

O/1173/24

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK REGISTRATION NO. 3980330
IN THE NAME OF ATHENA EDUCATION INTERNATIONAL, LLC
FOR THE MARK:**



IN CLASSES 35, 41 AND 42

AND

**THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT
FILED IN DEFENCE OF OPPOSITION PROCEEDINGS UNDER NO. 447580
BY MOTORING & LEISURE SERVICES LIMITED**

Background

1. Athena Education International, LLC (“the applicant”) applied to register the UK trade mark displayed on the front cover of this decision, under registration number **3980330** (“the applicant’s mark”). The applicant’s mark was filed on 16 November 2023 and published for opposition purposes in the trade mark journal on 16 February 2024. The application is to register the following services:

Class 35: Recruitment of students for educational institutions; development of advertising concepts for educational institutions; marketing services for educational institutions; marketing consulting services educational institutions; media planning, consulting and buying services for educational institutions.

Class 41: Educational and training services, namely, conducting live and on-line courses, seminars, workshops, and classes in the field of education, featuring the assembly, collation, selection, storage and management of educational content; Educational services, namely, providing online non-downloadable publications, namely, textbooks, workbooks, teacher guides and course materials in connection with courses in the field of language instruction and assessment; Educational services, namely, providing educational counselling services and retention advice to university students; developing, arranging, and providing custom online educational course material for educational institutions; providing online educational tutoring services.

Class 42: Application service provider, namely, providing, hosting, managing, developing, and maintaining applications, software, websites, and databases in the fields of education and corporate educational content; Providing temporary use of non-downloadable software and applications for educational institutions and school districts in the fields of assessment and improvement of student learning, instructor training, curriculum development and management; Providing

temporary use of non-downloadable software and applications for corporations in the field of corporate education and training; providing temporary use of online non-downloadable software featuring practice exam questions and other tutorial materials in connection with classes from the early learning through post-graduate levels; application service provider (asp) featuring software for accessing non-downloadable publications, audio, video, text and graphics; computer services, namely, designing and implementing interactive network web pages for others for the transfer and dissemination of information via a global computer information network; provision of technical and computer help desk services for educational institutions and for corporate training.

2. On 16 May 2024, Motoring & Leisure Services Limited (“the opponent”) opposed the application under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The opposition is targeted at all of the services of the contested mark’s specification.

3. On 28 May 2024, the Tribunal served the Form TM7 on the applicant, by post and by email. In accordance with rule 18 of the Trade Mark Rules 2008 (“the Rules”), the applicant was informed that it had two months from the date of the official letter in which to file its Form TM8 and counterstatement. The relevant paragraphs of the letter are as follows:

*“In accordance with Rules 18(1) and 18(3) of the Trade Marks Rules 2008, the applicant now has **two months** in which to file a TM8 and counterstatement at the Trade Marks Registry.*

The TM8 and counterstatement, or TM9C must be received on or before 29 July 2024.

If no TM8, or TM9c is filed on or before the date given above, the application shall, in accordance with rule 18(2) of the Trade Marks Rules 2008, be treated as abandoned in whole or part unless the registrar otherwise directs.” (Original emphasis)

4. However, the applicant did not file a Form TM9c nor TM8 by the prescribed deadline of 29 July 2024. Consequently, on 6 August 2024 the Tribunal wrote to the applicant stating:

“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, **20 August 2024**. 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.”*
(Original emphasis)

5. On 20 August 2024, the applicant filed a Form TM8 and witness statement from the applicant’s representative, Rachel Wilkinson-Duffy, dated the same, setting out its reasons for missing the prescribed deadline. The pertinent paragraphs are as follows:

“8. On 29 May 2024, the email from the UK IPO providing the Notice of Opposition and official letter was picked up by our post team and forwarded to the 'Office Support SNow' mailbox, which automatically triggers the creation of a ServiceNow case. This step is the correct standard process for the incoming post.

9. On 30 May 2024, the ServiceNow case was allocated to a dedicated analyst for processing, but the analyst was unable to locate a relevant record. This was because it related to an incoming opposition and therefore a record had not yet been created. In accordance with the correct standard process, a query was raised by the analyst regarding the relevant record via the ServiceNow case.

The analyst correctly populated all the necessary fields in ServiceNow and this triggered a notification to the 'LONTMU Specialists DL' mailbox. However, the analyst inadvertently selected 'Close Complete' when triggering the notification, which resulted in the ServiceNow case not defaulting to a standard review status.

10. On 30 May 2024, the email query was received by the 'LONTMU Specialist DL' email, which automatically disseminates to six individuals, all of whom are trade mark specialist paralegals in London. However, one member of the team was on annual leave that day, another had just returned from holiday and the remaining four did not respond on the mistaken assumption another member of the team would address the query.

11. As a result of the combined administrative oversights set out on points 9 and 10 above, the Applicant's defence deadline was not docketed and the correspondence was never sent to the appropriate case managers responsible for the opposed application.”

