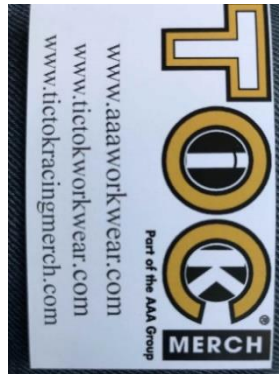


O/0116/24

TRADE MARKS ACT 1994

**IN THE MATTER OF
UK REGISTRATION NO. 3289631
IN THE NAME OF BRIAN FARMER IN
RESPECT OF THE TRADE MARK**



IN CLASS 25

AND

**THE LATE FILING OF FORM TM8(N) AND
COUNTERSTATEMENT
FILED IN DEFENCE OF THAT REGISTRATION IN
THE APPLICATION FOR REVOCATION
THEREOF
UNDER NO. 506461
BY OSBOURNE LINKS LTD**

BACKGROUND

1. Trade mark No. 3289631 for the trade mark shown on the cover page of this decision stands registered in the UK in the name of Brian Farmer (“the proprietor”). The application for registration was filed on 12 February 2018 and was registered on 20 July 2018, in respect of the following goods:

Class 25: Clothing; headgear.

2. On 29 August 2023, Osbourne Links Ltd filed form TM26(N) (“Application to revoke a registration [...] for reasons of non-use” and Statement of Grounds) on behalf of itself (“**the cancellation applicant**”) under the provisions of section 46(1)(a) of the Trade Marks Act 1994 (“the Act”). The application for revocation was filed in respect of all of the goods as registered.

3. On 4 September 2023, the Tribunal served the form TM26(N) by both email and by post upon the proprietor. The deadline for the proprietor to file its form TM8(N) was 6 November 2023, communicated by the Tribunal in the serving letter. The Tribunal’s letter contained the following:

“Please find enclosed a copy of a TM26(N) filed against your registration.

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

<https://www.gov.uk/government/publications/trade-mark-forms-and-fees/trade-mark-forms-and-fees>

Rule 38(3) of the Trade Marks Rules 2008 require that you must file your notice of defence and counterstatement (Form TM8(N)) within **two months** from the date of this letter.

IMPORTANT DEADLINE: A completed Form TM8(N) MUST be received on or before 06 November 2023.

Rule 38(3) and (4) allows you to file evidence of your use of the mark at the same time as your counterstatement. If you wish to do this your counterstatement must at Section 7 on the TM8(N) specify the goods/services that the mark has been used on, or in relation to. The evidence **must** be cross-referenced to specific exhibits e.g. the mark has been used on, or in relation to 'cutlery' as shown at Exhibit MR1.

You do not have to file evidence of use with your counterstatement. If you do not, a further opportunity of two months will be given for that evidence to be filed.

Rule 38(6) of the Trade Marks Rules 2008 states that **"Where the proprietor fails to file a Form TM8(N) within the period specified in paragraph (3) the registration of the mark shall, unless the registrar directs otherwise, be revoked."** It is important to understand that if the deadline date is missed, then in almost all circumstances, the registration will be treated as revoked in whole or part.

Please note that revocation is being sought under Sections 46(1)(a) of the Trade Marks Act 1994. The relevant five year period where non use is claimed are between **21 July 2018 – 20 July 2023** under Section 46(1)(a). The effective date of revocation if successful would be **21 July 2023**.

Before you decide whether to defend your registration, you may wish to refer to the guidance notes on revocation proceedings and the scale of costs which are available from the IPO website at <https://www.gov.uk/government/publications/trade-marks-revocation/revocation-non-use-proceedings>."

(Original emphasis)

5. On 30 October 2023, Mr Farmer emailed the Tribunal stating he was unable to find the TM8(N) form on the website and attaching evidence relating to the mark. In an official letter dated 2 November 2023, the Tribunal reminded the proprietor of the deadline. In the letter, the Tribunal stated that:

“I refer to the email dated 30 October 2023.

The official letter dated 04 September 2023 stated, **“a completed Form TM8(N) MUST be received on or before 06 November 2023.”**

Rule 38(3) of the Trade Marks Rules 2008 require that you **must** file your notice of defence and counterstatement (Form TM8(N)) within **two months** from the serving letter dated 04 September 2023.

A Form TM8(N) containing your counterstatement **must** be filed on or before **06 November 2023**.

