

O/613/20

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. 3441548
BY DER TOURISTIK UK LIMITED
TO REGISTER:

Alfred&

Alfred&Asia

Alfred&Africa

Alfred&South America

Alfred&North America

Alfred&Australasia

AS A SERIES OF TRADE MARKS
IN CLASSES 39 & 43

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 419967
BY A&K S.A.R.L.

BACKGROUND

1. On 4 November 2019, Der Touristik UK Limited (“the applicant”) applied to register the trade marks displayed on the cover page of this decision, under number 3441548 (“the application”). The application was accepted and published in the Trade Marks Journal on 27 December 2019 in respect of the following services:

Class 39: Travel agency services and booking services for arranging travel and tours; Holiday travel reservation services; Arranging of flights; Arranging of sightseeing tours and excursions; Conducting sightseeing tours; Arranging excursions for tourists; Arranging of day trips; Arranging tours; Organization of tours; Provision of tours; Transport services for sightseeing tours; Rental of vehicles; Providing information to tourists relating to excursions and sightseeing; Providing information about travel, via the internet.

Class 43: Arranging holiday accommodation; Hotel reservation services; Travel agency services for making hotel reservations; Travel agency services for booking temporary accommodation; Booking agency services for hotel accommodation; Hotel reservation services provided via the Internet; Provision of holiday accommodation; Providing on-line information relating to holiday accommodation reservations; Providing online information relating to hotel reservations.

2. On 24 February 2020, WP Thompson (“WPT”) filed a Form TM7A (Notice of threatened opposition) on behalf of A&K S.a.r.l. (“the opponent”), the effect of which was to extend the opposition period until 27 March 2020. On 27 March 2020, WPT filed a Form TM7 (Notice of opposition and statement of grounds) on behalf of the opponent.

3. The opposition is brought under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and is directed against all the services of the application. In relation to its 5(2)(b) and 5(3) claims, the opponent relies upon its European Union trade mark number 8248858 (“the opponent’s mark”), which consists of a figurative ampersand. The opponent’s mark was filed on 27 April 2009 and was entered into the

register on 11 February 2010 for a range of goods and services in classes 16, 39 and 43. The registration process for the opponent's mark was completed more than five years before the filing date of the application. As such, it is subject to the proof of use requirements specified in section 6A of the Act. In this regard, the opponent made a statement of use in respect of the goods and services it relies on. As for its claim under section 5(4)(a), the opponent relies upon its alleged earlier right in the sign **&**. The opponent claims to have used the sign throughout the UK since 2002.

4. The Tribunal served the Form TM7 on the recorded representative of the applicant, Sweetinburgh & Windsor Ltd ("SW"), by email on 6 May 2020. In accordance with Rules 18(1) and 18(3) of the Trade Marks Rules 2008 ("the Rules"), the applicant was informed that it had two months from the date of the letter in which to file its Form TM8 and counterstatement, namely, on or before 6 July 2020.

5. On 27 May 2020, SW filed the applicant's Form TM8 and counterstatement. In its counterstatement, the applicant denied all the claims made and indicated that it would require the opponent to provide proof of use of its mark for all the goods and services on which it relies.

6. On 2 June 2020, the applicant's Form TM8 and counterstatement was served on WPT. The opponent was notified that, in light of the circumstances surrounding the COVID-19 outbreak, the initial evidence/submissions period was to be set at four months, i.e. double the ordinary period allowed. Accordingly, the deadline for the filing of the opponent's evidence and/or submissions was given as 2 October 2020. In addition, the consequences of failing to file evidence in the prescribed period were outlined. The pertinent paragraphs of the letter are as follows:

"Please find enclosed a copy of the Form TM8 and counterstatement [...] which has been filed by the applicant on 27 May 2020.

[...]

In view of the current circumstances we are setting the initial evidence/submissions period at 4 months. At the end of this period, or

whenever the evidence/submissions are filed, we shall then review the situation at that time and set an appropriate deadline for the next round of evidence/submissions.

The evidence and submissions should therefore be received on or before **2 October 2020** and copied to the other party in accordance with Rule 64(6). Failure to do so will result in the evidence not being admitted into the proceedings.

Filing of opponent's evidence and submissions: 2 October 2020

[...]

If proof of use has been requested, this evidence of use must also be filed within the period set above. This is in accordance with Rule 20(2)(c) of the Trade Marks Rules 2008.

Failure to file evidence by the due date may result in your opposition/cancellation being deemed withdrawn. This is in accordance with Rule 20(3) of the Trade Marks Rules 2008.

[...]"

