

O/0614/25

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION
NO. 3894784
BY ASHURST LLP
TO REGISTER THE TRADE MARK:**

OUTPACING CHANGE

IN CLASSES 9, 16, 35, 36, 41, 42 & 45

AND

**THE LATE FILING OF FORM TM8 AND
COUNTERSTATEMENT
FILED IN DEFENCE OF THAT APPLICATION
IN OPPOSITION THERETO
UNDER NO. 442722
BY OUTPAYCE, S.A.**

Background

1. On 29 March 2023, Ashurst LLP (“the applicant”) applied to register the trade mark number shown on the cover page of this decision in the UK. The application was published for opposition purposes on 26 May 2023. The applicant seeks registration for goods and services set out in Annex 1 of this decision.
2. On 29 August 2023, Outpayce, S.A. (“the opponent”) filed a partial opposition based on Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”)¹. The opposition is directed only against the Class 9 goods and Class 35, 36 and 42 services. The opponent relies upon the following mark:

Trade Mark No.	UK00003848406
Trade Mark	OUTPAYCE
Goods & Services for which the mark is registered	9, 35, 36 & 42
Filing date	11 November 2022
Date of entry in register	3 February 2023

3. On 1 September 2023, the Registry served the TM7 on the applicant. The deadline for the applicant to file a completed Form TM8 or Form TM9c was set at 1 November 2023 which was communicated by the Registry in the serving letter. The pertinent 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

¹ The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

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 1 November 2023.

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 international registration will be treated as abandoned. [...]” (original emphasis)

4. On 1 November 2023 the parties filed a Form TM9c. On 7 November 2023, the Registry wrote to the parties stating that:

“I refer to the TM9c dated 1 November 2023 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 **3 June 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 **3 June 2024**.

If no such request is made, the TM8 and counter-statement should be filed on or before **3 June 2024** or applicant 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. [...]"

5. On 31 May 2024, the applicant filed a Form TM9E, requesting an extension to the cooling off period to allow the parties to further negotiate a settlement of the opposition. On 5 June 2024, the Registry allowed the extension stating that:

"The extension to the cooling off period is allowed. This period will now expire on **03 March 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 counterstatement are due to be filed on or before **03 March 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."

6. The applicant's Form TM8 was not received within the deadline of 3 March 2025.
7. On 4 April 2025, the Registry wrote to the applicant stating:

"I acknowledge receipt of the Form TM8 and counterstatement filed on **13 March 2025**. The official letter dated **05 June 2024** invited the applicant to file a TM8 and counterstatement on or before **03 March 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, **18 April 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. On 7 April 2025, the applicant requested a hearing enclosing a witness statement dated 4 April 2025. The witness statement was signed by Mr Alan Fiddes of Murgitroyd & Company, the applicant’s representative in these proceedings, outlining the reasons for the delayed filing of Form TM8 by its original deadline as follows:

“[...] 2. It is accepted that the TM8 on this matter was filed after the date set out in the UKIPO’s correspondence. The reason for the late filing of the TM8 was simply due to a clerical error in recording the response date into our records system which was accidentally inserted as the 13 March 2025, rather than the correct date. The Applicant fully intended to defend the Opposition and was not responsible for the late filing of the TM8. [...]”

9. On 23 April 2025, the Registry issued its preliminary view stating the following:

“[...] The applicant’s explanation for the late submission is deemed insufficient to permit the exercise of the Registrar’s limited discretion in such matters, that would permit the admission of these documents into the proceedings.

It is therefore the Registry's preliminary view that, as the notice of defence and counterstatement was filed outside of the statutory deadline, it cannot be permitted into the proceedings. [...]

If you disagree with the preliminary view, you can request a hearing within fourteen days from the date of this letter that is on or before **07 May 2025**. [...]"

10. The applicant on 24 April 2025 requested a hearing. A hearing was scheduled for 11 June 2025 and the details were sent to the parties in an official letter from the Tribunal on 28 April 2025. The applicant filed its skeleton argument on 6 June 2025. Only the applicant attended the hearing.

Skeleton Arguments

11. The applicant's skeleton argument reiterated the information from the previously submitted witness statement. With regard the facts relevant to exercise the Registrar's discretion conferred by Rule 18(2) Trade Mark Rules 2008, and with regard the legal test set in *Music Choice Ltd's Trade Mark* [2006] R.P.C. 13 ("*Music Choice*") the applicant submits that:
 - The error was simply the inclusion of an addition number in the deadline date which resulted in the deadline being missed by 10 days. This error was not picked up by the responsible fee earner who has responsibility for the case.
 - The Applicant intended to file Defence and that preparations were in hand to prepare and file the TM8 and Counterstatement which was filed on 13 March 2025, well before it came to the Applicant's Representative that the deadline had been missed.
 - There is nothing to suggest that the opponent's case has no merit.

