

BL O/0812/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 3998094  
IN THE NAME OF BELLAROSA LTD  
TO REGISTER THE TRADE MARK:

**BELLAROSA**

IN CLASS 25

-AND-

THE LATE FILING OF DEFENCE AND COUNTERSTATEMENT  
FILED IN DEFENCE OF THAT APPLICATION  
IN OPPOSITION PROCEEDINGS UNDER No. 447026  
BROUGHT BY BELLEROSE BELGIUM, SOCIÉTÉ ANONYME

## **BACKGROUND**

1. On 4 January 2024, BELLAROSA LTD (“**the Applicant**”) applied to register the trade mark shown on the cover page of this decision in the UK in respect of the following goods in Class 25: “*Tights*”. The application was accepted and published for opposition purposes on 19 January 2024.
2. On 13 March 2024, Baron Warren Redfern filed a notice of threatened opposition (Form TM7A) on behalf of Bellerose Belgium, Société anonyme (“**the Opponent**”) a copy of which was emailed by the Registry to the Applicant.
3. On 19 April 2024, Baron Warren Redfern filed a Form TM7 Notice of Opposition and statement of grounds on behalf of the Opponent, opposing the application on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”).
4. On 24 April 2024, the Registry served the TM7 on the Applicant by email (sent to the email address held on record for the Applicant i.e. ‘b.slisinski@gmail.com’), and it was also served by post (to the London Road, Derby postal address for service held on record for the Applicant).
5. The serving letter provided the Applicant a deadline of 24 June 2024 by which to file their 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 [...].

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 24 June 2024.**

Rule 18(2) of the Trade Marks Rules 2008 states that “*where an applicant fails to file a Form TM8 within the relevant period, the application for registration, insofar as it relates to the goods and services in respect of which the opposition is directed, shall, unless the registrar otherwise directs, be treated as abandoned.*”  
**It is important to understand that if the deadline date is missed, then in almost all circumstances, the application will be treated as abandoned.”**

6. On 2 July 2024, the Registry wrote to the Applicant (again sending its correspondence by post and email), stating that (original emphasis):

“The official letter dated 24 April 2024 invited the applicant to file a TM8 and counterstatement on or before 24 June 2024.

As no TM8 and counterstatement has been filed within the time period set, Rule 18(2) applies. Rule 18(2) states that the application:

“... shall, unless the registrar otherwise directs, be treated as abandoned.”

The Registry is minded to deem the application as abandoned as no defence has been filed within the prescribed period.

If you disagree with the preliminary view you **must** provide full written reasons and request a hearing on, or before, **16 July 2024**. This **must** be accompanied by a Witness Statement setting out the reasons as to why the TM8 and counterstatement are being filed outside of the prescribed period.

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

7. On 6 July 2024, Mateusz Slisinski, emailed the Registry on behalf of the Applicant in reply to the Registry’s official letter of 2 July 2024. The email had the Applicant’s TM8 and counterstatement attached (the reply was sent by email from ‘mateuszslisinski1@gmail.com’). as well as an accompanying Witness Statement in the name of, Mateusz Slisinski (a director of BELLAROSA LTD) dated 4 July 2024. Mr

Slisinski statement cited three reasons as the cause for the missed deadline, which he stated were “*circumstances beyond our control*”.<sup>1</sup> These three reasons are detailed in the Witness Statement as follows (my emphasis for clarity):

“Introduction:

I, Mateusz Slisinski, of BELLAROSA LTD, 21 London Road, Kegworth, Derby, DE74 2EU, make this witness statement in support of our request to allow the late filing of the TM8 and counterstatement in opposition proceedings number OP000447026.

[...]

Circumstances Leading to Delay:

**2. Unforeseen Circumstances Abroad:** In the months leading up to the deadline for filing the TM8 and counterstatement, I, along with other key members of our team, were abroad setting up operations at our new manufacturing facility. This expansion was crucial for meeting the growing demand for our products and improving our supply chain efficiency.

**3. Mail Directed to Old Office:** Unfortunately, during this period, critical correspondence, including the notification of opposition, was sent to our former office address. This address change had not been updated in all necessary records, and as a result, we did not receive the opposition notice and related documents in a timely manner.

**4. Delayed Notification Retrieval:** By the time we returned and retrieved the forwarded mail, the deadline for filing the TM8 and counterstatement had already passed. The delay in receiving this crucial information was beyond our control and was due to an unfortunate oversight during our relocation process.”

8. On 23 July 2024 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 Registry

---

<sup>1</sup> Paragraph 5 of the Witness Statement of Mateusz Slisinski dated 4 July 2024.

stated that 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.

