

**BL O/0033/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**THE LATE FILING OF NOTICE OF DEFENCE FORM AND  
COUNTERSTATEMENT**

**IN RELATION TO:**

**TRADE MARK APPLICATION NO. 3887966**

**BY CHRISTINE SANGER**

**TO REGISTER THE TRADE MARK:**

**Camp Beagle**

**IN CLASS 25**

**AND**

**THE OPPOSITION THERETO**

**UNDER NO. 441379**

**BY PAULINE HODSON**

## BACKGROUND

1. On 12 March 2023, Christine Sanger ('the Applicant') applied to register the trade mark Camp Beagle ("the contested mark") in the UK. The application was published for opposition purposes on 24 March 2023 in respect of *T-shirts* Class 25.
2. On 19 June 2023, Pauline Hodson ("the Opponent"), filed a notice of opposition. The opposition was brought under Sections 5(2)(b) of the Trade Marks Act 1994 ("the Act") and was directed at all the goods in the application. The opponent relies upon its UK trade mark application number 3828994, which has a filing date of 13 September 2022<sup>1</sup>.
3. On 1 August 2023, the Tribunal served the TM7 on Ms Sanger by e-mail and recorded postal delivery. The deadline for Ms Sanger to file a form TM8 ("Notice of defence and counterstatement") was 02 October 2023, communicated by the Tribunal in the serving letter. The Tribunal's letter contained the following:

"If you wish to continue with your application, you need to file a notice of defence and counterstatement by completing Form TM8 - please note the important deadline below. You will find a blank Form TM8 on the IPO website, together with brief guidance on what happens after it is filed...

Rule 18(1) and 18(3) of the Trade Marks Rules 2008 require that you must file your notice of defence and counterstatement (Form TM8) within **two months** from the date of this letter. Alternatively, if both parties wish to negotiate to resolve the dispute, they may request a "cooling off period" by filing a Form TM9c, which will extend the 2 month period in which to file a Form TM8 by up to a further seven months. Form TM9c is also available on the IPO website (above). Please note both parties must agree to enter into cooling off.

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<sup>1</sup> Although the mark has not yet been registered, it is still an earlier mark by virtue of its earlier filing date, pursuant to section 6(2) of the Act.

**IMPORTANT DEADLINE: A completed Form TM8 (or Form TM9c) MUST be received on or before 02 October 2023.**

Rule 18(2) of the Trade Marks Rules 2008 states that “*where an applicant fails to file a Form TM8 within the relevant period, the application for registration, insofar as it relates to the goods and services in respect of which the opposition is directed, shall, unless the registrar otherwise directs, be treated as abandoned.*” **It is important to understand that if the deadline date is missed, then in almost all circumstances, the application will be treated as abandoned.**” (original emphasis)

4. Ms Sanger, who is unrepresented, did not file a TM8 by the deadline, however, on 10 October 2023, Ms Sanger asked for an update regarding the opposition. On 10 October 2023, the Tribunal wrote to Ms Sanger again. In the letter, the Tribunal stated that:

“The official letter dated 01 August 2023 provided notification of an admissible opposition and invited the applicant to file a TM8 and counterstatement on or before 02 October 2023.....

As no TM8 and counterstatement has been filed within the time period set, Rule 18(2) applies. Rule 18(2) states that the application:

“.....shall, unless the registrar otherwise directs, be treated as abandoned.”

The registry is minded to deem the application as abandoned 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, **24 October 2023**. 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 deem the application abandoned.”

5. On 18 October 2023, Ms Sanger filed a witness statement providing written reasons for the delay in filing a TM8 and counterstatement, as shown below. A TM8 was submitted alongside the witness statement.

