

O/0816/26

TRADE MARKS ACT 1994

IN THE MATTER OF A JOINT HEARING HELD IN RELATION TO

APPLICATION NO. 4207860

TO REGISTER THE TRADE MARK:



IN CLASSES 6, 17, 19 & 37

IN THE NAME OF SR TIMBER & BUILDING MERCHANT LTD

AND

**THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT FILED IN
DEFENCE OF AN OPPOSITION THERETO UNDER NO. 456098**

BY SIG TRADING LIMITED

Background and pleadings

1. On 22 May 2025, SR TIMBER & BUILDING MERCHANT LTD (“the applicant”) applied to register the trade mark as shown on the cover page. It was accepted and published on 15 August 2025 in respect of the following goods and services:

Class 6: Metal materials for construction; Metal materials for building and construction; Building and construction materials and elements of metal; Construction materials of metal with soundproofing qualities; Steel building materials; Metal building materials; Building materials of metal; Metal materials for building; Metallic building materials; Building materials of metal with soundproofing qualities; Metal goods for use in construction.

Class 17: Insulating materials for building; Soundproofing materials; Insulation materials of plastics.

Class 19: Wood; Wood and artificial wood; Wood flooring; Flooring made of wood; Artificial wood flooring; Sawn wood; Veneer wood; Wood veneer; Wood siding; Parquet flooring made of wood; Wood paving; Building and construction materials and elements made of wood and artificial wood; Wood trim; Wood sheeting; Wood veneer parquet flooring; Parquet wood flooring; Parquet flooring of wood; Wood for building; Wood for use in building; Wood fibreboard; Wood core plywood; Wood tar; Building materials of wood; Preserved wood [anti-decay wood]; Floor coverings of wood; Wood paneling; Wood tile flooring; Wood shingles; Stave wood; Glue-laminated wood; Shuttering made of wood; Boards of wood fibre; Wood fibre boards; Wood moldings; Wood laminates; Hobby wood; Artificial wood; Wood veneers; Building components of imitation wood; Roofing boards [of wood]; Moulded wood; Wood chipboard; Planks [wood for building]; Planks of wood for building; Balsa wood; Scaffolding of wood; Wood panelling; Cask wood; Wood blocks; Mantels of wood for fireplaces; Wood sports floors; Building materials of plastics material; Facade construction components of non-metallic materials; Construction materials, not of metal; Materials, not of metal, for construction; Building and construction materials and elements, not of metal; Concrete building materials; Building materials (non-metallic); Non-metallic building materials; Construction

materials with soundproofing qualities, not of metal; Fiber reinforced plastic construction materials; Fiberboard [building materials]; Roofing materials; Strawboard [building materials]; Laminates of non-metallic materials for use in building; Wood for construction purposes; Bridge bearings [construction materials] not of metal; Intumescent building materials; Construction elements of timber; Non-metallic building materials for screeding; Building construction materials in the nature of aromatic cedar planking; Construction timber; Building boards of plastics materials; Building materials, not of metal.

Class 37: Construction; Construction of buildings; Buildings (Construction of -); Building construction.

2. On 18 August 2025, SIG Trading Limited (“the opponent”) filed a Form TM7.¹ The opposition was brought under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and was directed against all the goods and services in the application.

3. On 9 September 2025, the Tribunal served the TM7 on the applicant. The pertinent paragraphs of the official serving letter are as follows:

“Please find enclosed a copy of the 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 a Form TM8 - please note the important deadline below.

[...]

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

¹ Notice of opposition and statement of grounds.

TM9c, which will extend the 2 month period in which to file a Form TM8 by up to a further seven months. A 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 10 November 2025.

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)

4. The original letter was returned by the Royal Mail. The Registry reissued the letter on 27 October 2025, giving an updated deadline for filing a Form TM8 of 29 December 2025.

