

O-250-08

TRADE MARKS ACT 1994

**IN THE MATTER OF a joint hearing
in relation to application number 2384555A for the trade mark**

MORE 4

**in the name of Channel Four Television Corporation
and the opposition thereto,
under number 95081, by Meredith Corporation**

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Background

1. On 15 February 2005, Channel Four Television Corporation applied for the registration of the trade mark MORE 4 in classes 9, 16, 35, 38, 40, 41 and 42. During the course of the examination process, the application was divided creating application 2384555A, in classes 9, 16 and 41, (the application with which I am concerned). 2384555A was published in the *Trade Marks Journal* on 15 December 2006. On 15 March 2007, Meredith Corporation filed a Form TM7 and notice of opposition to the registration of trade mark application 2384555A.

2. The Trade Mark Registry served Form TM7 on the applicant on 26 March 2007, giving the applicant the statutory three month deadline of 26 June 2007 by which to file a Form TM8 and counterstatement if it wished to continue with its application. The applicant was informed that if no such defence was filed by that date, the application would be deemed withdrawn, unless both parties entered a cooling off period, by filing a Form TM9c, by the same date. On 26 June 2007, a Form TM9c was filed and the parties commenced the cooling off period. A letter dated 27 June 2007, confirming the position, was sent to both parties by the Trade Mark Registry, setting an inextensible date for the expiry of the cooling off period: 26 March 2008. The letter stated that the applicant must file its Form TM8 on or before this date if it wished to continue its application and that failure to do so would mean that the application would be deemed withdrawn in accordance with rule 13A(1) of the Trade Marks Rules 2000 (as amended).

3. On 25 March 2008, the day prior to the deadline for the expiry of the cooling off period, the Registry received a faxed letter from the opponent, dated 20 March 2008 and signed by both parties, which stated:

“In the light of ongoing settlement negotiations between the parties, we hereby request a joint suspension of the proceedings. We look forward to receiving confirmation of the suspension at your earliest convenience.”

The Registry replied on 31 March 2008 stating that the information provided in the above faxed letter was insufficient to allow a stay of proceedings and that more detailed reasons would be required. In particular, in line with Tribunal Practice Notice (TPN) 6/2004 on requests for stays and suspensions in inter partes proceedings, the Registry would need a

statement as to the progress of the negotiations, the dates of actions taken by the parties and the nature of those actions.

4. The opponent replied by fax on 17 April 2008 stating:

“We are unable to provide any further details about the negotiations between the two parties at this stage, and therefore understand that a further stay will not be granted. We look forward to hearing from you.”

The Registry then sent a letter to the applicant (22 April 2008) stating that, in line with rule 68(3), no further extensions to the cooling off period could be allowed and that since no Form TM8 and counterstatement were received by 26 March 2008, the application would be deemed withdrawn under rule 13A(1).

5. Nearly a month later, the applicant sent a faxed letter to the Registry, dated 19 May 2008. The letter said that it was not a requirement that the actual Form TM8 be filed to defend an application against an opposition and that the suspension request of 20 March 2008

“not only fulfilled the requirements of a Form TM8 and counterstatement, by clearly informing the Office that the Applicant is interested in the application, but it went much further than this. The suspension request made it clear that the Applicant is so serious about the application that they have been involved in protracted negotiations with the Opponent. Clearly the Applicant would not be partaking in such activities if they were not serious about defending their application and ultimately seeking registration for the mark applied for.”

The Registry responded to the applicant on 27 May 2008 by letter, stating that its letter of 31 March 2008, requesting further details about the negotiations, should not have been issued and that the Registry should have informed the parties that the application was deemed withdrawn in view of no Form TM8 and counterstatement having been received by the due date.

6. The applicant requested a hearing.

The Hearing

7. The matter came to be heard before me on 10 July 2008 by telephone. Mr Julius Stobbs of Boulton Wade Tennant represented the applicant; the opponent did not attend and did not provide written submissions in lieu of attendance.

