apparatus for the production, processing and preparation of foodstuffs and their intermediate products, in particular for the production, processing and preparation of meat substitute products; machines, machine tools and power-operated tools and apparatus for the food industry; parts and fittings for the aforesaid goods.

Class 40: Treatment and processing of food and their intermediate products for the production of food for third parties; customer-specific manufacturing and production of meat and sausage substitutes and products predominantly consisting of meat substitutes and/or sausage substitutes and their intermediate products; food processing; rental of machines, tools and apparatus for the production, processing and preparation of food and their intermediate products.

Class 42: Research of foodstuffs; product development in relation to groceries; computerised food analysis services; inspection of foodstuffs; professional advisory services relating to food technology; scientific and technological services relating to groceries; development of technologies for making sustainable food; development of technologies for making meat substitutes.

Class 45: Licensing services, in particular licensing of technology, intellectual property and industrial property rights in the field of food production and processing.

2. On 9 July 2024, The Eden Trust (“the opponent”) filed a Form TM7.¹ The opposition was brought under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”)

¹ Notice of opposition and statement of grounds.

and was directed against all the goods and services in the request for UK protection. The opposition was filed with notice by way of a Form TM7A² filed on 11 June 2024.

3. On 30 July 2024, the Registry served the opposition on the holder. The accompanying letter included the following:

“Please find enclosed a copy of the notice of opposition – amended Form TM7 - filed against your international registration. Copies of these documents have been sent to the World Intellectual Property Organisation (WIPO) informing them of this opposition.

If you wish to continue with your international registration, you need to file a notice of defence and counterstatement by completing Form TM8 - please note the important deadline below. You will find a blank Form TM8 on the IPO website, together with brief guidance on what happens after it is filed: <https://www.gov.uk/government/publications/trade-mark-forms-and-fees/trademark-forms-and-fees>.

Rule 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 30 September 2024.”

4. On 20 September 2024, the opponent filed a Form TM9C, requesting a cooling off period. This was accepted in a letter from the Registry dated 23 September 2024, which stated:

² Notice of threatened opposition.

“I refer to the TM9c dated **20th September 2024** indicating that the parties wish to enter into a cooling off period.

In accordance with Rule 18(4) of the Trade Marks Rules 2008, this period will expire on **30th April 2025**.

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 **30th April 2025**.

If no such request is made, the TM8 and counter-statement should be filed on or before **30th April 2025** or the international registration 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. On 23 April 2025, the opponent filed a Form TM9E, requesting an extension to the cooling off period. This was accepted in a letter from the Registry dated 24 April 2025, which stated:

“I refer to the TM9e dated 23 April 2025 which requested an extension to the cooling off period for a further nine months.

The extension to the cooling off period is allowed. This period will now expire on **30 January 2026**.

Under Rule 18(5) of the Trade Marks Rules 2008 no further extension to the cooling off period is allowed. Therefore, the TM8 and counter-statement are due to be filed on or before **30 January 2026**.

If no TM8 and counter-statement are filed within this period allowed the international registration 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.”

6. The IR holder did not file a Form TM8 by the deadline and so, on 9 February 2026, the Tribunal wrote to the applicant again. In the letter, the Tribunal stated:

“Our letter dated **24 April 2025** invited you to file a Form TM8 and counterstatement on or before **30 January 2026**.

As no Form TM8 and counter-statement has been filed within the time period set, the provisional refusal has been upheld in accordance with article 10B(1) of the Trade Marks (International Registration) (Amendment) Order 2004.

It is our preliminary view that the international registration 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, **9 March 2026**.

If no response is received by this date, we will proceed to notify the International Bureau that the provisional refusal has been upheld.”

7. The IR holder filed a notice of defence (Form TM8) and counterstatement on 9 March 2026. This was accompanied by a witness statement from Dr Fabian Pfefferkorn, a lawyer at Rechts-und Patentanwaltskanzlei Lewinsky & Kollegen, a law firm representing the opponent in Germany. Dr Pfefferkorn’s witness statement is dated 9 March 2026. The witness statement sets out the reasons for missing the prescribed deadline. The pertinent paragraphs are as follows:

“5. Before instructing Wilson Gunn, we represented Project Eaden GmbH in negotiations with the UK lawyers representing The Eden Trust. The lawyers representing The Eden Trust filed forms TM9C and TM9e in OP000448509 with our consent.

