O-0470-25

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION

NO. UK00003875050

BY

FARM ORIGINALS LIMITED

TO REGISTER

AND

AS A SERIES OF TWO TRADEMARKS

IN CLASSES 29, 30, 35 AND 43

AND OPPOSITION THERETO

UNDER NO. OP000440979

BY ORIGIN COFFEE (HOLDINGS) LIMITED

BACKGROUND AND PLEADINGS

1. On 6 February 2023, Farm Originals Limited ("the applicant") applied to register the series of trade marks shown on the cover page of this decision.

2. The application was published for opposition purposes on 24 February 2023 for goods and services in Classes 29, 30, 35 and 43.

3. On 23 May 2023, legal representative Bryers LLP filed Form TM7 ("Notice of opposition and statement of grounds") on behalf of Origin Coffee Limited. The opposition is based upon section 5(2)(b) and section 5(4)(a) of the Trade Marks Act 1994 ("the Act") and is directed against all of the applied for goods and services. I note that on 2 November 2023, Form TM33P was filed noting the change of representative from Bryers LLP to Bryers Intellectual Property Ltd ("BRYERS"). In the same correspondence, BRYERS confirmed the assignment of all prior rights on which the opposition is based from Origin Coffee Limited to Origin Coffee (Holdings) Limited, who from this point forward will be referred to as "the opponent". BRYERS confirms that the opponent has had sight of all correspondence on file, that it stands by the grounds on which the opposition was filed, and is aware of the costs in proceedings.[1] Under section 5(2)(b), the opponent relies upon two earlier marks, namely UK00917955354, relying on its class 43 services only, and UK00002496869, relying on all the goods and services for which the mark is registered.

4. The Form TM7 was served on the applicant by email on 10 July 2023 and I copy an extract from the Tribunal's covering letter below.

> "If you wish to continue with your application, you need to file a notice of defence and counterstatement by completing Form TM8 - <u>please note the important deadline below</u>. You will find a

[1] The change of names have been recorded accordingly and acknowledgement of the same was made by the Tribunal in the official letter dated 3 November 2023.

blank Form TM8 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

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 11 September 2023."

5. It was confirmed by the Tribunal's letter of 15 September 2023 that a Form TM9C had been received on 7 September 2023 and that the parties had agreed to enter a cooling off period. An extract from the letter is copied below.

"In accordance with Rule 18(4) of the Trade Marks Rules 2008, this period will expire on **10th April 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 **10th April 2024**."

6. It was confirmed by the Tribunal's letter of 18 April 2024 that a Form TM9E had been received and that the parties had requested an extension of the cooling off period of a further nine months. An extract from the letter is copied below.

> "The extension to the cooling off period is allowed. This period will now expire on **10 January 2025.**
>
> Under Rule 18(5) of the Trade Marks Rules 2008 no further extension to the cooling off period is allowed. Therefore, the TM8 and counter-statement are due to be filed on or before **10 January 2025.**
>
> If no TM8 and counter-statement are filed within this period allowed 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."

7. On 21 January 2025, the Tribunal wrote a letter to the applicant, and I copy an extract below.

> "The official letter dated 18 April 2024 invited the applicant to file a TM8 and counterstatement on or before 10 January 2025.
>
> 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, **04 February 2025**. 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."

8. Anne Bashir of Murgitroyd & Company ("Murgitroyd"), acting as legal representative of the applicant, replied to the Tribunal's letter by email on the same day, an extract of which I copy below.

> "We refer to your letter of 21 January 2025 and our voicemail messages left earlier today.
>
> We hereby request a hearing because the deadline to file the counterstatement was missed due to an error. The deadline was erroneously entered on our records as 25 January 2025 instead of 10 January 2025 and this error has only come to light today on receiving your aforementioned letter.
>
> We were working towards lodging the counterstatement by the erroneous deadline of 25 January 2025. We will now endeavour to have it to you sooner. In the meantime, we are preparing the full written reasons and will also have these to you, as soon as possible, and in any event before 4 February 2025."

