

O/0602/26

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 4198070
IN THE NAME OF CONTRACT BUDDY LTD
TO REGISTER THE FOLLOWING TRADE MARK:**

ContractBuddy

IN CLASSES 9, 35, 36, 42 AND 45

AND

THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT

IN DEFENCE OF AN OPPOSITION

UNDER NO. 456018

BY SD WORX PEOPLE SOLUTIONS N.V.

BACKGROUND

1. CONTRACTBUDDY LTD (“the applicant”) applied to register the trade mark **Contract Buddy** (“the applicant’s mark”) in the UK on 2 May 2025 under number 4198070. It was accepted and published in the Trade Marks Journal on 16 May 2025 in respect of the following goods and services:

Class 9: Computer software and applications: Brand Contract proof reading AI product.

Class 35: Business management and consultancy services, AI Product used for Brand Contract proof reading for use by talent managers, Agencies and Independent creators.

Class 36: Contract guarantee services.

Class 42: Software as a Service (SaaS) and technology services, used to build an AI driven Social media Contract between brands and the Creator to proof read every contract.

Class 45: Legal Services, document review, contract automation tools, between brands contracts and social media creators. This will be used by talent managers, independents and social media agencies.

2. SD Worx People Solutions N.V. (“the opponent”) opposed the trade mark application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its UK trade mark number 918235449, **BUDDY** (“the opponent’s mark”). The opponent’s mark was filed on 7 May 2020 and became registered on 15 September 2020. It stands registered for the following services, all of which are relied upon by the opponent:

Class 35: Human resources management; human resources consultancy, including reward consultancy; business analysis, research and information services; personnel and wages administration and consultancy in the field of personnel and personnel matters; Payroll assistance; Payroll preparation; payroll advisory services; Preparation of wage slips; Career information and advisory services (other than educational and training advice), outplacement, job placement, recruitment and selection of personnel, Personnel selection using psychological testing; temporary employment agencies; Recruitment and placement of temporary personnel; deployment of staff; compilation of

statistics; interim business management; accounting; business project management; commercial information; consultancy regarding business organisation, business process management and consulting, outsourcing services, business management and business economics; business strategy services, sale (retailing) of computer programs and/or computers and their peripheral devices or sale for others of computer programs and/or computers and their peripheral devices; benchmarking services (evaluation of business organisation practices); administrative data processing; business data analytics; analysis of market research data and statistics; business data analysis; corporate communications services.

Class 41: Career counselling [training and education advice]; Education, Training, Coaching; Arranging and conducting of workshops and seminars; Organization of recreational, educational, sporting and cultural events; Publishing, including publishing of books, newsletters and periodicals; Lending and distributing of books, newsletters and periodicals; electronic publishing services; providing electronic publications.

Class 42: Design, development and programming of software; IT service management; Installation and maintenance services for software; Hosting services, software as a service, and rental of software; Design and development of databases, computer programming; programming for electronic data processing.

Class 45: Research and expert consultancy relating to legal issues; legal services, legal consultancy; Licensing of software; mediation.

3. On 20 August 2025, Registry served the Form TM7 on the applicant, by both email and regular post. The serving letter included the following:

“If you wish to continue with your application, you need to file a notice of defence and counterstatement by completing Form TM8 - please note the important deadline below. You will find a blank Form TM8 on the IPO website, together with brief guidance on what happens after it is filed: <https://www.gov.uk/government/publications/trade-mark-forms-and-fees/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 20 October 2025

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. On 10 September 2025, the applicant filed a Form TM9C to request a cooling-off period. On 17 September 2025, the Registry accepted the request. However, on 18 September 2025, the opponent wrote to say that it did not agree to the cooling-off period. On 22 September 2025, the Registry wrote to both parties to confirm that the cooling-off period would not be granted, and therefore the deadline to file a TM8 on or by 20 October 2025 was still in place.

5. On 22 September 2025, the applicant responded to the Registry’s letter with the following:

“We accept that the applicant’s deadline to file its TM8 defence and counterstatement is 20 October 2025, and we confirm that we will submit our TM8 within this deadline.”

6. On 16 October 2025, the applicant filed a TM21B. However, it did not file a Form TM8 on or before the stipulated deadline of 20 October 2025.

7. On 26 November 2025, the Registry wrote to the applicant, by both email and regular post, in the following terms:

“As no Form TM8 and counter-statement has been filed within the time period set, Rule 18(2) of the Trade Mark Rules 2008 (as amended) applies. Rule 18(2) states:

“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.”

It is our preliminary view that the application should be treated as abandoned because no defence was filed by the deadline referred to above.

If you disagree with the preliminary view, you **must** file the Form TM8 and counter-statement **and** a witness statement setting out the reasons for the failure to meet the deadline on, or before, **10 December 2025**.

