

O/0913/26

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION
NO. UK00004288740
BY SHAH MAHMOOD
TO REGISTER THE TRADE MARK:**

YOU WANT BEEF?

IN CLASSES 29, 35 AND 45

AND

**THE LATE FILING OF FORM TM8 AND
COUNTERSTATEMENT
FILED IN DEFENCE OF THAT APPLICATION
IN OPPOSITION THERETO
UNDER NO. OP000459145
BY YOU WANT BEEF LTD**

Background

1. On 4 November 2025, Shah Mahmood (“the applicant”) applied to register the trade mark number shown on the cover page of this decision in the UK. The application was published for opposition purposes on 5 December 2025. The applicant seeks registration for the following goods and services:

Class 29: Potato fries, potato chips; milk, milk shakes, milk beverages; chicken or fish; cheese; pickles; Milk shakes; Milk drinks; Milk beverages, milk predominating; Flavoured milk; Milk beverages; Milk beverages with cocoa; Chicken burgers; Vegetable burgers; Veggie burger patties; Milkshakes; Potato fries; Chips [french fries]; Chicken nuggets; Chicken burgers.

Class 35: Business advice relating to restaurant franchising; Business assistance relating to franchising; Franchising (Business advisory services relating to -); Business assistance relating to the establishment of franchises.

Class 45: Licensing of franchise concepts.

2. On 29 December 2025, YOU WANT BEEF LTD (“the opponent”) filed an opposition based on Sections 5(2)(a), 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”)¹. The opposition, which was filed without notice,² is directed against all of the goods and services in the application.

¹ The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

² No notification date was stated in the Form TM7; and the Form TM7 was not foreshadowed by a Form TM7A (Notice of threatened opposition).

3. On 13 January 2026, the Registry served the Form TM7³ on the applicant. The Registry's serving letter informed the applicant that the deadline for filing a completed Form TM8 or Form TM9C was 13 March 2026. The pertinent paragraphs of the letter are as follows:

“It is important to understand that if the deadline date is missed then, in almost all circumstances, the application will be treated as abandoned in accordance with Rule 18(2) of the trade mark Rules 2008: *“where the applicant fails to file a Form TM8 and 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.”*

[...]

Failure to choose either option 1 or option 2 will, in almost all circumstances, result in your application being deemed abandoned.”
(original emphasis)

4. The applicant's Form TM8 was not received within the deadline of 13 March 2026. On 23 April 2026, the Registry wrote to the applicant stating:

“Our letter dated 13 January 2026 invited you to file a Form TM8 and counterstatement on or before 13 March 2026.

As no Form TM8 and counter-statement has been filed within the time period set, Rule 18(2) applies. Rule 18(2) states:

“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 Notice of opposition and statement of grounds.

It is our preliminary view that the application should be treated as abandoned because no defence was filed by the deadline referred to above.

If you disagree with the preliminary view, you **must** file the Form TM8 and counter-statement **and** a witness statement setting out the reasons for the failure to meet the deadline on, or before, **7 May 2026**.

If no response is received by this date, the application will be treated as abandoned (i.e. it will be withdrawn)."

5. Although the applicant filed a Form TM8 and counterstatement on 24 April 2026, no witness statement was filed with it. Following further correspondence from the Registry, dated 6 June 2026, Mr Mahmood filed a witness statement on 11 June 2026, dated the same, stating that he:

- worked permanent night-shifts, slept during the morning and woke late in the afternoon, and had very limited time for administrative and legal matters;
- had been extremely busy with the day-to-day running of his business and that his working routine made it difficult to prepare and file the response before the deadline; and
- apologised and said that the omission was not intentional.

6. On 15 July 2026, the Registry issued a preliminary view stating the following:

"[...] 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.

If you disagree with the preliminary view you must provide full written reasons and request a hearing on, or before, **29 July 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. [...]" (Original emphasis)

7. On 29 July 2026, the applicant requested a hearing. In that request, he gave further explanations, stating that:
 - he is a shared carer for his young daughter, who has severe and complex medical needs, and that around the deadline there had been a significant increase in the frequency and severity of her seizures;
 - his days and nights had been consumed by her care;
 - he had no respite or opportunity to delegate that care; and
 - that he had very little time even to tend to basic personal or administrative matters or keep track of the deadline.
8. A hearing took place before me by telephone conference on 2 September 2026. The applicant, Mr Mahmood, represented himself. Mr Craig Beaumont of Barker Brettell LLP represented the opponent.

