

**O/874/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**APPLICATION No. 504555**

**IN THE NAMES OF EZGO GROUP INC AND HONG CHEN**

**FOR INVALIDITY OF TRADE MARK REGISTRATION No. 3631323**

**IN THE NAME OF COMFORT CLICK LTD**

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**DECISION**

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1. On 03 December 2021, the following trade mark was registered under number 3631323 in the name of Comfort Click Ltd (“the Proprietor”) for use in relation to a broad range of goods in Class 3:



mysmile

2. On 01 February 2022, EZGO Group Inc. and Hong Chen (“the Applicants”) applied under number 504555 for a declaration to the effect that the trade mark was invalidly registered.
3. On 11 February 2022, the Trade Marks Registry sent a copy of the invalidity application to the Proprietor with a covering letter which referred to the two-month limit for filing a Form TM8 Defence and Counterstatement prescribed by Rule 41(6)

of the Trade Marks Rules 2008 and contained the following warning: **“IMPORTANT DEADLINE: A completed Form TM8 MUST be received on or before 11 April 2022. ... It is important to understand that if the deadline date is missed, then in almost all circumstances, the registration will be treated as invalid in whole or in part.”**

4. On 13 May 2022, the Registry sent a letter to the Proprietor noting that no Form TM8 Defence and Counterstatement had been received. The letter stated: “The registry is minded to treat the proprietor as not opposing the application for invalidation and declare the registration as invalid as no defence has been filed within the prescribed period” and went on to inform the Proprietor that if it disagreed with that preliminary view it “must provide full written reasons and request a hearing on, or before, 27 May 2022” failing which “the registry will proceed to issue an undefended decision on the issue of failure to comply with the Rules governing the filing of a defence.”
5. On 09 June 2022, Mr Raoul Colombo acting for the Registrar of Trade Marks issued a decision under Rule 41(6) of the 2008 Rules declaring the registration of the Proprietor’s trade mark invalid on the following basis:

By an application filed on 01 February 2022, EZGO Group Inc and Hong Chen applied for a declaration of invalidity of this registration under the provisions of Section 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 via email and the Royal Mail’s signed UK delivery service on 11 February 2022.

The registered proprietor did not file a counterstatement within the two months specified by Rule 41(6) of the Trade Marks Rules 2008. Neither party requested a hearing or gave written submissions in respect of the official letter of 13 May

2022, which was sent to the parties via email and the Royal Mail's signed for delivery service. Such circumstances are covered by Rule 41(6) which states

“... otherwise the registrar may treat him as not opposing the application.”

Under the provisions of the rule, the Registrar can exercise discretion. In this case, no reasons have been given why I should exercise this discretion in favour of the registered proprietor and I therefore decline to do so.

As the registered proprietor has not responded to the allegations made, I am prepared to infer from this that they are admitted.

Therefore, in accordance with Section 47(6) 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.

6. The Proprietor now appeals against the Hearing Officer's decision and order on the basis that it was not properly notified of the Applicants' invalidity application or the default notice subsequently issued in respect of it. The Registrar has confirmed that the official letters of 11 February 2022 and 13 May 2022 were sent to the Proprietor by email only and not by Royal Mail's signed for delivery service as incorrectly stated in the decision under appeal. The Proprietor maintains that the letters in question went into the 'spam' box at the email address used by the Registrar and were not read before they were auto deleted within the period of 30 days applied to the contents of the 'spam' box by the standard settings on the relevant email account.
7. The prevailing view (albeit subject to criticism and pressure for modernisation) is that an email address does not, as such, qualify for recognition as an **“address for service”** because it does not, as such, designate any particular premises at which papers intended for a particular person can with confidence be physically delivered c.f.

Axnoller Events Ltd v Brake [2022] EWHC 1162 (Ch) at paras. [16] to [19] (HHJ Paul Matthews sitting as a Judge of the High Court).

8. Electronic service needs to be an organised — rather than an *ad hoc* — process for the reasons identified by Lord Sumption JSC in Barton v Wright Hassall LLP [2018] UKSC 12 at para. [17]:

There are, moreover, particular problems associated with electronic service, especially where it is sought to be effected on a solicitor. A solicitor must have his client's authority to accept service of originating process. If he has that authority, it will in practice normally cover any mode of service. But a solicitor's office must be properly set up to receive formal electronic communications such as claim forms. As the Law Society's Practice Guidance on electronic mail (May 2005) points out, "email presents new problems, because it can arrive unperceived by other members of staff". The volume of emails and other electronic communications received by even a small firm may be very great. They will be of unequal importance. There must be arrangements in place to ensure that the arrival of electronic communications is monitored, that communications constituting formal steps in current litigation are identified, and their contents distributed to appropriate people within the firm, including those standing in for the person primarily responsible for the matter when he is unable to attend to such communications as they arrive.

