

O/0309/25

TRADE MARKS ACT 1994

**IN THE MATTER OF
REGISTRATION NO. UK00003863499
BY HIVE GROUP LTD
TO REGISTER:**

HIVE

**AS A TRADE MARK
IN CLASSES 9, 16, 35, 36, 41, 42 AND 45**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 441143
BY BUMBLE HOLDING LIMITED**

1. On 30 December 2022, HIVVE GROUP LTD (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The applicant applied to register the mark for goods in classes 9, 16, 35, 36, 41, 42 and 45 which can be seen in the **Annex** to this decision.

2. The applicant’s mark was published for opposition purposes on 3 March 2023. The opposition period ended on 3 May 2023. On 3 May 2023, Pinsent Masons filed a Form TM7a (notice of threatened opposition) on behalf of Bumble Holding Limited (“the opponent”). The deadline for the filing of the Form TM7 (notice of opposition and statement of grounds) was therefore extended to 3 June 2023.

3. On 2 June 2023, the opponent filed the Form TM7. A request for a cooling off period (Form TM9C,) followed by a request for an extension of the cooling off period (Form TM9E), were filed on 11 August 2023 and 25 March 2024, respectively; both of which were granted. According to Rule 18(5) of the Trade Mark Rules 2008, no further extension to the cooling off period was to be allowed and the deadline for the Form TM8 (notice of defence and counterstatement) and counterstatement was to be filed on or before 30 December 2024. The parties filed a suspension request on 20 December 2024. On 27 December 2024, the applicant responded to a query concerning its Form TM21B limitation. The Form TM8 and counterstatement were not received on the deadline of 30 December 2024. On 6 January 2025, the Registry wrote to the parties stating that the joint stay request could not be considered until the Form TM8 had been admitted into the proceedings.

4. On 6 January 2025, the Form TM8, counterstatement and a suspension request were filed. In the email accompanying the Form TM8 and counterstatement, the opponent stated that it was believed that the suspension request, which was received by the Registry on 20 December, would have been granted and the proceedings suspended. Resulting in a Form TM8 deadline was therefore not active.

5. On 21 January 2025, in an official letter, sent to both parties, the Registry stated:

“Dear Recipient,

Thank you for your email dated 17 January 2025 in which you submitted a late filed Form TM8 and counterstatement together with a witness statement of Louisa Fielding.

The case has been given consideration and it is the Tribunal's preliminary view that, although a Form TM8 and counterstatement has now been submitted, it cannot be admitted into the proceedings as it was received outside of the prescribed non-extendable period.

The Tribunal has considered your reasons as to why the deadline for filing the defence was missed, your request is refused as there appears to be no 'compelling reasons' or 'extenuating circumstances' that would permit the exercise of the Tribunal's very limited discretion.

You are referred to the following decisions of the Appointed Persons in this regard: Kickz AG and Wicked Vision Limited (BL-O-035/11) and Mark James Holland and Mercury Wealth Management Limited (BL-O-050/12). Copies of these decisions can be found on the IPO website at: <http://www.ipo.gov.uk/tm/t-decisionmaking/t-challenge/t-challenge-decisionresults.htm>

As a consequence of the above, it is therefore considered that there are no grounds on which to allow the exercise of the Tribunal's discretion in this case. In accordance with paragraph 10 of Tribunal Practice 2/2011, if either party disagrees with the preliminary view, they should provide full written reasons and request a hearing on, or before **04 February 2025**.

A hearing can be requested to challenge the preliminary view. However, 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 Tribunal 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. If no response is received within the time allowed, the preliminary view will automatically be confirmed.” [Original emphasis].

6. In an email dated 27 January 2025, the applicant disagreed with the preliminary view and requested a hearing.

THE JOINT HEARING

Representation

7. The joint hearing took place before me, by telephone, on 25 February 2025. Both parties attended. Ms Louise Fielding, of London IP, attended on behalf of the applicant. Mr Jack Richards, of Pinsent Masons LLP, attended on behalf of the opponent.

Hearing discussion

8. At the hearing, I asked Ms Fielding to explain why the TM8 was late. Ms Fielding submitted that it was late because she held the view that as soon as the suspension request was received it would be in place and that the TM8 deadline would no longer apply. She stated that there was a clear intention to submit the TM8 on time and the view was that the opposition should be allowed.

