

O/0937/23

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. UK3857213
IN THE NAME OF ANANTA MEDICARE LIMITED
TO REGISTER AS A TRADE MARK**

ARTIKON

IN CLASS 5

AND

**THE LATE FILING OF FORM TM8 AND
COUNTERSTATEMENT
FILED IN DEFENCE OF THAT APPLICATION
IN OPPOSITION PROCEEDINGS
UNDER NUMBER OP439749
BY ANICON LABOR GMBH**

BACKGROUND

1. On 08 December 2022, Ananta Medicare Limited (“the applicant”) applied to register trade mark number UK3857213, for the mark shown on the cover page of this decision, in the United Kingdom. The declarant named on the application form is Sourabh Kumar. The application was accepted and published for opposition purposes on 16 December 2022, in respect of the following goods:

Class 5: *Dietary supplements; Protein dietary supplements; Dietary food supplements; Dietary supplements for humans; Dietary and nutritional supplements; Dietary and nutritional preparations; Dietary supplements for human beings; Dietary supplements and dietetic preparations; Dietary supplements for medical use; Dietary supplements for humans not for medical purposes; Herbal medicine; Herbal supplements; Herbal preparations for medical use; Food supplements; Food supplements for medical purposes; Food supplements for non-medical purposes; Nutritional supplements; Pharmaceuticals and natural remedies.*

2. On 16 March 2023, WP Thompson filed form TM7 (“Notice of opposition and statement of grounds”) on behalf of AniCon Labor GmbH (“the opponent”). The opposition is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all of the goods in the application. The opponent relies upon its UK trade mark registration number 36657011 “**ANICON**”, which has a filing date of 07 July 2021, and for which the registration procedure was completed on 03 December 2021¹, and the comparable mark UK905930839, shown below, which has a filing date of 10 May 2007, and for which the registration procedure was completed on 26 February 2008.



¹ This case was filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union and the EU filing date was 20 March 2018.

3. On 20 April 2023, the Tribunal, using its stated preference for correspondence, served the form TM7 by email upon the applicant. The deadline for the applicant to file its form TM8 (“Notice of defence and counterstatement”) was 20 June 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 20th June 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)

4. The applicant, who is unrepresented, did not file a TM8 by the deadline, however, on the 03 July 2023, it filed a Form TM9R, requesting an extension to the deadline to file a Form TM8 and counterstatement. On 07 July 2023, the Tribunal wrote to the

applicant again (this time sent by email and post). In the letter, the Tribunal stated that:

“The official letter dated **20 April 2023** invited the applicant to file a TM8 and counterstatement on or before **20 June 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, **21 July 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.

It is noted the applicant filed a Form TM9R on **03 July 2023**, requesting an extension to the deadline to file a Form TM8 and counterstatement. The period for filing a defence is a statutory deadline defined in the Trade Marks Act and therefore cannot be extended. As the Form TM9R will not be examined, a refund of the fee paid, will be refunded in due course.

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

5. On 18 July 2023, the applicant filed a witness statement, signed by Sourabh Kumar, providing written reasons for the delay in filing a TM8 and Counterstatement, as shown below, although a TM8 was not submitted alongside the witness statement:

1. I, Sourabh Kumar, a Business Development Manager at Ananta Medicare Ltd of Suite 1, 2 Station Court, Townmead Road, Fulham, London SW6 2PY. The facts in this statement come from my personal knowledge or the records of my company and I am duly authorised to speak on my company's behalf in the prosecution of this application.

2. As per the Official Letter dated 20 April 2023 invited us to file a TM8 and counterstatement on or before 20 June 2023. We also received another letter dated 30 May 2023 with details of the Opponent to correspond related to the trademark opposition and negotiation. Due to mis-understanding it was assumed that we need to negotiate with the Opponent and not pursue TM8 filing for the moment. This was a genuine mistake which occurred due to wrong interpretation of the letters.

3. Although as per rule, we had to file TM8, however due to clerical oversight this was not done on time. And in the month of June 2023, I was unable to attend work due to medical reasons at home and this letter was overlooked by mistake. The moment I realised towards the end of June 2023, that there has been an oversight and due date has crossed, I filed for an extension vide TM9A, which now I understand is of no use.

