

O-0807-23

TRADE MARKS ACT 1994

IN THE MATTER OF  
TRADE MARK APPLICATION  
NO. UK00003758052  
BY MICHAEL PABLO SUTTON  
AND MARK KEVIN PINNOCK  
TO REGISTER

The logo for CHILLZ VODKA features the brand name in a bold, sans-serif font. The word 'CHILLZ' is in white with a blue outline, and 'VODKA' is in blue with a white outline. A small blue location pin icon is positioned above the letter 'I' in 'CHILLZ'. The entire logo is set against a black rectangular background.

AS A TRADE MARK  
IN CLASS 33  
AND OPPOSITION THERETO  
UNDER NO. OP000435419  
BY LEXAVI LTD

## BACKGROUND AND PLEADINGS

1. On 22 February 2022, Michael Pablo Sutton and Mark Kevin Pinnock (“the applicants”) applied to register the trade mark shown on the cover page of this decision.
2. The application was published for opposition purposes on 17 June 2022 for the following goods:

Class 33      Alcoholic beverages except beers.

3. Lexavi Ltd (“the opponent”) opposed the application based on section 5(4)(a) of the Trade Marks Act 1994 (“the Act”) by way of filing a Notice of opposition and statement of grounds (“Form TM7”) dated 10 October 2022 and received by the Registry on 28 November 2022.
4. The opponent in this case is represented by Astute Dynamic and the applicants are representing themselves.
5. On 31 January 2023, the Registry served the Form TM7 on the applicants by email, allowing the applicant until 31 March 2023 to file a Notice of defence and counterstatement (“Form TM8”) or request a cooling off period using Form TM9C. The serving letter contained the following paragraphs:

“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 31 March 2023.**

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.**”

6. On 29 March 2023, the Registry received a “statement of truth” from one of the applicants, Mr Sutton, signed and dated 18 March 2023.
  
7. On 18 May 2023, the Registry wrote to the applicants as follows:

“Dear Sirs,

The official letter dated 31 January 2023 invited the applicant to file a TM8 and counterstatement on or before 31 March 2023.

I acknowledge receipt of the applicant’s witness statement filed on 29 March 2023, however I am unable to admit this correspondence into proceedings as it is not accompanied by a form TM8.

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 form TM8 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, **01 June 2023**. 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. Please also file a completed form TM8 at this stage.

If no response is received the registry will proceed to deem the application abandoned.”

8. On 31 May 2023, Mr Sutton sent in a Form TM8 and counterstatement. He also supplied a witness statement, the pertinent part of which is copied below.

“Thank you for your correspondence letter dated 18th May 2023 in regard to the case between I Mr Michael P Sutton and Gabriel Aswosika. I believe I have been misled Informed by getting the wrong legal advice in regard to my case, I was told all I need was a statement of truth, (statutory declaration) and that should be enough, so I apologize for the misunderstanding I have done the TM8 Form to the best of my knowledge I hope it is correctly done this time around as I have no legal experience.”

9. On 27 June 2023, the Registry wrote to the applicants as follows:

“After careful consideration of the contents of the papers you have provided, it is the **preliminary view** of the Registrar that the reasons given are not sufficient to exercise his limited discretion and admit a late filed Form TM8 into these proceedings. Therefore **the Registrar’s preliminary view is that this application is to be treated as abandoned.**

In line with The Manual of Trade Marks Practice, if either party disagrees with a preliminary view, they may, within fourteen days from the date of this letter, that is, on or before **11 July 2023** express an objection and **request a hearing.**”

10. On 11 July 2023, Mr Sutton requested a hearing.

## **THE HEARING**

11. A hearing took place before me, via Microsoft Teams as an audio call, on Tuesday 8 August 2023.

12. Mr Gabriel Awosika from Astute Dynamic attended promptly as the representative of the opponent.

13. Mr Awosika had submitted skeleton arguments which reminded the Tribunal of the requirement for “extenuating circumstances” and “compelling reasons” to be demonstrated if a late-filed Form TM8 was to be admitted. Mr Awosika had also furnished the Tribunal with a copy of the *Kickz* case.

14. Neither of the applicants appeared at the start of the hearing. I paused the hearing while enquiries were made as to their whereabouts. After 10 minutes it became apparent that neither of the applicants were going to appear. I terminated the hearing and informed Mr Awosika that he would hear of what would happen next in due course.

15. Both of the applicants had been notified by letter to the addresses on file about the date of the hearing. The electronic calendar invitation was also emailed to the applicants to the email address on file which is the same email address for both applicants.

16. The applicants had not responded to the letters and the email. Shortly after the hearing had started, my colleague in the Tribunal Hearings team had

phoned Mr Sutton on his mobile. The call went to voicemail with a message that the voicemail was full.

