

**BL O/1194/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**THE LATE FILING OF NOTICE OF DEFENCE FORM AND COUNTERSTATEMENT**

**IN RELATION TO:**

**TRADE MARK APPLICATION NO. 3879503**

**BY NAEEM RASOOL**

**TO REGISTER THE TRADE MARK:**

**IZO All Supply**

**IN CLASSES 17 AND 40**

**AND**

**THE OPPOSITION THERETO**

**UNDER NO. 600002863**

**BY M&A STYLES LTD**

This decision follows the case management conference (CMC) that took place before me via telephone conference, on Monday 11 December 2023, in order to consider the implications of the defence having been filed late in these proceedings.

The CMC was attended by Mr Naeem Rasool (“the applicant”) and his representative, Mr Muhammad Nadeem of Lincoln Solicitors; and Mr Mobeen Farooq of M&A Styles Ltd (“the opponent”), who represented himself.

## **BACKGROUND**

1. On 17 February 2023, 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 28 April 2023 in respect of goods and services in Classes 17 and 40.

2. On 28 April 2023, the opponent, filed a fast-track notice of opposition. 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 and services in the application.

3. On 2 June 2023, the Tribunal served the TM7F on the applicant by email and by post via a tracked and signed for delivery service. The Tribunal’s records show that the TM7F was delivered to the applicant’s postal address on 3 June 2023 and was signed for by ‘Naeem’. The applicant was given the deadline of 2 August 2023, by which to file its form TM8 notice of defence and counterstatement, or alternatively a form TM9C (Request for a cooling off period).

4. As no TM8 and counterstatement was filed by the applicant within the time period set, the Tribunal wrote to the parties on 21 August 2023. Within this letter the Tribunal wrote:

“The official letter dated 02 June 2023 invited the applicant to file a TM8 and counterstatement on or before 02 August 2023.

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, 04 September 2023. 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.

If no response is received the registry will proceed to deem the application abandoned.”

5. On 1 September 2023, a TM33 was filed appointing Mr Nadeem, of Lincoln Solicitors, as representative for the applicant. On the same date, the applicant’s newly appointed representative, Mr Nadeem, filed a Form TM8 and counterstatement, along with a witness statement in the name of Naeem Rasool, the applicant. Within his witness statement the applicant writes:

“I make this statement in relation to and in support of my above application regarding trademark registration in the name of 'IZO All Supply'. I noticed the Intellectual Property Office's letter dated 21 August 2023 and another letter dated 2 June 2023 in my email's junk/spam folder yesterday, on 31 August 2023.

I confirm that the delay was not intentional but I could not check my spam folder earlier. Accordingly, I was unable to file TM8 earlier on the date due for filing i.e. 2 August 2023. I sincerely apologize for this oversight and request you to grant permission to file my Notice of defence and counterstatement and consider it accordingly.

I request the Honourable Tribunal to allow me to file TM8 (Notice of defence and counterstatement) for consideration which is attached herewith.”

6. Following this, the Tribunal wrote to the parties on 3 October 2023. Within this letter the Tribunal wrote:

“The contents of your witness statement have been carefully considered. Case law only permits a late filed defence to be admitted where it is shown that there exists ‘compelling reasons’ or ‘extenuating circumstances’. In this instance it is the Registrar’s preliminary view that the reasons provided are not sufficient for the Registrar to exercise its discretion and admit the late filed defence into the proceedings.

If you disagree with the preliminary view expressed above, a hearing can be requested to challenge the preliminary view. You must provide full written reasons and request a hearing on, or before 17 October 2023. If no response is received the registry will proceed to deem the application abandoned.

Please note, if the Hearing Officer maintains the preliminary view, the applicant may be required to contribute to the other party’s costs. This 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.”

7. On 16 October 2023, the applicant’s representative, Mr Nadeem, filed a request for a hearing. Within his letter, Mr Nadeem writes:

“Re: Request for Hearing - Opposition No. 0P600002863 - Trademark UK00003879503.

We write to you on behalf of our client, Mr. Naeem Rasool, the Applicant in Opposition No.OP600002863, concerning Trademark UK00003879503. We acknowledge receipt of your letter dated 3 October 2023, outlining the

Registry's preliminary view about the non-admission of the Applicant's Counterstatement in Form TM8. We appreciate your attention to this matter.

