

O/1008/23

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 505982
TO REVOKE FOR REASONS OF NON-USE
TRADE MARK REGISTRATION UK00003267803**

**OWNED BY
HATTON BOXING LTD**

AND

**THE LATE FILING OF FORM TM8 AND
COUNTERSTATEMENT IN DEFENCE THEREOF**

BACKGROUND

1. On 11 April 2023, Hykso Inc. ('HI') sought revocation of registration UK00003267803 which stands in the name of Hatton Boxing LTD ('HBL'), on the grounds of non-use, by way of Form TM26(N).¹ Under section 46(1)(a) of the Trade Marks Act 1994 ('the Act'), HI claims non-use in the five-year period following the date on which the contested mark was registered, i.e. 7 April 2018 to 6 April 2023, with an effective date of revocation of 7 April 2023. HI claims non-use in respect of all of the services in respect of which HBL's mark is registered:

Class 41: Conducting fitness classes; Conducting physical fitness conditioning classes.

2. On 2 May 2023, the Registry served the Form TM26(N) on HBL by post and email at the addresses (both physical and email) provided by them. That letter contained the following paragraphs:

"Please find enclosed a copy of a TM26(N) filed against your registration.

You have failed to indicate at Box 6 whether you have contacted the registered proprietor prior to filing the above revocation. In view of this, the Registrar intends to proceed on the understanding that the proprietor was not notified. Your attention is drawn to TPN 4/2007 - Costs in proceedings before the Comptroller, paragraph 9.²

If you wish to continue with your registration, you need to file a notice of defence and counterstatement by completing Form TM8(N) - please note the important deadline below. You will find a blank Form TM8(N) on the IPO website, together with brief guidance on what happens after it is filed:
<https://www.gov.uk/government/publications/trade-mark-forms-and-fees/trademark-forms-and-fees>

¹ Application to revoke a registration

² This paragraph is directed to the Applicant for Revocation and was included in the letter addressed to HBL in error.

Rule 38(3) of the Trade Marks Rules 2008 require that you must file your notice of defence and counterstatement (Form TM8(N)) within **two months** from the date of this letter.

IMPORTANT DEADLINE: A completed Form TM8(N) MUST be received on or before 3 July 2023.

Rule 38(3) and (4) allows you to file evidence of your use of the mark at the same time as your counterstatement. If you wish to do this your counterstatement **must** at Section 7 on the TM8(N) specify the goods/services that the mark has been used on, or in relation to. The evidence **must** be cross-referenced to specific exhibits e.g. the mark has been used on, or in relation to 'cutlery' as shown at Exhibit MR1.

You do not have to file evidence of use with your counterstatement. If you do not, a further opportunity of two months will be given for that evidence to be filed.

Rule 38(6) of the Trade Marks Rules 2008 states that **"Where the proprietor fails to file a Form TM8(N) within the period specified in paragraph (3) the registration of the mark shall, unless the registrar directs otherwise, be revoked."** It is important to understand that **if the deadline date is missed, then in almost all circumstances, the registration will be treated as revoked in whole or part.**

3. No Form TM8(N) was filed by HBL on or before 3 July 2023.
4. On 18 July 2023, HBL filed a Form TM8(N) accompanied by an email which stated the following:

"We acknowledge that the deadline for filing was 3 July 2023. The proprietor has asked us to express its sincere apologies for the late filing of this form."

5. On 24 August 2023, the Registry sent an official letter to HBL in the following terms:

“I acknowledge receipt of your late TM8N, received 18 July 2023.

The official letter dated **2 May 2023** informed you that if you wished to continue with your registration you should file TM8(N) and counterstatement on or before **3 July 2023**.

As no TM8(N) and counterstatement were filed within the time period set, Rule 38(6) applies. Rule 38(6) states that:

“...the registration of the mark shall, unless the registrar directs otherwise, be revoked.”

The registry is minded to treat the proprietor as not opposing the application for revocation and revoke the registration 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, **7 September 2023**. This **must** be accompanied by a Witness Statement setting out the reasons as to why the TM8N and counterstatement are being filed outside of the prescribed period.

