

O/1059/23

TRADE MARKS ACT 1994

**IN THE MATTER OF A JOINT HEARING IN RELATION TO
TRADE MARK APPLICATION NO. UK3852834
IN THE NAME OF WRII CORP.
TO REGISTER AS A TRADE MARK**

THE WELL SW1

**IN CLASSES 3, 5, 25, 35,
36, 41, 43 AND 44**

AND

**THE OPPOSITION THERETO
UNDER NUMBER OP600002756
BY LAZEO LONDON LIMITED**

BACKGROUND

1. On 24 November 2022, WRll Corp. (“the applicant”) applied to register trade mark number UK3852834, for the mark shown on the cover page of this decision, in the United Kingdom. The application was accepted and published for opposition purposes on 10 February 2023, in respect of goods and services in classes 3, 5, 25, 35, 36, 41, 43 and 44.

2. On 10 February 2023, Lazeo London Limited (“the opponent”) filed form TM7F (“Notice of FAST TRACK opposition and statement of grounds”).

3. On 25 February 2023, the Tribunal wrote to the opponent stating that more information was required before any further action could be taken. In particular, the sections of the form TM7F which needed to be addressed were in relation to the requirement for a representation of the earlier mark, and Q10 of the form relating to the grounds of the opposition under Section 5 of the Trade Marks Act 1994 (“the Act”). The letter contained the following paragraphs:

“Please file an amended statement of grounds, on or before 20 March 2023.

If you choose not to amend the statement of grounds the registry may decide to strike out any grounds which are not adequately explained.

A copy of this letter together with the statement of grounds has been sent to the applicant but the period for the applicant to file its counter-statement has not yet been set.”

4. On 20 March 2023, the opponent filed an amended form TM7F. The Tribunal wrote to the applicant to acknowledge receipt of the amended TM7F. As the information provided on the amended form TM7F was still unclear, in the official letter dated 18 April 2023, the Tribunal stated that more information was needed, with the deadline for response set as 02 May 2023.

5. On 04 May 2023, the opponent sent an email requesting an extension of time until 09 May to respond to the official letter.

6. On 26 May 2023, the Tribunal responded to the opponent acknowledging the request and allowing an extension of time until 02 June 2023 for the opponent to file an amended form TM7F.

7. As no response to the letter of 26 May 2023 had been received, the Tribunal wrote to the opponent again on 10 August 2023. The Tribunal's letter contained the following:

"The official letters dated 25 February 2023 and 18 April 2023 each invited you to file an amended form TM7 and statement of grounds. On 26 May 2023, in response to your request for an extension of time until 9 May 2023, the Tribunal confirmed that an extended period of time until 02 June 2023 had been allowed for you to file the amended TM7F. A copy of this letter is attached herewith for your reference.

The Registry received no response from the opponent and therefore, is unable to process the form TM7F filed against the above application. Please address the following issues:

...

Should you still wish to proceed with the opposition, please file an amended form TM7F and statement of grounds, on or before **18 August 2023**.

If you choose not to file an amended TM7F by the given deadline, it is likely that the Registry will issue the preliminary view that the opposition is deemed withdrawn due to the grounds of the opposition being inadequately explained."

(Original emphasis).

8. The opponent, who at the time was unrepresented, did not respond by the deadline, and so, on 21 September 2023, the Tribunal wrote to the opponent again with the following preliminary view:

"I refer to the above proceedings and to the previous official letter dated 10 August 2023, a copy of which is enclosed for your information.

The Tribunal has noted that you have not filed an amended TM7F which addresses the points raised in the previous official letters.

In the circumstances, it is the Registry's preliminary view to strike out the notice of opposition from the proceedings which will result in the trade mark application being forwarded to registration.

If either party disagrees with the preliminary view, they should request a hearing within 14 days from the date of this letter that is on or before 05 October 2023. If no response is received within the time allowed, the preliminary view will automatically be confirmed.”

9. On 05 October 2023, the opponent responded by email requesting a hearing:

Dear Sirs,

I am writing following receipt of your letter with regards to our opposition of WEll Corp's filing for a trademark that we believe conflicts and duplicates ours, as filed by Lazeo London Ltd, for "The Well".

I am confirming that we did send a new TM7F as instructed, so we do not understand how the opposition was allowed to arrange to strike out the notice.