We deeply regret this delay and sincerely apologize for any inconvenience caused. In light of this late filing of TM8 form, we present the following points for your kind consideration:

As you are aware from the Applicant's statement that the primary reason for failure to submit the TM8 form within the stipulated timeframe was a technical oversight within email system. Specifically, emails from the UK IPO, including reminders and notifications, were automatically redirected to our client's email's junk folder. This technical issue prevented him from being duly notified of the approaching deadline.

Upon discovering this issue, our client took immediate corrective actions to rectify his email settings. He has implemented necessary changes to ensure that all future communications from your esteemed office are promptly directed to the appropriate inbox. He also reinforced internal processes to monitor correspondence meticulously, thereby preventing similar incidents in the future.

We would like to emphasize that this delay was entirely unintentional and does not reflect our commitment to compliance and adherence to regulatory timelines. We value our trademark registration and recognize the importance of timely submissions. The completed TM8 form and all accompanying documents that were originally due on 2 August 2023 were submitted on 1 September 2023. We kindly request you to process these documents and proceed with the necessary steps to advance trademark registration process.”

8. Following this, a hearing was scheduled for 6 December 2023, the details of which were sent by the Tribunal to both parties in an official letter dated 9 November 2023.

9. Prior to the hearing, the applicant's representative, filed further written submissions, dated 4 December 2023, reaffirming his previous submissions.

## THE HEARING

10. At the hearing, Mr Nadeem apologised on behalf of the applicant for the late filing of the Form TM8. He explained that the failure to submit the TM8 form within the stipulated timeframe was solely attributable to a technical oversight within the applicant's email system, causing the relevant communications from the UKIPO to be automatically redirected to the applicant's junk folder, resulting in him not being aware of the TM8 deadline. Mr Nadeem added that it was not until 31 August 2023, that the applicant detected the UKIPO's letter of 21 August 2023, in his spam folder, which referred to an official letter of 2 June 2023, which the applicant also located in his spam folder. Mr Nadeem attests that as soon as the applicant became aware of these letters in his spam folder, he did not delay in instructing Lincoln Solicitors as his legal representatives in order to expeditiously address the matter of the late TM8 and handle the Tribunal's proceedings. Mr Nadeem submitted that upon receiving the applicant's instructions on 1 September 2023, the Form TM8 defence, counterstatement and witness statement was filed at the UKIPO on behalf of the applicant on the same date.

11. Mr Nadeem explained that upon discovering the technical issue, the applicant took immediate corrective action, by implementing changes to his email settings in order to rectify the issue to ensure that all future communications from the UKIPO are promptly directed to his appropriate inbox. Additionally, Mr Nadeem submitted that the applicant has set-up internal processes in order to carefully monitor electronic correspondence, thus mitigating the risk of similar incidents occurring in the future.

12. In conclusion, Mr Nadeem submitted that the delay in the form submission was entirely unintentional and does not reflect any lack of commitment to compliance or adherence to regulatory timelines, requesting that the Tribunal exercise its discretion and permit to admit and consider the applicant's Form TM8.

13. I pointed out to Mr Nadeem that not only did the Tribunal serve the TM7F on the applicant by email, but it was also sent to the applicant's address by post via a signed for postal delivery service with tracking. I informed Mr Nadeem that the Tribunal's records show that the TM7F was delivered to the applicant's postal address on 3 June 2023 and that it was signed for by 'Naeem', pointing out that the applicant's

name is 'Naeem Rasool'. In response, the applicant, denied having ever received the postal correspondence.

14. In response to Mr Nadeem's submissions, the opponent, Mr Farooq submitted that in his opinion the Tribunal's preliminary view should be upheld and that the applicant's TM8 should not be admitted into the proceedings as the rules for filing it had not been followed.

15. 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**

16. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by rule 18 of the Trade Marks Rules 2008 ("the Rules"). The relevant parts 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 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."

17. The combined effect of rules 77(1), 77(5) and Schedule 1 of the Rules mean 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.”

18. 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 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).

19. In approaching the exercise of discretion in these circumstances, I take into account the decisions of the Appointed Person in *Kickz AG v Wicked Vision Limited* (“Kickz”)<sup>1</sup> and *Mark James Holland v Mercury Wealth Management Limited* (“Mercury”)<sup>2</sup> i.e. I have to be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the applicant’s favour.

20. In *Music Choice Ltd’s Trade Mark* (“Music Choice”)<sup>3</sup> 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 discretion should be exercised in favour of a party in default. That is the approach I intend to adopt, referring to the parties’ submissions to the extent that I consider it necessary to do so.

