

O-275-17

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK REGISTRATION NO 3177639
IN THE NAMES OF BEVERLY GAYLE & PETER GAYLE
FOR THE TRADEMARK**



**IN CLASS 25
AND
THE FAILURE TO FILE FORM TM8 AND COUNTERSTATEMENT
IN DEFENCE OF THAT REGISTRATION
IN CANCELLATION PROCEEDINGS (NO. 501489)
LAUNCHED BY
ROHAN DESIGNS LIMITED**

BACKGROUND

1. Beverly Gayle and Peter Gayle are the registered proprietors of the following trademark in class 25 for **clothing**. The mark was applied for on 01 August 2016 and entered on the register on 02 December 2016.



2. On 12 December 2016, Rohan Designs Limited filed an application to declare the above mark invalid. The form TM26(I) was served on Mr & Mrs Gayle on 15 December 2016 setting a deadline of 15 February 2017 for the filing of a form TM8 and counterstatement. As no TM8 was received by 15 February 2017, the Tribunal wrote to Mr & Mrs Gayle on 24 February 2017 in the following terms:

“...As no TM8(N) and counterstatement have been filed within the time period set, Rule 38(6) applies. Rule 38(6) states that:

‘...the registration of the mark shall, unless the registrar directs otherwise, be revoked’.

The Registry is minded to treat the proprietors as not opposing the application for revocation and revoke the registration as no defence has been filed within the prescribed period.

If no response is received on or before 10 March 2017 the Registrar will proceed to issue a short decision on the issue of failure to comply with the Rules governing the filing of a defence.”

3. I note that the above letter erroneously refers to rule 38(6) and to the failure to file Form TM8(N). That rule and form are applicable only to revocation proceedings based on a claim that the proprietors have not put their mark to genuine use. As the

subject proceedings are based on a claim of invalidity, the letter should have referred to rule 41(6) and to the failure to file Form TM8. However, nothing turns on this error because I note that the original serving letter dated 15 December 2016 was correctly worded and it is the failure to respond to that letter which is relevant to the matter before me.

4. Mrs Gayle subsequently emailed the Tribunal on 26 February 2017 stating that after speaking to Mr Parrish of Nabarro LLP (the applicant's representative) she was *'very confused on what options I had or what to do next, as I was told that I had NO choice or option in the matter and had to cancel not only the submission of the logo but also the registration with Companies House'*. The rest of the email provides an explanation of how and why the subject mark was chosen and comments on the merits of the applicant's grounds of invalidation.

5. The Tribunal replied to Mrs Gayle on 18 March 2017 setting out a preliminary view that no sufficient reasons were provided as to why the form TM8 had not been filed by the due date. The Tribunal also offered Mrs Gayle the option of providing full written reasons and requesting a hearing on this matter. The deadline for such a request was set for 10 April 2017.

6. Mrs Gayle replied by email on 22 March 2017 setting out her difficulties with depression as mitigating circumstances and requested a hearing. The Tribunal responded on 28 March 2017 asking Mrs Gayle to set out her reasons in the form of a witness statement. Mrs Gayle provided a witness statement on 5 April 2017. There is no statement of truth or signature on the witness statement. Paragraphs 1 – 7 of the witness statement provide details about Mrs Gayle's use of her mark. None of this information is relevant to the matter before me. In terms of relevant information (i.e. why the TM8 and counterstatement was not filed by 15 February 2017), Mrs Gayle provides the same information which was provided in her email of 22 March 2017. The relevant part of the witness statement reads as follows:

“8. I have been made aware that I did not respond in time to filing a TM8 form, in regards to the cancellation of my trade mark. Although this is not an easy

subject for me to discuss, for the purpose of this matter am I willing to try and make a statement.

I have suffered with depression for the past 15-16 years, but I have worked hard to find a routine or something to occupy my feelings and thoughts, that will not hinder my duties as a wife and mother. However on the 30th March 2015, my Dad died. He was not only my Dad, but my friend, right hand, and I was his next of kin. Although, you may be thinking that this date has nothing to do with the filing date, I would like to say “it does and still does to this day”.

The month of:

- December – Christmas and Family functions (No Dad)
- February – My birthday (no Dad)
- March – The month he died
- May – Month of burial
- July – His Birthday and hopefully my graduation (no Dad)

These are all significant at the moment and is also a time when I am at my lowest, due to the fact that I have not been able to grieve his lost and the continuous study that I am committed to. It is only due to these reasons that I was unable to file the TM8 form in time.”

HEARING

7. A hearing took place before me on 30th May 2017 by telephone conference. Mrs Gayle represented herself and her husband and Mr David Parrish of CMS Cameron McKenna Nabarro Olswang LLP represented Rohan Designs Limited. I received a skeleton argument from Mr Parrish prior to the hearing.

8. At the outset of the hearing I reiterated that the purpose of the hearing was to establish the reasons for the failure to file a defence by the due date and was not an opportunity to discuss the merits or demerits of the substantive case. Mrs Gayle asked why she had been asked to file a defence. I explained that a defence should

be her opportunity to rebut the case made by the other party and that, without a defence, she would not have an opportunity to argue her case substantively.

9. Mrs Gayle then stated that she suffers from anxiety and depression and those conditions have been exacerbated since her father passed away in March 2015. She also stated that she had been affected by depression between December 2016 and February 2017 and had been unable to deal with any paperwork during this time. Mrs Gayle added that although she had applied for the mark as a joint applicant with her husband, Peter Gayle, she was solely responsible for the day to day running of the business including the administration. She had tried to seek assistance but she could not find anyone willing to help her with these matters.