[...]

7. Because we were involved in negotiations and we did not appoint a UK representative at the time of filing the TM9C and TM9e forms, we failed to

diarise the TM8 deadlines and unintentionally missed the deadline to file the TM8. For the reasons set out in the next paragraph we were unaware of the TM8 deadline of 30 January 2026.

8. The letter dated 9 February 2026 from the UKIPO was sent only to our client, Project Eaden GmbH, we did not receive a copy of this letter. Furthermore, neither our firm nor our client received a copy of the UKIPO letter dated 24 April 2025 which set the TM8 deadline of 30 January 2026.”

8. On 7 May 2026, the parties were informed that it was the preliminary view of the registrar that the IR holder’s Form TM8 and counterstatement could not be admitted into the proceedings. In the same official letter, the parties were given until 21 May 2026 to request a hearing if they wished to challenge the preliminary view.

9. On 9 March 2026, the holder appointed Wilson Gunn as its representatives. Subsequently, on 18 May 2026, the opponent’s new UK representatives wrote to the Tribunal to request a hearing on this matter. A hearing date was set for 17 June 2026.

10. Prior to the hearing, neither party filed skeleton arguments. The opponent’s representatives wrote to the Tribunal prior to the hearing to confirm that they would be attending the hearing in an observatory capacity only.

THE HEARING

11. The hearing took place before me, by conference call, on 17 June 2026. Mr Andrew Marsden, of Wilson Gunn, attended for the IR holder. Matthew Harris, of Pinsent Masons, attended on behalf of the opponent, as an observer.

12. At the hearing, I gave a summary of the timetable of the proceedings up to this point (also noted above). I also confirmed that I had read all of the documents relevant to the case before me.

13. Mr Marsden’s submissions reflected the witness statement filed alongside the Form TM8 and can be summarised as follows:

- a. Prior to filing the Form TM8, the holder was represented by Lewinsky & Kollegen, a German law firm. This firm were in negotiations with the

opponent's representatives. UK representatives Wilson Gunn were subsequently appointed by the holder. Due to a UK representative not being appointed at the time of filing of the TM9C and TM9e forms, the holder failed to diarise the TM8 deadlines and therefore unintentionally missed the deadline.

- b. The letter dated 9 February 2026 from the Registry was sent only to the holder, not to the German representatives.
- c. Neither the German representatives nor the holder received the letter dated 24 April 2025 from the Registry which set the TM8 deadline of 30 January 2026.
- d. Finally, Mr Marsden stated that the opponent had not objected to the late-filed TM8.

14. In making my decision, I have reviewed all of the papers on file, which I take into account.

DECISION

15. 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 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.

(3) Unless either paragraph (4), (5) or (6) applies, the relevant period is the period of two months beginning immediately after the notification date."

16. The combined effect of Rules 77(1), 77(5) and Schedule 1 of the Rules means that the time limit in Rule 18, which sets 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.”

17. There has been no suggestion of any irregularity on the part of the Registrar. Consequently, the only basis on which the IR holder may be allowed to defend the opposition 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 18(2).

18. In approaching the exercise of discretion in these circumstances, I consider the decisions of the Appointed Person in *Kickz AG v Wicked Vision Limited* (“*Kickz*”)³ and *Mark James Holland v Mercury Wealth Management Limited* (“*Mercury*”)⁴, i.e. I must be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the IR holder’s favour.

19. In *Music Choice Ltd’s Trade Mark* [2005] RPC 18 (“*Music Choice*”), 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

³ BL/O/035/11

⁴ BL/O/050/12

20. The IR holder's main reason for the late filing of the Form TM8 appears to be a failure to appoint a UK representative. Although this is unfortunate, this was an error on the part of the holder; there was no error on the part of the Registry. I do not consider this failure to appoint a UK representative to be an extenuating circumstance.