Rule 38(6) of the Trade Marks Rules 2008 states that **“Where the proprietor fails to file a Form TM8(N) within the period specified in paragraph (3) the registration of the mark shall, unless the registrar directs otherwise, be revoked.”** It is important to understand that **if the deadline date is missed, then in almost all circumstances, the registration will be treated as revoked in whole or part.**

(original emphasis)

6. The proprietor, who is unrepresented, did not file a TM8(N) by the deadline, and so, on the 16 November 2023, the Tribunal wrote to the proprietor again (also sent by email and post). In the letter, the Tribunal stated that:

“The official letter dated 04 September 2023 informed you that if you wished to continue with your registration you should file TM8(N) and counterstatement on or before 06 November 2023.

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, **30 November 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 issue an undefended decision on the issue of failure to comply with the Rules governing the filing of a defence.”

(original emphasis)

7. On 19 November 2023, the proprietor filed Form TM8. In an official letter dated 1 December 2023, the Tribunal informed the proprietor that the incorrect form was used and stated:

“If you disagree with the preliminary view you **must** provide a completed TM8(N) form, full written reasons and request a hearing on, or before, **15 December 2023**. This must be accompanied by a Witness Statement setting out the reasons as to why the TM8(N) and counterstatement are being filed outside of the prescribed period.

The registry has only a limited discretion to allow a late filed Form TM8(N) and counterstatement into the proceedings. If you wish to continue to defend

the trademark you will need to file a witness statement that contains the details that you have provided as to why the form was filed late.”

(original emphasis)

8. On 4 December 2023, the proprietor filed a Form TM8(N) and witness statement. In his witness statement, Mr Farmer apologised for the late return of the form, he stated:

“Please accept my apologies in the late return of the TM8(N) form, I have been out of the country and working away. Gaynor Farmer, GAAARD Protection Product Manager, did respond before 6-11-2023 by email to the ribunalsection@ipo.go.uk email address. We had only received the letter **3 days** before the deadline.”

(original emphasis)

9. Having considered the reasons given for the late filing, on 19 December 2023, the Tribunal wrote to the proprietor to acknowledge receipt of the TM8(N) and witness statement. In the official letter, sent by email, the Registrar issued the preliminary view that the reasons given were insufficient to exercise its limited discretion and admit the late filed Form TM8(N) into these proceedings, and that therefore, the Registrar’s preliminary view was that this registration was to be treated as revoked. It allowed until 2 January 2024 for a hearing to be requested, should either party disagree with the preliminary view.

10. On 30 December 2023, the Tribunal received an email from Mr Farmer, challenging the preliminary view and requesting a hearing.

11. A hearing was scheduled for 30 January 2024, the details of which were sent by the Tribunal to both parties in an official letter dated 3 January 2024.

THE HEARING

12. The hearing took place before me, via Microsoft TEAMS telephone conference, on Tuesday 30 January 2024. The proprietor represented himself. Alaina Newnes of One Essex Court attended on behalf of Osbourne Links Ltd.

13. At the hearing, I clarified 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, and as such, I needed to establish if there were any extenuating circumstances for the late filing of Form TM8(N).

14. Mr Farmer submitted that the reason the Form TM8(N) was late, was that he only received correspondence of the deadline 3 days prior to the deadline and that he was out of the country. Mr Farmer submitted that he received all correspondence other than the official letter dated 4 September 2023.

15. I confirmed with Mr Farmer that his email and postal address remained the same. Mr Farmer submitted that he was out of the country for a few weeks in September in the French Pyrenees and had limited access to the internet. I enquired how Mr Farmer had been made aware that he was required to respond to the tribunal to send the email dated 30 October 2023. Mr Farmer stated that the email correspondence from the Tribunal must have come through when he returned from France.

16. In relation to the postal correspondence, Mr Farmer submitted that he did not receive the letter in September and that if it had been sent by recorded delivery, he may have received it and been able to deal with it swiftly. I informed Mr Farmer that the Tribunal had proof of delivery of official letters dated 4 September 2023 and 2 November 2023, which were sent via Special delivery by 1pm and which were signed for by *'Farmer'*.