The Hearing

9. I explained that the purpose of the hearing was to consider whether the late filed defence should be admitted into the proceedings. I also highlighted that the TM8 deadline is a non-extendable time limit, pursuant to the relevant case law and Trade Mark Rules 2008 ("the Rules"), and my discretion to allow the Form TM8 to proceed to be examined is a narrow one which can only be exercised where there are compelling reasons or extenuating circumstances.
10. Since both parties attended the hearing, I will summarise the arguments and submissions briefly.

11. Mr Mahmood described the late filing as an honest administrative oversight and acknowledged it as a genuine mistake. He reiterated that his daughter was severely unwell and that, combined with his night-shift work, this caused matters to “slip his mind”. When asked specifically about the position around the deadline of 13 March 2026, Mr Mahmood stated that he had the relevant information and had completed the forms, but had not submitted them because they were not fully filled out. He admitted that his personal circumstances should not have hindered him from finalising and filing the Form TM8 and counterstatement. Mr Mahmood asked that the defence be admitted so that the opposition could be decided on its merits.
12. For the opponent, Mr Beaumont submitted that the deadline and the consequences of non-compliance had been clearly stated, but the Form TM8 was filed more than six weeks late and the witness statement was not filed with it. He observed that the caring circumstances relied upon in the hearing request and at the hearing were not set out in the witness statement, which relied on night-shift work and business commitments. While expressing sympathy for the applicant’s circumstances, Mr Beaumont submitted that no compelling reasons or extenuating circumstances had been established and that the preliminary view should be upheld. Finally, Mr Beaumont submitted that the opponent had experienced months of procedural uncertainty because of the late filing of the Form TM8, arguing that the preliminary view should therefore be upheld.
13. At the conclusion of the hearing, I reserved my decision in order to consider the parties’ oral submissions and the papers on file. In making my decision I have taken into account all of the papers on file, the parties’ skeleton arguments and their oral submissions.

Decision

14. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by Rule 18 of the Rules, which provides as follows:

“(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”. (Emphasis added)

15. 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-extendable other than in the circumstances identified in rules 77(5)(a) and (b) which provide that:

“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.”

16. It was not disputed that the late filing of the applicant’s Form TM8 in this instance was not attributable to any irregularity, default, omission or other error on the part of, *inter alia*, the Registrar. Therefore, my consideration is restricted to the limb of the discretion contained in the words “*unless the Registrar otherwise directs*” under Rule 18(2).

17. 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.

18. In *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 applicant's submissions and skeleton argument 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

19. The circumstances as to why the deadline was missed are summarised above at [5], [7] and [11]. The stipulated deadline for the filing of the applicant's Form TM8 and counterstatement was 13 March 2026. The Registry's serving letter clearly stated the deadline and explained the consequences of non-compliance. However, the Form TM8 and counterstatement were filed by the applicant on 24 April 2026. Therefore, the deadline was missed by 42 days.

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

20. The opposition is brought under Section 5(2)(a), 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Act and is directed against all goods and services in the application. There is nothing to suggest that the opposition is without merit.

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

21. 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, the application will be treated as abandoned in respect of all of the opposed goods and services, and the applicant will lose the filing date of 4 November 2025. Nevertheless, it will remain open to the applicant to re-file its application, which may, in turn, be open to opposition.

Any prejudice caused to the opponent by the delay

22. The opponent submitted that it had experienced procedural uncertainty since commencing the opposition.

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

23. I was not made aware of any other relevant considerations.

Conclusions

24. In reaching my decision, I bear in mind that the deadline for filing a Form TM8 is a statutory one, with the applicant having been made fully aware of the consequences of failing to comply by way of correspondence from the Registry. 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 its filing date for its mark. I also recognise that it may well be that the applicant's refiled application may again be opposed by the opponent (or another party) resulting in further opposition proceedings arising at some point in the future.
25. In his witness statement, Mr Mahmood explained that he missed the deadline because of the demands of his permanent night-shift work, sleeping pattern, business commitments, and limited time for administrative matters. However, in his letter dated 29 July 2026 requesting a hearing, and in his oral submissions, Mr Mahmood also relied,

primarily, on the increased demands of caring for his daughter during a period of medical instability. I agree with Mr Beaumont that the witness statement does not mention the caring responsibilities later relied upon.