7. On 1 October 2020, WPT filed Form TM9 (Request for an extension of time before the period has expired) and requested a further two months for the filing of the opponent's evidence for the following reasons:

Due to the current pandemic situation, our client – the Opponent- (namely its employees and Directors) has been unable for many months to physically access their various European based offices and gather the necessary evidence and information to substantiate their opposition based on their earlier European registered '&' trade mark, its reputation and passing off across the European Union and in the UK.

This is an unfortunate situation many businesses are facing at these recent times in light of the sanitary requirements and travel restrictions measures across Europe, in particular the UK.

We thus respectfully request a two (2) month extension to the current deadline in order to be able to properly gather and submit the evidence in support of all the grounds of the above referenced opposition – particularly taking into account all of the fluctuating restrictions and guidance across Europe and the UK in particular in terms of work place attendance, historical document retrieval and travel.

It is appreciated that the initial period set sought to take account of current circumstances, but unfortunately with those circumstances prevailing, and in some aspects worsening, the extension now requested is required to fully take account of such circumstances. No prejudice to the Applicant is hereby inferred by the extension of time request as there is no impending enforcement actions against the Applicant, so far.

8. On 8 October 2020, SW contacted the Tribunal by email in order to challenge the opponent's request for an extension of time. The applicant submitted that:

"We [...] note that the evidence and submissions to be received before 2 October 2020 have not been submitted.

We strongly disagree that a further extension to the deadline should be granted. As the Opponent acknowledges, the circumstances surrounding the pandemic were taken into account when the initial deadline was set. The Opponent was aware of any restrictions due to the pandemic situation when the deadline was set four months ago and should have allowed for this. A further two month extension significantly delays the registration of the applicant's marks, which was published in December 2019. We assume that the Opponent would have been aware of the need to submit evidence of use since the Notice of Threatened Opposition was submitted in February 2020. A time period of over seven months is reasonable to compile the evidence.

The applicant has responded promptly in all matters and would prefer that the opposition be resolved as soon as possible without extension to the deadlines set. We also request that if the Opponent is unable to provide proof of use, the opposition be withdrawn. Further, we request that evidence and submissions received after 2 October 2020 should not be admitted into the proceedings.

The Opponent states that no prejudice to the applicant arises from this extension of time request. However, the uncertainty and the delay in allowing the application to proceed to registration is detrimental to the applicant's continued investment in their trade marks."

9. On 19 October 2020, the parties were informed that it was the preliminary view of the Registrar that the reasons provided by the opponent did not justify an extension of two months. However, an extension of one month was granted and the new deadline for the filing of the opponent's evidence was given as 2 November 2020. The parties were advised that, if they disagreed with the preliminary view, a hearing was to be requested on or before 2 November 2020. The relevant paragraphs of the letter are as follows:

"The TM9 filed on 1 October 2020 requested an extension of time to file evidence.

The registry's preliminary view is that the reasons provided do not justify a two month's extension and the extension of time request until **2 November 2020** should be granted.

The registry would expect the parties to adhere to the following timetable below:

Filing of opponent's evidence and submissions: 2 November 2020

Filing of applicant's evidence/submissions: two months from receipt of opponent's evidence

[...]

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 **2 November 2020**.

If no response is received within the time allowed, the preliminary view will automatically be confirmed.”

10. On 2 November 2020, WPT requested a hearing on behalf of the opponent as it disagreed with the preliminary view not to grant the full extension of time.

THE HEARING

11. A Case Management Conference (“CMC”) took place before me by telephone on 25 November 2020. At the CMC, Ms Louise Windsor of SW appeared for the applicant, while Mr David Gill of WPT attended for the opponent.

12. At the CMC, Mr Gill explained that, consistent with the explanation given on the Form TM9, additional time was being sought by the opponent due to the disruption caused by the COVID-19 pandemic. According to Mr Gill, since April 2020 the opponent’s staff have been working from home, a practice which is continuing at present. In addition to homeworking practices, the opponent has implemented a furlough programme concerning over half of its staff. These factors, Mr Gill submitted, have created difficulties for the opponent in carrying on with its general business as well as locating, obtaining, checking and supplying the relevant documentation to support this opposition. Crucially, Mr Gill stated, the appropriate personnel within the organisation who would ordinarily have access to the required information have not been on site.

13. Mr Gill also outlined that some of the documents which the opponent intends to include within its evidence are paper based while others are electronic. Particularly in relation to the former, Mr Gill submitted that access, retrieval and supply of these documents to WPT has been problematic, especially given that many of its staff have also been working from home during the pandemic. In respect of the latter, Mr Gill stated that even many electronic documents can only be accessed when working on site due to their financial or sensitive nature.