- Prejudice would be caused to the Opponent in terms of costs if the late filed Form TM8 was to be admitted, however this could be compensated for via an award of costs to be taken into account at the final determination of the Opposition.

The Hearing

12. The hearing took place before me, via telephone conference, on Wednesday, 11 June 2025. Mr Fiddes represented the applicant.
13. At the hearing, I explained that the purpose of the hearing was to consider whether the late filed defence should be admitted into the proceedings. I also highlighted that the TM8 deadline is a non-extensible time limit, pursuant to the relevant case law and Trade Mark Rules 2008 (“the Rules”). However, my discretion to allow the Form TM8 to proceed to be examined is a narrow one which can only be exercised where there are compelling reasons or extenuating circumstances.
14. I further confirmed that I had received the skeleton argument from the applicant, and that I had read all the documents relevant to the case before me.
15. I note that this was a fairly brief hearing, and since only the applicant attended the hearing, I will briefly reassume the arguments and submissions.
16. Mr Fiddes’ submissions were foreshadowed in his skeleton arguments covering the criteria in *Music Choice*. Mr Fiddes started by referring to the late filing of the TM8, missing the deadline by 10 days. He highlighted that this oversight was entirely due to an error made by the applicant’s representative, who incorrectly entered the deadline into their record system, thereby making them the “author of their own misfortune”. Mr Fiddes emphasised that the deadline was missed by a relatively short period and the applicant had a clear intention to file their defence. Mr

Fiddes argued that both parties would face prejudice due to the significant time elapsed since the application was filed in March 2023. He then moved on to cover the other criteria in *Music Choice*, indicating the merits and nature of the opposition, namely being a section 5 opposition, the consequences of refusing the late TM8 form (i.e. refiling of another application). He contended that neither party should face adverse consequences due to this error and requested the Registry to exercise its discretion in this case.

17. Before concluding the hearing, I asked Mr Fiddes to elaborate on how the deadlines are recorded within their systems. Mr Fiddes explained that they have a centralised records team that handles all communications from the UK IPO, which are then sent to the relevant fee earner for review and documentation. Thus, he submitted that this oversight stemmed from a human error and was indeed a rare occurrence. Mr Fiddes concluded by requesting that no costs be awarded to the applicant for the hearing in question if the application was allowed into the proceedings. Conversely, he argued that only the TM7 fee should be awarded to the opponent, noting that the opponent had incurred no costs related to the hearing, had not filed any further submissions, and made no claims regarding costs.
18. At the hearing, I reserved my decision to give me an opportunity to properly reflect on the oral and written submissions put forward by the applicant. In making my decision, I have reviewed all of the papers on file, the applicant's skeleton argument, which I take into account.

Decision

19. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by Rule 18 of the Rules, which provides as follows:

“(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 shall begin on the notification date and end two months after that date”. (Emphasis added)

20. 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 rules 77(5)(a) and (b) which provide that:

“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. It was not disputed that the late filing of the applicant’s TM8 in this instance was not because of an irregularity, default, omission or other error on the part of, *inter alia*, the Registrar. Therefore, my consideration is restricted to the limb of the discretion contained in the words “unless the Registrar otherwise directs” under Rule 18(2).
22. 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.

23. 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 applicant's submissions and skeleton argument 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

24. The circumstances as to why the deadline was missed are summarised above. The stipulated deadline for the filing of the applicant's Form TM8 and counterstatement was 3 March 2025. However, the Form TM8 and counterstatement were filed by the applicant on 13 March 2025. Therefore, the deadline was missed by 10 days.

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. 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 permitted to defend the opposition, the proceedings will continue with the parties given an opportunity to file evidence, and the matters will be determined on their merits. However, if the applicant is not allowed to defend its application, it will be treated as abandoned, and the applicant will lose its filing date of 29 March 2023 for the opposed goods and services. Nevertheless, it will remain open to the applicant to re-file its application, which may, in turn, be open to opposition.

Any prejudice caused to the opponent by the delay

27. The applicant has submitted that the opponent would not be prejudiced as there was a relatively short delay in the filing of the defence.

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

28. There are no other relevant considerations.

Conclusions

29. In reaching my decision, I bear in mind that the deadline for filing a Form TM8 is a statutory one, with the applicant having been made fully aware of the consequences of failing to comply by way of correspondence from the Registry. 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. I also recognise that it may well be that the applicant's refiled application may again be opposed by the opponent resulting in further opposition proceedings arising at some point in the future.
30. Considering the specific circumstances in this matter, the reason for missing the initial deadline for the filing of Form TM8 was due to a critical oversight, resulting in the failure to file the Form TM8 and counterstatement in time. I bear in mind that the applicant was fully represented throughout these proceedings and that they entered into the (extended) cooling off period knowing that it will extend the period for filing the Form TM8 for a specified period of time, as per the Registry's official letter. At the hearing, Mr Fiddes asserted that the TM8 was not filed within the stipulated timeframe due to an oversight. However, I must note that, as very correctly Mr Fiddes himself acknowledged, this issue resembles a human error, which was not a technical failure, but rather a failure to accurately record the correct deadline in their system.