I am now confirming that we request a hearing in order to finalise the opposition. We remain open to negotiating with WEll Corp in order to come to a mutually satisfactory resolution, however we have not been contacted by them at all during this process to date.

Please do let me know how to proceed, should we resend the TM7P form again?

10. A hearing was scheduled for 30 October 2023, the details of which were sent by the Tribunal to both parties in an official letter dated 12 October 2023.

11. On 23 October 2023, form TM33P appointing D Young & Co LLP as representatives to the opponent was filed.

12. The representatives of both parties confirmed attendance at the scheduled hearing.

THE JOINT HEARING

13. The hearing took place before me, via Microsoft TEAMS telephone conference, on Monday 30 October 2023. Ms Sarah Brooks of D Young & Co LLP represented the opponent and Mr Ben Scarfield of Kilburn & Strode LLP represented the applicant.

14. At the hearing, I explained to both parties that the purpose of the hearing was to consider whether the preliminary view to strike out the opposition should be upheld.

15. Ms Brooks began by confirming that D Young & Co were only instructed to represent the opponent on 20 October and prior to this the opponent was

unrepresented. She continued that having filed an amended form TM7F following the first request for more information, the opponent missed the subsequent deadlines as she was covering staff illness over the summer. She explained that the opponent was a small business and was struggling to manage workloads. Ms Brooks added that allowing the opposition to proceed would avoid the multiplicity of proceedings as it would not then be necessary for the opponent to file an invalidity action once the contested application was registered. In line with rule 1.1 of the Civil Procedure Rules, this would save expenses by avoiding any future proceedings. Ms Brooks requested that the registry exercise its discretion under rule 62 of the Trade Mark Rules 2008 (“the Rules”) to allow the opponent one further attempt to file an amended form TM7F. She confirmed that she had instructions regarding the outstanding issues and would be able to file an amended TM7F immediately following the hearing.

16. Turning to Mr Scarfield, he stated that he understood the plight of small businesses. However, his client’s position was that the opposition was first filed in early February 2023 and that it was now almost November, and that at some point, a line had to be drawn in terms of the number of extensions and opportunities given. He also referred to the Civil Procedure Rules in terms of ensuring that the case is dealt with expeditiously and fairly, allotting an appropriate share of the Tribunal’s resources. He said that most importantly, the Tribunal must enforce compliance with the rules, practice directions and orders. He stated that in spite of being given multiple opportunities to address the issues, the opponent had not actually complied, and that an amended (admissible) TM7F had still not been filed.

17. Mr Scarfield continued that this was not a decision on a request for more time but on whether the opposition should be struck out following the opportunities given to clarify the scope of the opposition. He added that he understood the concerns over the multiplicity of proceedings, and wanting to avoid a consequent invalidation action. However, he felt that the opponent had been given enough opportunities to rectify (the issues) and if the decision resulted in multiplicity of proceedings, that was something that is part of the rules and procedures which parties have to abide by.

18. I asked Ms Brooks to confirm whether the period of staff illness which prevented the opponent from responding to the deadlines was ongoing from May (when the opponent's request for a short extension of time was filed) through to October when the opponent requested a hearing to dispute the preliminary view to strike out the opposition. Ms Brooks responded in the affirmative, saying that was what she had been advised. In the email request for a hearing, the opponent stated that "a new TM7F" had been sent. I asked Ms Brooks to clarify when the opponent had filed this further TM7F; Ms Brooks confirmed that this was the amended form sent on 20 March 2023, and that no further amended forms had been filed in the meantime. I asked Ms Brooks if she could explain why the opponent had not contacted the Tribunal to explain the circumstances regarding her staffing difficulties or to request clarity if the letters advising that an amended TM7F needed to be filed for the opposition to continue were unclear. Ms Brooks confirmed that the opponent was struggling with the workload and that was the reason why she did not contact the registry.

19. In summing up, I stated that I appreciated that until very recently the opponent was unrepresented, and I acknowledged that litigants in person are not going to be as conversant with what is expected of them in either the opposition or the defence of an application. However, I considered that filing a form TM7F was not particularly complicated, with many unrepresented opponents successfully filing opposition proceedings. Further, the letters sent by the case worker clearly set out what the opponent needed to do to rectify the issues. I continued that while I was sympathetic to the opponent's work issues, in the circumstances, I would have expected some response from the opponent, be that an email or a telephone call to discuss the letters sent by the Tribunal. However, the opponent had made no such attempt to communicate with the Tribunal.

