

The Rolls Building,  
Fetter Lane,  
London EC4A 1LN.  
Monday, 24th June 2019.

In the Matter of an Appeal to the Appointed Person from a  
Decision of Mr Raoul Colombo (acting on behalf of the Registrar  
of Trade Marks) dated 29th day of November 2018

Before:

**THE APPOINTED PERSON**

**Mr Geoffrey Hobbs QC**  
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**IN THE MATTER OF:**

The Trade Marks Act 1994

-and-

**IN THE MATTER OF:**

Trade mark Registration No. 2650833 in the name of  
Chevron Cars Ltd

-and-

**IN THE MATTER OF:**

An application for a declaration of invalidity filed in  
relation thereto under number 502198 by WDK Holdings Ltd

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(Transcript of the Shorthand Notes of:  
Marten Walsh Cherer Limited,  
1st Floor, Quality House, 6-9 Quality Court,  
Chancery Lane, London WC2A 1HP.  
Telephone: 020 7067 2900.  
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**MS FIONA CAYZER** appeared as company representative on behalf  
of the Trade Mark Proprietor (Appellant)

**MR DANIELE SELMI** instructed by Rosenblatt Solicitors appeared  
on behalf of the Applicant for Invalidity (Respondent)

**APPROVED DECISION**

**THE APPOINTED PERSON:** The trade marks **CHEVRON B8**, **CHEVRON B16** and **CHEVRON B19** were registered as a series of three under number 2650883 in the name of Chevron Cars Limited ("the Proprietor") with effect from 31 January 2013 for use in relation to "Custom manufacture of cars for racing purposes, road use and track uses and custom manufacture of spare parts for those cars" in Class 40.

On 8 August 2018, WDK Holdings Limited ("the Applicant") filed a Form TM26(I) and Statement of Grounds under Rule 41(1) of the Trade Marks Rules 2008 claiming a declaration to the effect that the Proprietor's trade marks were, and remained, invalidly registered under ss.47(2)(a) and 5(2)(b) of the Trade Marks Act 1994 having regard to the rights to which the Applicant was entitled as proprietor of two earlier trade marks:

1. Trade Mark No. 2239477, consisting of the word **CHEVRON** graphically represented in the form of a device mark, registered with effect from 15 July 2000 for "Road and racing vehicles; parts and fittings for all the aforesaid goods; all in Class 12, but not including brake linings or fans for motor vehicles";

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2. Trade Mark No. 2239479 consisting of the plain word **CHEVRON**, also registered with effect from 15 July 2000 for the same specification of goods in Class 12.

In accordance with the requirements of Rule 41(5), the Registrar sent a copy of the Form TM26(I) and Statement of Grounds to the Proprietor under cover of an official letter dated 10 August 2018. The Proprietor then had a period of two months, expiring on 10 October 2018, within which to file a Form TM8 and counterstatement in default of which "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" in accordance with the provisions of Rule 41(6).

The time limit of two months prescribed by Rule 41(6) is identified in Rule 77(5) and Schedule 1 to the 2008 Rules as a time limit which may be extended if, and only if, the requirements for doing so as specified in that rule are met. There is, and can be, no suggestion on the basis of the materials before me that the requirements of that rule are met in the present case.

The official letter of 10 August 2018 clearly and emphatically spelled out to the Proprietor what the consequences would be under Rule 41(6) if it did not file the required Form TM8 and counterstatement within the

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non-extendible period of two months expiring on 10 October 2018:

"If you wish to continue with your registration, you **must** in accordance with rule 41(6) of the Trade Marks Rules 2008 complete form TM8 and counterstatement (please see Glossary), and return it within **two months** from the date of this letter.

**The TM8 and counterstatement must be received on or before 10 October 2018.**

**In accordance with rule 41(6) if the TM8 and counter-statement are not filed within this period, (a period which cannot be extended), the registration of the mark shall, unless the registrar otherwise directs, be declared invalid in whole or part.**

**Before you decide whether to defend your registration, you may wish to refer to the guidance notes on invalidity proceedings and the scale of costs which are available from the IPO website at**

**<https://www.gov.uk/government/>**

publications.trade-marks-invalidations/  
trade-marks-invalidations."

The Proprietor failed to comply with the specified deadline. The Registrar therefore wrote to it in the following terms on 18 October 2018:

"The official letter dated **10 August 2018** informed you that if you wished to continue with your registration you should file TM8(N) and counterstatement on or before **10 October 2018**.