8. At the hearing, Mr Stobbs told me that because the opposition was going to be settled, both sides in fact wished the proceedings to continue. He said that an error had been made in relying upon the suspension request and therefore failing to file the Form TM8 by the due date. However, despite this, Mr Stobbs submitted that the failure to file Form TM8 and counterstatement was not, of itself, fatal to the application. The logic for his argument rested upon the allowance made, via Tribunal Practice Notice 4/2000, for an applicant to amend its counterstatement, which means that the counterstatement is not subject to the proscriptive effect of rule 68(3). Since it is possible to amend a counterstatement after the due date has passed, Mr Stobbs submitted that the actual content of the counterstatement is not

fundamental to the acceptance of the 'Form TM8 and counterstatement' referred to in rule 13A(1). He said that if a counterstatement merely stated "grounds denied", the Registry would return it for amendment (as per TPN 4/2000). The purpose of Form TM8 and counterstatement is therefore to express the applicant's interest in continuing with its application; what is said in the counterstatement is largely irrelevant. Furthermore, a statement of truth averring a simple denial of the grounds would be a hollow statement as there would be nothing to swear to, in contrast with averring that use had been made of a mark. Mr Stobbs argued that it did not therefore matter that the 'defence' (in the form of the suspension request) did not contain a statement of truth. In his submission, all the information that was required to mount a defence was present in the suspension request; that is, the proceeding numbers and the parties' details were identified and the suspension request itself stood as proof of the applicant's desire to continue with its application. Rule 57 could be used to augment anything considered too brief. There was also, he argued, no requirement that Form TM8, as it appears on the UK Intellectual Property Office's website, be filed; a handwritten note would be accepted, even without specific reference to the alphanumeric 'TM8'.

9. I maintained the Registry's preliminary view to deem the application withdrawn, confirming it in writing later that day. The relevant portion of my letter is reproduced below:

"You said that an error had occurred and that both parties wished the opposition to continue as it was, in fact, to be settled. You pointed out that Tribunal Practice Notice 4/2000 permits the amendment of counterstatements and therefore extensions to time in relation to counterstatements. Drawing my attention to the purposive construction of rules 13A(1) and 68(3), you said that the finite time allowed was to protect the public interest in having certainty, or finality, of litigation. An applicant must declare its continuing interest in its trade mark application proceeding to registration by filing Form TM8 and counterstatement by the due date; however, what is important is that the interest is declared, rather than it appearing on the physical Form TM8 as appears on the UK IPO's website. A handwritten Form TM8 would suffice; it does not have to be the actual form as long as the information required by the form is present: the opposition number, trade mark application number, parties involved. A Form TM8 which did not contain admittance or denial of the grounds would nevertheless constitute a denial by the very fact of its filing. A statement of truth in such a case would be hollow since it would not aver anything (e.g. a statement as to first use of the mark). The lack of a statement of truth in the suspension request of 28 March 2008 therefore did not detract from the suspension request containing all the information required by a Form TM8.

I disagreed, citing rule 3(2) which is quite clear as to what is required of a document which is meant to stand as a published form. In my view, the suspension request could not stand as a substitute for the published Form TM8 since it did not contain the information required by the form as published (including, but not limited to, the counterstatement and statement of truth). The registrar does not have any discretion to permit proceedings to continue in the event of a failure to file a Form TM8 and counterstatement in opposition proceedings, as per rule 13A(1): the word 'shall' appearing in that rule is mandatory. I also drew your attention to the decision of Geoffrey Hobbs Q.C. in *LEATHER MASTER*, BL O/084/04, which is almost on point. Since there is nothing in these proceedings which satisfies all the requirements of rule

3(2) (which gives effect to section 66 of the Trade Marks Act 1994), I have no alternative but to deem the application for registration withdrawn under rule 13A(1).

The consequence of my decision is that the registry's preliminary view to deem the application for registration as withdrawn due to the failure to file a Form TM8 and counterstatement by the due date is upheld. The application for registration is deemed to be withdrawn due to the failure to file a Form TM8 and counterstatement, such that satisfies the requirements of rule 3(2), as required by rule 13A(1) of the Trade Mark Rules 2000 (as amended)."