9. The Tribunal confirmed by a letter of 22 January 2025 that a Form TM8 and counterstatement, along with a witness statement setting out the reasons as to why the TM8 and counterstatement were being filed outside of the prescribed period, were required by 4 February 2025.

10. A witness statement in the name of Ms Bashir and the Form TM8 and counterstatement were duly received on 4 February 2025.

11. On 11 March 2025, the Tribunal wrote to the applicant, and I copy an extract below.

> “Thank you for your email dated 04 February 2025 in which you submitted a late filed Form TM8 and counterstatement together with a witness statement of Anjum Sheikh Bashir.
>
> 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.
>
> …
>
> 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 **25 March 2025**.”

12. I copy selected extracts from Ms Bashir’s witness statement below.

> “2. I received the official letter from the UKIPO setting out the timelines for the extension of the cooling off period and filing the counterstatement in this opposition, following the filing of the TM9e, in my email in-box on 18th April 2024.

3. Our records department, known in Murgitroyd as the Internal Support Group ("ISG"), entered the deadlines onto our case management system on 23rd April 2024. My understanding was that, when deadlines are entered on our records, one member of the ISG team enters the deadline, whilst another checks that the dates are entered correctly. When ISG has completed these actions, I receive a "pink slip" setting out the deadlines in question, which has a link to the official letter from the UKIPO attached to it. I receive the pink slips through "an app" called the Attorney Workflow Hub, which I then check periodically.

4. On 17 May 2024, I, as usual, conducted a "sense check" of the pink slip, in that I checked that the deadlines to file the counterstatement and the end of the cooling off period matched, I checked that they were approximately in 9 months' time, and that it was the Applicant's deadline and not the Opponent's deadline. I also cross-checked the deadlines on the pink slip with what appeared on the letter. I believe that I simply did not pick up that the day for both the deadline for filing the Form TM8 and counterstatement and the end of the cooling-off period was entered as 25 instead of as 10.

5. Thereafter, the deadline appeared incorrectly on the docket/diary for this case.

…

8. My mother passed away shortly before, on 31st March 2024. However, I cannot comment on whether this had any bearing on my not picking up the error on the pink slip."

13. I note that as well as the witness statement from Ms Bashir, there was also a witness statement received from Yvonne McSorley, "the Director in charge of the Internal Support Group ("ISG"), the Group within Murgitroyd that provides support services to the attorney group, including docketing services." I copy selected extracts below.

> "3. Over time Murgitroyd has developed a set of documented procedures to be followed by the team when docketing. These procedures have previously been approved under the 1SO9001 Quality Management System.
>
> 7. All deadlines being docketed are reviewed carefully before confirmation is forwarded to the attorneys responsible for the relevant file for them to review.
>
> 8. Despite taking every precaution, and having tried and tested procedures in place that are followed carefully, there is always the possibility of human error, which appears has occurred in this instance.
>
> …
>
> 10. This instance was a genuine human error when the year was entered as the day."

14. On receipt of the Tribunal's letter, on the same date, 11 March 2025, the applicant requested a hearing.

THE HEARING

15. A joint hearing took place before me, via Microsoft Teams as an audio call, on Wednesday 16 May 2025.

16. Anne Bashir from Murgitroyd attended on behalf of the applicant, this being the same Anjum Sheikh Bashir who was the signatory of one of the applicant's witness statements. Ms Bashir filed skeleton arguments prior to the hearing, together with a number of cases that she considered relevant to the proceedings.

17. Jo Pritchard from BRYERS attended on behalf of the opponent. She filed skeleton arguments prior to the hearing, together with one case that she considered relevant to the proceedings, the other cases referred to in her skeleton arguments having also been referred to and already filed by the applicant.