17. Ms. Newnes began by submitting that the preliminary view of the Registry was correct as the proprietor had not provided compelling reasons as to why the time limit could not be observed and that the reasons that it had provided did not constitute extenuating circumstances. As also referred to in the skeleton arguments,

Ms. Newnes mentioned the decisions of the Appointed Persons in *Mercury Trade Mark*, Case BL O-050-12 and *Kickz Trade Mark*, Case BL O-035-11, outlining that the discretion conferred by Rule 18(2) is a narrow one which may only be exercised in extenuating circumstances.

18. Ms. Newnes continued by summarising the proprietor's reasons that the deadline was missed; that he was working out of the country and "*only received the letter 3 days before the deadline*". She stated that the proprietor did receive the letter of 4 September 2023, more than 3 days before the deadline, as he responded to the correspondence on 30 October 2023, a week before the deadline for filing the TM8(N) and counterstatement. Consequently, Ms. Newnes stated that the proprietor was aware before the deadline of the need to meet the deadline and the subsequent consequences of failing to do so, as he was notified by the registry in its letters of 4 September and 2 November 2023. She stated that there was no ambiguity in the letters. She added that, as stated by the Appointed Person in *BOSCO Trade Mark*, Case O-399-15, litigants in person must still follow the rules, and that having no previous experience of legal proceedings was not a good reason for failing to comply with the rules.

19. Ms. Newnes stated the cancellation applicant's case for upholding the preliminary view by going through the criteria outlined in *Music Choice Ltd's Trade Mark* [2005] RPC 18. I will include her comments to the extent I consider necessary at this juncture, and I will further refer to the factors for consideration outlined in *Music Choice* later in this decision.

20. Ms. Newnes concluded by reiterating that there were no compelling reasons or extenuating circumstances which would justify the application of the Registrar's discretion, and therefore, the cancellation applicant requested that the preliminary view be upheld and the registration be revoked. She also made a request for an award of costs in the cancellation applicant's favour on the usual scale.

21. In response, Mr Farmer confirmed that he travelled by motorhome and ferry to France. Further, he reiterated that connection in the Pyrenees was poor and that he is a litigant in person with limited experience. Finally, he confirmed that he must

have seen the email from the Tribunal, dated 4 September 2024, when he returned to the UK.

22. At this stage, the hearing was concluded. I confirmed that I would reserve my judgment and that my decision would be issued in writing via email in due course. Regarding costs, I explained that the successful party would be entitled to contributory costs.

DECISION

23. The filing of a Form TM8(N) and counterstatement in revocation proceedings is governed by Rule 38 of the Trade Marks Rules 2008 (“the Rules”). The relevant parts read as follows:

“38.

...

(3) The proprietor shall, within two months of the date on which he was sent a copy of Form TM26(N) by the registrar, file a Form TM8(N), which shall include a counter-statement.

...

(6) Where the proprietor fails to file a Form TM8(N) within the period specified in paragraph (3) the registration of the mark shall, **unless the registrar directs otherwise**, be revoked.

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”

24. The combined effect of Rules 77(1), 77(5) and Schedule 1 of the Rules mean that the time limit in Rule 38, 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.”

25. Whilst there was a suggestion that there has been an irregularity on the part of the Tribunal in not sending the correspondence until 3 days before the deadline, the CMC has indicated that the correspondence was sent with good time. Consequently, the only basis on which the proprietor may be allowed to defend the revocation proceedings is if I exercise in its favour the discretion afforded to me by the use of the words “*unless the registrar directs otherwise*” in Rule 38(6).

26. In approaching the exercise of discretion in these circumstances, and as referred to by Ms. Newnes in her skeleton arguments and submissions at the hearing, 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 have to be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the proprietor’s favour.

27. 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:

28. As noted above, the stipulated deadline for the filing of the proprietor's Form TM8(N) and counterstatement was 6 November 2024. Mr Farmer filed a TM8 and evidence, rather than the required TM8(N) form on 19 November 23, which was deemed inadmissible. The Form TM8(N) and counterstatement were filed by the proprietor on 04 December 2023. Therefore, the deadline was missed by 28 days. The proprietor's explanation as to why the deadline was missed was that they did not receive the correspondence until 3 days before the deadline and that they were out of the country.

29. At the CMC, Ms. Newnes submitted that the letter dated 4 September 2023 did reach the proprietor more than 3 days ahead of the deadline, as he responded to the Tribunal on 30 October 2023. The proprietor was aware earlier than stated that there was a need to comply with the requirements and consequences of failing to do so.