31. In *Praesidiad NV v Tescon Sicherheitssysteme Schweiz GMBH* (“Tescon”), BL O/240/20, Mr Geoffrey Hobbs QC (as he then was) as the Appointed Person stated at paragraph 32 that:

“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) [...] 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.”

32. Although *Tescon* concerned an application for invalidity, the same assessment is relevant to the late filing of a Form TM8 and counterstatement in opposition proceedings. Moreover, while, ultimately, the decision not to admit the Form TM8 into proceedings was upheld in *Tescon*, Mr Hobbs acknowledged that human errors can constitute extenuating circumstances or compelling reasons sufficient for the exercise of discretion, where the specific facts of the case merit it.

33. Whilst I acknowledge human error can occur, I find this is hardly a compelling reason in this case, especially as the applicant is professionally represented, and it does not appear that the “minimal degree of vigilance”² required has been exercised. There is no doubt that the Registry’s emails had been effectively delivered, and it was the applicant’s responsibility to implement further checks. Moreover, the responsibility of recording correctly the deadlines rests entirely with the applicant’s representative and by not doing so, it shows that there was a lack of an adequate formal procedure in place. It is apparent from Mr Fiddes witness statement and submissions that he did not become aware of the deadline until after it was

² See *Kickz AG v Wicked Vision Limited*, BL-O-035-11, in paragraph 15.

missed, suggesting that no checks were conducted over an extended period. I also note that the applicant was well aware of the cooling off period and its extension, the opposition process and the strict statutory two month deadline to file a Form TM8, as explicitly stated in the Registry's letters, along with the consequences for not submitting the Form TM8 by this deadline.

34. The filing of a Form TM8 is a relatively simple task, capable of being successfully carried out, irrespective of whether an applicant is represented. Taking all of the above into account and having regard to the factors set out in the case law in *Kickz*, *Mercury* and *Music Choice*, I am not satisfied that the reasons why the Form TM8 and counterstatement were filed 10 days late are particularly compelling, nor do they constitute extenuating circumstances sufficient to permit the Registrar to exercise its discretion under rule 18(2). I therefore find that the applicant was clearly "*the author of its own misfortune*".³

Outcome

35. The Registry's preliminary view is upheld. The late Form TM8 is not to be admitted into the proceedings. Consequently, as the opposition against the application at hand is deemed as undefended, the application will, subject to any successful appeal, **be treated as abandoned in relation to the following goods and services:**

Class 9: Downloadable electronic publications provided on-line from databases, the Internet or other telecommunications connection, all relating to legal and business consulting services; Computer software including software enabling document exchange, electronic file maintenance and communications; Computer software for collecting, processing, storing, sharing, reviewing, searching, retrieving, managing, categorizing, coding and producing records, documents, emails, and other materials and information, whether generated or

³ See *Kickz*, paragraph 15.

stored electronically or otherwise; all the foregoing related to legal and business consulting services.

Class 35: Business research, compilation and provision of business information; advisory services relating to business information; advisory services relating to business management, business organisation, acquisitions and mergers, franchising, preparation of reports, provision of information and advisory services all relating to the aforesaid services; business consultancy; the provision of commercial and business information and costs analysis; project advice, business risk management, information risk (including privacy and data risk) management, process management; personnel management, selection and recruitment, outplacement services; tax consulting and advisory services; consulting and advisory services relating to personnel management; business consultancy; statistical information, data processing; commercial consultancy; consultancy on international business management, consulting and advisory services relating to operational and supply change management and the development, organisation and implementation of policies and programs in relation to such services.

Class 36: Financial services provided by solicitors; investment, actuarial and pension services; trusteeship services; financial services in relation to taxation, tax planning and tax assessment services; debt recovery and collection; financial services relating to insolvency; consultancy, advisory and information services relating to all the aforesaid service; financial risk management and financial crime risk advisory services.

Class 42: Technical research, enquiry and investigation services; consultancy, advisory and information services relating to all the aforesaid services; Computer software services, namely developing, supporting, maintaining, and hosting computer software systems and programs, and providing computer software consulting services; all in the field of litigation and record management software, and in

connection with legal and business consulting services; Software as a service in the field of litigation and record management software, and in connection with legal and business consulting services; Computer consultancy in the field of litigation and record management software, and in connection with legal and business consulting services; consulting and advisory services relating to technology, cyber and ICT risk (and the development, organisation and implementation of policies and programs in relation to such services).