9. Rules 6.3(1)(d) and 6.20(1)(d) of the Civil Procedure Rules and paras. 4.1 to 4.3 of Practice Direction 6A establish an "opt in" regime for the service of court documents by email. The "opt in" is expected to be clear and specific. Filing an official form or notification with an email address in the contact details for the person filing it is not sufficient — without more — to provide the required indication of a decision to "opt in": Sir Robert McAlpine Ltd v Richardson Roofing Co Ltd [2022] EWHC 982 (TCC) at paras. [15] to [25] (Waksman J).

10. An example of the way in which the power to authorise electronic service may be exercised under ss. 8 and 9 of the Electronic Communications Act 2000 is provided by the Party Wall etc Act 1996 (Electronic Communications) Order 2016 (SI 2016 No. 335) whereby new subsections (1A) – (1C) were added to s.15 of the 1996 Act in the following terms:

(1A) A notice or other document required or authorised to be served under this Act may also be served on a person (“the recipient”) by means of an electronic communication, but only if -

(a) the recipient has stated a willingness to receive the notice or document by means of an electronic communication,

(b) the statement has not been withdrawn, and

(c) the notice or document was transmitted to an electronic address specified by the recipient.

(1B) A statement under subsection (1A) may be withdrawn by giving a notice to the person to whom the statement was made.

(1C) For the purposes of subsection (1A) -

“electronic address” includes any number or address used for the purposes of receiving electronic communications;

“electronic communication” means an electronic communication within the meaning of the Electronic Communications Act 2000; and

“specified” means specified in a statement made for the purposes of subsection (1A).

11. Rule 79 of the Trade Marks Rules 2008 simply provides that: **“(1) The delivery using electronic communications to any person by the registrar of any document is deemed to be effected, unless the registrar has otherwise specified, by**

**transmitting an electronic communication containing the document to an address provided or made available to the registrar by that person as an address for the receipt of electronic communications; and unless the contrary is proved such delivery is deemed to be effected immediately upon the transmission of the communication. (2) In this rule “electronic communication” has the same meaning as in the Electronic Communications Act 2000.”**

12. It was submitted on behalf of the Applicants going into the hearing before me that the Proprietor could compatibly with the provisions of r.79 be taken to have agreed to electronic service of the invalidity application and also the default notice issued in respect of it if (which was not established) the email address used for that purpose had previously been provided by the Proprietor in the section of the prescribed Form TM3 Application for Registration where applicants are invited to indicate: **“Email address Complete if you have no representative and would like us to correspond with you by email.”**
13. At the hearing, the Registrar accepted that the failure to send the official letters of 11 February 2022 and 13 May 2022 by post to the Proprietor at its address for service was a procedural irregularity and confirmed that he was not seeking on this Appeal to rely on r.79 as an alternative basis for service of the invalidity application by email.
14. The present case demonstrates the need recognised in the references I have given in paras. [8] to [10] above for electronic service to be an organised — rather than an *ad hoc* — process. At this point it is sufficient for me to say that I am not satisfied that r.79 enables an email address to be used by the Registrar as an address for service in the manner suggested by the Applicants.

15. My determination having regard to the position adopted by the Registrar as noted in para. [13] above is:

- (i) the Proprietor's Appeal is allowed;
- (ii) the Hearing Officer's decision and order of 09 June 2022 are set aside;
- (iii) the Applicants' Invalidity Application No. 504555 is remitted to the Registrar for further processing by a different Hearing Officer under Rule 41(6) and generally in accordance with the provisions of the Trade Marks Act 1994 and the Trade Marks Rules 2008.

16. Since I consider that the usefulness of the proceedings before me is from a practical point of view liable to depend on the outcome of the proceedings as a whole, I direct that the costs of the Appeal be treated as incurred in the registry proceedings and dealt with by the Registrar in the usual way at the conclusion of the claim for invalidity.

**Geoffrey Hobbs KC**

11 October 2022

Ms Kanika Mathur appeared on behalf of the Proprietor

Mr Mark Sorenti of Trademarkit LLP appeared on behalf of the Applicants

Mr Mark King (Deputy Director, Tribunal) appeared on behalf of the Registrar