9. The Applicant was given a deadline of 6 August 2024 by which to request a hearing if it disagreed with the preliminary view, and 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. In light of the Applicant's statement that it had moved offices, the Registry also made the following direction in its letter of 23 July 2024:

"If the applicant wishes to request a hearing to challenge the preliminary view, they are also requested to file a Form TM21A with the Registry to update their contact details."

10. On 30 July 2024, the Applicant objected to the preliminary view requesting to be heard on the point, and complied with the above direction by filing a Form TM21A, which contained an updated postal address for service, being Ludlow Close, Leicestershire (the old address being listed as London Road, Derby) and confirmed the email address as 'b.slisinski@gmail.com' (i.e. the email address already held on file by the Registry.)

11. A hearing was scheduled. The Opponent confirmed it would not be attending the hearing and it did not file submissions in lieu of attendance. The Applicant did not confirm it would be attending the hearing however Mr Mateusz Slisinski joined the telephone conference on the day. Since the Applicant has no professional legal representation in these proceedings, it was not required to file skeleton arguments in advance of the hearing.

## **THE HEARING**

12. The hearing took place before me via telephone conference, on Wednesday 21 August 2024. Mr Mateusz Slisinski represented the Applicant.

13. At the hearing I ran through the background of events leading up to the hearing then invited Mr Slisinski to present his submissions.

14. Mr Slisinski began by stating that the reasons were the same as those contained in his Witness Statement. He elaborated on that by stating that the Applicant is a new company that just started up business in March last year and that there was so much work and so much going on that they did not even notice that an opposition had been filed against their trade mark application, and that they did not want to *“give it up just because we were late on our submission”* (I presume he meant give up the trade mark application).

15. He continued by submitting that *“it was very unlucky timing because we had to go abroad and set up our factory abroad and the emails and or post was received by somebody that was not even connected with our company anymore, because after we moved offices there was another company there and when it was too late, they told us that there was loads of correspondence, and that’s when we found out about the opposition”*. To his credit he admitted that it was the Applicant’s fault for not having filed the form on time.

16. In light of this submission I noted that he had made no reference to emails in his Witness Statement and that this was the first time he had mentioned emails. I therefore asked him to elaborate more on what he meant by the emails and post being received by somebody else. In response he informed me that when they moved out of their old office a new company moved in straight after them, but their *“postal letters”* were still going to their old office, and that when it was too late they (referring to the new tenants of the Applicant’s old office) *“informed us that there were a lot of messages and letters waiting for us. So as soon as we got back to the UK, we went to pick them up”*. The discussion at the hearing continued as follows:

HEARING OFFICER: You went to pick up your post?

APPLICANT: Yes, and then obviously I changed the address of the office to the new office.

HEARING OFFICER: Right. So you changed the address of the office; can you just explain to me a bit more about the emails?

APPLICANT: Yes. We did not have an official company email address. It was firstly registered with one of the worker’s personal email address which is also unfortunate.

HEARING OFFICER: The email address you provided was the email address we had on file, so I don't understand what point you are trying to make about the emails being read [...].<sup>2</sup>

APPLICANT: It was not an official email address. It was just an email address for meanwhile being while we finished setting up the brands on Amazon and we just needed a trade mark basically to register on the brand registry on the Amazon seller's account. Therefore we did not expect. We did not make it ready in time for any opposition to email us, and therefore we did not see the emails either.

HEARING OFFICER: You didn't see your emails?

APPLICANT: No, because it was an email used by a private worker, his private email, and [...]<sup>3</sup> basically did not check it on time.

HEARING OFFICER: *He* didn't check it on time?

APPLICANT: Yes, because he did not expect to receive any important emails on this email because it was not supposed to be used for a long time as our company email. At the minute we've got a new company email but obviously it's too late now.

HEARING OFFICER: What do you mean you have a new company email?

APPLICANT: Now we have an official email – 'dbellarossa@.co.uk'.

HEARING OFFICER: So what was the other email?

APPLICANT: It was 'b.slisinski@gmail.com' I believe.

17. At this point I asked Mr Slisinski to bear with me whilst I checked the Registry's file because I wanted to double check the Form TM21A filed by Mr Slisinski on behalf of the Applicant on 30 July 2024. The email address contained in the form was 'b.slisinski@gmail.com', which was not an updated email address, but the one the Registry had on file all along i.e. the one which had been originally provided when the

---

<sup>2</sup> At this point in my sentence, Mr Slisinski interjected and I had intended to say "*read by somebody else*".

<sup>3</sup> The next word was inaudible. I thought Mr Slisinski had said 'he' so I sought clarification in my subsequent question.

Applicant had applied for its mark. After having reviewed the file, the discussion continued as follows:

HEARING OFFICER: The address [contained in the Form TM21A] is 'b.slisinski@gmail.com', so that's the email you confirmed in your TM21A which is the one that we had all along.