17. Neither of the applicants contacted the Tribunal to explain their non-attendance at the hearing.

18. On 9 August, the Tribunal emailed both parties as follows:

“Further to the applicants’ non-attendance at yesterday’s joint hearing, the hearing will not be rescheduled and a written decision on the matter will be issued within four weeks.”

19. At the time of writing, the applicants have not been in touch to explain their non-attendance.

20. Nevertheless, I will re-examine the applicants’ witness statement explaining why they did not file a Form TM8 on time and the opponent’s response in the form of its skeleton arguments.

## **DECISION**

21. The filing of a Form TM8 in opposition proceedings is governed by rule 18 of the Trade Mark 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 shall begin on the notification date and end two months after that date.”

22. 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.”

23. Sitting as the Appointed Person in *Kickz AG and Wicked Vision Limited* (BL-O-035-11) (“*Kickz*”) Mr Geoffrey Hobbs QC held that the discretion conferred by Rule 18(2) can be exercised only if there are “extenuating circumstances”. And sitting as the Appointed Person in *Mark James Holland and Mercury Wealth Management Limited* (BL-O-050-12) (“*Mercury*”) Ms Amanda Michaels QC 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). The factors are as follows:

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

24. Mr Sutton says that he did not file a Form TM8 because he was misinformed “by getting the wrong legal advice in regard to my case, I was told all I need was a statement of truth, (statutory declaration) and that should be enough”. Furthermore, he states that he has “no legal experience”.
25. The Form TM8 was not filed by the applicants until the Registry prompted them to do so by 1 June 2023. The applicants filed the Form TM8 on 31 May 2023.

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

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

The consequences of treating the application as abandoned

27. If the applicants are allowed to defend the opposition, the proceedings will continue, and the matter will be determined on its merits. If, however, the applicants are not allowed to defend the opposition, their application will be deemed abandoned and the applicants will lose their filing date of 22 February 2022. It will remain open to the applicants to re-file their application which may, in turn, be opposed again.

Any prejudice caused to the opponent by the delay

28. The opponent has not identified any prejudice caused to itself other than costs. The applicants have made no comment on this subject.

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

29. The applicants have ticked the box on their late-filed Form TM8 to say that there are related proceedings before the UK courts but have provided no details. Nor

have they notified me of any reason why I might not deal with the proceedings before me without reference to those proceedings.

30. Having addressed each of the relevant factors as proposed in *Music Choice*, I must now decide whether the applicant's witness statement reveal extenuating circumstances or compelling reasons that would enable me to exercise the discretion to admit the late-filed Form TM8.

31. After carefully considering the expected detriment to the applicants in the event the discretion is not exercised in their favour, I find that the loss of a filing date and the possibility of further proceedings on much the same basis is often the consequence of a failure to comply with the non-extensible deadline for filing a Form TM8. These factors are not, therefore, particularly compelling.

32. Mr Sutton says that he received legal advice which wrongly said that he did not need to file a Form TM8 and that a statement of truth would suffice. Given the applicants' non-attendance at the hearing, they have not given a more detailed explanation than that.

33. Mr Sutton has no legal experience and, like his fellow applicant Mr Pinnock, is a litigant in person. However, I note that it is open to applicants to appoint legal representatives and if they choose to represent themselves it is incumbent upon them to familiarise themselves with the Registry's procedures. In this regard, I am mindful of the decision of Geoffrey Hobbs QC in *BOSCO* where he maintained that "being a litigant in person with no previous experience of legal proceedings is not a good reason for failing to comply with the rules."<sup>1</sup>

34. Having considered the applicants' reasons for their failure to file a Form TM8 by the deadline set, I find no single reason or combination of reasons sufficient to enable me to exercise my discretion to admit the late-filed Form TM8 into these proceedings.

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<sup>1</sup> BL-O-399-15

## **CONCLUSION**

35. The late-filed Form TM8 is not to be admitted into these proceedings. Subject to appeal, the application is treated as abandoned.

## **COSTS**

36. As my decision terminates the proceedings, I must consider the matter of costs.

37. The opponent seeks costs as follows:

“The Opponents seeks its costs against the applicants and is happy to accept £1000 plus VAT.”

38. I do not consider the opponent’s request to be a request for off-scale costs. However, I have arrived at a lower figure on the basis that costs are intended to be contributory rather than compensatory. I award the following costs by reference to Tribunal Practice Notice 2 of 2016:

Preparing a statement:	£200
Official fee:	£200
Preparing for and attending a hearing:	£300
<b>Total:</b>	<b>£700</b>

39. I order Michael Pablo Sutton and Mark Kevin Pinnock to pay Lexavi Ltd the sum of £700 as a contribution towards its costs. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

**Dated this 23rd day of August 2023**

**John Williams**

**For the Registrar**