“I sent an IPO online correspondence on 10.10.23 saying: “Hi - on the 3rd April 2023 you notified us that a third party intends to oppose the trademark application (TM7a). Did this individual ever actually file an opposition by the deadline of three months from the publication date of around 22nd March 23. If they did please may I have a copy and also instructions of what we must do next. Thank you Christine”

I spoke to Keiran Palmer on the same day who forwarded by email to me the TM7 dated 06.06.23, IPO letter dated 01.08.23 advising a completed Form TM8 (or Form TM9c) MUST be received on or before 02 October 2023 and also a letter dated 10 October 2023 giving me until 24th October 2023 to respond.

The reason the deadline was missed is I was unaware that the opponent had filed TM7 or that there was a deadline set of 2nd October. I have checked my emails and nothing was received.

The reason I thought to query was because I was putting together witness statements for an application the opponent has made. Trade Mark Number UK00003828994, opposition No. OP000438062, Applicant Pauline Hodson, Opposition Camp Beagle.

The fact in this witness statement are true to the best of my knowledge and belief.”

6. On 15 November 2023, the Tribunal wrote to Ms Sanger to acknowledge receipt of the witness statement and TM8. In the official letter the Tribunal stated that:

"I acknowledge receipt of your correspondence dated 18 October 2023, including:

- a Form TM8 (notice of defence and counterstatement)
- a witness statement providing information as to why the form was filed late and requesting that the registry admit the defence into the proceedings.

The Registry's letter dated 01 August 2023 emphasised that the deadline date for filing of a Form TM8 in these proceedings was 02 October 2023. The same letter also made clear that if the deadline date is missed at all, then in almost all circumstances, the application will be treated as abandoned. The letter was sent to the applicant by email and Royal Mail Special Delivery, under reference DS 7091 9427 1GB. This letter was confirmed to be delivered on 02 August 2023.

Trade mark appeal authorities have established that it is only in cases where there are "extenuating circumstances", or "compelling reasons" that the Registrar is able to exercise his discretion to admit into proceedings a Form TM8 filed outside the stipulated period. I draw your attention in particular to the appeal decisions in Kix: BL Number O/035/11 and Mercury: BL Number O/050/12, which provide further guidance on this type of issue. Those decisions can be found on the IPO website <https://www.ipo.gov.uk/t-challenge-decisionresults.htm>.

After careful consideration of the contents of the papers you have provided, it is the **preliminary view** of the Registrar that the reasons given are not sufficient to exercise his limited discretion and admit a late filed Form TM8 into these proceedings. Therefore **the Registrar's preliminary view is that this application is to be treated as abandoned.**

If you disagree with the preliminary view you **must** provide full written reasons and request a hearing on, or before **29 November 2023**. If no response is received within the time allowed, the preliminary view will automatically become final immediately after that date and the application will be confirmed as deemed abandoned.

Before requesting a hearing to challenge a preliminary view, you should bear in mind the following points:

- the deadline for filing a counter-statement on Form TM8 is not a flexible time limit (see Trade Mark Rule 77(6) and Schedule 1 to those rules);
- the legal constraints on the exercise of discretion by the Registrar in these circumstances; and
- that in the event that the hearing officer upholds the preliminary view, there may be costs implications arising from the hearing against the party who requested the hearing.

The above information is not intended to dissuade you from requesting a hearing, but merely to inform you of the potential consequences should you be unsuccessful in overturning the preliminary view”.

7. On 17 November 2023, the Tribunal received an email from Ms Sanger requesting a hearing. The email also expanded on the reason the deadline was missed by explaining that Ms Sanger’s husband had received and signed for the postal delivery, but it then become muddled with other post. Thus, Ms Sanger had not seen the letter and was unaware of the set deadline.

8. A hearing was scheduled for 3 January 2024, the details of which were sent by the Tribunal to both parties in an official letter dated 7 December 2023. Both parties confirmed attendance, and Ms Sanger and Ms Hodson filed written submissions before the hearing.

## **THE JOINT HEARING**

### **Representation**

9. The hearing took place before me, via Microsoft TEAMS telephone conference, on Wednesday 3 January 2024. Ms Sanger and Ms Hodson represented themselves at the hearing.