20. I am mindful that the registry has a duty to ensure that the system is fair to both parties and that the delays caused by the missed deadlines on the part of the opponent will have an impact on the applicant. In fairness to the applicant, given the opponent's failure to respond to the deadlines on numerous occasions, I considered that I was left with little choice but to uphold the preliminary view to strike out the opposition.

21. As neither party had anything more to add, I drew the hearing to a close, confirming my direction that the preliminary view be upheld. The reasons behind my decision are set out below.

DECISION

22. As outlined at 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.”

23. Rule 17 states:

“ ...

(5) Where the opposition is based on a trade mark which has been registered, there shall be included in the statement of the grounds of opposition a representation of that mark and—

- (a) the details of the authority with which the mark is registered;
- (b) the registration number of that mark;
- (c) the goods and services in respect of which—
 - (i) that mark is registered, and
 - (ii) the opposition is based; and

...”.

24. Tribunal Practice Notice (“TPN”) 1/2018 states:

“Examination of pleadings based on earlier marks

1. *The purpose of pleadings is to set out the party’s legal case with sufficient clarity so that the other side can make an informed decision about whether to defend their trade mark, and in which respects. The pleadings filed in trade mark oppositions and invalidation proceedings do not always meet this standard.*
2. *The registrar has a duty to ensure that the system is fair to both parties and that, so far as is reasonably practical, those without legal representation and/or of limited means, are given equal access to justice.*
3. From 1 January 2019, where the pleadings in trade mark opposition/invalidation proceedings under s.5(1) -s.5(3) of the Act are not sufficiently clear, the registrar’s casework examiners may require further information...”; and

“Failure to follow directions

11. Failure to comply with directions under Rule 62 may have the following consequences:
 - (i) an increase in costs awarded against the offending party, if it is unsuccessful, or a reduction in costs to that party, if it is successful;

- (ii) the registrar selecting the earlier marks which appear to represent the party's best case and directing under Rule 62 that the evidence and arguments be limited to those marks;
- (iii) where the basis of the claimed similarity between the respective goods/services remains non-apparent, and has not been explained, the decision maker is likely to find dissimilarity;
- (iv) where there is a serious risk of unfairness to, or oppression of, the other party, *directions will be made subject to the condition (per Rule 62(3)) that failure to comply with them will result in the opposition/application being struck out in whole or in part.*"

(My emphasis)

25. In confirming my decision to strike out the opposition, I am conscious of the impact that this will have on the opponent. I am mindful of the guidance given in TPN 1/2018 and I consider that the opponent has been given equal access to justice. I also acknowledge the submissions of Ms Brooks that the opponent may wish to file an invalidity action should the preliminary view be upheld. However, I do not consider this to be sufficient reason to allow the proceedings to continue following the opponent's failure to respond to multiple deadlines.

26. The opponent's request for an extension of time to file an amended TM7F was allowed, in spite of the deadline to respond being missed by two days. However, following the grant of the extension of time, the opponent failed to respond. Neither did the opponent respond to the subsequent letter allowing a further period in which to file an amended form, only responding to the official communications which contained the preliminary view that the opposition be struck out.

27. I bear in mind Ms Brooks' submissions that the opponent is a small business concern who was struggling to cope with the workloads resulting from staff illness. I reiterate that I consider the completing and filing of the form TM7F to be relatively straightforward. Even if the opponent had not found that to be the case, I consider

that clear guidance on the issues to be addressed in order to file an admissible form TM7F were provided in the official letters from the Tribunal, dated 25 February 2023, 18 April 2023, and 10 August 2023. Even if the opponent had still been unclear on what it needed to do, no attempt to contact the Tribunal for clarification was made. Furthermore, although the opponent's representative confirmed that she would be able to file an amended TM7F immediately following the hearing, the fact remains that the opponent did not come to the hearing with an updated form TM7F.

CONCLUSION

28. Having considered the opponent's reasons for its failure to file an amended form TM7F by the deadlines given, I find the reason given for its failure to comply as insufficient to overturn the preliminary view to strike out the opposition in its entirety.

OUTCOME

29. Subject to any successful appeal against this decision, the application will proceed to registration.

Dated this 7th day of November 2023

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