18. Ms Bashir said that she considered Ms Pritchard's criticisms of the applicant's evidence to run contrary to Tribunal Practice Notice 5 of 2007 which states that it is normally unacceptable to question the veracity of evidence without asking the witness to respond by further via written evidence or through cross examination being requested. Ms Bashir said that Ms Pritchard had not pursued either of these courses of action but instead had waited until the submission of her skeleton arguments to challenge the applicant's evidence. That point having been made, Ms Bashir made the following key points which included responses to some of the arguments put forward in Ms Pritchard's skeleton arguments:

- Ms Bashir said that she clicked on the link to the letter from the Tribunal which appeared on a separate screen, and she did not pick up the fact that the date on the pink slip and the date on the letter from the Tribunal differed. This was an "oversight", and the error was a "vanishingly rare" one.

- The witness statements from Ms Bashir and from Ms McSorley were compiled entirely independently of each other.

- In respect of the paralegal who entered the date incorrectly, Ms MsSorley interviewed them as part of the process of compiling her witness statement, but it was not considered appropriate to ask the paralegal to make a witness statement of their own.

- Ms Bashir did not see what benefit could have been derived from filing exhibits, such as a copy of the pink slip, as there were no external documents pertinent to the case and any exhibits filed would have had the same probative value as the two witness statements.

- While acknowledging that it was hearsay, Ms Bashir had spoken to Ms McSorley that morning and she had said that the ISO9001 accreditation referred to in Ms McSorley's witness statement ran from 1994 to 2003, and the procedures followed since then have not changed.

- Again, this is hearsay, but while Ms Bashir's understanding had been when she made her witness statement that the ISG process involved a second check, Ms MsSorley had said that morning that a second check did not always take place – it depended on the seniority of the paralegal in question.

- Ms Pritchard had said in her skeleton arguments that "Ms Bashir's recollection [of having carried out a crosscheck] appears unusually precise". Ms Bashir found this to be an odd comment: this was a difficult case which caused Ms Bashir to recall the sequence of events in the case quite specifically.

- Ms Bashir set out her analysis of the consequences of treating the applicant as defending or not defending the opposition and whether any prejudice was caused to the opponent by the delay in these proceedings.

19. Ms Pritchard took me through her skeleton arguments, her key points being:

- In acknowledging that Ms Bashir had voiced concerns about the manner in which she had criticised the applicant's evidence, Ms Pritchard said that it was part of her role to highlight weaknesses in the evidence and to prepare a critique of it on behalf of her client.

- It is unusual to file witness statements without supporting exhibits and the absence of exhibits in this case means that there is no supporting documentation to consider such as records from Murgitroyd's case management system.

- The checking process utilised by Murgitroyd's ISG has not been set out in detail.

- We have not been told how well-qualified the paralegal who made the error was or how many years' experience they had.

- There was an error in entering the wrong date on the case management system and we do not know whether a second check of that entry took place or not.

- Ms Bashir's ability to recall how she carried out her sense check is "impressive". Be that as it may her sense check method was unreliable and likely to fail at least half of the time.

- Entering the year in place of the day would appear to be more than just a keystroke error.

- There were four points of error which resulted in the wrong date being entered and not corrected: 1. The wrong date was entered. 2. The ISG checking process failed. 3. The sense check did not pick up the error. 4. Ms Bashir did not notice the different date on the original letter from the Tribunal.

20. Turning to what she considered to be relevant cases, Ms Pritchard referred to *Kickz AG and Wicked Vision Limited* (BL- O-035-11) ("*Kickz*"), contending that the applicant is the "author of its own misfortune" in the sense there was limited adherence to an unclear system in this case.

21. In the context of the *Music Choice* factors (as later referred to in paragraph 28 of this decision), the deadline was missed due to a catalogue of errors, pointing away from this case being worthy of the exercise of discretion. The deadline for filing the Form TM8 in this case was missed by 25 days. In *Music Choice*, the Form TM8 was filed one day late, and the counterstatement had already been filed.

22. Ms Pritchard considered the *SiBio* case (BL O/0971/24) to be relevant to the case at hand because it concerns the failure of an administrative procedure on more than one occasion and the late filed Form TM8 was not admitted in that case.