## **The written submissions**

10. Ms Hodson's written submissions consisted of four pages and included a timeline of events in the proceedings; submissions in relation to the missing of the TM8 deadline; and reference to and application of the relevant statutory guidance. Ms Hodson contended that no extenuating circumstances or compelling reasons were provided by the applicant and that the Tribunal's preliminary view to not admit the late-filed TM8 into the proceedings should be upheld. It concluded by requesting an award of costs made in favour of Ms Hodson.

11. Ms Sanger's written submissions consisted of three pages, in which Ms Sanger admitted that the letter was received by someone who signed for it on 2 August 2023 at the address to which it was sent, however, not by her. She denies that she was aware of the deadline to submit the defence, although admits that she should have made enquiries earlier to find out whether Ms Hodson had opposed her trade mark application. She also states that with hindsight it was a mistake to use the service address recorded as her husband runs a business from that address. Ms Sanger has since changed the address for service. Ms Sanger also states that if the late defence is not allowed and the application is treated as abandoned, she intends on filing a new application which will lead to further delay and costs for both parties.

## **Hearing discussion**

12. I explained to both parties that the purpose of the hearing was to consider whether the late filed defence should be admitted into the proceedings and not to discuss the merits of the substantive issues. I further confirmed that I had received written submissions from both Ms Sanger and Ms Hodson, and that I had read all the relevant documents to the case before me.

13. I asked Ms Sanger if there were any extenuating circumstances or compelling reasons that lead to her missing the deadline of 2<sup>nd</sup> October to file the form TM8 and counterstatement. Ms Sanger stated that she had not received the official letter of 2<sup>nd</sup> August 2023. She explained that her husband had received and signed for the letter, but he did not inform her of this. He had put the letter to one side, and she had not had

sight of it. She would not have missed the deadline had she been aware of it because the application is very important to her.

14. I asked Ms Hodson if she had any comments in response to Ms Sanger's comments, however, she had nothing more to add to her written submissions.

15. At the conclusion of the hearing, I reserved my decision to give me an opportunity to properly reflect on all the submissions put forward by the parties.

## **DECISION**

16. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by rule 18 of the Trade Marks Rules 2008 ("the Rules"). The relevant parts read as follows:

"18. (1) The applicant shall, within the relevant period, file a Form TM8, which shall include a counter-statement.

(2) Where the applicant fails to file a TM8 or counter-statement within the relevant period, the application for registration, insofar as it relates to the goods and services in respect of which the opposition is directed, shall, **unless the registrar otherwise directs**, be treated as abandoned."

17. The combined effect of rules 77(1), 77(5) and Schedule 1 of the Rules mean that the time limit in rule 18, which sets the period in which the defence must be filed, is non-extensible other than in the circumstances identified in Rule 77(5) which states:

"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.”

18. There is no suggestion that there has been any irregularity on the part of the Tribunal. Consequently, the only basis on which the applicant may be allowed to defend the opposition proceedings is if I exercise in its favour the discretion afforded to me by the use of the words “unless the registrar otherwise directs” in Rule 18(2).

19. In approaching the exercise of discretion in these circumstances, I take into account the decisions of the Appointed Person in *Kickz AG v Wicked Vision Limited* (BL O-035-11) and *Mark James Holland v Mercury Wealth Management Limited* (BL O-050-12), i.e. I must be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the applicant’s favour.

20. In *Music Choice Ltd’s Trade Mark* [2005] RPC 18, the Court indicated that a consideration of the following factors (shown below in bold and underlined) is likely to be of assistance in reaching a conclusion as to whether or not discretion should be exercised in favour of a party in default. That is the approach I intend to adopt, referring to the parties’ submissions to the extent that I consider it necessary to do so.