4. I accept and apologize for the oversight and mistake. However, I would please request a hearing and a chance to file TM8, since I strongly believe that the opposition is unjustified and our trademark is completely different than the opposed mark.

5. The fact in this witness statement are true to the best of my knowledge and belief.

6. On 17 August 2023, the Tribunal wrote to the applicant to acknowledge receipt of the witness statement. In the official letter, sent by email, the Tribunal stated that:

I acknowledge receipt of your email dated **18 July 2023** outlining the reasons why the Form TM8 was not submitted within the prescribed period and providing a witness statement.

The Registry notes that a notice of defence and counterstatement would be filed outside the statutory two-month period, set in accordance with Rule 18(1) and 18(2) of the Trade Mark Rules 2008. In line with these rules, the period allowed to file a Form TM8 and counterstatement is two months beginning immediately after the notification date.

The Form TM7 was filed by the opponent on **16 March 2023** and the applicant was notified on **20 April 2023**. The deadline for submitting a Form TM8 and counterstatement was **20 June 2023**. The applicant's explanation for a

late submission is deemed insufficient to permit the exercise of the Registrar's limited discretion in such matters, that would permit the admission of these documents into the proceedings.

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 can request a hearing within fourteen days from the date of this letter that is on or before **31 August 2023**.

Please note, if you do request a hearing, you are required to file a TM8 and counterstatement at the same time as it is noted that you have only filed a witness statement so far.

If no response is received within the time allowed, the preliminary view will automatically be confirmed, and the registry will proceed to deem the application abandoned.

Please note, if the Hearing Officer maintains the preliminary view, the applicant may be required to contribute to the other party's costs. This is not intended to dissuade you from attending a hearing, but merely to inform you of the potential consequences should you be unsuccessful in overturning the preliminary view."

7. On 31 August 2023, the Tribunal received an email from the applicant requesting a hearing. The email request was accompanied by Form TM8 and Counterstatement.

8. A hearing was scheduled for 28 September 2023, the details of which were sent by the Tribunal to both parties in an official letter dated 13 September 2023. Both parties confirmed attendance, and the opponent filed its skeleton arguments on 26 September 2023.

THE JOINT HEARING

9. The hearing took place before me, via Microsoft TEAMS telephone conference, on Thursday 28 September 2023. Sourabh Kumar represented the applicant, and David Alan Gill of WP Thompson represented the opponent.

10. I explained to both parties that the purpose of the hearing was to consider whether the late filed defence should be admitted into the proceedings and not to discuss the merits of the substantive issues. 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.

11. The opponent's skeleton arguments outlined the timeline for the proceedings to date, and the opponent's position on the applicant's witness statement and on the applicant's (late filed) TM8 and counterstatement. It concluded that the preliminary view should be upheld and an award of costs made in favour of the opponent.

12. At the hearing, Mr Kumar began by admitting that the applicant had received the Form TM7 served on 20 April 2023. He stated that with regard to the correspondence sent by the Tribunal on 30 May which confirmed the recordal of the email address supplied for correspondence to the opponent, at the time of receipt, he misunderstood it's meaning. He added that he now realised that it had nothing to do with the filing of the TM8, and that it was a genuine misunderstanding on his part and that this was the reason for the delay. He said that when he realised that he had missed the deadline, he requested an extension of time to the deadline, being unaware of the rules and regulations pertaining to the correct processes.

13. Turning to Mr Gill, he began by reflecting on the reasons given for the delay as set out in paragraph 2 of the witness statement of Mr Kumar. In his witness statement, Mr Kumar had stated that following receipt of the copy letter from the Tribunal regarding the opponent's email address for correspondence, he assumed that he needed to negotiate with the opponent. Mr Gill stated that the official letter dated 20 April 2023 outlined the possibility of filing a request for a cooling off period to allow for

negotiation. He said that he could see no reason for confusion or uncertainty which could arise from the communications in relation to the opponent's email address as being a suggestion that the applicant needed to now negotiate with the opponent. Turning to paragraph 3 of the witness statement, Mr Gill said that as to the effects of the medical reasons which distracted the applicant from what needed to be done, there was a "distinct lack of detail" on which to judge if there were extenuating circumstances. Further, the applicant had made no attempt to contact the opponent to pursue negotiations, which would have been reasonable behaviour if that is what the applicant thought was required of them. Mr Gill concluded that he believed that there were no extenuating circumstances provided to allow the Registrar to exercise the very narrow discretion that is required in these circumstances.

