

O/0809/23

TRADE MARKS ACT 1994

**IN THE MATTER OF A JOINT HEARING HELD IN
RELATION TO INTERNATIONAL REGISTRATION NO.
WO0000001596161 IN THE NAME OF GRSY LTD.**

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. CA000504609
BY ANBPM LIMITED**

BACKGROUND

1. These proceedings concern an application by ANBPM Limited (“the cancellation applicant”) for a declaration of invalidity in respect of the international registration (“IR”) held by GRSY Ltd. (“the IR holder”) under no. WO0000001596161. The trade mark is copied below.

SAINT E

2. It has an international registration date of 12 February 2021, with a priority date of 9 February 2021. The date of protection of the international registration in UK is 20 January 2022.
3. The mark stands registered for goods and services in Classes 18, 25, and 35.
4. The cancellation applicant filed a Form TM26(l) on 21 December 2022 based on section 5(4)(a) and sections 47(1) and 47(2) of the Trade Marks Act 1994 (“the Act”), directed against all the goods and services in the registration.
5. The IR holder filed a Form TM8 on 3 February 2023.
6. The Registry sent a letter serving the Form TM8 on the cancellation applicant by email on 3 March 2023 with a deadline for filing evidence and/or submissions of 3 May 2023.
7. Not having received any evidence or submissions, the Registry wrote to the cancellation applicant on 6 June 2023, an extract of the letter being copied below.

“The Registry’s letter dated 3 March 2023 advised you of the need to file your evidence and/or submissions in support of the opposition by 3 May 2023.

As you have neither filed the evidence nor requested additional time within which to file it, your opposition will, in accordance with 20(3) of the Trade Marks Rules 2008, shortly be deemed withdrawn.

If you wish to put forward reasons why this action should not be taken, please ensure that the Registry receives your written comments or your request for a hearing under Rule 63(1) on or before **20 June 2023.**”

8. On 7 June 2023, the cancellation applicant sent the following email:

“Thank you for your email and letter below.

Please note I have NOT received the earlier email to which you have referred in your letter. Can you please urgently advise on how I can respond accordingly?

Thank you

Sajaid Shaukat
ANBPM LTD”

9. The Registry then emailed another copy of its letter of 3 March 2023 to the cancellation applicant.
10. The cancellation applicant emailed the Registry on 11 June 2023 to reiterate that it did not receive the original letter and on 26 June 2023 it emailed again asking to be heard on the matter.

THE JOINT HEARING

11. The Joint Hearing took place before me, via Microsoft Teams, on Wednesday 19 July 2023. Mr Sajaid Shaukat attended as a litigant in person on behalf of the cancellation applicant. The IR holder did not attend.

12. This matter turns on whether Mr Shaukat received the Registry's email of 3 March 2023. That was his stated reason for not having submitted evidence and/or submissions on time – that he did not receive the email.
13. Mr Shaukat confirmed that the yahoo.co.uk email address that the Registry has on file has not changed throughout these proceedings. He also confirmed that there were no other circumstances that needed to be taken account of in respect of his not submitting evidence and/or submissions on time.
14. Mr Shaukat spoke of “at least two and it's as many as four” emails from the IPO over an eight-month period that he had not received. He speculated as to whether these emails went “into my junk mail ... or ... the cyber ether”.
15. I asked whether Mr Shaukat had had problems with emails from anybody else. He said that an email from his wife recently gone into his spam folder. I said that it was his responsibility to check his spam folder given that emails from corporate addresses sometimes go into spam folders.
16. I explained that the central question was whether the email was received and that I would commission a technical investigation. The outcome of this investigation and whether there was a failure of a communication service would be key.
17. I said that I would write to the cancellation applicant with my decision in due course.
18. At that point, I closed the hearing.

DECISION

Statutory provisions and guidance

19. Rule 76 of the Trade Mark Rules 2008 is set out below.

“Delays in communication services

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 service” means a service by which documents may be sent and delivered and includes post, facsimile, email and courier.”

20. Rule 62 provides the Registrar with their general powers in relation to the management of proceedings. In particular that:

“(1) Except where the Act or these Rules otherwise provide, the registrar may give such directions as to the management of any proceedings as the registrar thinks fit, and in particular may—

(a) require a document, information or evidence to be filed within such period as the registrar may specify.”

21. In addition, Rule 77 provides:

“(1) Subject to paragraphs (4) and (5), the registrar may, at the request of the person or party concerned or at the registrar’s own initiative extend a time or period prescribed by these Rules or a time or period

specified by the registrar for doing any act and any extension under this paragraph shall be made subject to such conditions as the registrar may direct.

(2) A request for extension under this rule may be made before or after the time or period in question has expired and shall be made—

(a) where the application for registration has not been published and the request for an extension is made before the time or period in question has expired, in writing; and

(b) in any other case, on Form TM9.”

