

O/0355/25

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3953143
IN THE NAME OF DELTAFLARE LIMITED
FOR THE FOLLOWING SERIES OF MARKS:**



IN CLASS 9

AND

**THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT
FILED IN DEFENCE OF OPPOSITION PROCEEDINGS UNDER NO. 445400
BY PHOENIX SOFTWARE INTERNATIONAL, INC**

Background

1. Deltaflare Limited (“the applicant”) applied to register the UK trade mark displayed on the cover page of this decision, under registration number 3953143 (“the contested mark”). The applicant’s mark was filed on 5 September 2023 and published for opposition purposes in the trade mark journal on 27 October 2023. The application is to register goods in class 9.

2. On 22 January 2024, Phoenix Software International, Inc (“the opponent”) opposed the application under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The opposition is targeted at all of the goods of the contested mark’s specification.

3. On 6 February 2024, the Tribunal served the Form TM7 on the applicant, by post and by email. In accordance with rule 18 of the Trade Mark Rules 2008 (“the Rules”), the applicant was informed that it had two months from the date of the official letter in which to file its Form TM8 and counterstatement. The relevant paragraphs of the letter are as follows:

“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.

IMPORTANT DEADLINE: A completed Form TM8 (or Form TM9c) MUST be received on or before 04 April 2024.

*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. The opponent with the consent of the applicant filed a Form TM9c by the prescribed deadline of 4 April 2024. Consequently, on 16 April 2024 the Tribunal wrote to the parties stating:

“I refer to the TM9c dated 4th April 2024 indicating that the parties wish to enter into a cooling off period.

*In accordance with Rule 18(4) of the Trade Marks Rules 2008, this period will expire on **6th November 2024.***

*The Registrar, may on request, extend the cooling off period for a further nine months where such request is filed on TM9e and with the agreement of both parties. Please note that the TM9e should be received on or before **6th November 2024.***

*If no such request is made, the TM8 and counter-statement should be filed on or before **6th November 2024** or the application shall, unless the Registrar otherwise directs, be treated as abandoned in whole or part, in accordance with Rule 18(2) of the Trade Marks Rules 2008.*

If the opponent wishes at any time to terminate the cooling off period they should submit a TM9t. The applicant can terminate the cooling off period at any time by filing the TM8 and counterstatement.” (Original emphasis)

5. On 5 November 2024, at 5pm, the applicant wrote to the Tribunal stating:

“The Applicant hereby would like to provide notice of their intention to sever the TM9c cooling off period as agreed between the parties and formally notifies the UKIPO Tribunal Section of their intention to file a TM8 in light of the Opponent's

TM7 that was [filed on] 22 January 2024 and subsequently acknowledged by the UKIPO Tribunal Section on 6 February 2024.

The Applicant would be grateful for a revised deadline in relation to the filing of their TM8 counter statement in response to the above-mentioned opposition filing.”

6. However, the deadline for filing the Form TM8 is a non-extendable deadline. Consequently, the Tribunal wrote to the applicant on 25 November 2024, with the following:

*“The official letter dated **16 April 2024** invited the applicant to file a TM8 and counterstatement on or before **06 November 2024**.*

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, **09 December 2024**. 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.”*
(Original emphasis).

7. On 6 December 2024, the applicant filed a Form TM8 and witness statement from the applicant’s representative, Muhammad Abbas Abdulla, dated the same. The witness statement sets out a chronology of interactions between the applicant, its representative, and the opponent’s representative; it also sets out its reasons for missing the prescribed deadline. The pertinent paragraphs are as follows:

“As you can see, the Applicant has tried umpteen times to correspond as much and as quickly as possible with the Opponent, and in turn was not aware that the TM9C would originally lapse on 6 November to which the TM8 should have been filed.

Given that the Applicant has tried its best to correspond with the Opponent and feels as though the Opponent may have purposely pushed and not corresponded with the Applicant in order to push them over the line of the cooling off period without any notice of an extension of the cooling off period or agreeing a stay in proceedings, the Applicant hereby asks the Tribunal Section for leniency to be granted and the TM8 to be accepted by the Tribunal Section in order for the opposition proceedings to continue into the evidence rounds.”

