

**BL O/0886/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**INVALIDITY APPLICATION No. 505788**

**BY ZHEJIANG QIANJIANG MOTORCYCLE CO. LIMITED**

**AGAINST TRADE MARK REGISTRATION No. 3731789**

**IN THE NAME OF PRESTACIONES Y ASESORIA JURIDICA PATMARK LIMITADA**

### **DECISION**

1. Invalidation Application No. 505788 (filed on behalf of Zhejiang Qianjiang Motorcycle Co. Limited) was served on the registered proprietor of Trade Mark No. 3731789 (Prestaciones y Asesoría Jurídica Patmark Limitada) on 09 February 2023.
2. The registered proprietor failed to comply with the non-extendable deadline of 11 April 2023 for filing a Form TM8 Defence and Counterstatement under Rule 41(6) of the Trade Marks Rules 2008 and thereafter failed to respond to an Official Letter of 25 April 2023 setting a deadline of 09 May 2023 by which to file a request, supported by reasons in writing, for permission to defend the unanswered claim for invalidity.
3. On 17 May 2023, the trade mark registration was declared invalid and deemed never to have been made pursuant to the provisions of Rule 41(6) which specify that upon default in the filing of the required Form TM8 Defence and Counterstatement: “... *registration of the mark shall, unless the registrar otherwise directs, be declared invalid.*”
4. Ms Maria Eugenia Lopez was subsequently recorded in the Register of Trade Marks as the proprietor of the invalidated registration on the basis of a notice of assignment received by the Registry on 05 June 2023 in which the effective date of assignment was identified as 30 May 2023.
5. Then on 15 June 2023 her professional representatives filed a Form TM55P Notice and Grounds of Appeal contending that there were extenuating circumstances and / or compelling reasons for setting aside the order for invalidity which the Registrar had made under Rule 41(6) on 17 May 2023.

6. These, in summary, were that: *“the Appellant was not informed by the assignor / previous owner, nor by their agents, of the deadline for filing the TM8 and Counterstatement or any subsequent deadlines. Nor was the Appellant provided with copies of the correspondence and documents until after the request to record the assignment had been filed on 30 May 2023. The Appellant, being an Argentine national was not familiar with the UK Registry procedures and did not appreciate that any action was required on her part. The Appellant was naturally dependent on the information that was passed on to her.”*
7. That statement of position raised more questions than it answered with regard to the way in which Ms Lopez and the Assignor dealt with one another in relation to the Assignment of the trade mark registration.
8. However, it is sufficient for present purposes to note that Ms Lopez stands in the shoes of the Assignor when it comes to the decisive question whether there were any extenuating circumstances or compelling reasons which ought to have resulted in the Registrar permitting the Assignor as registered proprietor of the trade mark to defend the unanswered claim for invalidity.
9. No explanation or excuse of any kind has been provided by Ms Lopez or anyone else for the failure of the registered proprietor — Prestaciones y Asesoría Jurídica Patmark Limitada — to respond or react to the Invalidity Application in the Registry proceedings. There is, in fact, no basis on which the Registrar’s order for invalidity made on 17 May 2023 could be found by this Tribunal to have been erroneous or procedurally irregular.
10. For the reasons I have given, the Appeal is dismissed. Ms Lopez is directed to pay £200. to the Respondent in respect of its costs of the unsuccessful Appeal, to be paid within 21 days of the date of this Decision. I regard that as a reasonable amount to award by way of costs from the perspective of the approach to quantification indicated in paras [12] to [14] of my Decision in AMARO GAYO COFFEE Trade Mark BL O/257/18 (25 April 2018).

Geoffrey Hobbs KC

19 September 2023

Mr Mark Sorenti of Trademarkit LLP appeared on behalf of the Appellant.

Mr Huw Evans of IPEY filed written representations on behalf of the Respondent.