6. On 29 August 2024, the Tribunal referred the applicant to *Kickz AG and Wicked Vision Limited* (BL-O-035/11) and *Holland and Mercury Wealth Management Limited* (BL-O-050/12), and informed the parties of the following:

“The applicant’s explanation for the 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 was filed outside of the statutory deadline, it cannot be permitted into the proceedings.”

7. On 1 October 2024, the applicant requested a hearing on the matter and consequently, a procedural hearing was set for 25 October 2024, to discuss the matter of the late filed defence.

The hearing

8. A joint hearing took place before me by video conference on 25 October 2024. At the hearing, Ms Wilkinson-Duffy appeared for the applicant; the opponent chose not to attend, instead it filed written reasons outlining why it agreed with the Tribunal's preliminary view. The applicant filed a skeleton argument in advance of the hearing.

9. At the hearing, Ms Wilkinson-Duffy expanded on both her witness statement and skeleton argument, and confirmed the following:

- The ServiceNow email address is a global email address where post received is forwarded and an analyst outside the London office will populate a new record on ServiceNow. In this case, the analyst correctly populated all the necessary fields within ServiceNow which automatically triggered an email query being sent to a centralised mailbox that is monitored by six trade mark specialist paralegals based at the London office. However, the analyst then accidentally clicked to close the case, the result of which was that it did not appear on daily or weekly docket reports.
- The automated email which was sent to a centralised mailbox was overlooked. This inbox was monitored by six trade mark specialist paralegals, one was on leave and another had just returned from holiday. Whilst there were four other paralegals that were monitoring the inbox this was at a time when there was a capacity crunch, further the centralised email is more of a back up as the case will also be allocated to an individual who actually has responsibility for it.
- In this particular case, the individual who was allocated the case via email was on leave at the time the email was sent, and investigations are still underway about whether the email was accidentally removed or deleted from the individual's mailbox.

- In response to the opponent's comments that the firm had failed to ensure that there was a second checking process, the ServiceNow mailbox is one that receives in total an excess of over 600,000 emails and that although on this occasion a multi-tier error resulted in this deadline being missed, in general the firm does have fairly robust measures in place. This is evident from the process having stood up over a very long period of time. It is certainly exceptional for correspondence to be overlooked by the firm in this way given the multi-tiered system in place.
- As for the 22-day delay for filing the late TM8, the length of time was due to the firm having to investigate what had happened so that they could provide a witness statement addressing the matter.

10. In relation to costs Ms Wilkinson-Duffy requested that in the event the Form TM8 was not admitted into proceedings, costs would be issued on the scale.

DECISION

11. The filing of the Form TM8 and counterstatement in opposition proceedings is governed by rule 18 of the Rules. The applicable parts to these proceedings 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 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.

(3) Unless either paragraph (4), (5) or (6) applies, the relevant period is the period of two months beginning immediately after the notification date.”

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 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.

13. 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 is if I exercise in its favour the discretion afforded to me by the use of the words “unless the registrar directs otherwise” set out above in rule 18(2).

14. In approaching the exercise of discretion in these circumstances, I take into consideration the decisions of the Appointed Person in *Kickz AG v Wicked Vision Limited* (“*Kickz*”)¹ and *Mark James Holland v Mercury Wealth Management Limited* (“*Mercury*”)² i.e. I have to be satisfied that there are extenuating circumstances or compelling reasons which justify the exercise of the narrow discretion afforded to me in the applicant’s favour.

15. In *Music Choice Ltd’s Trade Mark* (“*Music Choice*”),³ the High 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 discretion should be exercised in favour of a party in default. That is the approach I intend to adopt, addressing each factor below in turn, and referring to the parties’ submissions to the extent I consider necessary.

¹ BL/O/035/11

² BL/O/050/12

³ [2006] R.P.C. 13

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

16. The proprietor has never suggested that it had not received the registry's letter dated 28 May 2024. Rather it is argued that due to multi-tiered errors the date for filing the Form TM8 was not docketed on the firm's systems and as a result it was missed. The first being an error by the analyst who clicked on 'close complete' when populating the file so that the case was not picked up in daily/weekly reports. The second was that the person who was allocated the case to their individual inbox and who had actual responsibility for it was on leave at the time and on return did not pick up the email regarding the matter. The third being that the automated email sent to a central inbox (as a result of the analyst populating the case) was overlooked, despite the fact that this should have acted as a back-up being monitored by no less than six individuals, all described as trade mark specialist paralegals. It is said that one was on leave, and another was returning from holidays, but ultimately there were four remaining trade mark specialist paralegals that it is assumed would have been aware of the significance of the deadline. Whilst I appreciate that there may have been a capacity crunch at this time, crucially, as is evident from Ms Wilkinson-Duffy's witness statement set out above, the remaining paralegals did not respond on the mistaken assumption that another member of the team would address the query. Consequently, the email was not actioned and the deadline for the applicant to file its TM8 was never docketed.

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

17. The opposition is brought under sections 5(2)(b) and 5(3) of the Act. Whilst it is not for the present hearing to determine the merits of the case, there is nothing to suggest that there is not an arguable case to be determined. Furthermore, the case will require the filing of cogent evidence in respect to section 5(3) grounds.