8. On 16 January 2025, the Tribunal referred the applicant to *Kickz AG and Wicked Vision Limited* (BL-O-035/11) and *Holland and Mercury Wealth Management Limited* (BL-O-050/12), and informed the parties of the following:

“I acknowledge receipt of your email dated 6 December 2024, which also included a Witness Statement of Muhammad Abbas Abdulla.

Upon a review of the proceedings, including taking the content of the Witness Statement into consideration, it is the preliminary view of the Registry to refuse the discretion to allow the late filing of a Form TM8 and counterstatement or Form TM9c into the proceedings.

*When considering the request to admit the late filed TM8 the Registrar has taken account of the guidance provided by the Appointed Person in *Kix* (BL-O-035-11) and *Mercury* (BL-O-050/12) which indicate that the Registrar can only exercise its discretion and admit a late filed TM8 where there are ‘extenuating circumstances’ and ‘compelling reasons’ to do so.*

The circumstances in this case do not provide sufficient reasoning to allow a retrospective extension of time to file a Form TM8 and counterstatement. In the

absence of any procedural irregularity identified on the part of the Registrar, there exists no grounds on which to exercise any discretion.

*If either party disagrees with the preliminary view given, they should request a hearing within 14 days of this letter, which is on or before **30 January 2025.**"*
(Original emphasis)

9. On the same date, the applicant requested a hearing on the matter and consequently, a procedural hearing was set for 3 February 2025, to discuss the matter of the late filed defence.

10. Prior to the hearing both sides filed skeleton arguments.

The hearing

11. A joint hearing took place before me by video conference on 3 February 2025. At the hearing, Mr Abbas appeared for the applicant and Ms Pang appeared for the opponent. Both parties filed skeleton arguments in advance of the hearing. It is important to note that new information was divulged within the applicant's skeleton argument, namely that the applicant suffered a bereavement in late October 2024 and was not able to engage in the proceedings due to the gravity of the bereavement.¹ The skeleton argument explained the bereavement was not included in the original witness statement due to the personal sensitivity and ongoing issues with the applicant.²

12. At the hearing, Mr Abbas expanded on both his witness statement and skeleton argument, and confirmed the following:

- He was instructed some time in mid to late September 2024, although he was unable to confirm the exact date. Nevertheless, he accepted that it was prior to 30 September when he first corresponded with the opponent's representative on the applicant's behalf.

¹ Applicant's skeleton argument, paragraph 9

² Ibid, paragraph 10

- The applicant suffered a bereavement in about mid to late October, the bereavement was of a close family member who lived in Iran so the applicant was out of the country attending to family from about mid October to mid December, during which time it was difficult to get instructions from the applicant.
- Mr Abbas did not know that the deadline for filing the Form TM8 was 6 November 2024. He asserted that as he was not instructed previously, he did not have a copy of the letter sent from the Tribunal to the applicant which set out the deadline for filing the Form TM8 and counterstatement following the cooling off period.
- Following a period of trying to negotiate with the opponent, which was unsuccessful, on 5 November 2024, the applicant instructed Mr Abbas to sever the cooling off period and file the Form TM8. However, Mr Abbas believed that after the cooling off period there was still another 4 weeks to file the Form TM8 and counterstatement, although no clear reasoning was given as to why this belief was held.
- Mr Abbas also raised the point that there had been an issue trying to get the Form TM33³ transposed so that he could be on the record as acting for the applicant. He explained that he rang up a number of times to try and resolve this and that at times there had been delays with the 'Forms section' for formal documents such as the Form TM33. I asked for the date on which he had initially sent the Form TM33. However, Mr Abbas did not have that information to hand, therefore, I allowed him to finish his submissions and afforded the opportunity to find the date(s) which he had sent in the Form TM33 during Ms Pang's submissions, so that I could address this matter. Despite being allowed time to find this information, he claimed the search function on his emails was 'not the best' so he was unable to find the original email but confirmed that he had sent an email prior to one marked urgent on 25 November 2024.

³ Which is for the appointment or change of representative.

