

**BL O/0685/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK4062179  
IN THE NAME OF GLASGOW FOOD MARKET LTD  
TO REGISTER THE TRADE MARK:**



**IN CLASSES**

**6,11,12,16,18,20,21,22,29,30,31,35,37,39,43**

**AND**

**THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT  
FILED IN DEFENCE OF THAT APPLICATION  
IN OPPOSITION PROCEEDINGS UNDER NO. 450701  
BROUGHT BY ALADDIN INDUSTRIES LLC**

## **BACKGROUND**

1. On 11 June 2024, GLASGOW FOOD MARKET LTD (“the Applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was accepted and published for opposition purposes on 09 August 2024 in respect of the following goods and services in Classes 6, 11, 12, 16, 18, 20, 21, 22, 29, 30, 31, 35, 37, 39, 43:
2. On 08 October 2024, Withers & Rogers LLP filed a notice of threatened opposition (Form TM7A) on behalf of Aladdin Industries LLC (“the Opponent”) a copy of which was emailed by the Registry to the Applicant.
3. On 11 November 2024, Withers & Rogers LLP filed a Form TM7 Notice of Opposition on behalf of the Opponent. The opposition is based upon Sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”), and is directed against all of the goods and services in the application.
4. On 25 November 2024, the Registry served the TM7 on the Applicant by email and by post to the email address and to the postal address for service held on record for the Applicant.
5. The serving letter provided the Applicant a deadline of 27 January 2025 by which to file its Form TM8 ‘Notice of defence and counterstatement’. The Registry’s letter contained the following information (original emphasis):

“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 27 January 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.**”

6. The applicant, who is unrepresented, did not file a TM8 by the given deadline. On 04 February 2025, the Registry wrote to the Applicant (again sending its correspondence by post and email), stating that (original emphasis):

“The official letter dated **25 November 2024** invited the applicant to file a TM8 and counterstatement on or before **27 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, **18 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.

If no response is received the registry will proceed to deem the application abandoned.”

7. On 05 February 2025, Ali Masri, being the Director of the Applicant, emailed the Registry in reply to the Registry’s official letter of 04 February 2025. The email contained, as attachments, the Applicant’s TM8 and counterstatement, as well as an accompanying signed Witness Statement, dated 05 February 2025, in the name of Mr Masri. It is noted that the Form TM8 and Witness Statement were sent from a different email address than the one held on record for the applicant. Mr Masri’s statement cited an ‘unforeseen administrative oversight and exceptional work commitments’ as the reasons for the delay, as well as mentioning that he was “heavily engaged in critical business operations” during this period.
8. On 24 March 2025 the Registry replied to the Applicant by post and email issuing a preliminary view not to admit the TM8 Notice of Defence and counterstatement into the proceedings as they were filed outside of the statutory deadline. The letter stated that the Applicant’s reasons for the late submission was deemed insufficient for the Registrar to exercise his limited discretion such that he could permit the admission of the late-filed documents into the proceedings.
9. The Applicant was given a deadline of 07 April 2025 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 26 March 2025, the Applicant formally responded to the preliminary view with further written reasons for missing the deadline, as well as requesting to be heard on the point.
11. A Hearing was scheduled, however, the Applicant confirmed that it would not be able to attend in person and instead filed written submissions in lieu. The Opponent also confirmed that it would not be attending the hearing, nor would it be filing any written submissions in lieu. Consequently, I make the following decision having considered, in full, the papers before me.

### **Preliminary issue**

12. In its Witness Statement of 05 February 2025, the Applicant submitted that the deadline for filing the TM8 was missed because of an “unforeseen administrative oversight and exceptional work commitments”. Following this, the Applicant, in its written submissions of 26 March 2025, stated that the delay in filing the TM8 was due to “operational military services and legitimate business pressures”. Further, on the 04 April 2025 the Applicant reiterated that due to his full-time military service, he “was subject to operational training, mobilisation, and overseas deployment during the relevant period.” He added that he “was undergoing redeployment training, followed by pre-deployment exercises [...]” and is “currently deployed abroad with the British Army until mid-August 2025”. On this point the Registry wrote to the Applicant on 15 May 2025 stating the following:

“Following your submissions dated 04th April 2025 I note that you have stated that one of the reasons for not filing the TM8 form in time was due to your full-time military service where you were subject to operational training, mobilisation, and overseas deployment, as well as redeployment training and pre-deployment exercises. Whilst this information may be useful, it is not in the format of a signed witness statement and therefore the veracity of the statement could be called into question. The original witness statement dated 05 February 2025 at

2.1 states that ‘an unforeseen administrative oversight and exceptional work commitments’ were the reason for the delay however this is considered vague. In order for your clarified claims of 04th April 2025 to be considered a supplementary signed witness statement may be submitted within 7 days of this letter. If no response is received the decision will be issued regardless.”

At the date of writing this decision, no response to this communication has been received from the Applicant.

### **Decision**

13. 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.”

14. 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-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.”