The nature of the cancellation applicant's allegations in its statement of grounds

30. The application to revoke the registration for reasons of non-use is brought under section 46(1)(a) of the Act. Whilst it is not for the present hearing to determine the merits of the case, there is nothing to suggest that the application is without merit.

The consequences of treating the registered proprietor as defending or not defending the opposition:

31. If the proprietor is permitted to defend the application for revocation, the proceedings will continue, with the parties given an opportunity to file evidence. The matters will be determined on their merits, should the aforementioned negotiations not be completed in the meantime, and the application for revocation not be

withdrawn. However, if the proprietor is not allowed to defend the application, it will lose its registration.

Any prejudice caused to the cancellation applicant by the delay:

32. At the hearing, Ms. Newnes submitted that the cancellation applicant had faced uncertainty in relation to this registration. I also note the inevitable costs associated with delays of this type.

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

33. There are no related proceedings between the parties.

Considerations

34. I note that the reasons provided by Mr Farmer, as to why the deadline was missed was that he was out of the country and he did not receive the correspondence until 3 days before the deadline. At the hearing, Mr Farmer confirmed that his email and postal address remained the same and he initially submitted that he received all correspondence other than the initial letter dated 4 September 2023.

35. I note that Mr Farmer admitted that correspondence dated 4 September 2023 must have been received when he returned to the UK. He admitted sight of the email in October which prompted the email that Mr Farmer stated was submitted by Gaynor Farmer through to the Tribunal dated 30 October 2023. It was the receipt of this email that prompted the Tribunal to send through additional correspondence dated 2 November 2023 to confirm the deadline and requirements to Mr Farmer. Further, as I mentioned at the CMC, the Tribunal has evidence that both the letters dated 4 September and 2 November 2023 were received and signed for at Mr Farmer's postal address, by '*Farmer*'. Therefore, I do not consider that the correspondence was received by Mr Farmer only 3 days before the

deadline. I note that even if Mr Farmer did not personally receive the correspondence by post, it was correctly send to the recorded address for service.

36. At the hearing, Ms. Newnes maintained that there were no compelling reasons or extenuating circumstances which would justify the application of the Registrar's discretion, and requested that the preliminary view of the Registrar to refuse to admit the TM8(N) and counterstatement be upheld, and the registration revoked from the earliest effective date.

37. In the official letter dated 4 September 2023 and reiterated on 2 November 2023, the Tribunal made it very clear that failure to file a form TM8(N) by the deadline would, in almost all circumstances, result in the registration being treated as revoked. I accept that the proprietor was unrepresented at the UKIPO during these proceedings and have taken this into consideration. Further, as referred to by Ms. Newnes at the hearing, I consider that the proprietor was fully aware of the deadline: Mr Farmer, firstly, at the CMC confirmed receipt of the letter dated 4 September 2023 which he responded to via email on 30 October 2023. Secondly, the Tribunal has confirmation of delivery to Mr Farmer's postal address. I therefore have no reason to believe that the letter was not received in a timely manner.

38. In reaching my decision, I recognise that if the discretion is not exercised in the proprietor's favour, the registration will be revoked. However, as the loss of the registration is often the consequence of a failure to comply with the non-extendable deadline to file form TM8(N), this factor is not particularly compelling.

39. Having considered the proprietor's reasons for its failure to file a TM8(N) by the deadline given, I find no single reason or combination of reasons sufficient to constitute extenuating circumstances or compelling reasons to enable me to exercise my (limited) discretion under Rule 38(6) to admit the late-filed TM8(N) and counterstatement into these proceedings.

OUTCOME

40. The late form TM8(N) and counterstatement is not to be admitted into the proceedings. Subject to any appeal, the proprietor will be treated as

not opposing the application for revocation and the registration will be revoked in full under section 46(1)(a) of the Act with effect from 21 July 2023.

COSTS

41. Given that the outcome of this decision has terminated the proceedings, the cancellation applicant is entitled to a contribution towards its costs, based on the scale published in the TPN (Tribunal Practice Notice) 1/2023. Applying the TPN as a guide, I assess costs as follows:

Official fee:	£200
Preparing the statement of case:	£250
Preparing for and attending the hearing, including filing skeleton arguments:	£300
Total:	£700

42. I therefore order Mr Brian Farmer to pay Osbourne Links Ltd the sum of £750. This 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 14th day of February 2024

Akira Klass
For the Registrar,
the Comptroller-General