

BL O/1101/23

TRADE MARKS ACT 1994

IN THE MATTER OF

THE LATE FILING OF NOTICE OF OPPOSITION AND STATEMENT OF GROUNDS

IN RELATION TO:

TRADE MARK APPLICATION NO. 3905955

BY MR. SARFRAZ MUNEEER

TO REGISTER THE TRADE MARK:

TOPSTYLE COLLECTION

IN CLASS 17

AND

THE OPPOSITION THERETO

UNDER NO. 442539

BY NAEEM RASOOL

This decision follows the hearing that took place before me via telephone conference, on Friday 10 November 2023 in order to consider the notice of opposition and statement of grounds having been filed late in these proceedings.

Mr Muhammad Nadeem of Lincoln Solicitors appeared on behalf of the opponent. Also in attendance was the applicant, Mr Sarfraz Muneer, who represented himself.

BACKGROUND

1. On 27 April 2023, Mr Sarfraz Muneer ('the applicant') applied to register the trade mark shown on the cover page of this decision ('the contested mark') in the UK. The application was published for opposition purposes on 19 May 2023, in respect of goods in Class17 (see annex for the full list of goods). The opposition period was due to end on 19 July 2023.

2. On 15 August 2023, Mr Muhammad Nadeem of Lincoln Solicitors filed a TM7 notice of opposition, on behalf of Naeem Rasool ('the Opponent'). The opposition was brought under Sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 ('the Act') and was directed at all the goods in the application.

3. Following receipt of the TM7, the Tribunal wrote to the parties on 20 September 2023, informing them that the TM7 could not be permitted into the proceedings. Within this letter, the Tribunal wrote:

"The Registry notes that your notice of opposition has been filed outside the statutory two-month period, set in accordance with Rule 17(1) of the Trade Mark Rules 2008.

In line with Rule 17(3) and 17(4) of the Trade Mark Rules 2008, the period allowed to file an opposition is two months beginning immediately after the date on which the application was published. This period can be extended to three months by the filing of a Form TM7A.

The application was published on 19 May 2023, and it is noted that no Form TM7A was filed on behalf of Naeem Rasool (the opponent named on the TM7) by the expiry of the two-month deadline, i.e. 19 July 2023. Your notice of opposition, Form TM7, was received on 15 August 2023, after the deadline.

It is the Registry's preliminary view that, as the notice of opposition was filed outside of the statutory deadline, it cannot be permitted into the proceedings.

If either party disagrees with the Registry's preliminary view, they must request a hearing and outline their reasoning for doing so, on or before 04 October 2023."

4. On 3 October, the opponent's representative, Mr Nadeem, of Lincoln Solicitors, filed a request for a hearing. Within his letter Mr Nadeem writes:

"We acknowledge the tardiness of this submission and are appreciative of the opportunity to present the following compelling grounds for our request to entertain this opposition despite the lapse in time.

Regrettably, it was the opponent's view that his wife's (living at the same address and running their family business jointly) TM7A¹ would suffice for both and/or his submissions for earlier mark 'TOP STYLE COLLECTION' be accepted by the IPO together with his wife in the same TM7 form and it will save their costs. The opponent was unable to file his opposition notice TM7A within the prescribed time frame.

The Registry confirmed on 15 August 2023 *"Please note, there is no mechanism within the Trade Marks Act to allow multiple opponents in the same proceedings. As UK00003227102 and UK00003902642 are owned by separate legal entities, UK00003902642 and Naeem Rasool cannot be joined to these proceedings"*.

¹ Filed on 6 July 2023 I respect of opposition 442464.

Due to these circumstances and the Opponent's misunderstanding notably impacted his ability to attend to professional matters, including the timely filing of this opposition Notice.

The principle of justice is foundational to the legal system, and the Intellectual Property Office plays a vital role in upholding this principle within the domain of intellectual property law. In the present matter, it is crucial to recognize that our late filing in no way undermines the fundamental fairness and integrity of the opposition process. Granting an exception in this instance ensures that the opposition procedure is comprehensive and that all relevant arguments are considered, promoting the very essence of justice upon which the legal system is built.

The opposition put forth by our client is not only well-founded but also addresses significant issues pertaining to the validity and distinctiveness of the mark/patent under consideration. The arguments presented are substantiated by exhaustive research and compelling evidence. Permitting our opposition, albeit filed beyond the stipulated timeline, would guarantee a thorough examination of these merits. This, in turn, strengthens the intellectual property system by ensuring that registrations are granted only to marks/patents that genuinely meet the criteria for protection, thereby maintaining the credibility of the Intellectual Property Office.

In light of the aforementioned, we kindly request the Intellectual Property Office to exercise its discretion and permit the consideration of our opposition. Should you require any further information or clarification, we stand ready to provide the same promptly.”