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 proprietor as not opposing the application for revocation and revoke the registration 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, **01 November 2018**.

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 issue a short decision on the issue of failure to comply with the Rules governing the filing of a defence."

The letter erroneously referred to the provisions of Rule 38 rather than the provisions of Rule 46, but nothing of any significance attaches to that in the circumstances of the present case. The Proprietor did not avail itself of the opportunity to request a hearing. It responded by filing a Form TM8, counterstatement and witness statement of Fiona Cayzer on 24 October 2018. In her witness statement Ms Cayzer stated:

"The TM8 and counterstatement are being filed outside the prescribed period as we wrongly took the filing date to be the same as the date the evidence was due to be filed for the

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two further applications by WDK Holdings to revoke and invalidate our other trademark UK 2616321 CHEVRON, CLASS 12.

WDK Holdings is the current registered owner of the mark UK2239477 CHEVRON(LOGO) and UK2239479.

Their predecessor in title, Chevron Racing Team Ltd, was previously found to be the junior user of the Chevron Mark in earlier disputes with Chevron Cars Ltd in 2009 & 2010.

Despite referring to the previous hearing and subsequent appeals to the use of the Chevron marks, and associated marks, WDK Holdings are starting proceedings to stop Chevron Cars Ltd using the marks it is entitled to use, as found previously in 2009 & 2010.

Chevron Cars Ltd would like to request a hearing for this latest invalidation claim by WDK Holdings, so the matters due to use of the trademarks can once again be clarified to

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the latest registered owner of the Chevron mark UK2239477 & UK2239479."

The Registrar confirmed receipt of these papers in an official letter of 29 October 2018, which went on to state as follows:

"The contents of the witness statement have been carefully considered. However, it is the Registrar's preliminary view that the reasons provided are not sufficient for the Registrar to exercise his discretion. The witness statement confirms that the proprietor received the papers serving the notice of cancellation and the failure to submit the notice of defence was due to a misunderstanding on the proprietor's part. the request to allow the late filed TM8 into the proceedings is therefore refused.

I would point out that only in cases where there are 'extenuating circumstances', or 'compelling reasons', is the Registrar able to exercise his discretion and admit a late filed Form TM8. It is the Registrar's view that the circumstances described in the

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witness statement are not sufficient justification to permit the use of his discretion.

I would also draw your attention to the following trade mark decisions which provide further guidance on this type of issue:

Kix decision - (BL-O-035/11)

Mercury decision - (BL-O- 050/12)

These can be found on our website under the heading: 'Trade Marks: results of past decisions.'

In accordance with paragraph 10 of Tribunal Practice Notice 2/2011, if either party disagrees with the preliminary view they should request a hearing within 14 days from the date of this letter; that is on or before **12 November 2018**.

If no response is received within the time allowed, the preliminary view will automatically be confirmed, and the Registrar will proceed to issue a short decision to

declare the registration invalid."

In the absence of any request for a hearing, or any further response from the Proprietor, the Registrar proceeded to issue a decision in the following terms on 29 November 2018:

"By an application filed on 2 August 2018, WDK Holdings Ltd applied for a declaration of invalidity of this registration under the provisions of 47(2)(a) of the Trade Marks Act 1994.

A copy of this application was sent to the registered proprietor's recorded address for service on 10 August 2018.

The registered proprietor did not file a counterstatement within the two months specified by Rule 41(6) of the Trade Mark Rules 2008. Neither party requested a hearing or gave written submissions in respect of the official letter of 18 October 2018. Such circumstances are covered by Rule 41(6) which states:

'... 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.'

On 25 October 2018 the registered proprietor filed a Form TM8 and a witness statement by Fiona Cayzer, explaining why the Form TM8 had not been filed by the original deadline.

The Registry issued a preliminary view on 29 October 2018, to refuse the request to admit the late Form TM8 into the proceedings. The registered proprietor did not request a hearing to challenge the Registry's preliminary view.

Under the provisions of the rule, the Registrar can exercise discretion. In this case, insufficient reasons have been given as to why I should exercise this discretion in favour of the registered proprietor and I therefore decline to do so.

Therefore, in accordance with Section 47(6)

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of the Act, the registration is declared invalid and I direct that it be removed from the register and deemed never to have been made."