23. Ms Bashir had cited the *Billions* case (BL O/070/19). However, Ms Pritchard pointed out that the representative in that case had completed the Form TM8 nearly three weeks prior to the deadline. The Hearing Officer noted that there were related proceedings between the parties in that case and these were instrumental in her exercising her discretion, whereas there was no risk of conflicting decisions in the case at hand.

24. In reply, Ms Bashir argued that the *SiBio* case was different on its facts. In that case, there was no procedure in place for the handing over of cases, whereas in the matter before us Ms McSorley had attested to Murgitroyd having procedures that it followed.

DECISION

25. The filing of a Form TM8 in opposition proceedings is governed by rule 18 of the Trade Mark 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 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.
>
> (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."

26. 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."

27. 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).

28. Sitting as the Appointed Person in *Kickz*, Mr Geoffrey Hobbs KC held that the discretion conferred by Rule 18(2) can be exercised only if there are "extenuating circumstances". And sitting as the Appointed Person in *Mark James Holland and Mercury Wealth Management Limited* (BL-O-050-12) ("*Mercury*") Ms Amanda Michaels KC held that there must be "compelling reasons" to justify the Registrar exercising that discretion. In considering relevant factors, Ms Michaels referred to the criteria established in *Music Choice Ltd's Trade Mark* [2006] R.P.C. 13 ("*Music Choice*"), which provides guidance applicable by analogy when exercising the discretion under rule

18(2). The factors are as follows:

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

29. As confirmed by Ms Bashir's witness statement, "I received the official letter from the UKIPO setting out the timelines for the extension of the cooling off period and filing the counterstatement in this opposition, following the filing of the TM9e, in my email in-box on 18th April 2024."

30. On 23 April 2024, the relevant deadline – 10 January 2025 – was entered erroneously into Murgitroyd's case management system by a member of its ISG as 25 January 2025.

31. Ms McSorley said in her witness statement that all deadlines are reviewed carefully and that the ISG's procedures are tried and tested.

32. Ms Bashir had understood that "when deadlines are entered on our records, one member of the ISG team enters the deadline, whilst another checks that the dates are entered correctly." However, at the hearing, Ms Bashir said that she had spoken to Ms McSorley that morning and been advised that second checks do not always take place.

33. Ms Bashir conducted a "sense check" of the deadline recorded on the "pink slip" – that the date of the expiry of the final nine month cooling off period and date of the deadline for submission of the Form TM8 and counterstatement were one and the same. This sense check also included checking that the expiry date/deadline was in approximately nine months' time.

34. On clicking on the link to the Tribunal's letter in the Attorney Workflow Hub, Ms Bashir did not notice that the date on the pink slip and the date on the Tribunal's letter differed.

35. Ms Bashir was therefore working towards a deadline of 25 January 2025 and "the error regarding the deadline being entered incorrectly only came to light" when Ms Bashir received the letter from the Tribunal dated 21 January 2025 informing her that the deadline for filing the Form TM8 and counterstatement had been missed.

36. The Form TM8 and counterstatement was subsequently received on 4 February 2025.

<u>The nature of the opponent's allegations in its statement of grounds</u>

37. The opposition was brought under sections 5(2)(b) and 5(4)(a) of the Act. There is nothing to suggest that the opposition was without merit.

<u>The consequences of treating the applicant as defending or not defending the opposition</u>

38. If the applicant was allowed to defend the opposition, the proceedings would continue, and the matter would be determined on its merits. If, however, the applicant was not allowed to defend the opposition, its application would be deemed abandoned, and the applicant would lose its filing date of 6 February 2023. It is possible to re-file an application and I am told that the applicant has in fact already defensively filed two new applications. However, I am told that a separate potential opponent has emerged who has made a new application for its mark and whose filing date would now pre-date that of the applicant's new applications.