10. On 6 August 2008, Boulton Wade Tennant filed Form TM5 requesting a written statement of the grounds of my decision, which I give below.

Decision

11. Section 66 of the Trade Marks Act 1994 states:

"Power to require use of forms

66.—(1) The registrar may require the use of such forms as he may direct for any purpose relating to the registration of a trade mark or any other proceeding before him under this Act.

(2) The forms, and any directions of the registrar with respect to their use, shall be published in the prescribed manner."

Rule 3 of the Trade Marks Rules 2000 (as amended) states:

"Forms and directions of the registrar under s.66

3.—(1) Any forms required by the registrar to be used for the purpose of registration of a trade mark or any other proceedings before her under the Act pursuant to section 66 and any directions with respect to their use shall be published and any amendment or modification of a form or of the directions with respect to its use shall be published.

(2) A requirement under this Rule to use a form as published is satisfied by the use either of a replica of that form or of a form which is acceptable to the registrar and contains the information required by the form as published and complies with any directions as to the use of such a form."

Rule 13A states:

"Opposition proceedings: filing of counter-statement and cooling off period (Forms TM8, TM9c & TM9t)

13A.—(1) The applicant shall, within the relevant period, file a Form TM8, which shall include a counter-statement, otherwise his application for registration shall be deemed to be withdrawn.

(2) Unless either paragraph (3) or (4) applies, the relevant period shall begin on the notification date and end three months after that date.

(3) This paragraph applies where –

(a) the applicant and the person opposing the registration agree to an extension of time for the filing of Form TM8;

(b) within the period of three months beginning on the notification date, either party files Form TM9c requesting an extension of time for the filing of Form TM8; and

(c) during the period beginning on the date Form TM9c was filed and ending twelve months after the notification date, no notice to continue on Form TM9t is filed by the person opposing the registration,

and where this paragraph applies the relevant period shall begin on the notification date and end twelve months after that date.

(4) This paragraph applies where –

(a) a request for an extension of time for the filing of Form TM8 has been filed on Form TM9c; and

(b) the person opposing the registration has filed a notice to continue on Form TM9t,

and where this paragraph applies the relevant period shall begin on the notification date end one month after the date on which Form TM9t was filed or three months after the notification date, which ever is the later.

(5) The registrar shall send a copy of Form TM8 to the person opposing the registration and, unless rule 13B applies, the date upon which this is sent shall, for the purposes of rule 13C, be the ‘initiation date’.”

Rule 57 states:

“Registrar’s power to require documents, information or evidence

57. At any stage of any proceedings before the registrar, she may direct that such documents, information or evidence as she may reasonably require shall be filed within such period as she may specify.”

Rule 68 states:

“Alteration of time limits (Form TM9)

“68.—(1) The time or periods—

(a) prescribed by these Rules, other than the times or periods prescribed by the rules mentioned in paragraph (3) below, or

(b) specified by the registrar for doing any act or taking any proceedings,

subject to paragraph (2) below, may, at the written request of the person or party concerned, or on the initiative of the registrar, be extended by the registrar as she thinks fit and upon such terms as she may direct.

(2) Where a request for the extension of a time or periods prescribed by these Rules—

(a) is sought in respect of a time or periods prescribed by rules 13 to 13C, 18, 23, 25, 31, 31A, 32, 32A, 33, 33A or 34, the party seeking the extension shall send a copy of the request to each person party to the proceedings;

(b) is filed after the application has been published under rule 12 above the request shall be on Form TM9 and shall in any other case be on that form if the registrar so directs.