5. The applicant did not respond to the Tribunal’s serving letter, therefore on 18 January 2026, after the expiry of the statutory deadline, an official letter was issued to the applicant and copied to the opponent, stating that the Registry was minded to deem the application as abandoned as no defence had been filed within the prescribed period. The applicant was given a deadline of 2 February 2026 to file a Form TM8 and provide full written reasons for a late-filed defence.

6. The applicant filed a Form TM8 on 2 February 2026. The Registry responded with a letter stating that there were deficiencies with the form. The applicant subsequently filed an admissible form on 12 March 2026. This was accompanied by a witness statement from Sarwan Singh, the Director of the applicant, dated the same. This witness statement set out its reasons for missing the prescribed deadline. The pertinent paragraphs are as follows:

“3. Following receipt of correspondence relating to the opposition proceedings, the Applicant instructed a firm of solicitors to act on its behalf in connection with

this matter. All relevant documents and information were provided to the instructed solicitors in good time.

4. The Applicant reasonably believed that the instructed solicitors were dealing with the opposition proceedings, including the filing of the necessary defence and counterstatement within the applicable time limits.

5. During the relevant period, the instructed solicitors informed the Applicant that progress was delayed due to annual leave, the Christmas period, and the New Year holiday break, during which the matter was not actively progressed.

6. Subsequently, and after the expiry of the original deadline for filing Form TM8, the Applicant was informed by the instructed solicitors that they were no longer in a position to act in this matter and would not be taking the case forward.

7. As a result of these circumstances, which were outside of the Applicant's direct control, the Applicant was left without legal representation at a critical stage and was therefore unable to file the Form TM8 within the original time period.

8. Upon becoming aware of the position and the seriousness of the situation, the Applicant acted promptly and without delay to prepare and file Form TM8 together with this witness statement."

7. On 10 April 2026, the Registry issued a letter to the applicant acknowledging receipt of the late-filed TM8 and counterstatement. This letter further stated:

"From the witness statement it is noted that the applicant has instructed a firm of solicitors to act on its behalf in this matter. It is also noted that the Applicant was informed by this firm that the progress of the matter was delayed due to annual leave, and the holiday period throughout Christmas and New Year. In paragraph 6 of the witness statement, Mr Singh states that after the expiry of the original deadline for filing Form TM8, the Applicant was informed by that firm of solicitors that they were no longer in a position to act in this matter and were not taking the case forward.

In light of the above, to consider the matter fully, the Applicant is requested to provide any evidence such as an email chain or letters confirming the circumstances outlined in paragraphs 5 and 6 of the witness statement. Please do so on or before **24 April 2026**.”

8. On 23 April 2026, the applicant filed evidence of its correspondence with Protect Law, showing that discussions were ongoing regarding representation of the applicant. However, I note that no Form TM33 was filed, and therefore the applicant was never officially represented by this firm. As such, all correspondence from the Registry was sent directly to the applicant.

9. On 12 June 2026, a letter was issued stating:

“Upon review of the documents you provided, it was noted that you did appoint solicitors from Protect Law to act on your behalf on 5 March 2025. Most of the correspondence to or from Protect Law appears to have taken place before the present opposition was filed on 18 August 2025. Most importantly, it is noted that Protect Law never filed a Form TM33 to be added to our records as your representatives and all correspondence regarding this opposition was sent to you directly. Therefore, you should have been aware of the deadline to file a Form TM8 on or before 29 December 2025.

It is therefore the Registry’s preliminary view that, as the notice of defence and counterstatement would be filed outside of the statutory deadline, it cannot be permitted into the proceedings.

You are referred to the following decisions of the Appointed Persons in this regard: *Kickz AG and Wicked Vision Limited* (BL-O-035/11) and *Mark James Holland and Mercury Wealth Management Limited* (BL-O-050/12). Copies of these decisions can be found on the IPO website at:

<https://www.ipo.gov.uk/t-challenge-decision-results.htm>

If you disagree with the preliminary view you must provide full written reasons and request a hearing on, or before, **26 June 2026**. If no response is received

within the time allowed, the preliminary view will automatically become final immediately after that date and the trademark will be struck out.”

