

**O/1027/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF A CASE MANAGEMENT CONFERENCE**

**IN RELATION TO TRADE MARK APPLICATION NUMBER**

**UK00003863843**

**IN THE NAME OF DUBAI FRAGRANCE LTD**

**TO REGISTER AS A TRADE MARK**

**Dubai Fragrances UK**

**IN CLASS 3**

**AND**

**THE OPPOSITION THERETO UNDER NUMBER**

**OP000440408**

**BY ASGHAR ADAM ALI IBRAHIM**

## BACKGROUND

1. On 2 January 2023, Dubai Fragrance Ltd (“the applicant”) applied to register trade mark number UK00003863843 for the mark shown below. The application was accepted and published for opposition purposes on 27 January 2023, for the specification detailed below.

## Dubai Fragrances UK

Class 3            Perfumes; Fragrances; Oils for perfumes and scents; Perfumery and fragrances; Perfume; Perfume oils.

2. On 4 May 2023, the Tribunal received a Form TM7 filed by Asghar Adam Ali IBRAHIM (“the opponent”).
3. On 23 June 2023, the Tribunal received a Form TM8 from the applicant.
4. The applicant’s counterstatement was as follows:

“I am writing to provide a denial counterstatement in defence of our brand, 'Dubai Fragrances,' in response to the opposition raised against our trademark. It has come to our attention that the opponent has registered the term 'Dubai' as a trademark for themselves. We strongly believe that 'Dubai' is a generic term and cannot be legitimately monopolized as a trademark. We kindly request your careful consideration of the points presented herein.

'Dubai' is widely recognized as the name of a city and holds no exclusive association with any specific brand or entity. It is a geographical term referring to the well-known city of Dubai in the United Arab Emirates. Generic terms, by their very nature, cannot be monopolized as

trademarks since they are essential for common use by all businesses operating within a particular industry.

The opponent's claim to the trademark 'Dubai' exceeds the bounds of trademark protection. It is well-established that generic terms should be freely available for all market participants to use, ensuring fair competition and preventing undue monopolies. Granting exclusive rights to a generic term like 'Dubai' would unduly restrict the rights of other businesses, including ours, to use the term in a descriptive or geographical sense.

As 'Dubai Fragrances,' we have been operating as an online business for several years, specializing in the sale of fragrances. Our business has successfully established a unique brand identity by associating our products with the cultural heritage and aromatic traditions of the city of Dubai. It is crucial to recognize our rights to use the term 'Dubai' in conjunction with 'Fragrances UK' to accurately describe the origin and characteristics of our products. Denying us the ability to do so would unjustly curtail our ability to market and promote our offerings.

Allowing the opponent to register the term 'Dubai' as a trademark would result in confusion and restrict consumer choice. Consumers have the right to identify and differentiate products from various sources, including those associated with the city of Dubai. Granting an exclusive trademark for 'Dubai' to a single entity would create an unfair advantage, preventing other businesses from accurately describing their products' geographical or cultural associations, thus impeding fair competition.

We kindly request a thorough review of our counterstatement, considering the points presented above.”

5. On 3 July 2023, the Tribunal wrote to the applicant as follows:

“The counterstatement has now been considered and it is the registry’s preliminary view that more information is required before any further action can be taken.

This is in line with the Tribunal Practice Notice 4/2000 which is available on the IPO website at [www.ipo.gov.uk](http://www.ipo.gov.uk)

The purpose of the Form TM8 and counter-statement is to admit or deny the claims made by the opponent and provide reasons for doing so. In these proceedings, the opponent has made claims under Section 5(2)(b), Section 5(3) and Section 5(4)(a). In this instance the Registry does not consider that you have provided this information.

Consequently, the applicant is requested to state if they admit or deny the opponent’s claim and provide a basis for doing so.

In the Form TM7, the opponent has stated that they consider that all goods in your trade mark application to be identical or similar to those contained in their earlier rights. At the end of the proceedings the hearing officer will consider this point as part of the Section 5(2)(b) claim, therefore, it is important that this point is also addressed. Please will you review this and file an amended Form TM8 and counterstatement.

Regarding the comments made about the opponent’s earlier rights, please note there is no mechanism within opposition proceedings before the Registry to include counterclaims against the opponent’s earlier trademarks. If you wish to apply to invalidate/revoke the opponent’s trade mark this should be brought under separate proceedings. I refer you to the registry’s Tribunal Practice Notice 4/2009.