(3) The rules excepted from paragraph (1) above are rule 10A(2) (failure to file address for service), rule 11 (deficiencies in application), rule 13(1)(time for filing opposition), rule 13A(1) (time for filing counter-statement), rule 23(4) (time for filing opposition), rule 25(3) (time for filing opposition), rule 29 (delayed renewal), rule 30 (restoration of registration), rule 31(3) (time for filing counter-statement and evidence of use or reasons for non-use), rule 32(3) (time for filing counter-statement), rule 33(6) (time for filing counterstatement), and rule 47 (time for filing opposition).

(4) Subject to paragraph (5) below, a request for extension under paragraph (1) above shall be made before the time or period in question has expired.

(5) Where the request for extension is made after the time or period has expired, the registrar may, at her discretion, extend the period or time if she is satisfied with the explanation for the delay in requesting the extension and it appears to her to be just and equitable to do so.

(6).....

(7) without prejudice to the above, in the case of any irregularity or prospective irregularity in or before the Office of the registrar which—

(a) consists of a failure to comply with any limitation as to times or periods specified in the Act or these Rules or the old law as that law continues to apply and which has occurred or appears to the registrar as likely to occur in the absence of a direction under this rule, and

(b) is attributable wholly or in part to an error, default or omission on the part of the Office or the registrar and which it appears to her should be rectified,

she may direct that the time or period in question shall be altered in such manner as she may specify upon such terms as she may direct.”

12. There are two issues here. The first is the problem of when a document constitutes a statutory form and when it does not. The second is the problem of compliance with statutory time limits. I will deal firstly with the issue of forms.

13. Mr Stobbs stressed that it not necessary to use the physical Form TM8 as published on the Office website; a handwritten note would be accepted; and that ‘TM8’ does not specifically have to appear on the ‘form’ accepted. With the first of these three propositions, I agree. Rule 3(2) explicitly states that a requirement to use a form as published is satisfied by the use either by a replica of that form or of a form which is acceptable to the registrar and contains the information required by the form as published and complies with any directions as to the use of such a form. A replica would therefore suffice; indeed it is common practice within the trade mark profession for firms of attorneys to use replicas of the statutory forms. It is impossible to say what view the Registry might take of a ‘handwritten note’ since it depends on the note. It may be replica of the form, reproduced by hand, in which case it may suffice; in any event, it is not of any benefit to this case to hypothesise since I do not have a handwritten note before me. Mr Stobbs effectively asked me to substitute the suspension request of 20 March 2008, received at the Office on 25 March 2008, as a Form TM8. That letter could not be said to be a replica of a Form TM8 or indeed a form at all, as envisaged by rule 3(2). Rule 13A(1) specifically states that for a defence to an opposition to be mounted, a Form TM8 which shall include a counterstatement must be filed within the relevant period. If there is nothing to identify a document as a Form TM8, it cannot be said to comply with rules 3 or 13A(1). I disagree with the third proposition; it is necessary for ‘TM8’ to appear on the form. The Office deals with thousands of pieces of correspondence every week; there would be no certainty that documents constituted applications, oppositions or defences without their proper identification, which is why the rules specify the forms that must be used.

14. Mr Stobbs contended that the information required by Form TM8 was contained in the suspension request. I agree that the application number, opposition proceedings number and the parties were identified. Form TM8 calls, in box 7, for a counterstatement. Mr Stobbs argued that ‘grounds denied’ is implicit in the defence having been filed and that it is unnecessary to say more. I disagree; it may be that an applicant admits certain grounds and denies others. It is impossible to glean such information from the suspension request. Rule 13A(1) states that the Form TM8 “shall include a counter-statement”. ‘Shall’ is not optional but is mandatory. Further, box 8 of Form TM8 requires a statement of truth. There was none in the suspension request. Again, Mr Stobbs submitted that a statement of truth is unnecessary, indeed is hollow, when all that is stated is ‘grounds denied’. I cannot ignore the wording of the rule which stipulates that the replica form or other form must contain the information required by the form as published. The form as published requires a counterstatement and a statement of truth and the suspension request contains neither. Box 4 of Form TM8 requires the applicant to provide an address for service. The suspension request, although signed by both parties, came from the *opponent*; it is therefore unsurprising that it did not contain the required identification of the applicant’s address for service, but it is undeniable that Form TM8 requires one. I conclude that the suspension request cannot stand in lieu of Form TM8 and counterstatement. The purpose of Form TM8 is to defend an application against opposition proceedings; the purpose of a suspension request is to suspend proceedings that have been joined. If no Form TM8 has been filed by the due date, the