36. However, **the application will proceed to protection for the following unchallenged goods and services:**

Class 16: Printed matter, printed publications, pamphlets, brochures, manuals, books, instructional and teaching materials (other than apparatus), all relating to the law and the provision of legal services and business consulting services; Printed matter, printed publications, pamphlets, brochures, manuals, books; stationery and writing instruments; publications providing business information.

Class 41: Arranging and conducting of conferences and seminars; education and training services, all relating to the law and the provision of legal services and business consulting services; provision of information relating to the aforesaid services; provision of information relating to the aforesaid services provided on-line from a computer database, the Internet or other telecommunications connection; publication services providing business information.

Class 45: Legal services; legal research, enquiry and investigation services; company formation and registration services; establishment, maintenance and management of intellectual property rights, patent agency and trade mark agency services; advocacy, mediation and other dispute resolution services; legal services relating to business; consultancy, advisory and information services relating to all the aforesaid services; governance advisory services; consulting services connected to regulatory change and regulatory

enforcement risks; litigation and dispute resolution support services; Advice and consultancy services relating to health, safety and wellbeing risk, and the development, organization and implementation of related policies and programs for others; litigation and dispute support services; legal information services.

Costs

37. As my decision terminates the proceedings, I must consider the matter of costs. Awards of costs are set out in Tribunal Practice Notice (“TPN”) 1/2023. Using the guidance set out in the TPN, I award the opponent costs on the following basis:

Official opposition fee	£100
Preparing a notice of opposition	£250
Total	£350

38. I order Ashurst LLP to pay to Outpayce, S.A. the sum of £350. This sum is to be paid within two months of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of July 2025

Dr Stylianos Alexandridis

For the Registrar,

The Comptroller General

Annex 1 - Applicant's specification

Class 9: Downloadable electronic publications provided on-line from databases, the Internet or other telecommunications connection, all relating to legal and business consulting services; Computer software including software enabling document exchange, electronic file maintenance and communications; Computer software for collecting, processing, storing, sharing, reviewing, searching, retrieving, managing, categorizing, coding and producing records, documents, emails, and other materials and information, whether generated or stored electronically or otherwise; all the foregoing related to legal and business consulting services.

Class 16: Printed matter, printed publications, pamphlets, brochures, manuals, books, instructional and teaching materials (other than apparatus), all relating to the law and the provision of legal services and business consulting services; Printed matter, printed publications, pamphlets, brochures, manuals, books; stationery and writing instruments; publications providing business information.

Class 35: Business research, compilation and provision of business information; advisory services relating to business information; advisory services relating to business management, business organisation, acquisitions and mergers, franchising, preparation of reports, provision of information and advisory services all relating to the aforesaid services; business consultancy; the provision of commercial and business information and costs analysis; project advice, business risk management, information risk (including privacy and data risk) management, process management; personnel management, selection and recruitment, outplacement services; tax consulting and advisory services; consulting and advisory services relating to personnel management; business consultancy; statistical information, data processing; commercial consultancy; consultancy on international business management, consulting and advisory services relating to operational and supply change management and the development, organisation and implementation of policies and programs in relation to such services.

Class 36: Financial services provided by solicitors; investment, actuarial and pension services; trusteeship services; financial services in relation to taxation, tax planning and tax assessment services; debt recovery and collection; financial services relating to insolvency; consultancy, advisory and information services relating to all the aforesaid service; financial risk management and financial crime risk advisory services.

Class 41: Arranging and conducting of conferences and seminars; education and training services, all relating to the law and the provision of legal services and business consulting services; provision of information relating to the aforesaid services; provision of information relating to the aforesaid services provided on-line from a computer database, the Internet or other telecommunications connection; publication services providing business information;.

Class 42: Technical research, enquiry and investigation services; consultancy, advisory and information services relating to all the aforesaid services; Computer software services, namely developing, supporting, maintaining, and hosting computer software systems and programs, and providing computer software consulting services; all in the field of litigation and record management software, and in connection with legal and business consulting services; Software as a service in the field of litigation and record management software, and in connection with legal and business consulting services; Computer consultancy in the field of litigation and record management software, and in connection with legal and business consulting services; consulting and advisory services relating to technology, cyber and ICT risk (and the development, organisation and implementation of policies and programs in relation to such services).

Class 45: Legal services; legal research, enquiry and investigation services; company formation and registration services; establishment, maintenance and management of intellectual property rights, patent agency and trade mark agency services; advocacy, mediation and other dispute resolution services; legal services relating to business; consultancy, advisory and information services relating to all the aforesaid services; governance advisory services; consulting services

connected to regulatory change and regulatory enforcement risks; litigation and dispute resolution support services; Advice and consultancy services relating to health, safety and wellbeing risk, and the development, organization and implementation of related policies and programs for others; litigation and dispute support services; legal information services.