APPLICANT: Yes, because I did not want to change it. We already knew after we checked it that everything is coming to that address, so we kept checking it, but at the beginning we didn't realise that such important correspondence is going to come there.

HEARING OFFICER: Do you have anything else to add?

APPLICANT: No not really, it's just we would appreciate a chance to confront the opposition and that's it.

## **DECISION**

18. 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."

19. 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.”

20. There is no suggestion that there has been any irregularity on the part of the Registry. Consequently, the only basis on which the Applicants may be allowed to defend the opposition proceedings is if I exercise in their favour the discretion afforded to me by the use of the words “*unless the registrar otherwise directs*” in rule 18(2).

21. In approaching the exercise of discretion in these circumstances, I take into account the decisions in *Kickz AG v Wicked Vision Limited* (“*Kickz*”)<sup>4</sup> and *Mark James Holland v Mercury Wealth Management Limited* (“*Mercury*”)<sup>5</sup> i.e. I have to be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the Applicants’ favour.

22. In *Music Choice Ltd’s Trade Mark* (“*Music Choice*”),<sup>6</sup> 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 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

23. As noted above, the stipulated deadline for the filing of the Applicant’s Form TM8 and counterstatement was **24 June 2024**. The Form TM8 and counterstatement was filed by the Applicant on **6 July 2024**, in response to the Registry’s letter of 2 July 2024. Therefore the deadline was missed by 12 days.

---

<sup>4</sup> BL O/035/11

<sup>5</sup> BL O/050/12

<sup>6</sup> [2005] RPC 18

24. The Applicant's explanation as to why the deadline was missed is summarised in Mr Slisinski's Witness Statement above, i.e. "*unforeseen circumstances abroad*", "*mail directed to old office*" and "*delayed notification retrieval*". At the hearing Mr Slisinski elaborated on this and stated that not only had they not been in receipt of their post because they were abroad and because it was going to their old address, but they also had not checked their emails because the email address used (i.e. 'b.slisinski@gmail.com') was the private email address of one of the Applicant's workers.

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 will be treated as abandoned and the Applicant's mark will lose its filing date of 4 January 2024.

Any prejudice caused to the opponent by the delay

27. No submissions were made regarding prejudice to the Opponent.

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

28. There do not appear to be any other relevant considerations.

**Conclusions**

29. It is important to be clear as to what is really sought when a request is made for the Registry to exercise its discretion: it is an application for an extension of time to a non-extendable deadline. These extensions are therefore only granted exceptionally where there are compelling reasons or extenuating circumstances justifying it.

30. In reaching my decision, 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 the filing date for its mark. I further recognise that it remains open to the Applicant to re-file an 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 a filing date and the 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, these are not factors that are particularly compelling, nor do they constitute extenuating circumstances sufficient to permit the Registrar to exercise its discretion. I must instead consider the specific circumstances at hand.

31. As I have already noted, the Registry served the TM7 on the Applicant by post using the Applicant's chosen address for service (the 'London Road, Derby' address) and by email (using the Applicant's chosen address for correspondence i.e. 'b.slisinski@gmail.com'). There is no question that the Registry followed the correct procedure in serving the TM7 on the Applicant.

32. Even in Mr Slisinski's Witness Statement, in which he states that the Applicant had changed its office address, he confirms the address of the Applicant in the first line of the statement as the 'London Road, Derby' address i.e. the 'old office address'.

33. The reasons for the missed deadline, as set out in the Witness Statement, boil down to an assertion that "*key*" members of the Applicant's team were not in the UK in the "*months leading up to*" the TM8 deadline because they were attending to business abroad, and also during this period the Applicant had relocated its offices in the UK which resulted in their postal correspondence being sent to their old address. By the time they returned from abroad and retrieved their "*forwarded mail*", the deadline had passed which was attributed to "*an unfortunate oversight during [the] relocation process*". All being circumstances Mr Slisinski deemed as being beyond the Applicant's control.

34. The issue with regard to the post not reaching the Applicant in time (because the Applicant's team were abroad and because they had moved offices) was re-confirmed by Mr Slisinski at the hearing, he elaborated on this reason by stating that new tenants had moved into their old office straight away yet the Applicant's post was still being sent there. It was those tenants that had not let the Applicant know that it had postal

correspondence waiting for them, and it wasn't until the Applicant's 'team' returned from abroad that they picked up their post from their old office.

35. At the hearing, Mr Slisinski made mention of emails being received by somebody else who *"was not even connected with our company anymore"*. This was the first time he had mentioned emails (since his Witness Statement only makes reference to postal correspondence). When I queried him about this, he informed me that the email address provided i.e. 'b.slisinski@gmail.com' was the personal email address of one of the Applicant's employees and that this employee had not checked his emails because he didn't expect to receive such important correspondence to this email address; and that this email address was never intended for long-term use, it was only used for the time being.