10. Prior to this, in an email dated 11 May 2026, the opponent requested a hearing to discuss the late-filed Form TM8. On 17 June 2026, the applicant also requested a hearing to discuss the same. A hearing date was set for 4 August 2026.

11. Prior to the hearing, only the opponent filed skeleton arguments.

THE HEARING

12. The hearing took place before me, by conference call, on 4 August 2026. Alan Fiddes was in attendance on behalf of the opponent.

13. Sajal Sharma was in attendance on behalf of the applicant. Mr Sharma stated that he was representing the applicant on behalf of a law firm, although he declined to state which law firm. I noted in the hearing that a TM33 had not been filed so the Registry could not officially recognise Mr Sharma as a representative of the applicant. Mr Fiddes, on behalf of the opponent, stated that, to avoid any further delays, he was prepared to proceed with the hearing on the basis that a TM33 would be filed imminently. I agreed with this suggestion and continued with the hearing.

14. No Form TM33 had been filed before the hearing and none has been filed subsequently. The Registry has therefore been unable formally to record either Sajal Sharma or the unidentified firm as the applicant’s representative or address for service.

15. In any event, Sajal Sharma’s submissions did not materially add to the explanation contained in Sarwan Singh’s witness statement and the applicant’s written response to the preliminary view. I have determined the matter on the basis of that written evidence and the documents on file. The outcome would have been the same had I taken Sajal Sharma’s oral submissions fully into account.

16. At the hearing, I gave a summary of the timetable of the proceedings up to this point, which has also been summarised above. I also confirmed that I had read all of the documents relevant to the case before me, including the skeleton arguments filed by the opponent.

17. The applicant's submissions were given in the witness statement accompanying the late-filed Form TM8 and in the letter responding to the Registry's preliminary view. These submissions can be summarised as follows:

- a. The applicant instructed a firm of solicitors to act on its behalf and provided all relevant documents and information to said firm in good time. The applicant reasonably believed that the instructed solicitors were dealing with the opposition proceedings, including filing the necessary defence and counterstatement within the applicable time limits.
- b. After the expiry of the deadline to file a defence, the applicant was informed by the instructed solicitors that they were no longer in a position to act in the matter and would not be taking the case forward.
- c. Upon becoming aware of the position and the seriousness of the situation, the applicant acted promptly and without delay to prepare and file the Form TM8.
- d. The applicant's business was also undergoing an office address change at the time, which contributed to administrative confusion and resulted in the deadline being unintentionally overlooked.

18. Mr Fiddes's submissions in the hearing reflected the skeleton arguments filed and can be summarised as follows:

- a. Protect Law were never on record as the address for service for the application by filing a Form TM33 and all the correspondence with UKIPO was directly with the applicant using the addresses provided by the applicant. This means the applicant would have been fully aware of the deadlines set by the UKIPO and was therefore responsible for ensuring that the deadline for filing the TM8 was met.
- b. There has been no irregularity on the part of the Tribunal.

- c. The applicant received all of the correspondence from the Registry and it was its responsibility to ensure that the deadlines were met and it failed to do so. As a result, the applicant is the “author of its own misfortune”.
- d. The opponent is prejudiced by the ongoing delay in the proceedings, which have been ongoing for nearly a year, and would be further prejudiced by the late entry of the TM8 into the proceedings.

19. At the conclusion of the hearing, I reserved my decision to give me an opportunity to properly reflect on the submissions put forward by the parties and all the circumstances of the case. In making my decision, I have reviewed all of the papers on file, which I take into account.

DECISION

20. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by Rule 18 of 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.”

21. 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.”

22. There has been no suggestion of any irregularity on the part of the Registrar. Consequently, the only basis on which the applicant 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).

23. 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*”)² and *Mark James Holland v Mercury Wealth Management Limited* (“*Mercury*”)³ i.e. I must be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the applicant’s favour.