Please will you review your counterstatement with a view to removing these counterclaims against the opponent's earlier rights.

In light of the preliminary view expressed above, you are invited to file an amended counterstatement, on or before **24 July 2023**. If you choose not to amend the counterstatement the registry may move to strike out any parts of your defence which are not adequately particularised.”

6. The Tribunal received no reply to the above letter. On 9 August 2023, the Tribunal sent a second letter, by post as well as email, giving the applicant a further fourteen days to reply i.e. by 23 August 2023.
7. The Tribunal received no reply to the second letter either and wrote to the applicant as follows on 8 September 2023:

“As the date for the amended TM8 to be filed has expired, you are afforded one final period in which to address the deficiencies in your counterstatement. Please file your amended Form TM8 and counterstatement on or before **15 September 2023**.

If an amended Form TM8 and counterstatement is not filed by the applicant, then it is the preliminary view of the registry that the application will be treated as abandoned.

If you wish to challenge this view you have 7 days to request a Case Management Conference (CMC), namely by **15 September 2023**.”

8. On 14 September 2023, the applicant replied by email as follows:

“Dear Sir,

Sorry About the confusion as I am abroad and would like to have CMC

Regards

Dubai Fragrances”

9. The CMC was scheduled for 25 September 2023. The applicant wrote again by email on 14 September 2023 as follows:

“Dear Sirc

Could you please change the date as I am abroad

I will be back on 30th of this month

Regards

Dubai Fragrances”

10. The date for the CMC was then set for 3 October 2023.

### **CASE MANAGEMENT CONFERENCE (CMC)**

11. At 14:00 on 3 October 2023, the opponent’s representative, Mark Hickey from Lane IP Limited, joined the meeting promptly. The applicant did not appear. After a couple of adjournments, Mohammed Abdur Rafi (styling himself as Mr Ali) joined the meeting as a litigant in person and it commenced at 14:15.

12. Mr Ali explained that the reason for the delay in joining the meeting was that he was at the hospital due to his wife having just come out of intensive care and that he was phoning from the hospital car park.
13. He asked for an update on why the opponent was opposing the applicant's mark. I replied that it was more a question of him updating me on what had been done since the original letter of 3 July 2023.
14. Mr Ali said that the explanatory email had been sent to the Tribunal after 3 July 2023. However, he did not elaborate on what the contents of this email were. I observed that the Tribunal had no record of having received the email.
15. I then reiterated what the letter of 3 July 2023 said in terms of the deficiencies in the Form TM8.
16. I asked Mr Ali whether he was able to submit an updated Form TM8 that day and he said that he was not. When asked how much more time he would need, he said that he would need a further two to three weeks.
17. I asked him whether he was in a position to know what it was that he needed to do to correct the shortcomings in the form.
18. He asked what these shortcomings were. I restated them.
19. He gave no indication that he now knew what he needed to do to correct the Form TM8.
20. For the opponent, Mr Hickey observed that the applicant had failed to meet the deadline set for filing a correctly particularised Form TM8 on two occasions. He also referred to Tribunal Practice Notice 2 of 2011 whereby there should be efficient and effective use of the Tribunal's resources as well as the resources of the relevant parties.

21. Mr Hickey argued that, given that the Form TM8 was not ready for submission in a better state today or tomorrow, allowing further time would amount to an abuse of process. To do so would set a very unfortunate precedent as no cogent reasons had been advanced to justify this. It would also be inequitable.

22. At the conclusion of the CMC, the applicant asked for further time over and above the time that he had already been granted to deal with this matter.

## **LEGISLATION AND GUIDANCE**

23. Rule 18 of the Trade Mark Rules states:

“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 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.”

24. Tribunal Practice Notice 4 of 2000 states:

### **“Counter Statement**

19. A defence should comment on the facts set out in the statement of case and should state which of the grounds are admitted or denied and those which the applicant is unable to admit or deny but which he requires the opponent to prove.

20. The counter-statement should set out the reasons for denying a particular allegation and if necessary the facts on which they will rely in their defence. For example, if the party filing the counter-statement wishes to refer to prior registrations in support of their application then, as above, full details of those registrations should be provided.

21. It has been noted that some counter-statements seek to challenge the validity of the trade mark(s) on which the opposition/invalidity proceedings are based. Whilst such claims can be made before the Court -see Civil Procedure Rules at Part 49 - the trade mark rules do not make provision for the making of such a counter-claim in opposition or invalidity proceedings before the Registrar. Should any party wish to challenge the validity of a trade mark cited in the statement of case then it would be a matter for them to commence revocation or invalidity proceedings before the Registrar or the Court.”