9. I clarified to Ms Fielding that filing a suspension request does not mean that it has or would be granted. Rather, the suspension request cannot be held to have been granted until confirmation has been received by the parties. Further, I stated that it would be risky to have presumed otherwise, especially given the time of year that the request was put in, when many offices close or operate at a slower rate over the festive period. In addition, I stated that, given the time of year, the request may not have even been picked up before the TM8 deadline was passed (as was the case here).

10. Further, I note that the parties sent through the stay request on 20 December 2024 and then chased on 30 December 2024. I stated that it did not align with me that the applicant would have chased a suspension request on 30 December 2024 if it had presumed that it had already been granted.

11. I enquired as to whether there was a reason why, after chasing the stay request on 30 December 2025 (and receiving no response to the affirmative), alongside the knowledge that the deadline to file the TM8 was the 30 December 2024, Ms Fielding did not file a TM8 to protect her client's interests. I stated that this would have been the reasonable thing to have done in the circumstances. Ms Fielding stated that there was no real explanation as to why she failed to do this. She stated that internally she queried whether a TM8 should be filed but she ultimately did not file the TM8 and made a mistake.

12. Ms Fielding stated that the parties were in discussions and attempting to settle the proceedings by filing a form TM21B to amend the applicant's specification. I drew the applicant's attention to the fact that the TPN 1/2024 clearly states that non extendable TM8 deadlines are not affected by settlement negotiations. Therefore, the deadline still applied.

13. Mr Richards had little to add to the submissions made by Ms Fielding. However, he did state that the opponent supports the late filing of the Form TM8. He went on to say that, given that the settlements are close to the end, the opponent has no interest in the other side incurring further costs or the risk of the settlement potentially breaking

down. Despite this, it was acknowledged that the discretion was mine alone to decide whether to allow the late filed Form TM8.

14. Turning to the issue of costs, I asked both parties for their submissions in relation to costs. Both parties stated that, as parties were working towards a settlement, they had decided that both parties would be bearing their own costs.

15. At the end of the hearing, I reserved my decision to give me an opportunity to reflect on the additional information provided by Ms Fielding.

DECISION

Statutory provisions

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.

(3) Unless either paragraph (4), (5) or (6) applies, the relevant period is the period of two months beginning immediately after the notification date.

(4) This paragraph applies where—

(a) the applicant and the person opposing the registration agree to an extension of time for the filing of Form TM8;

(b) within the period of two months beginning immediately after the notification date, either party files Form TM9C requesting an extension of time for the filing of Form TM8; and

(c) during the period beginning on the date Form TM9C was filed and ending nine months after the notification date, no notice to continue on Form TM9t is filed by the person opposing the registration and no request for a further extension of time for the filing of Form TM8 is filed on Form TM9e,

and where this paragraph applies the relevant period is the period of nine months beginning immediately after the notification date.”

17. The combined effect of rules 77(1), 77(5) and Schedule 1 of the Rules means 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 that has caused the Form TM8 to be filed late. The applicant’s representative has submitted that it was late because she held the view that as soon as the suspension request was received it would be in place and that the TM8 deadline would no longer apply. 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 have to 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 (underlined below) 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. The Form TM8 was due by 30 December 2024, it was received by the Tribunal on 6 January 2025. Therefore, the deadline was missed by six days. The applicant’s explanation as to why the deadline was missed was that the applicant’s representative held the view that as soon as the suspension request was received by the office it would be in place and that the TM8 deadline would no longer apply. The applicant’s representative stated that internally she queried whether a TM8 should be filed but she ultimately did not file the TM8 and made a mistake.

22. The opponent stated it supported the applicant’s view that the Form TM8 filed late by the applicant should be accepted. This is on the basis that the settlements that are in progress are close to reaching their conclusion and that there is no interest in the parties incurring further costs or the risk that settlement progression could break down.

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

23. The opponent relied upon grounds under sections 5(2)(b) and 5(3) of the Act. Whilst it is not for the present decision to determine the merits of the case, for the purpose of the criteria under consideration it is sufficient to note that there is an arguable case to be determined.

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

24. If the applicant is allowed to defend the opposition, the proceedings will continue with the parties being given the opportunity to file evidence and the matter will be determined on its merits.

25. However, if the applicant is not allowed to defend the opposition, the application will be deemed abandoned, and the applicant's mark will lose its filing date of 30 December 2022. It will also remain open to the applicant to re-file its application which may, in turn, be opposed again by the opponent.