15. There is no suggestion that there has been any irregularity on the part of the Registry. 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).
16. In approaching the exercise of discretion in these circumstances, I take into account the decisions in *Kickz AG v Wicked Vision Limited* (“*Kickz*”) <sup>1</sup> and *Mark James Holland v Mercury Wealth Management Limited* (“*Mercury*”) <sup>2</sup> i.e. I have to be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the Applicants’ favour.
17. In *Music Choice Ltd’s Trade Mark* [2005] RPC 18 (“*Music Choice*”), the Court indicated that a consideration of the following factors (shown below in bold and underlined) 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 submissions made on behalf of the Applicant 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**

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<sup>1</sup> BL O/035/11

<sup>2</sup> BL O/050/12

18. As noted above, the stipulated deadline for the filing of the Applicant's Form TM8 and counterstatement was **27 January 2025**. The Form TM8 and counterstatement was filed by the Applicant on **05 February 2025**, in response to the Registry's letter of 04 February 2025. Therefore, the deadline was missed by 9 days.
19. The Applicant's explanation as to why the deadline was missed is summarised in Mr Masri's Witness Statement, i.e. an "unforeseen administrative oversight and exceptional work commitments". In its written submissions in lieu of a hearing, the Applicant elaborated by stating that it was due to "operational military services and legitimate business pressures", as well as being "subject to operational training, mobilisation, and overseas deployment during the relevant period", and "undergoing redeployment training, followed by pre-deployment exercises" that the deadline was missed. Additionally, the Applicant submitted that, as well as his active military service, he manages multiple business ventures, and, during the relevant period was overseeing a legal and operational transition involving the restaurant arm of his business. Further, also in its written submissions, the Applicant stated that in addition to his military obligations, he had been managing urgent personal matters, including supporting his father through ongoing cancer treatment, which added to the strain on his ability to meet procedural deadlines.

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

20. The Opponent relied upon grounds under Sections 5(2)(b) and 5(4)(a) of the Act. Whilst it is not for the present decision to determine the merits of the case, for the purpose of the criteria under consideration it is sufficient to note that there is an arguable case to be determined which requires a number of careful multifactorial assessments.

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

21. If the Applicant is allowed to defend the opposition, the proceedings will continue with the parties being given an opportunity to file evidence and the matter will be determined on its merits. However, if the Applicant is not allowed to defend the opposition, its application will be deemed abandoned, and the Applicant's mark will lose its filing date of 11 June 2024. It will also remain open to the Applicant to re-file its application which may, in turn, be opposed again by the Opponent.

**Any prejudice caused to the Opponent by the delay**

22. No submissions were made regarding prejudice to the Opponent. However, I note the inevitable costs and additional time associated with delays of this type.

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

23. There do not appear to be any other relevant considerations and there are no related proceedings between the parties.

**Considerations**

24. 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. However, as the loss of priority and possibility of further proceedings on much the same basis is often the consequence of a failure to comply with the non-extensible deadline to file a TM8, these are not factors that, in my view, are particularly compelling.

25. In the official letter dated 27 January 2025, the Tribunal made it very clear that failure to file a form TM8 by the deadline would in most circumstances result in the application being treated as abandoned. I accept that the applicant is unrepresented, and that the defence of a trade mark opposition may be somewhat confusing to those unfamiliar with the process. However, the filing of form TM8 is a relatively simple task, and the Tribunal receives many defences from litigants in person who successfully defend opposition to their trade mark applications in a timely manner without professional representation.
26. I appreciate Mr Masri's submission that he is the sole director of the Applicant, and that he was subject to operational training, mobilisation, and overseas deployment during the relevant period. However, he has not provided any details about these activities, such as the dates these activities took place, how long they were for, or how long he was deployed overseas. The Applicant claimed that due to this active military commitments his ability to attend to the TM8 was limited, however, his submissions establish that he was able to, whilst on deployment, actively oversee a legal and operational transition involving the restaurant arm of his business. This, in my view, demonstrates that Mr Masri was capable of attending to business matters whilst also being engaged in active military service, prioritising the overseeing of a legal and operational change in one of his businesses. As such, it is my view that he was also capable of attending to the filing of the Form TM8 form during the relevant period. Additionally, I accept that the Applicant may have been out of the country, however I do not accept this as a compelling or justifiable reason to allow the TM8 into proceedings. It is incumbent on businesses, even small ones, that they should be able to operate effectively in prolonged periods of absence by their directors/owners. It is not unreasonable to have expected some sort of correspondence from the Applicant prior to the deadline for filing the Form TM8, even if this was merely to communicate its intention to defend the application in the opposition proceedings and to explain the situation with regard to Mr Masri's absence. Further, I have considerable sympathy for Mr Masri's situation regarding his father and have no doubt that this was distressing, however, as established above, Mr Masri's submissions show that he was capable of managing a variety of business responsibilities during the relevant period whilst

also being engaged in active military service, and I do not view this as a justifiable reason for not also being able to attend to the filing of the form TM8.

27. Taking all of the above into account, I am not satisfied that the discretion provided under rule 41(6) should be exercised in the Applicant's favour. Upon careful consideration of all the submissions and the factors set out in the case law in *Kickz*, *Mercury* and *Music Choice*, I see no compelling reason or extenuating circumstance which would justify the use of the registrar's discretion provided under Rule 41(6).

## CONCLUSION

28. 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 proceedings will be treated as undefended and the application is deemed abandoned in respect of all of the goods and services applied for.

## COSTS

29. 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.<sup>3</sup> I assess these as follows:

Official fee for filing the form TM7:	£200
Preparing the statement of case:	£250
<b>Total:</b>	<b>£450</b>

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<sup>3</sup> As the oppositions proceedings were brought after 1 February 2023.

30. I therefore order GLASGOW FOOD MARKET LTD to pay the sum of £450 to Aladdin Industries LLC. The above 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 23<sup>rd</sup> day of July 2025**

**Oliver Rose'Meyer  
For the Registrar**