If no response is received the registry will proceed to issue an undefended decision on the issue of failure to comply with the Rules governing the filing of a defence.”

6. On 7 September 2023, HBL filed a Witness Statement from Jon Eade, director of HBL, which included the following:

5. I acknowledge that the communication from the IPO of 2 May 2023 set a deadline of 3 July 2023 to file a TM8N and counterstatement.
6. It was not until I instructed legal counsel to represent me that I realised this deadline had been set. I instructed legal counsel on 7 July 2023 when I realised I had missed the deadline. The TM8N was duly filed by Panoramix Limited on 18 July 2023.

7. On 21 September 2023, the Registry sent an official letter to HBL in the following terms:

“Having considered the registered proprietors [sic] witness statement and its reasons for the late filing of the TM8(N), the Registry is of the view that the reasons provided for the failure to meet the statutory deadline are insufficient to permit the exercise of the Registrar’s limited discretion. Therefore, it is the Registry’s preliminary view to refuse to admit the late filed TM8(N) and counterstatement.

As requested, the case has been passed to the Hearings Team and a procedural hearing will be appointed. Parties should bear in mind that in the event the hearing officer upholds the preliminary view, there may be cost implications arising from the hearing against the party who requested the hearing.

The above information is not intended to dissuade you from requesting a hearing, but merely to inform you of the potential consequences should you be unsuccessful in overturning the preliminary view.”

THE HEARING

8. A joint hearing took place before me, by telephone conference, on 18 October 2023. Mr Kevin Hanson, of Panoramix Limited, attended on behalf of HBL. Mr Matthew Dick, of D Young & Co LLP, attended on behalf of HI. Both representatives filed skeleton arguments in advance of the hearing.

9. The essence of Mr Hanson's submission was that HBL: did not understand the correspondence sent by the Registry, dated 2 May 2023; was not legally represented; and found the paragraphs directed to the Applicant for revocation, as opposed to the Registered Proprietor, confusing. Mr Hanson accepts that a lack of understanding of the correspondence is, without more, 'no excuse on its own', but argues that the paragraphs which were erroneously included in the letter and inapplicable to HBL, compounded HBL's confusion. Mr Hanson submitted that once HBL did understand that it needed to seek legal advice, it did so as soon as practicable, on 7 July 2023. Mr Hanson further submitted that the delay of 11 days between instructing a legal representative on 7 July 2023 and the filing of the Form TM8(N) on 18 July 2023 was due to the workload of HBL's legal representative, rather than HBL itself.
10. Mr Dick submitted that official letters are abundantly clear regarding deadlines and the consequences of non-compliance, and that the absence of a legal representative is not a compelling reason for the failure to file a Form TM8 within a prescribed deadline. Mr Dick argues that Mr Eade's Witness Statement contains two contradictory propositions: i) that Mr Eade did not appreciate that a deadline has passed until he had sought legal advice; and ii) that he sought legal advice when he realised that the deadline had been missed. Mr Eade submits that the reasons provided by HBL for the late filing of the Form TM8 do not amount to extenuating circumstances.

DECISION

11. The filing of a Form TM8(N) and counterstatement in revocation proceedings is governed by rule 38 of the Trade Marks Rules 2008 ('the Rules'). The relevant parts read as follows:

“(3) The proprietor shall, within two months of the date on which he was sent a copy of Form TM26(N) by the registrar, file a Form TM8(N), which shall include a counter-statement.

(4) [...]

(5) [...]

(6) Where the proprietor fails to file a Form TM8(N) within the period specified in paragraph (3) the registration of the mark shall, unless the registrar directs otherwise, be revoked.”

12. 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 out the period within 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.”

13. There is no suggestion that there has been an irregularity on the part of the Tribunal. Consequently, the only basis upon which HBL 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).

14. In making my assessment as to whether to exercise my discretion to allow the defence to be considered in the instant case, I will 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 must be satisfied that there are extenuating circumstances which justify the exercise of the discretion in HBL’s favour.

15. In *Music Choice Ltd's Trade Mark* [2005] RPC 18, 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 the discretion should be exercised in favour of a party in default. That is the approach that I will adopt.