36. As I have already noted above, following the assertions made in the Witness Statement with regard to the change of postal address of the Applicant, the Registry directed the Applicant to file a Form TM21A to update its contact details. The filing of this form therefore came after the filing of the Applicant's Witness Statement. The postal address was changed from the 'London Road, Derby' address to the Leicestershire address, and the contact email address provided was 'b.slisinski@gmail.com', which was in any event the email address that the Registry had on file all along i.e. the address the Registry had been using to correspond with the Applicant. Therefore, when he filed the Form TM21A, Mr Slisinski did not change the email address. At the hearing he submitted that he did not want to change it because he realised that that was the email address being used for correspondence in relation to the opposition.

37. It is apparent therefore that at some point between the Applicant having applied for its trade mark and the serving of the Form TM7 Notice of Opposition, the Applicant changed its postal address and it had not notified the Registry. It is clear that it had not however changed its email address, and notwithstanding Mr Slisinski's submission that the emails were being received by someone who wasn't even connected with the company anymore, and that this email address was a private email address, Mr Slisinski nevertheless still provided that person's email address in the Form TM21A after being directed by the Registry to update the Applicant's contact details.

38. The onus rests with a trade mark proprietor to ensure that the relevant details attached to their trade mark are correct, in particular their name and address details, and to ensure that these details are kept up-to date. If an old address is recorded on the Register this cannot be regarded as a defence in the event of a failure to file a Form TM8. Notifying the Registry of a change of address is, and continues to be, throughout all stages of proceedings, completely within the Applicant's control. This does not represent an extenuating circumstance.

39. Nor is it an extenuating circumstance that the Applicant failed to put sufficient measures in place to ensure continued receipt of its postal correspondence notwithstanding its office relocation.

40. The Applicant asserts that it did not see the email correspondence because the employee (whose personal address it was) didn't check his emails in time. However, this is not an extenuating circumstance. The choice of email address was completely within the Applicant's control, and failure to check an email does not mean that the email was not received, and there is nothing before me to suggest that the inbox of the Applicant's chosen email address was not in receipt of the Registry's email correspondence on 24 April 2024. In this regard I note that rule 79(1) of the Rules provides that (my emphasis for clarity):

“The delivery using electronic communications to any person by the registrar of any document is deemed to be effected, unless the registrar has otherwise specified, by transmitting an electronic communication containing the document to an address provided or made available to the registrar by that person as an address for the receipt of electronic communications; and unless the contrary is proved **such delivery is deemed to be effected immediately upon the transmission of the communication.**”

41. I fail to see how a change in postal address or a trip abroad would have affected the Applicant's ability to receive email correspondence since the receipt of email correspondence is not dependent on a recipient's physical location, the way in which postal correspondence is.

42. Therefore, even though “key” members of the Applicant's team were working abroad, this would not have prevented them from dealing with email correspondence

from the Registry. Whilst they may have been busy setting up operations at their new manufacturing facility, they were given two months in which to file the Applicant's defence, which was not only ample time for this relatively simple task, it also means they had a two month window in which to check their emails (but they did not), and a two month window in which to make arrangements for the redirection of their post (but they did not make such arrangements).

43. Another factor against the Applicant which I also take into account, is that the Applicant's filing of its TM8 appears to have been reactive as opposed to proactive, since it appears the response was eventually prompted following receipt of the Registry's letter dated 2 July 2024, (especially when taking into consideration that the Witness Statement was signed merely two days after, on 4 July 2024, and the TM8 was eventually filed merely 4 days after, on 6 July 2024).

44. The deadline for filing a TM8 is a statutory one, and applicants are made fully aware of the consequences if they fail to comply. Taking all of the above into account, I am not satisfied that the reasons why the Form TM8 and counterstatement were filed 12 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.<sup>7</sup>

## **OUTCOME**

45. The Registry's preliminary view is upheld. The Applicant's late filed TM8 and counterstatement are therefore not admitted into proceedings and consequently the opposition against the application is deemed as undefended. Trade mark application number 3998094 will, subject to any appeal, be treated as abandoned.

## **COSTS**

46. Given that the outcome of this decision has terminated the proceedings, the Opponent is entitled to a contribution towards its costs. In the circumstances, I award the Opponent the sum of £350, based on the scale set out in TPN 1/2023, as a contribution towards the cost of the proceedings. The sum is calculated as follows:

---

<sup>7</sup> See *Kickz*, paragraph 15.

Official fee	£100
Preparing the statement of grounds	£250
<b>TOTAL</b>	<b>£350</b>

47. I therefore order BELLAROSA LTD to pay Bellerose Belgium, Société anonyme the sum of **£350**. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 23<sup>rd</sup> day of August 2024**

**Daniela Ferrari**  
**For the Registrar**