- Mr Abbas relied on a case he referred to as “Mercury Wealth”, for which he did not have a BL number nor any other information, but which I understand to be the commonly referred to case in proceedings such as these under *Mercury Wealth Management Limited* (BL/O/050/12). It was asserted that in that case the deadline was missed by three months and discretion was still granted. However, those are not the facts of that case. In that case, the hearing officer did not exercise discretion to extend the non-extensible deadline, a decision which was upheld by the Appointed Person on appeal.
- Mr Abbas requested that as there were compelling and extenuating circumstances in this case that discretion to extend the deadline should be exercised.
- In relation to costs Mr Abbas stated that his client was happy for the parties to bear their own costs in relation to this matter, but that if the proceedings continued then costs should be issued on the case in the usual way.

13. In response Ms Pang made the following points:

- The new information regarding the bereavement suffered by the applicant should not be accepted as an admissible compelling reason. Ms Pang pointed to the lateness of this information and the fact that the information was not provided in the usual manner of a witness statement accompanied by a statement of truth.
- The key test is that there must be compelling reasons or extenuating circumstances for discretion to be exercised and that discretion cannot be awarded as of right.
- As for the reasons why the deadline was missed, the witness statement refers to the fact that the applicant was not aware of the deadline, whilst in oral submissions it was stated that it was thought that there was a month left in which to file the Form TM8.

- There was also an additional reason provided, that the bereavement of a family member of the applicant, an instructing principal, meant the applicant could not engage with the process. However, it is clear that the representative was instructed by the applicant from at least 30 September 2024, as that was when Mr Abbas first engaged on the applicant's behalf with the opponent's representatives. Further, it is clear from the witness statement that the applicant instructed its representative to sever the cooling off period and file the Form TM8. This was a day before the deadline and, therefore, the applicant's representative was instructed in time.
- The applicant's representative did not exercise a minimum degree of vigilance as set out by Mr Geoffrey Hobbs in *Kickz*. Having been instructed from September, no effort was expended to check what the deadline was following the cooling off period. At the very least the applicant's representative was aware of an upcoming deadline as, following instructions on 5 November, they wrote to the Tribunal on the same day to request an extension of the deadline.
- In relation to the bereavement and the applicant's absence from the business, having looked at the business on Companies House during Mr Abbas' submissions, there is more than one director, therefore there is more than one person that would have been able to make key decisions in the absence of Mr Abbas' client.⁴
- She disputed the statement that the opponent's case is vexatious or without merit.
- She identified prejudice in the form of costs that the opponent had incurred in considering the witness statement, drafting the skeleton argument and attending the hearing.

⁴ This is not evidenced before me other than verbally by the opponent's legal representative so this diminishes the weight which I can place on this point.

- In relation to costs Ms Pang requested costs off the scale due to the unfounded allegations made against the opponent and that due to those allegations it required the time and expense to consider the witness statement and provide a detailed skeleton argument as well as the attendance of a representative to refute them.

DECISION

14. The filing of the Form TM8 and counterstatement in opposition proceedings is governed by rule 18 of the Rules. The applicable parts to these proceedings 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 Form 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.”

15. 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.

16. There has been a suggestion that there was a delay in actioning the Form TM33 provided by the applicant's representative. However, during the hearing Mr Abbas could not provide the date(s) that the Form TM33 was initially emailed to the Tribunal which had not been actioned, only that he sent an email marked as urgent on 25 November 2024. This matches the annotations on file which confirm receipt of a recordal received on 25 November 2024 and actioned on 27 November 2024. Having reviewed the file, there is no mention of any previous correspondence containing a Form TM33. In the absence of a date to check, or the emails themselves to examine whether any initial emails were sent to the correct email address, I am not willing to conclude that there has been any procedural irregularity on the part of the Tribunal. Additionally, I observe that Mr Abbas did not expressly argue within his skeleton argument that there were any procedural irregularities for which rule 77(5) should be enacted. As such, I do not accept 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 is if I exercise in its favour the discretion afforded to me by the use of the words "unless the registrar directs otherwise" set out above in rule 18(2).

17. In approaching the exercise of discretion in these circumstances, I take into consideration the decisions of the Appointed Person in *Kickz AG v Wicked Vision Limited* ("Kickz")⁵ and *Mark James Holland v Mercury Wealth Management Limited* ("Mercury")⁶ i.e. I have to be satisfied that there are extenuating circumstances or compelling reasons which justify the exercise of the narrow discretion afforded to me in the applicant's favour.

