

O/0854/23

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. UK3634900
IN THE NAME OF SHEAR PAWFECTION LTD
TO REGISTER AS A TRADE MARK**



ShearPawfection
Mobile Pet Grooming Spa

IN CLASS 44

AND

**THE LATE FILING OF FORM TM8 AND
COUNTERSTATEMENT
FILED IN DEFENCE OF THAT APPLICATION
IN OPPOSITION PROCEEDINGS
UNDER NUMBER OP426508
BY MRS. NATASHA BAINES**

BACKGROUND

1. On 30 April 2021, Shear Pawfection Ltd (“the applicant”) applied to register trade mark number UK3634900, for the mark shown on the cover page of this decision, in the United Kingdom. The application was accepted and published for opposition purposes on 16 July 2021, in respect of the following services:

Class 44: *Dog and cat grooming services.*

2. On 25 August 2021, JMP Solicitors¹ filed Form TM7 (“Notice of opposition and statement of grounds”) on behalf of Mrs. Natasha Baines (“the opponent”). The opposition is based upon Section 5(1), Section 5(2)(a), Section (5)(2)(b), Section 5(3), Section 5(4)(a), and Section 3(6) of the Trade Marks Act 1994 (“the Act”), and is directed against all of the services in the application. The opponent relies upon its UK trade mark registration number 3548357, shown below, which has a filing date of 26 October 2020 and for which the registration procedure was completed on 19 March 2021.



3. The Form TM7 as originally filed was deemed non-admissible due to multiple errors within the form. In a period of over twelve months, several rounds of correspondence between the Tribunal and the opponent’s representatives followed, with each letter sent by the Tribunal outlining the necessary amendments to be made before the form could be accepted, with corresponding deadlines given in each case for a correctly amended form to be filed. I note that the opponent did not respond by the given deadline on four separate occasions. While the amended Form TM7 filed on 12

¹ The Tribunal was notified on 02 August 2023 by email from JMP Solicitors that they were no longer representatives to the opponent. Mrs Baines is now unrepresented in these proceedings.

September 2022 still contained errors, it was considered to be acceptable and thus was admitted into the proceedings.

4. On 15 November 2022, the Tribunal served the Form TM7 by both post and by email upon the applicant. The deadline for the applicant to file its Form TM8 (“Notice of defence and counterstatement”) was 16 January 2023, communicated by the Tribunal in the serving letter. The Tribunal’s letter contained the following:

“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 16 January 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.”
(original emphasis)

5. The applicant, who at this stage in the proceedings was unrepresented, did not file a TM8 by the deadline, and so, on 24 January 2023, the Tribunal wrote to the applicant again. In the letter, the Tribunal stated that:

“The official letter dated 15 November 2022 invited the applicant to file a TM8 and counterstatement on or before 16 January 2023.

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 February 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.

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

6. On 31 January 2023, Form TM33 appointing Anthony Burrows as representative to the applicant was filed, alongside an unsigned and undated witness statement by the applicant marked “CONFIDENTIAL” which outlined the reasons for the missed deadline, and a request for a two month extension of time for the filing of the defence.

7. On 02 March 2023, the Tribunal wrote to the applicant via the representative to acknowledge that Mr Burrows had been recorded as representative. A period of two weeks until 16 March 2023 was allowed for the applicant to file a late Form TM8 and an amended (signed and dated) witness statement setting out the reasons why the TM8 had not been filed within the prescribed period that could be shared with the

other party. This correspondence was sent to the representative's email address as recorded on the electronic filing system of the United Kingdom Intellectual Property Office ("UKIPO").

8. As no response to the above mentioned letter was forthcoming, on 01 April 2023, the Tribunal wrote to both parties to confirm that the application had been deemed withdrawn in accordance with Rule 18(2) of the Trade Mark Rules 2008 ("the Rules").

9. However, on 09 May 2023, the Tribunal wrote again to the parties to acknowledge that the letter dated 02 March 2023 had been sent to an incorrect email address and therefore, given this irregularity, the Registrar invoked Rule 76(1) of the Rules to reset the period for the applicant to file a late Form TM8 and amended witness statement to 23 May 2023.

10. On 23 May 2023, the applicant filed Form TM8, accompanied by an amended witness statement by Kara Blackwell, being the sole director of the applicant company. The statement set out the reasons for the late filing of the defence, which Ms Blackwell stated was due to "serious personal difficulties" including the ill-health and subsequent death of her father. Ms Blackwell states that she was living with her father at the time, and as a result of his death, she was given until 23 January 2023 to find alternative accommodation. At the same time, Ms Blackwell had the main responsibility to make arrangements for the funeral, which took place on 1 February 2023.

11. On 27 July 2023, the Tribunal issued the preliminary view to both sides that it considered that there existed compelling reasons which enabled the late-filed TM8 to be admitted into proceedings, adding that if either party disagreed with the preliminary view, they should request a hearing by 10 August 2023.

12. On 08 August 2023, the Tribunal received an email from the opponent requesting a hearing.

13. A hearing was scheduled for 06 September 2023, the details of which were sent by the Tribunal to both parties in an official letter dated 14 August 2023. Both parties

confirmed attendance, and the opponent filed its skeleton arguments on 01 September 2023.

THE JOINT HEARING

14. The hearing took place before me, via Microsoft TEAMS telephone conference, on Wednesday 06 September 2023. The opponent, Mrs Natasha Baines, was in attendance, represented at the hearing by Mr Carroll Blackford, and Mr Anthony Burrows represented the applicant.

15. At the hearing, I explained to both parties that the purpose of the hearing was to consider whether the preliminary view to allow the late-filed defence to be admitted into the proceedings should be upheld. I further confirmed that I had received the skeleton arguments from the opponent, and that I had read all the relevant documents to the case before me.