14. Mr Kumar responded by reiterating that although he had the whole month of May when he could have filed the defence, he was under the assumption that he had to negotiate with the opponent rather than file the Form TM8. However, he gave no explanation as to why he had made no attempt to contact the other side, other than to say that due to the family emergency in June, he was unable to follow up on things.

15. In summing up, I said that I felt that the correspondence sent by the Tribunal clearly set out the steps to be taken by the applicant and the deadlines by which the actions were to be taken. Mr Kumar had admitted that he could have filed the Form TM8 in May, before the distraction of his family circumstances in June, but had not acted upon it at that time. Neither did he attempt to contact either the Tribunal for further clarification, or the opponent in order to begin negotiations. I confirmed that the deadlines given for filing the Form TM8 are non-extensible, and that a clerical oversight or misunderstanding were not considered to be compelling reasons or extenuating circumstances which allowed me to exercise my discretion to admit the late filed defence.

16. As such, I directed that the preliminary view not to admit the late filed Form TM8 and Counterstatement into the proceedings be upheld. I confirmed that the decision would also be issued in writing in due course. I will now proceed to expand on the reasons behind my decision.

DECISION

17. 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.”

18. 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.”

19. There is no suggestion that there has been any irregularity on the part of the Tribunal. 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).

20. 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.

21. 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

22. As noted above, the stipulated deadline for the filing of the applicant's Form TM8 and counterstatement was 20 June 2023. The Form TM8 and counterstatement was filed by the applicant on 31 August 2023. Therefore, the deadline was missed by 72 days. However, I note that the applicant filed a request for an extension to the deadline on 03 July 2023, being 13 days after the missed deadline.

The applicant's written explanation as to why the deadline was missed, i.e. owing to "a misunderstanding" and "a clerical oversight" is shown above at paragraph 5.

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

23. The opposition is brought under section 5(2)(b) of the Act. There is nothing to suggest that the opposition is without merit.

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

24. 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 08 December 2022. 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

25. 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

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

CONCLUSIONS

27. 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.

28. In the official letter dated 20 April 2023, 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. I accept that the applicant is unrepresented, and that the defence of a trade mark opposition may be somewhat confusing to those unfamiliar with the process. However, the filing of form TM8 is a relatively simple task, and the Tribunal receives many defences from litigants in person who successfully defend opposition to their trade mark applications in a timely manner without professional representation. I also consider it reasonable to expect an applicant to contact the

Tribunal to seek further clarification if they felt unsure of the directions given, however, in this instance the applicant made no attempt to do so.

29. I note that on 03 July 2023, on realising that the deadline had been missed, the applicant erroneously filed a Form TM9R, requesting an extension to the deadline to file a Form TM8 and counterstatement. However, given Mr Kumar's admission that he had received the TM7 in a timely manner, and that he could have filed the TM8 during the whole of the month of May, prior to his familial circumstances in June, I do not consider this to be a compelling factor sufficient to justify me exercising my discretion in the applicant's favour. I am reminded that in dismissing the appeal in *Kickz AG*, Geoffrey Hobbs Q.C.(as he then was), sitting as Appointed Person, found that the applicant "had been the author of his own misfortune"². I find that to also be true of the applicant in the case before me.

30. Having considered the applicant's reasons for its failure to file a TM8 by the deadline given, I find those reasons insufficient to constitute extenuating circumstances or to be compelling reasons which would enable me to exercise my limited discretion to admit the late-filed TM8 and counterstatement into these proceedings.

OUTCOME

31. The late form TM8 and counterstatement is not to be admitted into the proceedings. Subject to any successful appeal, the application is treated as abandoned in respect of all the goods applied for.

COSTS

32. Given that the outcome of this decision has terminated the proceedings, the opponent is entitled to a contribution towards its costs, based on the scale published in the TPN (Tribunal Practice Notice) 1/2023. Applying the TPN as a guide, I assess costs as follows:

² At [15].

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| Official fee: | £100 |
| Preparing the statement of case: | £250 |
| Preparing for and attending the hearing, including filing skeleton arguments: | £350 |
| Total: | £700 |

33. I therefore order Ananta Medicare Limited to pay AniCon Labor GmbH the sum of £700. This 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 3rd day of October 2023

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