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

21. The applicant’s explanation as to why the deadline was missed is summarised above, i.e. a technical oversight within the applicant’s email system, causing the Tribunal’s official letters to be automatically redirected to the applicant’s junk folder and the Tribunal’s official letters to the applicant’s postal address via a signed for

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<sup>1</sup> (BL O-035-11)

<sup>2</sup> (BL O-050-12)

<sup>3</sup> [2005] RPC 18

postal delivery service with tracking was not received, despite the Tribunal's records showing that the correspondence was signed for by 'Naeem'. As noted above, the stipulated deadline for the filing of the applicant's Form TM8 and counterstatement was **2 August 2023**. The Form TM8 and counterstatement was filed by the applicant on **1 September 2023**. Therefore, the deadline was missed by 30 days.

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

22. Under section 5(1), 5(2)(a) and 5(2)(b) of the Act, the opponent claims that the applied for mark is identical to its earlier right 'IZO All Supply' and that the respective goods and services are similar and therefore there is a likelihood of confusion.

23. Whilst it is not for the present hearing to determine the merits of the case, there is nothing to suggest that the opposition is without merit.

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

24. If the applicant is allowed 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. However, if the applicant is not allowed to defend its mark, the application will be deemed as abandoned, and the applicant will lose his filing date of 17 February 2023.

Any prejudice caused to the opponent by the delay;

25. The opponent has not identified any prejudice caused to itself. The applicant has made no comment on this subject.

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

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

## CONCLUSION

27. I bear in mind that the deadline for filing a TM8 is a statutory one. I recognise that if the discretion is not exercised in the applicant's favour, the application will be treated as abandoned and the applicant will lose its filing date in respect of all the goods and services in the application (since the opposition is directed against the application in full). I further recognise that it may be that the applicant will simply re-file his application and that this may, once again, be opposed by the opponent resulting in further opposition proceedings arising at some point in the future. However, as the loss of priority and possibility of further proceedings on much the same basis are often consequences of a failure to comply with the non-extendable deadline to file the Form TM8, these are not factors that are particularly compelling, nor do they constitute extenuating circumstances sufficient to permit the Tribunal to exercise its discretion.

28. The applicant has maintained in these proceedings that its Form TM8 defence and counterstatement was not filed within the stipulated timeframe due to a technical oversight within his email system which caused the relevant communications from the Tribunal to be automatically redirected to his junk folder, resulting in him not being aware of the TM8 deadline.

29. However, as was pointed out to the applicant and his representative during the hearing, the Tribunal also sent the TM7F to the applicant's recorded address via a tracked and signed for postal delivery service. Furthermore, on checking this, the Tribunal's letter containing the Form TM7F was listed as being successfully delivered to the applicant's address on 3 June 2023 and was signed for by 'Naeem'. It is noted that the applicant's name is Naeem Rasool. That said, during the hearing Mr Rasool denied ever receiving the postal correspondence.

30. The Tribunal followed the correct procedures, and the notice of the opposition was not only sent to the applicant's email address but was also sent to his postal address via a tracked and signed for postal delivery service. Whilst it is noted that the applicant submits that his email system caused the relevant emailed communications from the Tribunal to be automatically redirected to his junk folder and that he rebuts ever receiving the TM7F by post, having given careful consideration to the applicant's

explanation for their failure to file a Form TM8 by the deadline set, I find no single reason or combination of reasons sufficient to constitute extenuating circumstances or compelling reasons to enable me to exercise my limited discretion in the applicant's favour to admit the late filed TM8 and counterstatement into these proceedings.

## **OUTCOME**

31. The preliminary view is upheld and the late form TM8 and counterstatement is not to be admitted into the proceedings. Subject to any appeal, the contested mark will be deemed as undefended and treated as abandoned.

## **COSTS**

32. Given that the outcome of this decision has terminated the proceedings, I must consider the matter of costs. As the opponent 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 these proceedings including attending the hearing. However, I note that the opponent has not been provided with a cost proforma. As a result, I am unable to deal with the issue of costs at this stage.

33. Accordingly, a copy of the cost proforma will be provided to the opponent upon the issuance of this decision. The opponent 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.

34. In the event that the opponent 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 19<sup>th</sup> day of December 2023**

**Sam Congreve  
For the Registrar**