16. The applicant's skeleton arguments (labelled Annex A) outlined the background to the dispute, alongside Annex B listing the eight attachments by number, which included copies of correspondence sent between the Tribunal and the parties (labelled 66-69).

17. At the hearing, Mr Blackford said much about the correspondence sent by the Tribunal to the wrong email address of the applicant's representative on 02 March 2023. I clarified that an error had been made by the UKIPO which had erroneously recorded an incorrect email address for the applicant's appointed representative, however, this had occurred following the missed deadline for filing the Form TM8. Therefore, it was not directly relevant to the issue before me, being whether the reasons given in the witness statement for the missed deadline by the applicant should be considered to be compelling and to constitute extenuating circumstances which allow me to use my discretion to admit the late-filed TM8 and counterstatement into these proceedings.

18. Mr Blackford continued that he had investigated Ms Blackwell's personal circumstances and at the relevant time, she was running three businesses, going on

holiday and moving house, amongst other activities. When asked to clarify whether Mr Blackford was questioning the validity of the witness statement regarding the ill-health and subsequent death of the applicant's father at the given time, he conceded that he knew this to be true but said that the witness statement was "lacking in some of its basis".

19. Turning to Mr Burrows, he stated that the problem was simply down to an inadvertence on the part of the Registry, who had sent correspondence to an erroneous email address. I reiterated that this had occurred after the non-extensible deadline given for filing the TM8 had been missed. Mr Burrows then added that Ms Blackwell had indeed had the problems as set out in her witness statement and that the reason for missing the deadline in the first place was due to the terribly distressing circumstances that she was under at that time.

20. While not directly relevant to the reasons for the missed deadline for filing Form TM8, Mr Burrows also brought to my attention the "series of extensions" granted by the Tribunal to the opponent for the filing of the required amendments to the Form TM7, which had caused delay earlier on in these proceedings.

21. 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

22. 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.”

23. 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.”

24. I accept that the Tribunal sent correspondence to the incorrect email address of the applicant’s newly appointed representative, causing further delay to the late filing of Form TM8. However, this was subsequent to the already missed deadline for filing the form and as such has no direct bearing on the applicant’s reasons for missing that deadline. Accordingly, I do not consider that there has been any irregularity on the part of the Tribunal in this regard. 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).

25. 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.

26. 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:

27. As noted above, the stipulated deadline for the filing of the applicant's Form TM8 and counterstatement was 16 January 2023. The Form TM8 and counterstatement was filed by the applicant's representative on 23 May 2023. Therefore, the deadline was missed by 127 days.

28. However, for a more accurate reflection of the extent to which the deadline was missed, I note that the Form TM33 appointing Mr Burrows as representative to the applicant, alongside the first (inadmissible) witness statement of Ms Blackwell and a request for an extension of time in which to file the late TM8 were filed on 31 January 2023. This was only 15 days after the missed deadline. I must also take into consideration the time lapse between the aforementioned correspondence being sent to the applicant's representatives' incorrect email address on 02 March 2022, and the subsequent rectification of that email address. This led to the deadline for filing an amended witness statement and late TM8 being reset to 23 May 2023, which accounts for 82 days of the 127 day period.

29. The applicant's witness statement provided a written explanation as to why the deadline was missed, i.e. owing to serious personal problems, including the ill-health of the applicant's father. This explanation was considered a compelling reason by the Tribunal in its consideration leading to the preliminary view to admit the late-filed TM8.

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

30. The opposition is brought under sections 5(1), 5(2)(a), 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Act. At first glance, the marks do not appear to be identical, therefore the

opposition under sections 5(1) and 5(2)(a) seem unconvincing, however, there is nothing to suggest that the remaining grounds of the opposition are without merit.

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

31. 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 of 30 April 2021. 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;

32. No submissions were made by either party regarding prejudice to the opponent. However, I note the inevitable costs and additional time associated with delays of this type.

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

33. There do not appear to be any other relevant considerations.

CONCLUSIONS

34. 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.

35. In the official letter dated 15 November 2022, the Tribunal made it very clear that failure to file a Form TM8 by the deadline would in most circumstances result in the application being treated as abandoned. At this time, the applicant was unrepresented, and while the filing of Form TM8 is a relatively simple task, the circumstances in which she found herself, as outlined previously, occurred prior to and immediately following the time that the TM7 was served upon her. I consider it reasonable to accept that the deadline was missed as a direct result of the difficulties she faced.

36. I understand the frustrations of both parties caused by the delays to these proceedings. I also acknowledge Mr Burrows' submissions that earlier in these proceedings, the Form TM7 had not been correctly completed by the opponent, leading to what he considered to be extensions of time. I take into account that the opponent was allowed several opportunities to file amended TM7s, which could not be served for more than a year following the initial filing of the opposition. Given that the Tribunal had repeatedly reset the deadline for the opponent to file an amended TM7, and while the conditions before me are not quite the same, the deadline for filing Form TM8 being non-extensible except in exceptional circumstances, considering the circumstances already outlined in this decision, it would be inconsistent and unfair not to afford a similar courtesy to the applicant.

37. In order to exercise my discretion to admit the late-filed TM8 and counterstatement into these proceedings, I must take into account all of the mitigating circumstances which led to the late filing of the applicant's defence of the opposition to its application. Having considered the applicant's reasons for its failure to file a TM8 by the deadline given, I consider them sufficient to constitute extenuating circumstances and compelling reasons which enable me to uphold the preliminary view to admit the defence.

OUTCOME

38. The consequences of the above finding is that the applicant's late-filed Form TM8 and counterstatement will 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

39. 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 8th day of September 2023

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