The circumstances relating to the missing of the deadline including reasons why it was missed and the extent to which it was missed;

16. As noted above, the Form TM26(N) was served by post and email on 2 May 2023 at the addresses (both physical and email) provided by HBL. There has been no suggestion from HBL that this correspondence was not received. Mr Dick submitted that HBL had made contact with HI's legal representative the day after the correspondence was sent, which was not contradicted by Mr Hanson during the hearing. It is therefore clear that HBL was aware that its registration was subject to revocation proceedings.

17. HBL filed its Form TM8(N) 15 days after the after the deadline set by the Registry.

The nature of HI's allegations in its Statement of Grounds;

18. The Application for Revocation is based upon section 46(1)(a) of the Act and is directed against HBL's registration in its entirety. In order for HBL to defend the action against it, it would be required to adduce evidence of genuine use of its trade mark for the five-year period following registration of the mark.

The consequences of treating HBL as defending or not defending the revocation;

19. If HBL is allowed to defend the revocation action against it, the proceedings will continue with the parties given an opportunity to file evidence and the matter will be determined on its merits.

20. If, however, HBL is not allowed to defend the revocation action, the registration will be revoked in its entirety with a revocation date of 7 April 2023. It will, however, remain open for HBL to re-file an Application for the contested mark. Mr Hanson submitted that, if the contested mark were to be revoked, HBL would 'have to rely upon unregistered rights to seek cancellation of the Cancellation Applicant's trade marks and to enable them to deal with any ongoing dispute'. Mr Dick replied that there were no other related proceedings currently pending and that, if HBL were to institute cancellation proceedings against HI, HBL would bear a comparable evidential burden to that imposed by the instant proceedings anyway.

Any prejudice caused to HI by the delay

21. Mr Dick submitted that HBL's delay in filing the Form TM8(N), together with failures to copy relevant correspondence to HI, have caused HI to incur additional unnecessary costs.

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

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

Conclusions

23. In reaching my decision, as noted above, I recognise that if the discretion is not exercised in HBL's favour, the revocation action will succeed in its entirety and HBL's registration will be revoked as of 7 April 2023. I further recognise that HBL may re-file an application in respect of the contested mark. HBL has also indicated that it is contemplating instituting cancellation proceedings against HI's registrations. However, the loss of HBL's registration and the possibility of further proceedings entailing much the same evidential burden upon HBL are often the consequences of a failure to comply with the non-extensible deadline to file a Form TM8(N). Therefore, these factors are not, in my view, particularly compelling.

24. I accept that the official correspondence of 2 May 2023 contained paragraphs that should not have been included because they did not apply to HBL. That said, it is my view that the paragraphs regarding the deadline of 3 July 2023 to file the Form TM8(N), and the consequences of failing to observe that deadline, were communicated clearly in plain English. The fact that HBL was not legally represented is not, in my view, a compelling reason for the delay in filing the Form TM8. I accept that the 11-day delay between HBL instructing its legal representative on 7 July 2023 and the legal representative filing the Form TM8 on 18 July 2023 is not entirely the fault of HBL. However, I note that HBL has not provided any reasons for the delay of 4 days or so between the deadline of 3 July 2023 and the act of seeking legal advice on 7 July 2023. HBL has, in my view, been the author of its own misfortune.

Outcome

25. In the light of the foregoing, it is my view that it would be inappropriate for me to exercise the discretion available under Rule 18(2) in favour of HBL. Subject to any successful appeal, the preliminary view to refuse to admit the late filed TM8(N) and counterstatement is confirmed and registration UK00003267803 will be revoked with an effective date of revocation of 7 April 2023.

Costs

26. Given that my decision terminates proceedings, I must consider the matter of costs. Although HI has been successful, I note that HI did not notify HBL that it would be instituting revocation proceedings against it.³ I note the following from TPN 1/2023:⁴

“Costs in undefended actions

³ HI's Form TM26(I) at point [6] has been left blank.

⁴ Tribunal Practice Notice (TPN) 1/2023: Costs in proceedings before the Comptroller

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.”

27. I therefore make no order as to costs.

Dated this 27th day of October 2023

N. R. MORRIS

For the Registrar