If no response is received by this date, the application will be treated as abandoned (i.e. it will be withdrawn)” (original emphasis)

8. On 8 December 2025, the applicant filed a Form TM8, accompanied by a witness statement dated 8 December 2025 provided by Mr Alex Ells (director for the applicant). The content of Mr Ells’ witness statement can be summarised as follows:

- The deadline was missed as he “understood that filing the corresponding TM21B limitation would address the points raised in the opposition and that no further procedural steps were required until the limitation had been processed by the IPO”.
- He was “unaware that the TM8 defence deadline remained active during this period. This was a genuine misunderstanding of the procedure and not an attempt to abandon or delay the application”.
- Upon receiving the Registry’s preliminary view, he “acted immediately to prepare the TM8, counter-statement, and corrected TM21B”.

9. On 29 May 2026, the Registry wrote to the parties to state that “[a]fter careful consideration of the contents of the information”, its preliminary view was to “refuse the Form TM8 and counterstatement”. The applicant was given a deadline of 12 June 2026 by which to request a hearing if it disagreed with the preliminary view. The Registry made the applicant aware that if no response was received by that date, the preliminary view would automatically become final, and the application would be confirmed as being deemed abandoned.

10. On 2 June 2026, the applicant formally responded to the preliminary view by disagreeing with the Registry’s preliminary view and requesting to be heard on the issue.

11. On 23 June 2026 Mr Ells sent skeleton arguments prior to the hearing scheduled for 25 June 2026.

The hearing

12. A hearing took place before me, by telephone conference, on 25 June 2026. Only the applicant attended, with Mr Alex Ells and Mr Mathew Carey appearing on its behalf. The applicant filed a skeleton argument along with an evidence bundle. The Opponent did not attend, nor did it make any submissions in lieu of the hearing.

13. At the hearing, I began by clarifying an issue in relation to the applicant’s understanding of the Registry’s letter issued on 26 November 2025 (which gave the deadline of the 10 December 2025), as the applicant had referred to this deadline of the 10 December 2025 as it being “permitted to file a late TM8”, and that it had understood the deadline as being a “remedial window”. As the applicant filed its witness statement with the Form TM8 on the 8 December 2025, it therefore argued in the skeleton argument that it had filed the required documents “two days inside the window the Registry allowed”.

14. I explained that the deadline of the 10 December 2025 was given so that any party wishing to challenge the Registry’s preliminary view that the application should be treated as abandoned (and that to do this, the applicant must file a witness statement providing the reasons for missing the deadline along with its Form TM8) had the opportunity to do so, rather the deadline being a remedial window which would

automatically allow the Form TM8 into the proceedings. At the hearing, Mr Ells stated that he understood the clarification I provided, and that he had mistakenly understood the deadline of 10 December 2025 to be the last opportunity to file a Form TM8. However, he accepted that the mistake was due to his misunderstanding of the procedural process, and that he had tried his best to resolve the issue as quickly as he could.

15. I asked Mr Ells if he could give further clarification of the circumstances that had led him to assume incorrectly that filing a Form TM21B would override the need to meet the statutory Form TM8 deadline. He reiterated that he had done this in error. He said that he mistakenly assumed that the agreement with the opponent and the parties' common ground resulted in the Form TM8 deadline not being necessary at that time.

16. I asked Mr Ells if he had considered contacting the Registry to clarify this, given his awareness of the deadline for the TM8 form, and the consequences that the applicant would face for failing to file it within the deadline. He said that he had not, otherwise he would have spoken to the Registry. He then added further that he was aware that the applicant had made an error, and he emphasised that the applicant's conduct and behaviour throughout the process demonstrated its commitment to the application. Mr Ells also stated on a number of occasions that he understood that the Registry's ability to exercise its discretion in this case is very narrow.

17. Mr Carey reiterated the points raised by Mr Ells. Whilst he accepted that the applicant had made an error, he also highlighted that it would be a shame for the late-filed defence not to be admitted into the proceedings due to the need to repeat the application process.

18. I thanked Mr Ells and Mr Carey for their submissions. I confirmed that I would take them away for consideration and issue my decision in due course. Having given consideration to all of the submissions made I now give my decision below.

Decision

19. The filing of a Form TM8 and counterstatement 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 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.”

20. The combined effect of rules 77(1), 77(5) and Schedule 1 of the Rules mean that the time limit in rule 18, which sets the period in which the defence must be filed, is non-extendable 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.”

21. In approaching the exercise of discretion in these circumstances, I consider the decisions of the *Appointed Person in Kickz AG v Wicked Vision Limited*¹ and *Mark James Holland v Mercury Wealth Management Limited*² i.e. I must be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the applicant’s favour.

22. In *Music Choice Ltd’s Trade Mark*,³ 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

¹ BL/O/035/11

² BL/O/050/12

³ [2005] RPC 18

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

23. Both in the skeleton argument as well as at the hearing, Mr Ells emphasised that the failure to comply with the Form TM8 deadline was due to the applicant's misunderstanding of the procedural process. He accepts that he made an error in believing that the Form TM21B had superseded the need to file a Form TM8. He stated at the hearing that he had not realised that the Form TM8 was still outstanding until the Registry issued its letter on 26 November 2025.

24. As the deadline to file the Form TM8 was 20 October 2025 and the applicant did not file the witness statement along with the missing Form TM8 until 8 December 2025, the Form TM8 deadline was missed by **nearly seven weeks**.