5. Following this, a hearing was scheduled for 10 November 2023, the details of which were sent by the Tribunal to both parties in an official letter dated 5 October 2023.

6. Prior to the hearing, the opponent’s representative, Mr Nadeem, filed further written submissions, dated 9 November 2023, reaffirming his previous submissions.

THE HEARING

7. At the hearing, Mr Nadeem apologised on behalf of the opponent for the late filing of the Form TM7. He explained that the opponent and his wife, Zahida Parveen, live at the same address and both assume the role of manager in their family run business, Top Style Collection Ltd., which they have jointly owned since 2018. He added that Zahida Parveen, is the owner of UK registered trade mark 3227102, for the mark TOPSTYLE COLLECTION in Classes 20 and 24 and that the opponent is the owner of UK registered trade mark 3902642, for the mark TOP STYLE COLLECTION in Classes 17 and 40. Mr Nadeem explained that on noting that the applicant had applied for the mark TOPSTYLE COLLECTION,² both the opponent and his wife attended his office and provided joint instructions to file a Form TM7A on 6 July 2023, thereby extending the opposition period to three months. Mr Nadeem added however that it had been wrongly assumed that the TM7A filed in Zahida Parveen's name would allow both her and the opponent, Naeem Rasool, to benefit from the extended publication period in which to oppose the applicant's mark (by 19 August 2023).

8. During the hearing Mr Nadeem explained that it was not until Zahida Parveen had filed a Form TM7 and statement of grounds on 9 August 2023 that she was made aware by Tribunal in their letter of 15 August 2023 that as the two earlier rights relied on in the opposition have different owners, there was no mechanism within the Trade Marks Act to allow multiple opponents in the same proceedings and therefore as the two earlier rights relied on are owned by two separate legal entities, they could not be joined in the proceedings relating to opposition number 442464 filed in the name of Zahida Parveen. Mr Nadeem added that as a result of this information, the opponent, Naeem Rasool launched a separate opposition on 15 August 2023, however was subsequently informed by Tribunal in their letter of 20 September 2023, that the notice of opposition had been filed outside the statutory period, set in accordance with Rule 17(1) of the Trade Mark Rules 2008, on the basis that the period allowed to file an opposition is two months beginning immediately after the date on which the application was published, which can only be extended to three months by filing a Form TM7A.

² Trade mark application UK00003905955 (TOPSTYLE COLLECTION) filed in the name of 'MR. SARFRAZ MUNEEER'

9. Mr Nadeem explained that as the opponent had wrongly assumed that the TM7A filed by Zahida Parveen would suffice for both of them to file two oppositions on one form, Naeem Rasool did not file a form TM7A in his own name and therefore, the notice of opposition filed by him was done so outside the statutory deadline and consequently could not be permitted into the proceedings. Mr Nadeem added that the opponent's misunderstanding notably impacted his ability to attend to professional matters, including the timely filing of the opposition Notice.

10. In conclusion Mr Nadeem submitted that whilst the Form TM7 was filed outside the statutory deadline, the late filing of the opposition does not compromise the fundamental fairness and integrity of the opposition process and that granting an exception ensures a comprehensive examination of all relevant arguments, promoting justice and fairness, which are the cornerstones of the legal system. He added that the opposition put forth by the opponent is not only well-founded but also addresses significant issues pertaining to the validity and distinctiveness of the applicant's mark, and that the arguments presented by the opponent in his Form TM7 are substantiated by exhaustive research and compelling evidence, and therefore permitting the opposition, albeit filed beyond the stipulated timeline, would guarantee a thorough examination of the grounds raised.

11. In response to Mr Nadeem's submissions, the applicant, Mr Muneer stated that in his opinion the Registry's preliminary view should be upheld and that the opponent's TM7 should not be admitted into the proceedings as the rules for filing it had not been followed.

12. At the conclusion of the hearing, I reserved my decision to give me an opportunity to properly reflect on the submissions put forward by the parties.

DECISION

13. Opposition to registration of an application is provided for by Section 38 of the Act. Section 38(2) states:

“Any person may, within the prescribed time from the date of the publication of the application, give notice to the registrar of opposition to the registration. The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.”

14. Rule 17(2)-(4) specifies that:

“(2) Unless paragraph (3) applies, the time prescribed for the purposes of section 38(2) shall be the period of two months beginning immediately after the date on which the application was published.

(3) This paragraph applies where a request for an extension of time for the filing of Form TM7 has been made on Form TM7A, before the expiry of the period referred to in paragraph (2) and where this paragraph applies, the time prescribed for the purposes of section 38(2) in relation to any person having filed a Form TM7A (or, in the case of a company, any subsidiary or holding company of that company or any other subsidiary of that holding company) shall be the period of three months beginning immediately after the date on which the application was published.