18. In *Music Choice Ltd's Trade Mark* ("Music Choice"),⁷ the High 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, addressing each factor

⁵ BL/O/035/11

⁶ BL/O/050/12

⁷ [2006] R.P.C. 13

below in turn, and referring to the parties' submissions to the extent I consider necessary.

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

19. There has been a delay of one month in filing the Form TM8 and counterstatement which it is claimed was caused as the result of several accumulating factors. The bereavement of a close family member of an instructing principal within the applicant's business, the applicant's representative's belief that it had a further 4 weeks/one month to file the Form TM8 after severing the cooling off period, and the fact that the applicant's representative had not been provided with the Tribunal's letter dated 16 April 2024 as it was not instructed at that time, consequently, the applicant's representative was unaware of the deadline of 6 November 2024 for filing the Form TM8 and counterstatement.

20. At the hearing it was disclosed that the applicant had suffered a bereavement of a close family member and that as a result the applicant had to travel to Iran from around mid October to mid December which made receiving instructions difficult, and the applicant was unable to fully engage in the process. However, I note that from at least the end of September the applicant had instructed a representative to act on its behalf. Indeed, on 30 September 2024, the applicant's representative wrote to the opponent's representatives to try and reach an amicable agreement that was acceptable to both parties. Furthermore, on 5 November 2024, the applicant was still able to instruct its representatives to sever the cooling off period and file the Form TM8.

21. The applicant's representative claims that he was unaware of the deadline for filing the Form TM8 and asserts that he believed that on severing the cooling off period the applicant had a further 4 weeks to file its Form TM8 and counterstatement. However, it is unclear on what basis he held this belief. I note that the applicant instructed its representatives to file the Form TM8 prior to the deadline of 6 November 2024. However, instead of filing the Form TM8 the applicant's representative requested an extension of time for its filing, this would suggest contrary to Mr Abbas' submissions that the applicant and its representative were aware that there was an upcoming

deadline. In my view, there is no good reason why the applicant or its representative would not have known about the deadline. As can be viewed above, the applicant was sent a letter on 16 April 2024 informing it of the deadline of 6 November 2024, it is good practice for legal professionals to obtain the dates of any important deadlines such as the non-extensible deadline for filing a Form TM8 when instructed. The applicant's representative had over a month to establish this information from either the client themselves (at the time of instruction or shortly after) or from the Tribunal. Whilst I appreciate that the applicant's representative has claimed that there were delays with the implementation of the Form TM33, Mr Abbas could not provide me with the dates on which the Form TM33 was filed other than on 25 November 2024, which was acknowledged and processed on 27 November 2024. Therefore, I have nothing before me to show that the applicant's representative had made any efforts with the Tribunal to ascertain the deadline for the filing of the Form TM8 prior to its passing.

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

22. The opposition is brought under sections 5(2)(b) and 5(3) of the Act. Whilst it is not for the present hearing to determine the merits of the case, there is nothing to suggest that there is not an arguable case to be determined. Furthermore, the case will require the filing of cogent evidence in respect to section 5(3) grounds.

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

23. Should the defence be admitted into proceedings, the applicant will be permitted to defend the opposition, the proceedings will continue, with the parties given an opportunity to file evidence, and the matter will be determined on its merits.

24. If, however, the defence is not admitted into proceedings, the application will be deemed as abandoned, and the applicant will lose its filing date of 5 September 2023; although, I accept that is always the case where the Tribunal makes an adverse decision against a party because of a failure to file a defence in time in opposition

proceedings. Nevertheless, it will remain open to the applicant to re-file its application which I acknowledge may, in turn, be opposed again by the opponent.

Any prejudice caused to the opponent by the delay;

25. Prejudice has been identified against the opponent in the form of time spent having to consider the witness statement, prepare a skeleton argument and attend the procedural hearing. The opponent has also encountered a delay of one month and the time taken for a subsequent hearing following the applicant's objection to the Tribunal's preliminary view. However, I accept that much of this can be addressed through costs.

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

26. The parties have not highlighted any other relevant considerations or related proceedings involving the marks of the opposition where the outcome of this decision will have an impact on those future decisions.