application shall be deemed to be withdrawn and there can be no proceedings capable of suspension. I also bear in mind that rule 13A(5) requires the registrar to send a copy of Form TM8 to the opponent, thereby triggering the 'initiation date', from whence the clock starts ticking for the opponent to file its evidence. It would be difficult to reconcile rule 13A(5) with a non-existent Form TM8.

15. It is regrettable that the Registry initially gave a period of time for further details about the negotiations to be provided, rather than stating that the time for filing Form TM8 and counterstatement expired on 26 March 2008 and that there could be no extension after the full cooling-off period had been exhausted. This constituted an error on the part of the Office. Rule 68(7) provides for a discretion on the part of the registrar to alter time periods when an error occurs which is wholly or partly attributable to the registrar. The rule also stipulates that it is without prejudice to the remainder of rule 68 and I bear in mind that rule 68(3) prohibits the extension of time for filing a counterstatement. Looking at the date and time the suspension request was received by fax at the Office, it preceded the deadline by one day and was sent at 5.20 in the evening. Even if the Registry had given the correct response to the suspension request, by the time it reached the caseworker, it would have been too late, in all probability, for a response to have been given to the parties with enough time remaining for the applicant to have filed Form TM8 and counterstatement by the close of 26 March 2008. With or without the Registry's error, I do not consider that the outcome would have been any different; either way, there was insufficient time for the applicant to rescue the application from the effect of rule 13A(1). There is no discretion in that rule: if no Form TM8 and counterstatement is received by the Office within the relevant period, the application *shall* be deemed to be withdrawn. Rule 68(7) cannot supersede rule 68(3) in such circumstances. Likewise, there is no room for manoeuvre using rule 57; to invoke rules 57 and 68(7) in the face of rule 68(3) would be to act outside of the Registrar's inherent jurisdiction, as per the comments of the late Pumfrey J in *Pharmedica GmbH's Trade Mark Application* [2000] RPC 536 when he said:

“Notwithstanding the fact that the registrar is, like the county court, a tribunal which is established by statute, I have no doubt that the registrar has the power to regulate the procedure before her in such a way that she neither creates a substantial jurisdiction where none existed, nor exercises that power in a manner inconsistent with the express provisions conferring jurisdiction upon her.”

16. I referred at the hearing, and in my follow-up letter, to *LEATHERMASTER* BL O/084/04, a decision by Geoffrey Hobbs Q.C., sitting as the appointed person. Although that case concerned a timeously filed counterstatement but a late Form TM8, there are some similarities between that case and this. Although the rule numbers cited in *LEATHERMASTER* were those prior to the 2004 amendment, they correspond to the rules cited in this decision. Mr Hobbs said, at paragraph 15:

“I regret that I am unable to grant the Applicant relief or dispensation. I would have allowed it to rely on the Form TM8 which it sent to the Registry on 25th September 2002 if I could have found a way of enabling it to do so in accordance with the Act and the Rules. However, the provisions of Rules 13(3), 13(6), 68(1) and 68(3) are too stringent and explicit to be denied their full meaning and effect.”

Rules 3(2), 13A(1), 68(1) and 68(3) do not allow me to exercise discretion and allow time for amendment/further information; neither do they permit an alternative form of defence to stand as a Form TM8 and counterstatement. I therefore conclude that the consequence of the applicant's failure to file a Form TM8 and counterstatement by the due date of 26 March 2008 is that the application for registration is deemed to be withdrawn within the meaning of rule 13A(1) of the Trade Marks Rules 2000 (as amended).

Dated this 2nd day of September 2008

Judi Pike
For the Registrar,
The Comptroller-General