(4) Where a person makes a request for an extension of time under paragraph (3), Form TM7A shall be filed electronically using the filing system provided on the Office website or by such other means as the registrar may permit.”

15. I note that there has been no default, omission or error by the Registry and no suggestion that there has been any irregularity on the part of the Registry.

16. At the hearing, Mr Nadeem submitted that the TM7 was late because the opponent, Naeem Rasool, had wrongly assumed that a TM7A filed by his wife, in her name, would allow them both to benefit from the extended publication period in which to both oppose the applicant's mark, and therefore, as this was a genuine misunderstanding of the process, as the opponent clearly thought that he was submitting his TM7 on time, the opposition should be allowed. However, I am of the view that this undermines Rules 17(2)-(4), as shown above. The fact of the matter remains that the opponent

failed to request an extension of time for the filing of the Form TM7 in his name on a Form TM7A, before the publication expiry period, namely two months beginning immediately after the date on which the application was published.

17. The tenability of the human error argument (albeit on the application of Rule 41(6) in relation to an invalidity application) was considered by Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person in *TESCON Trade Mark* [2020] FSR 33; BL O/240/20, as follows:

“32. I readily accept that human error is not necessarily inconsistent with the existence of extenuating circumstances or compelling reasons for permitting invalidity proceedings to be defended in the exercise of the discretion conferred by rule 41(6). I would, for example, regard it as appropriate for the discretion to be exercised in favour of permitting a claim for invalidity to be defended in circumstances where it was clearly established that the failure to comply with a filing deadline of (say) 12 February 2020 was the result of an unnoticed keystroke error which caused the due date to be incorrectly entered in an otherwise reliable record keeping system as (say) 21 February 2020. It is nonetheless clear that the test to be applied cannot be taken to permit or require all human errors to be treated as excusable for the purposes of rule 41(6). There must, in other words, be a fact specific evaluation for the purpose of determining whether the particular error in question should or should not be treated as excusable in the circumstances of the case at hand.

33. This is the point at which the Proprietor’s request for relief under rule 41(6) ran into difficulty. The general tenor of the representations made on its behalf was that its attorneys had taken reasonable and proper steps to ensure that the required Form TM8 and Counterstatement were filed before expiry of the specified deadline, but were inadvertently deflected from doing so until after the deadline had expired. However, the Registrar was presented with assertions rather than evidence and materials of sufficient clarity and precision to substantiate that or any proposition to the like effect. In the end, as emphasised in the Respondent’s Notice, the Hearing Officer was left with no satisfactory explanation for the default which had occurred.”

18. Therefore, for similar reasons, I do not accept that the opponent's failure to comply with the procedure for filing the Form TM7 was due to human error that falls within the scope of the case law above. Therefore, this argument has no foundation given the circumstances surrounding the failure to satisfy the procedural requirement.

19. In reaching my decision, I recognise that if the late TM7 is not accepted, the application will, subject to any other opposition proceedings, continue to registration and the current opposition proceedings will no longer continue. Further, I recognise that it may be that the opponent will simply file an application for invalidity of the applicant's mark resulting in further proceedings arising at some point in the future. However, the possibility of further proceedings on much the same basis is often the consequence of a failure to comply with the non-extendable deadline to file Form TM7s. In my view, to regard the mere prospect of invalidation proceedings as a strong consideration would significantly undermine the prescriptive nature of the timeframes under the rules for filing a Form TM7. Further, whilst repeated proceedings, which I accept may be likely in this case, are, in my view, regrettable on the account of wasted cost and efforts of the parties, not to mention the further strain on the Registry's resources, I must consider the specific circumstances at hand.

20. In considering whether any unfairness or prejudice is caused to the opponent, I note that the opportunity has been afforded, by way of this hearing, to the opponent (who at all material times has been professionally represented) to rectify the situation by providing cogent arguments for the Registry to validate its late filing of its TM7. I considered that if there is any inconsistency in complying with the overriding objective, it is more likely to be found on the part of the opponent, who has effectively unilaterally departed from the prescribed mode of filing the Form TM7 by filing it outside the statutory deadline. The application was published on 19 May 2023, and it is noted that no Form TM7A was filed on behalf of Naeem Rasool (the opponent named on the TM7) by the expiry of the two-month deadline, i.e. 19 July 2023. Naeem Rasool's notice of opposition, Form TM7, was received on 15 August 2023, after the deadline. Further, I bear in mind that if the application progresses to registration, the opponent will have the opportunity to file an application to invalidate the contested mark.

21. I must also take into consideration the fairness of subjecting the applicant to opposition proceedings when it has had no prior warning of those proceedings, and more importantly, based upon an action filed outside of the strict opposition window when the applicant could have reasonably expected oppositions or notices of threatened opposition to have been filed.