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

25. The opposition is brought under section 5(2)(b) 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 opposition is without merit.

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

26. If the applicant is allowed to defend the opposition, the proceedings will continue, and the matter will be determined on its merits.

27. If, however, the defence is not admitted into the proceedings, the application will be deemed abandoned, and the applicant will lose their filing date of 2 May 2025. It will remain open to the applicant to re-file their application, which may, in turn, be opposed again by the opponent.

Any prejudice caused to the opponent by the delay

28. In its skeleton arguments, the applicant submitted that the prejudice caused to the opponent due to the delay is minimal.

Any other relevant considerations

29. In the applicant's skeleton arguments, as well as at the hearing, Mr Ells emphasised that the applicant had consistently maintained good engagement with the IPO and the opponent throughout the opposition proceedings. He stated that despite making mistakes in the process, he had done his best to resolve issues as quickly as possible. He argued that this conduct showed its commitment to defend the application, rather than abandon it.

Conclusions

30. In reaching my decision, as noted above, I recognise that if the discretion is not exercised in the applicant's favour, the opposition will succeed, and the applicant will lose their filing date in respect of all the goods and services in the application (since the opposition is directed against the application in full). I further recognise that it may be that the applicant will simply re-file their application and that this may, once again, be opposed by the opponent resulting in opposition proceedings arising at some point in the future.

31. However, 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 TM8. In my view, to regard the mere prospect of another application as a strong consideration would significantly undermine the statutory nature of the timeframes under the rules for filing a Form TM8. These are therefore not factors that, in my view, are particularly compelling. Furthermore, whilst I acknowledge that repeated proceedings may occur (which are regrettable on the account of the parties' wasted cost and efforts, as well as a further strain on the Registry's resources), I must consider the specific circumstances at hand.

32. The purpose of the Form TM21B being filed in these proceedings is to limit the applicant's specification. A Form TM21B may be filed as a result of ongoing negotiations with the other party in an attempt to resolve the dispute between the parties. However, the filing of a Form TM21B does not interrupt the continuity of the proceedings. Moreover, there is nothing in the Manual of Trade Marks Practice, the Trade Mark Rules, or on the Registry's website to suggest that filing a Form TM21B

eliminates the requirement for a Form TM8. Furthermore, TPN 1/2024 specifically states the following:

“Filing Form TM21B in lieu of Form TM8

The Tribunal has identified a common practice of applicants filing a Form TM21B in lieu of a Form TM8. This is not an acceptable substitution.

The TM8 deadline is statutory and non-extendable and, consequently, a Form TM8 should be filed to protect the applicant’s position, even if the parties have negotiated a settlement and filed a TM21B to reflect that.

Until the TM21B has been approved and implemented by the Tribunal, and a withdrawal has been confirmed, the opposition proceedings are still ongoing and should be treated as such.”

33. On this basis, the requirement for the applicant in question to file a Form TM8 by the deadline remained unaltered, notwithstanding the filing of the Form TM21B. Furthermore, I also note that, following the filing of the Form TM21B on 16 October 2025, the Registry never communicated to the parties that the statutory requirement and deadline of Form TM8 had been waived, nor did the applicant seek confirmation from the Registry on this particular point.

34. The deadline for the Form TM8 was clearly set out for the applicant in the Registry’s letter on 20 August 2025. The letter also made it very clear that failure to file a Form TM8 by the deadline would result in the application being treated as abandoned. Importantly, the Registry provided a reminder of this deadline in its letter dated 22 September 2025, and the applicant acknowledged in writing the requirement to file the Form TM8, without raising any questions in his communication. It is also considered that the filing of a Form TM8 is a relatively simple task, capable of being successfully carried out, irrespective of whether an applicant is represented.

35. I remind myself that, in dismissing the appeal in *Kickz AG* (cited above), Geoffrey Hobbs Q.C. (as he then was), sitting as the Appointed Person, found that the applicant “*had been the author of his own misfortune*”. Whilst I am sympathetic to Mr Ell’s comments regarding his acceptance that he made an error in his understanding of the procedural rules, I find the Appointed Person’s comments also be true of the applicant

in the case before me. Taking all of the above into account, I am not satisfied that the reasons given to explain why the Form TM8 and counterstatement were filed approximately seven weeks late are particularly compelling, nor do they constitute extenuating circumstances sufficient to permit the Registrar to exercise its (limited) discretion under rule 18(2) to admit the late filed Form TM8 and counterstatement into these proceedings.

OUTCOME

36. The Registry's preliminary view is upheld and the late-filed Form TM8 is not admitted into the proceedings. The applicant will be treated as not defending the opposition. The application is deemed abandoned in respect of all of the applied-for goods and services.

37. 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, based upon the scale published in Tribunal Practice Notice 1/2023. I assess these as follows:

Official fee for filing the form TM7: £100

Preparing a statement: £250

Total: £350

38. I therefore order CONTRACTBUDDY LTD to pay the sum of £350 to SD Worx People Solutions N.V.. The above sum should be paid within twenty-one days of the expiring of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 13th day of July 2026

KATHRYN SERRAVALLE

For the Registrar