On 27 December 2018, the Proprietor filed a Form TM55P with reasons for appeal to an Appointed Person under Section 76 of the Trade Marks Act 1994, asking for "the decision to revoke the trade mark number UK2650883 to be denied". The reasons for appeal omitted to refer to the basis on which the decision of 29 November 2018 had been taken and failed to identify any particular error or procedural irregularity on the part of the Registrar in coming to the conclusion that he did under Rule 41(6). I therefore considered it appropriate to ask my clerk, when notifying the parties of the date and time of today's hearing, to bring the following decisions to their attention:

1. *Permanent Secretary v John & Pascal Ltd (Halloumi Trade Mark)* [2018] EWHC 3226 (Ch) (28.11.2018).
2. *Cow and Pig British Kitchen Trade Mark* BL O/774/18 (12.11.2018)
3. *Bosco Trade Mark* BL O/399/15. (21.08.2015)

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The Proprietor filed its skeleton argument for today's hearing on 19 June 2019. This again omitted to address the basis on which the decision under appeal had been taken. It also failed to identify any error or procedural irregularity affecting the determination and did not consider or refer to any of the three decisions which my clerk had brought to the parties' attention.

My clerk therefore emailed the proprietor at 09:46 on 20 June 2019 stating:

"Having looked at the appellant's skeleton argument dated 19 June 2019, the Appointed Person has asked me to remind you of the three decisions brought to the attention of the parties in the email sent to them on 7 June 2019 (below)".

Not long afterwards, the applicant filed its skeleton argument and at the same time copied it to the Proprietor. This explained in detail, with reference to those and other decisions, why it maintained that the decision under appeal was unimpeachable in point of fact and in point of law.

At the hearing before me this morning, the Proprietor wished to emphasise that the registered trade mark in issue was an asset that it had successfully defended in earlier proceedings which had resulted in decisions issued in its

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favour under reference BL O/364/09 on 25 November 2009 and BL O/354/10 on 4 October 2010. However, it found itself in difficulty in trying to identify a substantive basis for contending that the Hearing Officer had fallen into error on his application of the law to the facts of the present case.

The question for this tribunal on appeal is, in essence, whether it was open to the Registrar, on the evidence and materials before him, to arrive at the conclusion he did, for the reasons he gave in the decision he issued on 29 November 2018. That boils down to the question whether it was open to him to conclude, as stated in the penultimate paragraph of the decision that "insufficient reasons have been given as to why I should exercise this discretion in favour of the registered proprietor and I therefore decline to do so".

The explanation given in Ms Cayzer's witness statement for the Proprietor's failure to comply with the non-extendible deadline for filing the Form TM8 and counterstatement is simply this: "We wrongly took the filing date to be the same as the date the evidence was due to be filed for the two further applications by WDK Holdings to revoke and invalidate our other trademark UK2616321 CHEVRON, CLASS 12".

I can only say that I do not see how that position could reasonably or realistically have been adopted on the basis of what was actually said in the official letter of 10

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August 2018. It was made explicitly clear in that letter that what the proprietor had to do in order to stay on the right side of the non-extendible deadline was file its Form TM8 and counterstatement by no later than 10 October 2018. Instead of doing what it was required to do, the proprietor "wrongly took the filing date" to be a different date from the one specified.

It might be the case that the official letter was not read, or not read with the minimal degree of care and attention required in order to see that the applicable deadline was 10 October 2018. It might be the case that the letter was read with enough care and attention to see that the deadline was 10 October 2018 but nonetheless ignored by someone acting with a greater or lesser degree of conscious disregard for what it said. I do not know because the Proprietor has not descended into any real detail as to why it "wrongly" proceeded as if no binding deadline had been set by the official letter it had received under Rule 41(5). What I do see is that the Proprietor did not reach first base in its attempt to establish a case for the exercise of discretion in its favour under Rule 41(6).

On the evidence and materials before the Registrar, it had only itself to blame for its failure to comply with the strict requirements of the rules. I am satisfied that the Registrar was entitled, consistently with the considerations identified and discussed in the decisions I have referred to,

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and other decisions along the same lines, to come to the conclusion he did in the decision under appeal. The appeal is therefore dismissed.

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Appeal dismissed with costs.

The Proprietor to pay £1,950.00 to the Applicant in respect of its costs of the Appeal within 21 days of 24 June 2019.