10. Mr Parrish did not wish to add anything further to the submissions he had made in his skeleton argument regarding the necessary extenuating circumstances or compelling reasons that must be made out for a late TM8 to be allowed. The most relevant part of Mr Parrish's skeleton argument reads as follows:

“11. Application of the decision in *Mercury* shows that the Proprietor has not provided a compelling reason to allow her further time to file the TM8. The Cancellation Applicant sympathises with the Proprietor's personal circumstances, but following *Mercury* the Registry must conclude that the Proprietor has not said anything that shows that it would not have been possible for her to find the time necessary to file her TM8 and counterstatement between 15 December 2016 and 15 February 2017 by reason of her study commitments or ill-health. *Mercury* also shows that it should be viewed as significant that the Proprietor has not suggested that she tried to comply with the deadline of 15 February 2017 or has taken any steps toward the drafting of the TM8 and counterstatement”.

DECISION

11. With regard to the late filing of a form TM8. I must refer to Rule 41(6) of the Trade Marks Rules 2008 which states that:

“The proprietor shall, within two months of the date on which a copy of Form TM26(l) and the statement was sent by the registrar, file a form TM8, which shall include a counter-statement, otherwise the registrar may treat the proprietor as not opposing the application and registration of the mark shall, unless the registrar otherwise directs, be declared invalid”

12. The combined effect of Rules 77(1), 77(5) and Schedule 1 of the Rules means that the time limit in rule 41(6), which sets the period in which the defence must be filed, is non extensible other than in the circumstances identified in rules 77(5)(a) and (b) which state:

“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.”

As there is no claim to any irregularity in procedure in the case before me, the above rule does not assist Mr and Mrs Gayle. It follows that the only legal basis on which I may allow them to defend the registration is the discretion provided to me by the words “unless the registrar otherwise directs” in rule 41(6). In *Kickz*, Mr Hobbs QC sitting as the Appointed Person held that the registrar’s discretion in this regard is narrow and can be exercised only if there are “extenuating circumstances”. In *Mercury*, Ms Amanda Michaels, sitting as the Appointed Person, in considering the factors the Registrar should take into account in exercising such discretion, held that there must be “compelling reasons”. She also referred to the criteria established in *Music Choice Ltd’s Trade Mark* [2006] R.P.C. 13 (*‘Music Choice’*), which provides guidance when exercising this discretion. Such factors are:

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

- (2) The nature of the applicant's allegations in its statement of grounds;
- (3) The consequences of treating the proprietors as opposing or not opposing the application;
- (4) Any prejudice caused to the applicant by the delay;
- (5) Any other relevant considerations, such as the existence of related proceedings between the same parties.

13. Insofar as the first *Music Choice* factor is concerned, the deadline for receipt of the Form TM8 and counterstatement was 15 February 2017. Mrs Gayle has stated that she has suffered from depression for the past 15-16 years and has found things difficult since her father passed away in March 2015, particularly during family occasions such as Christmas. She has explained that she suffered from a depressive episode between December 2016 and February 2017 and did not attend to any paperwork relating to her registered mark during this period and could not find anyone to assist her. Her first contact with the Tribunal was on 26 February 2017 following receipt of the official letter stating the deadline of 15 February 2017 to file a defence had expired. The Form TM8 and counterstatement has still not been filed.

14. In terms of the second *Music Choice* factor, the grounds of cancellation are based on section 5(2) and 5(3) of the Trade Marks Act 1994, as Rohan Designs Limited alleges the marks are confusingly similar and that its earlier marks have a reputation in the UK.

15. Turning to the third *Music Choice* factor, the consequences for Mr and Mrs Gayle if discretion is not exercised in their favour are serious as the registered trade mark would be invalidated for want of a defence. By contrast, if discretion is exercised in their favour, they would have the opportunity to defend the registered trade mark and a decision would be made on the merits of the case.

16. In terms of the fourth *Music Choice* factor, Mr Parrish did not identify any specific prejudice that may have been caused to the applicant by the delay so far. I say ‘so far’ because the Form TM8 and counterstatement has still not been filed and therefore the delay is ongoing.

17. As regards the fifth *Music Choice* factor, I have not been made aware of other related proceedings between these parties nor did either party bring to my attention any other relevant considerations to be taken into account.

18. Having addressed each of the relevant factors in *Music Choice*, I must now decide whether there are sufficient extenuating circumstances/compelling reasons to enable me to exercise my discretion. After careful consideration, my decision is that the necessary extenuating circumstances/compelling reasons have not been made out. Whilst I am sympathetic to Mrs Gayle’s ongoing issues with depression, her confusion over what filing a defence meant, and that she could not find anyone to assist her, her explanation in this regard is insufficient to satisfy me that those factors made it impossible for her to comply with the deadline. In all of the circumstances, and despite the lack of any specific prejudice to the applicant and the serious consequences for Mr and Mrs Gayle, the trade mark registration is declared invalid under rule 41(6).

COSTS

19. As my decision terminates the proceedings, I must consider the matter of costs. Using the guidance set out in Tribunal Practice Notice 2/2016, I award the applicant costs on the following basis:

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| Official fee for Form TM26(I) | £200 |
| Preparing the TM26(I) | £200 |
| Preparing for, and attending, the joint hearing | £300 |
| Total | £700 |

I order Beverly Gayle and Peter Gayle (being jointly and severally liable) to pay Rohan Designs Limited the sum of **£700**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7TH day of June 2017

**June Ralph
For the Registrar,
the Comptroller-General**