39. If the applicant was treated as not defending the opposition, it would be subject to significant delay, costs and uncertainty due to, its representatives argue, no fault of its own, its representatives having made an error.

<u>Any prejudice caused to the opponent by the delay</u>

40. The opponent has said that, given that the opposition has been ongoing for two years, the further delay involved in re-running these proceedings would not be significant. But the opponent has incurred costs in relation to the deadline for filing the Form TM8 being missed, not least costs relating to preparing for and attending this hearing.

41. The applicant has recognised that prejudice would be caused to the opponent in terms of costs if the late filed Form TM8 was to be admitted. It has said that this could be compensated for via an award of costs off the scale to take account of the delay and the costs of preparing for and attending this hearing.

<u>Any other relevant considerations such as the existence of related proceedings between the parties</u>

42. There are no other relevant considerations.

43. Having addressed each of the relevant factors as proposed in *Music Choice*, I need to decide whether the applicant’s witness statements and subsequent comments at the hearing revealed extenuating circumstances or compelling reasons that would enable me to exercise my discretion to allow the proceedings to continue.

44. After carefully considering the expected detriment to the applicant in the event that discretion was not exercised in its favour, I find that the loss of a filing date and then the enactment of further proceedings on much the same basis is often the consequence of a failure to comply with the non-extensible deadline for filing a Form TM8. The emergence of a new potential opponent as a result of what would be a later filing date is also to be expected. This factor is not, therefore, particularly compelling.

45. I am told that the deadline for submitting a Form TM8 and counterstatement was entered in error whereby the year was entered as the day. However, I do not have any information or screenshots before me that show what date

format Murgitroyd's case management system uses. What I can say is that the error was more than just a simple transposition of digits when typing.

46. Furthermore, Ms Bashir's checking process was not particularly rigorous. Her "sense check" was rough and ready, and on clicking on the link to the Tribunal's letter in the Attorney Workflow Hub, Ms Bashir did not notice that the date on the pink slip and the date on the Tribunal's letter differed.

47. Ms McSorley attests to all deadlines being reviewed carefully and the ISG's procedures being tried and tested. However, it appears that second checks do not always take place, and in this instance an error was not picked up during the checking process.

48. Having taken all of the relevant factors into account, I am not satisfied that the reasons why the Form TM8 and counterstatement were filed late are particularly compelling, nor do they constitute extenuating circumstances sufficient to permit the Registrar to exercise its discretion under rule 18(2). I am in agreement with the opponent in finding that the applicant was "the author of its own misfortune".[2]

49. I should say that I would have reached the same conclusion even if I had struck out Ms Bashir's comments about what Ms McSorley had told her on the morning of the hearing.

50. I should also say that I note that at paragraph 8 of Ms Bashir's witness statement, that her mother passed away on 31st March 2024 and that she could not comment on whether this had any bearing on her not picking up the error in the pink slip. This matter was only briefly touched on by Ms Bashir during the hearing and in Ms Pritchard's skeleton arguments she states at paragraph 20.10 that, "If Ms Bashir is not able to comment on this, it is not possible for any other party, on the information that is available to us, to extrapolate anything from paragraph 8 to support the claim to extenuating

[2] *Kickz,* paragraph 15

circumstances.” While I am sorry to hear of Ms Bashir’s bereavement, I find that I have to agree with Ms Pritchard on this point.

CONCLUSION

51. The late-filed Form TM8 is not to be admitted into the proceedings. Subject to appeal, the application is treated as abandoned.

COSTS

52. As my decision terminates the proceedings, I must consider the matter of costs which the opponent requested at the end of its skeleton arguments.

53. The opponent sought costs, and I award it costs in line with Tribunal Practice Notice 1/2023:

Official fees:	£200
Preparing for and attending a hearing:	£500
Total:	**£700**

54. I order Farm Originals Limited to pay Origin Coffee (Holdings) Limited the sum of £700 as a contribution towards its costs. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 28th day of May 2025

John Williams
For the Registrar