14. Despite the above, Mr Gill confirmed that progress has been made in compiling the opponent’s evidence; he stated that a witness statement and accompanying

exhibits are nearing completion. Mr Gill submitted that the documents which have already been obtained comprise advertisements, promotional materials and brochures. The outstanding documents are, predominantly, invoices relating to business conducted during the relevant period. These, Mr Gill explained, are generally stored on site and, due to the aforementioned factors, accessing and redacting personal information from these documents has been slow and challenging. However, Mr Gill submitted that the proceedings could still be considered to be moving at an efficient pace and the extension of time would not, in the opponent's view, add a significant delay. Further, Mr Gill argued that, in light of the circumstances surrounding the pandemic, general expectations as to what is considered efficient have been altered somewhat and it would be unfair to penalise the opponent for the difficulties they have faced.

15. Mr Gill confirmed that, although the opponent has offices across Europe, the sites relevant to the compiling of evidence for these proceedings are in the UK, namely, London and Cheltenham. It is not disputed that members of staff have, to some extent, been able to access these sites and obtain documents.

16. In addition to the originally requested extension of two months, it became apparent at the CMC that the opponent is seeking a further two week extension. This, according to Mr Gill, will allow the opponent to produce the outstanding documents and for them to be reviewed and integrated into the evidence which has already been compiled.

17. For her part, Ms Windsor reiterated the applicant's argument that the prescribed time period for the compilation of the opponent's evidence has been sufficient, not least because the contested application was published in December 2019. In this regard, Ms Windsor submitted that a further extension will result in the opponent effectively having a year in which to compile evidence, highlighting that the opponent would have been aware that it would require evidence to substantiate the opposition when it was launched.

18. Ms Windsor continued by outlining that the period of interrupted days was implemented by the UKIPO to account for difficulties and delays caused by the

pandemic.¹ While Ms Windsor expressed an appreciation for the fact that some of the opponent's staff have been required to work from home while others have been furloughed, it appeared to her that staff are available now to gather the evidence. Further, she argued that it is unfair to the applicant that those staff did not do so in the initial period that was set. Ms Windsor also indicated that much of the evidence should be available electronically, intimating that difficulties in accessing the opponent's sites should not unduly delay matters.

19. Ms Windsor stressed that the applicant has responded promptly at all stages and has demonstrated its commitment to resolving this matter. Conversely, according to Ms Windsor, the opponent has persistently responded at, or a very short time before, the deadlines. In this connection, the applicant is concerned that the extension of time is being sought to delay a determination of the opposition, whereas it would prefer for matters to be resolved in a timely manner and at minimum cost. In summation, the applicant has submitted that the reasons given by the opponent are not sufficient to warrant a delay to the proceedings.

20. In reply, Mr Gill sought to rebut the applicant's argument that the opponent has effectively had a year from the publication of the application to compile its evidence. He submitted that, in the initial stages of the proceedings, the opponent had considered that the opposition may not reach the evidential stages; there was apparent uncertainty as to whether the matter may reach settlement before evidence was necessary.

21. On the applicant's point regarding staff being available now to compile the evidence, Mr Gill submitted that the outstanding documents are more specialist in nature. The documents, according to Mr Gill, will need to be redacted by appropriate staff and the opponent has faced difficulties in relation to resourcing for this task.

22. In her concluding remarks, Ms Windsor expressed concern that granting the extension would put the applicant at a disadvantage as its allocated time for compiling

¹ On 24 March 2020, the Intellectual Property Office declared a period of interrupted days as a consequence of the COVID-19 pandemic, resulting in the suspension of many deadlines. The period of interruption was brought to an end on 30 July 2020.

evidence and/or submissions would then fall over the Christmas period. On this point, Mr Gill indicated that the opponent would not challenge an extension of time request from the applicant, should it be necessary.

23. At the conclusion of the CMC, I reserved my directions to give me an opportunity to properly reflect on the submissions put forward by both parties, as well as information provided by the opponent which had not been foreshadowed in its Form TM9.

DECISION

24. Rule 20 of the Rules sets out the procedure for evidence rounds in an opposition. It also details the instances in which the filing of evidence is mandatory and the consequences of a failure to file such evidence. The relevant parts are set out below:

“20. (1) Where—

[...]

(b) the opposition or part of it is based on grounds other than those set out in section 5(1) or (2) and the applicant has filed a Form TM8;

[...]

the registrar shall specify the periods within which evidence and submissions may be filed by the parties.

(2) Where—

[...]

(b) the opposition or part of it is based on grounds other than those set out in section 5(1) or (2); or

(c) the truth of a matter set out in the statement of use is either denied or not admitted by the applicant, the person opposing the registration (“the opposer”) shall file evidence supporting the opposition.