26. I note that when a party claims that circumstances prevented compliance with a statutory deadline, they must present sufficiently detailed (narrative and/or documentary) evidence that outlines their nature, timing and practical effect upon the person responsible for compliance.⁴ In this regard, I point out that the applicant was explicitly informed of the need to provide a witness statement explaining the missed deadline and was directed to the relevant guidance materials. The official letter dated 6 June 2026 informed the applicant that:

“I also refer to the letter dated 23 April 2026 stating that if the applicant disagrees with the preliminary view, they should file a Form TM8 and a witness statement setting out reasons for the failure to meet the deadline. Therefore, you are required to provide a witness statement as well.

A witness statement should be headed up to refer to the registration and proceedings number and the details of the parties, provide the details of the person making the statement, contain a statement of truth and be signed and dated. An example of a witness statement can be found on our website at <https://www.gov.uk/government/publications/filing-evidence-about-an-application-or-in-tribunal-proceedings>”

27. The guidance available through the link provided in the official communication states:

“Part 2: body of the statement

[...]

⁴ See for example *Gabriel Cesar Alvarado v Karl Robert Johnson*, BL O/378/18.

You should provide any documentary evidence to support your statement in the form of exhibits. The exhibits need to be mentioned in the witness statement and should be clearly labelled. If possible, include separate header sheets for each exhibit.

If your evidence relates to any other matters (for example bad faith)

You should explain the facts which you consider support your case.
[...]"

28. A party is expected to set out all of the relevant facts that explain why the deadline was missed. Although Mr Mahmood did not explain at the hearing why he omitted his caring duties and his daughter's acute medical condition from his witness statement, I have taken into account the additional reasons in full for the purposes of this assessment.
29. From the submissions, it is clear that the permanent night-shift work, the ordinary demands of running a business and ongoing caring responsibilities may have placed a significant burden on Mr Mahmood. Nevertheless, these commitments, including general caring responsibilities, were ongoing and foreseeable circumstances that Mr Mahmood was aware of. Although he claimed his daughter's condition worsened shortly before the deadline, he did not specify when this deterioration began, how long it lasted, or why it prevented him from filing the Form TM8 during the two-month period. The serving letter allowed the applicant two months to file a defence or, alternatively, a Form TM9C. At the hearing, Mr Mahmood acknowledged that he had nearly completed the forms but did not submit them because they were not fully finished.
30. Further, I note that Mr Mahmood did not indicate any efforts to meet the deadline, such as seeking assistance or appointing a representative. Crucially, Mr Mahmood admitted that his circumstances should not have prevented him from finalising and filing the form and repeatedly described the failure as a genuine mistake or oversight. Consequently, it appears to

me that the fundamental issue was a failure to complete and file the form, rather than an inability to act within the relevant timeframe.

31. Whilst I sympathise with Mr Mahmood's circumstances, without specific clarification or supporting evidence, I am unable to find these have prevented him from filing the Form TM8 within the stipulated deadline. Whilst I appreciate that Mr Mahmood is a litigant in person, it is considered that the filing of a Form TM8 is a relatively simple task, capable of being carried out successfully, whether or not an applicant is represented.
32. Taking all of the above into account and having regard to the factors set out in the case law in *Kickz*, *Mercury* and *Music Choice*, I am not satisfied that the reasons why the Form TM8 and counterstatement were filed 42 days late are particularly compelling, nor do they constitute extenuating circumstances sufficient to permit the Registrar to exercise its discretion under rule 18(2). I therefore find that the applicant was clearly "*the author of [his] own misfortune*".⁵

Outcome

33. The Registry's preliminary view is upheld. The late Form TM8 is not to be admitted into the proceedings. Consequently, as the opposition against the application at hand is deemed as undefended, the application will, subject to any successful appeal, be treated as abandoned.

Costs

34. Given that my decision terminates the proceedings, I must consider the matter of costs. Awards of costs are set out in Tribunal Practice Notice ("TPN") 1/2023. As noted above, the opposition has been filed without notice. The following paragraph of TPN 1/2023 therefore, applies:

⁵ See *Kickz*, paragraph 15.

“Costs in undefended actions

7. Unless factors exist which suggest otherwise, costs will not be awarded against parties who do not defend an action which has been brought against them without prior notice.”

35. I therefore make no order for costs.

Dated this 6th day of October 2026

Dr Stylianos Alexandridis

For the Registrar,

The Comptroller General