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

18. Should the defence be admitted into proceedings, the applicant will be permitted to defend the opposition, the proceedings will continue with the parties given an opportunity to file evidence and the matter will be determined on its merits.

19. If, however, the defence is not admitted into proceedings, the application will be deemed as abandoned, and the applicant will lose its filing date of 16 November 2023; although, I accept that is always the case where the Tribunal makes an adverse decision against a party because of a failure to file a defence in time in opposition proceedings. Nevertheless, it will remain open to the applicant to re-file its application which I acknowledge may, in turn, be opposed again by the opponent.

Any prejudice caused to the opponent by the delay;

20. Neither of the parties have identified any prejudice that has been caused to the opponent by the delay, and I do not consider there to be any beyond the delay of 22 days and the subsequent hearing for which it did not attend but filed short reasons for why it agreed with the Tribunal's preliminary view.

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

21. The parties have not highlighted any other relevant considerations or related proceedings involving the marks of the opposition where the outcome of this decision will have an impact on those future decisions.

Considerations

22. In reaching my decision, I consider that if discretion is not exercised in the applicant's favour, the opponent will automatically succeed, and the applicant's mark will not proceed to registration. However, as discussed above, I acknowledge that this

is often the consequence of a failure to comply with the non-extensible deadline to file a form TM8, and furthermore, the applicant could choose to re-file an application to protect its mark. Therefore, this factor is not, in my view, determinative in isolation.

23. In the course of reaching my decision I have kept in mind the words of Mr Geoffrey Hobbs QC (as he then was) in *Praesidiad NV v Tescon Sicherheitssysteme Schweiz GMBH* (“Tescon”), BL O/240/20, where he stated at paragraph 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) [...] 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.”

24. Whilst *Tescon* concerned an application for invalidity, the same assessment is relevant to the late filing of a Form TM8 and counterstatement in opposition proceedings. Mr Hobbs acknowledged that human errors can constitute extenuating circumstances or compelling reasons sufficient for the exercise of discretion, where the specific facts of the case merit it.

25. I take account of the circumstances that caused the late filed defence. Whilst I acknowledge the genuine human error of the analyst in accidentally choosing ‘close complete’ that caused the deadline not to be docketed on the system, in my view, there were further checks in place that if followed could have identified this error and seen it rectified, however they were overlooked or ignored by numerous individuals. There was the email to an individual’s inbox that was not actioned on their return. I was informed at the hearing that the matter was still currently being investigated, as such, on this point, I do not have any further information as to why exactly this email was overlooked. Further, there was also the automated email that was sent to a central mailbox monitored by six trade mark specialist paralegals that was supposed to act as a back-up to identify errors in the process. I accept that not all six members were in

the office at the time that the email came in, I also appreciate that there may have been a capacity crunch around that time, however, there were still four individuals that were present and supposed to be monitoring the inbox. Even for those on leave, the deadline allows a period of two months, this should have been plenty of time for the individuals monitoring the centralised inbox to have returned to the unactioned email or at the very least raise the matter with the individual with whom it had been allocated to ensure that the deadline was docketed and not missed. The failure to do so, by the six paralegals monitoring the inbox, due, in at least part it seems, to the mistaken assumption that the matter would be picked up and actioned by someone else, in my view, amounts to the failure to exercise the 'minimal degree of vigilance' required to meet the deadline as set out by Mr Hobbs in *Kickz*. Therefore, whilst it is possible for a human error to amount, in some cases, to extenuating circumstances for exercising discretion, given the facts, I do not find that to be the case here. This is due, not least, to the lack of attentiveness afforded to the subsequent monitoring systems that would have otherwise allowed for the error to be detected and the deadline to be docketed.

26. Taking all of the above into account, I am not satisfied that the discretion provided under rule 18(2) should be exercised in the applicant's favour. Upon careful consideration of all the submissions made and the factors set out in the case law in *Kickz*, *Mercury* and *Music Choice*, I see no compelling reason or extenuating circumstance which would justify the use of the registrar's discretion provided under rule 18(2).

CONCLUSION

27. The consequence of the above finding is that the Registrar's preliminary view is upheld and the applicant's late filed Form TM8 will not be admitted into the proceedings. Subject to any appeal, the opposition will be deemed as undefended, and the applicant's mark will not proceed to registration.

COSTS

28. As my decision terminates the proceedings, I must consider the matter of costs. The opponent is entitled to a contribution towards its costs, based on the scale published in the TPN 1/2023.⁴ I therefore assess the costs as follows:

Official fee:	£200
Preparing the statement of case:	£250
Preparing brief written submissions in lieu of attending the hearing:	£100
Total:	£550

29. I therefore order Athena Education International, LLC to pay Motoring & Leisure Services Limited the sum of **£550**. 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 11th day of December 2024.

Sarah Wallace
For the Registrar

⁴ As the invalidation proceedings were brought after 1 February 2023.