25. As outlined at section 1.8 of the Manual of trade marks practice (“the Manual”), “the Tribunal adheres to the same overriding objective as the court for dealing with cases justly. This is set out in rule 1.1 of the Civil Procedure Rules 1998 (as amended) and includes, so far as is practicable:

(2) (a) Ensuring that the parties are on an equal footing

(b) Saving expense

(c) Dealing with the case in ways which are proportionate –

(i) to the amount of money involved (ii) to the importance of the case (iii) to the complexity of the issues and (iv) to the financial position of each party

(d) Ensuring that it is dealt with expeditiously and fairly and

(e) Allotting to it an appropriate share of the court's resources, while taking into account the need to allot resources to other cases.”

## **DECISION**

26. It has been the longstanding practice of the Tribunal to scrutinise counterstatements to ensure that any defence is adequately particularised. Using Tribunal Practice Notice 4 of 2000 as a guide, any deficiencies that are identified are brought to the attention of the applicant. It is also the longstanding practice of the Tribunal to offer the applicant a number of opportunities to correct these deficiencies, but should they not do so, to treat its application as abandoned in accordance with Rule 18.

27. I have reviewed the applicant's counterstatement. I find that the Tribunal acted correctly in identifying a number of deficiencies: the applicant had said nothing to confirm or deny the claims made by the opponent and all of its arguments related to whether the opponent's marks should be registered. On that latter point, the applicant was properly advised that counterclaims need to be brought under separate proceedings.

28. Dating back to 3 July 2023, the applicant was afforded two opportunities to correct the deficiencies in its counterstatement, but it failed to reply to either of the two official letters that were sent to it. Mr Ali claims that an explanatory email was sent to the Tribunal at some point after 3 July 2023, but the Tribunal has no record of receiving any such email.

29. According to the Tribunal's records, only when a third communication was sent did the applicant respond. At that point, Mr Ali emailed to say that he would like a hearing and then requested that the date of the hearing be put back. At that stage, he could have offered an explanation for his failure to respond to previous

communications and/or offered some reassurances about his intention to submit an amended counterstatement, but he did not do so.

30. While it is understandable that Mr Ali was late joining the CMC, given that his wife was hospitalised and he was phoning in from the hospital car park, he did not say that his wife's illness had been an impediment to responding to the Tribunal's communications.

31. Having had ample opportunity to amend his counterstatement, Mr Ali came to the CMC without having an updated version to hand. At the CMC, he gave me no indication that he understood what was required of him. Indeed, he asked to be updated on where matters as a whole stood, which suggests that he has not been paying close attention to the proceedings.

32. I have taken note of Mr Ali being a litigant in person, but the letters that he was sent indicated clearly what was required of him and he could have asked for clarification at any point between 3 July and the day of the CMC. Further, I am mindful of Geoffrey Hobbs QC's decision in *BOSCO* where, sitting as the Appointed Person, he maintained that "being a litigant in person with no previous experience of legal proceedings is not a good reason for failing to comply with the rules."<sup>1</sup>

33. When I prompted Mr Ali to offer a timescale for submitting an updated counterstatement, he said he would need two to three weeks, but I have no confidence that allowing him any further time would yield any positive results. In any event, to grant the applicant more time would be unfair to the opponent.

34. The applicant has exhausted its opportunities to file a correctly particularised counterstatement. Keeping in mind the necessity of equality between the parties, the public interest in resolving disputes efficiently, and allowing that the Tribunal

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<sup>1</sup> BL-O-399-15

has a duty to allocate its resources fairly, I uphold the preliminary view that the application be treated as abandoned.

## **CONCLUSION**

35. Subject to any appeal, the application is treated as abandoned.

## **COSTS**

36. Given that this decision has terminated the proceedings, the opponent is entitled to a contribution towards its costs, based on the scale published in Tribunal Practice Notice 2/2016.

37. I award costs as follows:

Official fee:	£200
Preparing a statement:	£200
<b>Total:</b>	<b>£400</b>

38. I therefore order Dubai Fragrance Ltd to pay Asghar Adam Ali IBRAHIM the sum of £400. 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 1<sup>st</sup> day of November 2023**

**John Williams**  
**For the Registrar**