**The circumstances relating to the missing of the deadline including reasons why it was missed and the extent to which it was missed**

21. Ms Sanger’s explanation as to why the deadline was missed is summarised above, i.e., the official letter was delivered to the address to which it was sent and signed for by the applicant’s husband, however, he did not inform Ms Sanger of this. Ms Sanger is unable to explain what became of the letter after it had been received and was unaware of the deadline of 2<sup>nd</sup> October in which to submit the form TM8 and counterstatement. As noted above, the stipulated deadline for the filing of the applicant’s Form TM8 and counterstatement was **2 October 2023**. The form TM8 and counterstatement was filed by the Applicant on **18 October 2023**. Therefore, the deadline was missed by 16 days.

### **The nature of the opponent's allegations in its statement of grounds**

22. The opposition is brought under section 5(2)(b) of the Act. There is nothing to suggest that the opposition is without merit.

### **The consequences of treating the applicant as defending or not defending the opposition**

23. If Ms Sanger is permitted to defend the opposition, the proceedings will continue with the parties given an opportunity to file evidence and the matters will be determined on their merits. However, if Ms Sanger is not allowed to defend her application, it will be treated as abandoned and Ms Sanger's mark will lose its filing date of 12 March 2023. Nevertheless, it will remain open to Ms Sanger to re-file her application, which may, in turn, be opposed by Ms Hodson.

### **Any prejudice caused to the opponent by the delay**

24. No submissions were made by either party regarding prejudice to Ms Hodson. However, I note the inevitable costs and additional time associated with delays of this type.

### **Any other relevant considerations such as the existence of related proceedings between the parties**

25. There are related proceedings between the parties concerning an opposition to Ms Hodson's earlier pending application<sup>2</sup>. In that regard I note that should Ms Sanger be successful in the related proceedings then the earlier application relied upon by Ms Hodson would fall away. However, I consider that the admittance of the late filed TM8 and counterstatement should be determined on its own merits and not be prejudiced by the related proceedings.

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<sup>2</sup> This concerns opposition No 438062 where Ms Sanger has opposed Ms Hodson's earlier application No. 3828994 under sections 5(4)(a) and 3(6).

## **CONCLUSION**

26. In reaching my decision, I recognise that if the discretion is not exercised in Ms Sanger's favour, the application will be treated as abandoned and Ms Sanger will lose the filing date for her mark. I also recognise that Ms Sanger may elect to re-file the application which may again be opposed by Ms Hodson, resulting in further opposition proceedings in the future, with further cost implications. However, as the loss of priority and the possibility of further proceedings on much the same basis are often the consequences of failure to comply with the non-extendable deadline to file form TM8, these factors are not particularly compelling.

27. I acknowledge that Ms Sanger is unrepresented, and that the defence of a trade mark opposition may be somewhat confusing to those unfamiliar with the process. However, given the importance that Ms Sanger has attached to her application, I would have expected there to have been some system or procedure in place for checking and dealing with official correspondence. The serving letter was delivered to the address provided to the Registry by Ms Sanger. That letter was mislaid because the minimal degree of attention required to prevent that from happening did not happen. Even though Ms Sanger knew there was a risk of opposition by Ms Hodson, she did nothing to monitor the risk. Thus, I do not consider there to be any extenuating circumstances or compelling reasons sufficient to enable me to exercise my discretion under Rule 18(2) to admit the late filed TM8 and counterstatement into these proceedings.

## **OUTCOME**

28. The late form TM8 and counterstatement is not to be admitted into the proceedings. Accordingly, subject to any successful appeal, the application is treated as abandoned.

## **COSTS**

29. Given that the outcome of this decision has terminated the proceedings, the opponent is entitled to a contribution towards its costs. However, as Ms Hodson is not

professionally represented, as outlined in Tribunal Practice Notice (“TPN”) 1/2023, before I can assess these costs, I invite Ms Hodson to submit a pro forma giving details of the costs she has incurred. I therefore defer my decision on costs pending the submission of the pro forma.

**Dated this 18<sup>th</sup> day of January 2024**

**Lee Scott  
For the Registrar,  
the Comptroller-General**