22. In reaching a decision, I have taken all the above matters into account, including the overriding objective (which is to ensure fairness to both parties) to deal with this case expeditiously and justly. I have found no single reason or combination of reasons sufficient to enable me to admit the Form TM7 into these proceedings. The opponent has failed to fulfil the procedural requirement (one that his representatives should have been entirely familiar with) and did not provide sufficient or cogent evidence to demonstrate that it had made a real attempt to file the Form TM7 in accordance with the Rules.

23. In the circumstances I find that the opponent has failed to show any compelling reason to justify its deviation from the rules and consider that the strict adherence to the procedural requirement outweighs the opponent's interest in having the matter determined via opposition proceedings.

OUTCOME

24. I uphold the Registry's preliminary view that the TM7 is not to be admitted as a formal opposition against the application. Therefore, the opposition has failed.

COSTS

25. Given that the outcome of this decision has terminated the proceedings, I must consider the matter of costs. As the applicant has not instructed professional representatives, they are entitled to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given activities relating to attending the hearing. However, I note that the applicant has not been provided with a cost proforma. As a result, I am unable to deal with the issue of costs at this stage.

26. Accordingly, a copy of the cost proforma will be provided to the applicant upon the issuance of this decision. The applicant is hereby invited to file a completed cost proforma to the Tribunal within 14 days of the date of this decision. Once this is received, I will issue a supplementary decision dealing with the issue of costs.

27. In the event that the applicant fails to file a costs proforma within 14 days of the date of this decision, I still propose issuing a supplementary decision dealing with the issue of costs.

Dated this 21st day of November 2023

**Sam Congreve
For the Registrar**

Annex

Class 17 Polyurethane foam [semi-finished]; Polyurethane foam in blocks; Foam supports for floral arrangements; Packing foam in sheet; Polyurethane foam for insulating purposes; Low-density polyurethane foam for insulation; Foam for use as heat insulation; Foam for use in sound absorption; Low-density polyurethane foam for packing; Polyurethane foam in blocks for insulating; Foam for use as heat shields; Foam for use in sound insulation; Insulating materials made of polyurethane foam; Laminates containing polyamide foams for thermal insulation; Foam for use as motor compartment linings; Foam supports for flower arrangements [semi-finished products]; Polyethylene synthetic resin [semi-processed] for foam mouldings; Polyurethane foam in sections for use in manufacture; Polyurethane foam sheeting for use as building insulation; Foam sheeting for use as building insulation; Foam insulation materials for use in building and construction; Polyurethane foam in strips for use in manufacture; Molded foam insulated container packing for commercial transportation; Polyurethane foam in blocks for use in flower arranging; Foam in the form of blocks for use as heat insulation; Polyurethane foam [semi-finished]; Polyurethane foam in blocks; Foam supports for floral arrangements; Packing foam in sheet; Polyurethane foam for insulating purposes; Low-density polyurethane foam for insulation; Foam for use as heat insulation; Foam for use in sound absorption; Low-density polyurethane foam for packing; Polyurethane foam in blocks for insulating; Foam for use as heat shields; Foam for use in sound insulation; Insulating materials made of polyurethane foam; Laminates containing polyamide foams for thermal insulation; Foam for use as motor compartment linings; Foam supports for flower arrangements [semi-finished products]; Polyethylene synthetic resin [semi-processed] for foam mouldings; Polyurethane foam in sections for use in manufacture; Polyurethane foam sheeting for use as building insulation; Foam sheeting for use as building insulation; Foam insulation materials for use in building and construction; Polyurethane foam in strips for use in manufacture; Molded foam insulated container packing for commercial transportation; Polyurethane foam in blocks for use in flower arranging; Foam in the form of blocks for use as heat insulation; Polyurethane foam in blocks; Low-density polyurethane foam for insulation; Polyurethane foam in blocks for insulating; Low-density polyurethane foam for

packing; Polyurethane foam [semi-finished]; Polyurethane foam sheeting for use as building insulation; Foam for use in sound insulation; Foam for use as heat insulation; Polyurethane foam in sections for use in manufacture; Polyurethane foam in blocks for use in flower arranging; Foam for use as heat shields; Foam sheeting for use as a building insulation; Foam for use in sound absorption; Foam in the form of blocks for use as heat insulation; Packing foam in sheet form; Polyamide foams; Silicone foam thermal insulation; Polyurethane foam in strips for use in manufacture; Polyurethane foam for insulating purposes; Insulating materials made of polyurethane foam; Insulating materials made of polyethylene foam; Polyethylene synthetic resin [semi-processed] for foam mouldings; Foam for use as motor compartment linings; Foam insulation for use in building and construction; Foam supports for floral arrangements; Foam insulation materials for use in building and construction; Shaped strips of foam rubber for use as draught seals in windows; Foam glass for use as an insulating materials; Padding materials of rubber or plastic; Foam supports for flower arrangements [semi-finished products].