Considerations

27. In reaching my decision, I consider that if discretion is not exercised in the applicant's favour, the opponent will automatically succeed, and the applicant's mark will not proceed to registration. However, as discussed above, I acknowledge that this is often the consequence of a failure to comply with the non-extensible deadline to file a Form TM8, and furthermore, the applicant could choose to re-file an application to protect its mark. Therefore, this factor is not, in my view, determinative in isolation.

28. I take account of the circumstances that caused the late filed defence. However, I do not find these to be compelling and extenuating circumstances that would allow me to exercise discretion. Even accepting the bereavement of the applicant's close family member in the absence of a witness statement and in circumstances which were communicated to the Tribunal at a late stage. I do not accept that this bereavement

had any impact on the late filing of the Form TM8 and counterstatement, this is because the applicant was still able to instruct its representative to file the Form TM8 prior to the deadline. Further, no good reason has been put forward for why the applicant's representative believed that it had a further four weeks/one month to file the Form TM8 and counterstatement. I observe that the applicant's representatives were instructed at (at least) the end of September 2024, with the deadline being 6 November 2024; this afforded the applicant's representative plenty of time to engage with either the applicant or the Tribunal to check the deadline for filing the Form TM8. This should have been an urgent date to obtain, particularly as the applicant's representative should have been aware of the importance of this non-extensible deadline to the applicant given its expertise in this area of law. In my view, this amounts to the failure to exercise the 'minimal degree of vigilance' required to meet the deadline as set out by Mr Hobbs in *Kickz*.

CONCLUSION

29. The consequence of the above finding is that the Registrar's preliminary view is upheld and the applicant's late filed Form TM8 will not be admitted into the proceedings. Subject to any appeal, the opposition will be deemed as undefended, and the applicant's mark will not proceed to registration.

COSTS

30. As my decision terminates the proceedings, I must consider the matter of costs. The opponent has requested costs off the scale. This was requested due to the 'unfounded allegations' made by the applicant against the opponent, which the opponent deems to be unreasonable behaviour. It was asserted that as a result of those allegations it required the additional time and expense to consider the witness statement, provide a detailed skeleton argument and attend the hearing to refute the allegations against the opponent. As I indicated at the hearing, I did not consider the behaviour outlined to meet the requirements for awarding off scale costs, having reviewed the guidance relating to off scale costs I still consider this to be the case. With regards to off scale costs the TPN 1/2023 states:

“Notwithstanding the published scale, the Tribunal retains the discretion to award costs “off the scale” to deal proportionately with unreasonable behaviour. It is not possible to set out all the circumstances in which a Hearing Officer might depart from the scale. It is worth clarifying though that just because a party has lost, this in itself is not indicative of unreasonable behaviour. Some examples of what might constitute unreasonable behaviour include a party seeking an (avoidable) amendment to its statement of case which, if granted, would cause the other party to have to amend its statement or would lead to the filing of further evidence. Other examples include behaviour designed to delay, frustrate or unreasonably increase the costs/burden on the other party and/or repeated breaches of procedural rules. Off-scale costs may also be awarded if a losing party unreasonably rejected efforts to settle a dispute before an action was launched or a hearing held, or unreasonably declined the opportunity of an appropriate form of Alternative Dispute Resolution.”

31. I appreciate that not all the circumstances in which off scale costs may be granted are set out above, however, having reviewed the documents filed by the applicant and the instances of unreasonable behaviour set out at paragraph 14 of the opponent’s skeleton argument, I do not consider there to be anything within that document that is so offensive as to warrant off scale costs on the basis of unreasonable behaviour. During litigation proceedings tensions may be raised, which would lead a party to consider the worst of the other, whilst the applicant has made several accusations against the opponent, this is all within the course of litigious proceedings. I do not consider it necessary to award costs off the scale particularly as the Form TM8 and counterstatement which contain the majority of these accusations will not be admitted into proceedings.

32. Therefore, the opponent is entitled to a contribution towards its costs, based on the scale published in the TPN 1/2023.⁸ I therefore assess the costs as follows:

Official fee:	£200
Preparing the statement of case:	£250

⁸ As the opposition proceedings were brought after 1 February 2023.

Preparing a skeleton argument and
attending the hearing: £350

Total: £800

33. I therefore order Deltaflare Limited to pay Phoenix Software International, Inc the sum of **£800**. 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 April 2025.

Sarah Wallace
For the Registrar