21. I also note the holder's statement that the letters dated 24 April 2025 and 9 February 2026 from the Registry were sent only to the holder, not to the German representatives. It is not clear why these letters were sent to the holder and not the German representatives. However, the previous letters had been sent to the holder and Mr Marsden confirmed they had been received. Although it is unfortunate that the letters were not sent to the German representatives, the holder was aware of the opposition proceedings and at least the first two deadlines set for filing a defence. I do not consider the letters being addressed to the holder instead of the German representatives to be an extenuating circumstance.

22. The stipulated deadline for the filing of the IR holder's Form TM8 and counterstatement was 30 January 2026. The form was filed by the IR holder on 9 March 2026. Therefore, the deadline was missed by over five weeks.

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

23. The opposition is brought under section 5(2)(b) and section 5(3) of the Act. Whilst it is not for the present hearing to determine the merits of the case, there is nothing to suggest that the opposition is without merit.

The consequences of treating the IR holder as defending or not defending the opposition

24. If the IR holder is allowed to defend the opposition, the proceedings will continue with the parties given an opportunity to file evidence and the matter will be determined on its merits.

25. If, however, the defence is not admitted into the proceedings, the request for UK protection will be deemed abandoned, and the IR holder will lose its UK filing date of 14 November 2023, as well as its priority date of 15 May 2023. It will remain open to

the IR holder to re-file their request for UK protection, which may, in turn, be opposed again by the opponent.

Any prejudice caused to the opponent by the delay

26. The opponent did not submit any comments regarding prejudice caused. I do not consider that any significant prejudice has been caused to the opponent by the delay. 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.

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

27. I have not been made aware of any related proceedings or other relevant issues to consider.

Conclusions

28. Having addressed each of the relevant factors as proposed in *Music Choice*, I must now determine whether the holder's explanation for the failure to observe the prescribed deadline amounts to extenuating circumstances or compelling reasons that would enable me to exercise my discretion to allow the proceedings to continue.

29. In reaching my decision, as noted above, I recognise that if the discretion is not exercised in the IR holder's favour, the opposition will succeed, and the IR holder will lose their designation and priority dates in respect of all the goods and services in the request for UK protection (since the opposition is directed against the request for UK protection in full). I further recognise that it may be that the IR holder will simply re-file their request for UK protection and that this may, once again, be opposed by the opponent (or another party) resulting in opposition proceedings arising at some point in the future. However, as the loss of priority 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.

30. In the official letter dated 30 July 2024, the IR holder was provided with clear instructions and given a deadline by which it was required to file a Form TM8 and counterstatement, should it wish to defend its request for UK protection. This was reiterated in the official letter dated 23 September 2024, which extended the deadline. This was again repeated in the official letter dated 24 April 2025, extending the deadline again. As stated above, this final letter appears to have not been received by the IR holder. The letters, of which at least the first was received, informed the holder that failure to file a defence within the prescribed period would result in the request for UK protection being treated as abandoned. I am also conscious that the IR holder has been legally represented throughout these proceedings, albeit by a German firm. I do not consider the failure to appoint a UK representative to be a sufficient basis for granting the Tribunal's limited discretion for extending the deadline in this instance.

31. Having considered the IR holder'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

32. For the reasons outlined above, the Registry's preliminary view of 7 May 2026 is upheld and the late-filed TM8 is not admitted into the proceedings. The IR holder will be treated as not defending the opposition. The request for UK protection is deemed abandoned in respect of all of the goods and services applied for.

COSTS

33. As my decision terminates the proceedings, I must consider the matter of costs. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. I assess these as follows:⁵

Official fee for filing the form TM7: £100

⁵ I did not award costs for the hearing because, although the opponent's representatives attended, they did so only in an observatory capacity.

Preparing a statement: £250

Total: £350

34. I therefore order Project Eaden GmbH to pay the sum of **£350** to The Eden Trust. The above 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 3rd day of September 2026

K HAZLEBACH

For the Registrar