(3) Where the opposer files no evidence under paragraph (2), the opposer shall be deemed to have withdrawn the opposition to the registration to the extent that it is based on—

(a) the matters in paragraph (2)(a) or (b); or

(b) an earlier trade mark which has been registered and which is the subject of the statement of use referred to in paragraph (2)(c).

(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.

[...]”

25. There is no dispute that the period for filing evidence is a period which may be extended or that the opponent filed the requisite form and paid the appropriate fee. However, there is no automatic right to an extension of time for filing evidence. Rather, it is a matter of discretion which will be exercised in exceptional cases, taking into account all relevant factors. The opponent, as the party seeking the extension, has the burden of justifying it and the reasons for the extension should be strong and compelling.²

26. In considering the request for an extension of time, I bear in mind the comments made in *Siddiqui’s Application*, BL O/481/00, where the Appointed Person stated:

“In a normal case this will require the applicant to show clearly what he has done, what he wants to do and why it is that he has not been able to do it. This does not mean that in an appropriate case where he fails to show that he has

² *A.J and Levy’s Trade Mark* (1999) RPC 292

acted diligently but that special circumstances exist an extension cannot be granted. However, in the normal case it is by showing what he has done and what he wants to do and why he has not done it that the Registrar can be satisfied that granting an indulgence is in accordance with the overriding objective and that the delay is not being used so as to allow the system to be abused.”

27. In reaching a conclusion, I bear in mind that the consequence of a refusal of the opponent’s request for additional time will, in this case, result in the opposition being deemed withdrawn under Rule 20(3), above. I am also mindful of the fact that a refusal may ultimately lead to another action between the same parties on essentially the same basis, by way of invalidation. Notwithstanding these factors which mitigate against a refusal, I am not prepared to allow the opponent further time to file its evidence. Accordingly, **the preliminary view is upheld and the request for a further extension of time is refused.** While I have kept in mind that an apparent lack of diligence by a party does not necessarily mean that an extension cannot be granted, the Tribunal has an overriding objective to ensure that all proceedings are completed within a reasonable time, avoiding unnecessary expense.

28. Whether or not evidence is available at the time a hearing or CMC on a contested extension of time request takes place is not determinative, though it is an important factor. In this regard, I note that, although Mr Gill confirmed that a proportion of the opponent’s evidence is available, none has been filed to date; it is clear that important documentation has not been forthcoming. Moreover, Mr Gill did not confirm that the evidence would be filed imminently or provide a specific timeframe in which the evidence will be completed. On the contrary, at the CMC Mr Gill indicated that the opponent would require another two weeks, in addition to the two months that have already been requested; I have not been satisfied that there will be any material change in circumstance within the additional time which would enable the opponent to complete its evidence.

29. I accept that the pandemic has been challenging for individuals and businesses alike. However, the sorts of issues to which Mr Gill has referred, i.e. home working and staff shortages, have been experienced by many in this country during the

pandemic and, in my experience, deadlines before this Tribunal have, for the most part, continued to be met. While I have some sympathy with the position in which the opponent has found itself, it has not demonstrated any specific impact on its business operations over and above the general difficulties which all businesses have been faced with. The opponent was initially afforded four months, i.e. double the amount of time that is ordinarily given, in which to file its evidence. A further one month extension was then granted, giving the opponent a total of five months in which to file its evidence. Moreover, Mr Gill confirmed that some members of staff have, in fact, been able to access the opponent's sites and historical documentation; although Mr Gill suggested that the outstanding documents are more specialised in nature, I can see no reason why the appropriate members of staff could not have attended the opponent's offices to retrieve them, when it appears that others have previously been able to do just that. This is particularly pertinent considering the opponent has initiated these proceedings and would have been aware that it was required to collate cogent evidence. Without more, the generalised explanation given by the opponent is not, in my view, a strong or compelling reason to justify granting the opponent additional time.

CONCLUSION

30. As per rule 20(2)(b), the opponent's opposition is based on grounds other than those set out in section 5(1) or 5(2) and, as per rule 20(2)(c), the truth of a matter set out in the statement of use is either denied or not admitted by the applicant. The opponent has not filed evidence. That being the case, in accordance with rule 20(3), the opponent is deemed to have withdrawn its opposition.

COSTS

31. At the CMC I advised the parties that, if I were to refuse the opponent's extension of time request, the proceedings would be terminated and, therefore, costs would need to be determined. Neither party challenged this view.

32. The opposition being deemed withdrawn, the applicant is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016.

In the circumstances, I award the applicant the sum of **£300** as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the Notice of Opposition	£150
Preparing a counterstatement	£150
Total:	£300

33. I therefore order A&K S.a.r.l. to pay Der Touristik UK Limited the sum of **£300**. The above 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 7th day of December 2020

James Hopkins
For the Registrar,
The Comptroller General