22. Guidance regarding extendable time limits is provided in Tribunal Practice Notice 2 of 2011 and I copy an extract below:

“Case management of inter partes proceedings: efficient, fair and less costly resolution of disputes before the Trade Marks Tribunal

1. There is a public interest in resolving disputes before the Tribunal efficiently and within a predictable timescale. Swift and effective determination of cases not only creates certainty for third parties but reduces the burden of litigation and the accompanying costs for the parties involved. Furthermore, drawn-out proceedings which become unnecessarily complicated or sidetracked affect the resources which the Tribunal is able fairly to allocate to other users. The Trade Mark Rules 2008 empower the Tribunal to give case management directions (rule 62). This Tribunal Practice Notice (TPN) sets out the Tribunal's approach to case management of disputes in order to:

- Deal with cases promptly, efficiently and fairly
- Deal with cases in ways which are proportionate to the complexity of the issues

- Give cases an appropriate share of the Tribunal's resources
- Save expense

Time periods

2. Following the filing of a defence, the Tribunal sets and notifies the parties of the timetable for filing evidence and/or submissions (as per the periods set out in TPN 2/2010). The timetable is to be adhered to. It provides more than enough time, in the vast majority of cases, for facts or submissions pertinent to the pleaded grounds to be gathered and presented to the Tribunal. Parties should not regard this timetable as a 'starter for ten', to be varied at a later date. The Tribunal will, **in exceptional cases**, consider requests to extend the time allowance. Such requests will need to be fully supported with explanations as to not only what has been done to date but, more particularly, what is left to do and how long it will take to produce the evidence. The Tribunal will also need to be satisfied that the extra time is warranted in the context of the pleaded grounds and what is necessary to determine the case efficiently and fairly.

3. Further, the Tribunal will use its discretion to set time periods as it sees necessary, which may be less than the further time which the party has requested. Parties should particularly note that, if they have specified a time when the evidence will be ready and been allowed that further period of time, the Tribunal will look unfavourably upon further extension requests.”

My findings

23. On 31 July 2023, I contacted the relevant caseworker and asked him to obtain a report from the IPO IT department to confirm that the email in question was received by the cancellation applicant.

24. On 3 August 2023, the IPO IT department produced a report from its Message Tracking system. The report shows that the email in question with

the letter and the Form TM8 as attachments was successfully processed by no-reply@ipo.gov.uk on 03/03/23 at 11:26:42. It was then “Accepted for processing by SMTP Outbound Transport Service” on 03/03/23 at 11:26:46 and “Delivered to destination SMTP server for the cancellation applicant’s email address – xxxxxxx@yahoo.co.uk – on 03/03/23 at 11:26:48.

25. I am satisfied that the email in question was successfully delivered and therefore there was no failure of a communication service and therefore Rule 76 does not apply.

26. The Registry discharged its responsibilities in sending the cancellation applicant a letter by email serving the Form TM8 and notifying it of the requirement to file evidence and/or submissions by 3 May 2023.

27. While the cancellation applicant responded promptly to the Registry’s email of 6 June 2023 to explain that it did not receive the Registry’s letter of 3 March 2023, the possibility that the email in question went into its spam folder is not “an exceptional case” which would justify the exercise of my discretion to allow the cancellation applicant to file late evidence and/or submissions.

28. The Manual of Trade Marks Practice in the context of requests for extensions of time says: “The fact that evidence is available at the time a Hearing/CMC on a contested extension of time takes place is not determinative, though it is an important factor.” The cancellation applicant did not send in its evidence and/or submissions in advance of the hearing, nor did it come to the hearing with any undertakings as to when it could file evidence and/or submissions. Furthermore, it has not filed a Form TM9R.

29. I have considered the cancellation applicant’s apparent unfamiliarity with Registry procedures as a litigant in person. However, I am mindful of Geoffrey Hobbs QC’s decision 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.”¹

30. The timely, cost efficient, and fair management of proceedings depends upon the parties adhering to the deadlines set by the Registry. In the absence of an exceptional reason explaining why the cancellation applicant did not meet the Registry’s deadline, I reject its request to late file evidence and/or submissions in this case.

CONCLUSION

31. I have found that rule 76 does not apply and I decline to exercise my discretion to allow the cancellation applicant to late file evidence and/or submissions.

32. Subject to any appeal, the application for a declaration of invalidity is deemed to be withdrawn.

COSTS

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

34. The IR holder has not requested costs, but I do consider a costs award in line with Tribunal Practice Notice (“TPN”) 2/2016 to be appropriate.

35. I award costs to the IR holder as follows:

Preparing a statement and considering the other side’s statement:	£200
Total:	£200

¹ BL-O-399-15

36. I order ANBPM Limited to pay GRSY Ltd. £200. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of August 2023

John Williams
For the Registrar