24. 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

25. The applicant’s main reason for the late filing of the Form TM8 appears to be a failure of the law firm with which the applicant was in communication. Evidence was provided of correspondence between itself and the law firm. The applicant’s assumption that the firm would act on their behalf did not relieve it of the responsibility for correspondence sent directly to it, particularly where no representative had been formally appointed or recorded in these proceedings. On the basis of the evidence

² BL/O/035/11

³ BL/O/050/12

provided, I do not consider the applicant's dealings with the firm to constitute an extenuating circumstance.

26. The applicant also states that it was undergoing a change of address at the time, contributing to administrative confusion. Full details of the dates of change of address were not provided. However, it is the responsibility of the applicant to manage incoming correspondence in proceedings and therefore I also do not consider this to constitute an extenuating circumstance.

27. The deadline for the filing of the applicant's Form TM8 and counterstatement was 29 December 2025. The form was filed by the applicant on 2 February 2026. Therefore, the deadline was missed by 35 days.

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

28. The opposition is brought under sections 5(2)(b), 5(3) and 5(4)(a) 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 applicant as defending or not defending the opposition

29. If the applicant 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.

30. If, however, the defence is not admitted into the proceedings, the application will be deemed abandoned, and the applicant will lose their filing date of 22 May 2025. It will remain open to the applicant to re-file their application, which may, in turn, be opposed again by the opponent.

Any prejudice caused to the opponent by the delay

31. In its skeleton arguments, the opponent states that it is prejudiced by the delay to the proceedings. It states that the matter has been ongoing for nearly a year and the delays have been caused by the applicant's failure to meet the deadline.

32. Although I accept that the proceedings have been delayed, 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

33. The opponent states that, in parallel to the opposition proceedings, there is an action filed before the Company Names Tribunal. I do not consider that the existence of this action has any bearing on the outcome of this decision.

Conclusions

34. Having addressed each of the relevant factors as proposed in *Music Choice*, I need to decide whether the applicant's witness statement in response to the preliminary view 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, as noted above, I recognise that if the discretion is not exercised in the applicant's favour, the opposition will succeed, and the applicant will lose their filing date in respect of all the goods and services in the application (since the opposition is directed against the application in full). I further recognise that it may be that the applicant will simply re-file their application and that this may, once again, be opposed by the opponent 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.

36. In the official letters dated 9 September 2025 and 27 October 2025, 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 letters informed the applicant that failure to file a defence within the prescribed period would result in the application being treated as abandoned.

37. I also note that, although the applicant was in the process of appointing representation, no formal representation was appointed and, as such, all of the correspondence was sent directly to the applicant. The applicant was therefore aware of the deadlines set, and the severity of the consequences for not meeting said deadlines. The applicant has also not explained why it did not verify with Protect Law that the necessary action had been taken.

38. In addition, the applicant received a letter from Protect Law on 8 January 2026 stating that the firm would no longer be acting for the applicant. Following this, the applicant made no effort to contact the Tribunal to determine the status of the proceedings, only doing so upon receipt of the letter of 18 January 2026 from the Tribunal, which informed the applicant that the deadline for filing a Form TM8 had passed. The applicant has also not outlined what steps were taken after receiving the letter of 18 January 2026 to ensure that a defence was filed by the deadline.

39. Although it is unfortunate that the firm the applicant was in discussions with was unable to act on the applicant's behalf, it was ultimately the responsibility of the applicant to act to protect its trade mark.

40. 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.

41. 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

42. For the reasons outlined above, the Registry's preliminary view is upheld and the late-filed TM8 is not admitted into the proceedings. The applicant will be treated as not defending the opposition. The application is deemed abandoned in respect of all of the goods and services applied for.

COSTS

43. 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:

Official fee:	£100
---------------	------

Filing a Form TM7 and preparing a statement and considering the Form TM8 and counterstatement:	£250
--	------

Preparing for and attending a hearing:	£300
--	------

Total:	£650
---------------	-------------

44. I therefore order SR TIMBER & BUILDING MERCHANT LTD to pay the sum of **£1250** to SIG Trading Limited. 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 8th day of September 2026

K HAZLEBACH

For the Registrar