Any prejudice caused to the opponent by the delay

26. The opponent does not submit that there is prejudice due to the delay in proceedings, as the deadline was only missed by 6 days. Despite this, I do consider that, due to the delay in filing the Form TM8, there has been an unnecessary delay in the progress of the case and additional costs would have been incurred, due to the time taken to prepare for and hold this joint hearing.

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

27. I am aware that there is a related opposition, 448420.

CONCLUSIONS

28. Having addressed each of the relevant factors as proposed in *Music Choice*, I must now decide whether the applicant's submissions disclose extenuating circumstances or compelling reasons to enable me to exercise the discretion to admit the late filed TM8 and counterstatement.

29. In reaching my decision, I recognise that if the discretion is not exercised in the applicant's favour, the application will be treated as abandoned and the applicant will lose its filing date for its mark. Further, I recognise that it may be that the applicant will simply re-file its application and that this may, once again, be opposed by the opponent resulting in further opposition proceedings arising at some point in the future. However, as the loss of priority and possibility of further proceedings on much the same basis are often the consequences of a failure to comply with the non-extendable deadline to file Form TM8s, these are not factors that are particularly compelling. In my view, to regard the mere prospect of another application as a strong consideration would significantly undermine the prescriptive nature of the timeframes under the rules for filing a Form TM8. Further, whilst repeated proceedings, which I accept may be likely in this case, are, in my view, regrettable on the account of wasted cost and efforts of the parties, not to mention the further strain on the Registry's resources, I must consider the specific circumstances at hand.

30. Although I can sympathise with the applicant's failure to file a TM8 on time, I have not been given sufficient reason to excuse it. In relation to the tenability of the human error argument (albeit on the application of Rule 41(6) in relation to an invalidity application), I note that this was considered by Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *TESCON Trade Mark* [2020] FSR 33; BL O/240/20, as follows:

"32. I readily accept that human error is not necessarily inconsistent with the existence of extenuating circumstances or compelling reasons for permitting invalidity proceedings to be defended in the exercise of the discretion conferred

by rule 41(6). I would, for example, regard it as appropriate for the discretion to be exercised in favour of permitting a claim for invalidity to be defended in circumstances where it was clearly established that the failure to comply with a filing deadline of (say) 12 February 2020 was the result of an unnoticed keystroke error which caused the due date to be incorrectly entered in an otherwise reliable record-keeping system as (say) 21 February 2020. It is nonetheless clear that the test to be applied cannot be taken to permit or require all human errors to be treated as excusable for the purposes of rule 41(6). There must, in other words, be a fact-specific evaluation for the purpose of determining whether the particular error in question should or should not be treated as excusable in the circumstances of the case at hand.

33. This is the point at which the Proprietor's request for relief under rule 41(6) ran into difficulty. The general tenor of the representations made on its behalf was that its attorneys had taken reasonable and proper steps to ensure that the required Form TM8 and Counterstatement were filed before expiry of the specified deadline, but were inadvertently deflected from doing so until after the deadline had expired. However, the Registrar was presented with assertions rather than evidence and materials of sufficient clarity and precision to substantiate that or any proposition to the like effect. In the end, as emphasised in the Respondent's Notice, the Hearing Officer was left with no satisfactory explanation for the default which had occurred."

31. Therefore, for similar reasons, I do not accept that the reasons for the applicant's failure to comply with the procedure for filing the Form TM8 was due to an extenuating human error nor that this argument has any foundation given the circumstances surrounding the failure to satisfy the procedural requirement.

32. In reaching a decision, I have taken all the above matters into account, including the overriding objective (which is to ensure fairness to both parties) to deal with this case expeditiously and justly. I have found no single reason or combination of reasons

sufficient to enable me to admit the Form TM8 and counterstatement into these proceedings. The applicant has failed to fulfil the procedural requirement (one it was entirely familiar with) and did not provide sufficient or cogent evidence to demonstrate that it had made a real attempt to file the Form TM8 in accordance with the Rules (within the deadline).

33. In all the circumstances I find that the applicant has failed to show any compelling reason to justify its deviation from the rules and consider that the strict adherence to the procedural requirement outweighs the applicant's interest in having the matter determined via these opposition proceedings.

OUTCOME

34. After careful consideration of the parties' oral and written submissions, and bearing in mind the case law cited above, my decision is not to exercise the discretion in favour of the applicant. Subject to appeal, I uphold the Registry's preliminary view that the Form TM8 is not to be admitted into proceedings. Therefore, the opposition will be considered undefended.

COSTS

35. As my decision terminates the proceedings, I must consider the matter of costs. The opponent has been successful and is entitled to a contribution towards its costs. However, it was confirmed by both parties at the CMC that as part of the settlement proceedings being undertaken by the parties, they intend to bear their own costs. There is therefore no order for costs.

Dated this 1st day of April 2025

A Klass

For the Registrar

Annex

Class 9: Computer software; mobile application software; computer software for use as an application programming interface (API); computer software to enable searching of data; recorded media; software downloadable from the Internet; downloadable electronic publications; all of the aforementioned goods relating to the collection, management and analysis of information relating to the social, environmental and economic impact of businesses and organizations, and the benchmarking and monitoring of social, environmental and economic performance of businesses and organizations; none of the aforesaid in relation to the management, control, optimisation or efficiency of energy and energy consumption.

Class 16: Paper, cardboard; printed matter; publications in the form of printed matter; all of the aforementioned goods relating to the collection, management and analysis of information relating to the social, environmental and economic impact of businesses and organizations, and the benchmarking and monitoring of social, environmental and economic performance of businesses and organizations.

Class 35: Business research services; analysis of business information; business consultancy and advisory services; business strategy services; preparation and provision of business reports; market research services; market surveillance; provision of business and commercial information; provision of business information on public and private companies; systemization of information in to computer databases; computer databases (compilation of information into -); all of the aforementioned services relating to the collection, management and analysis of information relating to the social, environmental and economic impact of businesses and organizations, and the benchmarking and monitoring of social, environmental and economic performance of businesses and organizations; research and analysis of the social, environmental and economic impact of businesses and organizations; provision of information relating to the social, environmental and economic impact of businesses and organizations; benchmarking services; business auditing services; provision of marketplaces for goods/services; organization, operation and supervision of loyalty

and incentive schemes; provision of advice, information and consultancy in relation to the aforementioned services; none of the aforesaid in relation to the management, control, optimisation or efficiency of energy and energy consumption.

Class 36: Provision of prepaid cards and tokens; issue and redemption of tokens of value; crowdfunding; fund raising services via crowdfunding website; crowdfunding services in the nature of providing financing from money collected from individuals; cryptocurrency services, namely, providing a digital currency or digital token for use by members of an on-line community via a global computer network; cryptocurrency services, namely, a digital currency or digital token, incorporating cryptographic protocols, used to operate and build applications and distributed ledger technology on a decentralized computer platform and as a method of payment for goods and services; issuing of tokens of value ; issuing of tokens of value in relation to incentive schemes; provision of advice, information and consultancy in relation to the aforementioned services.

Class 41: Education; providing of training; the provision of non-downloadable on-line electronic publications; hosting of exhibitions, conferences and seminars and networking events for business, cultural and educational purposes; organizing and conducting online educational and training events including virtual meetings and seminars; all of the aforementioned services relating to the collection, management and analysis of information relating to the social, environmental and economic impact of businesses and organizations, and the benchmarking and monitoring of social, environmental and economic performance of businesses and organizations; provision of advice, information and consultancy in relation to the aforementioned services.

Class 42: Providing online non-downloadable software for data collection, management and analysis; leasing or providing access to computer software for use by third parties; leasing or providing access to computer software for the collection, management and analysis of information via computer systems and computer networks; update, maintenance and installation of computer software, computer

consultancy services; software development, programming and implementation; providing user authentication services using single sign-on technology for online software applications; design of software for multimedia data storing and recalling; providing access to software via computer networks; all of the aforementioned services relating to the collection, management and analysis of information relating to the social, environmental and economic impact of businesses and organizations, and the benchmarking and monitoring of social, environmental and economic performance of businesses and organizations; provision of advice, information and consultancy in relation to the aforementioned services; none of the aforesaid in relation to the management, control, optimisation or efficiency of energy and energy consumption.

Class 45: Online social networking services; online social networking services in the fields of business, and business compliance; online social networking services relating to the social, environmental and economic impact of businesses and organizations; regulatory compliance auditing; legal services relating to the management, control and granting of licence rights; granting of software licenses; provision of advice, information and consultancy in relation to the aforementioned services.