

O/0910/26

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK REGISTRATION NO. UK00003082972
PREVIOUSLY IN THE NAME OF TIFFIN BEATS LTD. NOW BONA VACANTIA
FOR THE FOLLOWING TRADE MARK:**

Junai Kaden

IN CLASSES 9, 16, 18, 28, 38 AND 41

AND

**THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT
FILED IN DEFENCE OF INVALIDATION PROCEEDINGS UNDER NO. 509400
BY JUNAID BUTT**

Background

1. Tiffin Beats Ltd. was originally the registered proprietor (“TBL”) at the time of filing the UK trade mark displayed on the cover page of this decision (“the contested mark”). The trade mark was filed on 25 November 2014 and registered on 27 February 2015 for goods and services in classes 9, 16, 18, 28, 38 and 41.

2. On 10 September 2025, Junaid Butt (“the applicant”) made an application to invalidate the contested mark pursuant to sections 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”). This was directed against all the goods and services of the contested mark.

3. The Registry served the Form TM26(I) on TBL by both email and post on 22 September 2025. In accordance with rule 41(6) of the Trade Mark Rules 2008 (“the Rules”), TBL was informed that it had two months from the date of the official letter in which to file its Form TM8 and counterstatement. The relevant paragraphs of the letter are as follows:

“Rule 41(6) 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.

IMPORTANT DEADLINE: A completed Form TM8 MUST be received on or before 24 November 2025

In accordance with rule 41(6) if the TM8 and counter-statement are not filed within this period, (a period which cannot be extended), the registration of the mark shall, unless the registrar otherwise directs, be declared invalid in whole or part. **It is important to understand that if the deadline date is missed, then in almost all circumstances, the registration will be treated as invalid in whole or part.**” (Original emphasis)

4. However, given that the letter to TBL was returned marked as ‘Addressee Gone Away’ another letter was issued on 21 October 2025 re-setting the deadline for the proprietor to file its Form TM8. The pertinent paragraphs are as follows:

“Please find enclosed a letter dated 22 September 2025 that was sent to you via Royal Mail’s “Signed for” service and also to your email address jamal@hgmm.co.uk. This letter was returned by the Royal Mail marked “Addressee Gone Away”.

As service is deemed not to have been effected, this letter is being issued by Royal Mail standard post and the period allowed for the applicant to file TM8 and counterstatement has been reset. This is in accordance with the description of “effective service” as set out in Section 7 of the Interpretation Act 1978, and the Appointed Person’s decisions in BL O/0051/23 MARCOS and BL O/874/22 MySmile Please find enclosed a copy of a TM26(I), application for invalidity, filed against your registration.

[...]

Rule 41(6) 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.

IMPORTANT DEADLINE: A completed Form TM8 MUST be received on or before 22 December 2025

In accordance with rule 41(6) if the TM8 and counter-statement are not filed within this period, (a period which cannot be extended), the registration of the mark shall, unless the registrar otherwise directs, be declared invalid in whole or part. **It is important to understand that if the deadline date is missed, then in almost all circumstances, the registration will be treated as invalid in whole or part.**” (Original emphasis)

5. Before 22 December 2025 deadline, the proprietor filed a Form TM8 on 19 December 2025. However, on 14 January 2026, the Registry informed TBL that the Form TM8 was not acceptable and set a deadline of 4 February 2026 for TBL to file

an amended Form TM8. Again, prior to the deadline on 29 January 2026 TBL filed an amended Form TM8.

6. Following the receipt of the amended Form TM8, it came to the Registry's attention that TBL was not the correct owner of the trade mark in question. On 22 December 2025, a Form TM16¹ was filed requesting that the ownership of the contested mark be changed from Tiffin Beats Ltd. (06622866) to TBL based on an assignment dated 16 May 2023. This was actioned by the Registrar as it was not aware at the time that Tiffin Beats Ltd. (06622866) had been dissolved in 2016, prior to any assignment of the mark. On learning this, the Registrar wrote to TBL on 24 March 2026 explaining that the contested mark would therefore fall under Bona Vacantia and belong to the Crown; and provided a link regarding the next steps in relation to Bona Vacantia.

7. Promptly, on the same day, TBL filed Form BVC8 with the Government Legal Department for the purpose of obtaining the trademark from the Crown.

8. On 2 April 2026, the Registry wrote to TBL acknowledging the receipt of Form BVC8 to the Government Legal Department and requesting that TBL file a Form TM27 as it was no longer the proprietor so it could become an intervener as a party with an interest in the proceedings. The relevant parts are replicated below:

“However, the Registry requests that Tiffin Beats Ltd files a Form TM27 instead, requesting leave to intervene. This Form can be filed by any person, other than the registered proprietor, claiming to have an interest in proceedings on an application for invalidity, as per Rule 45 of the Trade Marks Rules 2008.

Whilst the Registry awaits the filing of the Form TM27, the Form TM26(i) has been served to the Government Legal Department (as the UK00003082972 mark is Bona Vacantia).”

9. On 8 April 2026, TBL filed a Form TM27 as instructed to do so. Relevant to these proceedings I observe that in the Form TM27 filed by the proprietor under section 6 ‘*Statement of reasons for making this application*’ it states:

¹ Application to record a change of ownership.

“4. RELIEF SOUGHT

[...]

(b) The applicant for intervention be permitted to rely upon the amended counterstatement filed on 29 January 2026 as its statement of intervention;”

10. On 17 April 2026, the Registry wrote to the Government Legal Department providing a copy of the Form TM26I for them to consider and informing them that TBL had filed a Form TM27 to intervene in the proceedings. On the same day they also wrote to TBL, **now the intervener**, informing them that it was the Registry’s preliminary view to accept TBL’s request to intervene,² giving the parties until 1 May 2026 to object to this preliminary view. The Registry also included the following in the same letter:

“Please note that on 2 April 2026, the Tribunal served a Form TM26(I) on the Government Legal Department and, in accordance with Rule 74, reset the deadline for filing a Form TM8 to 2 June 2026. Accordingly, Tiffin Beats Ltd is required to re-file its Form TM8 on or before **2 June 2026** for it to be considered.”

11. I observe that on 20 April 2026, TBL wrote to the Tribunal with the following:

“Thank you for your letter dated 17 April 2026.

Tiffin Beats Ltd (Company No. 14867418) welcomes the Tribunal's preliminary view that its application to intervene should be granted and confirms it does not object to that preliminary view.

Tiffin Beats Ltd notes the requirement to re-file its Form TM8 on or before 2 June 2026 and will comply with that deadline.

² The intervener’s role being akin to the proprietor’s role in these proceedings and therefore being governed under the same rules as the proprietor. In particular and relevant to these proceedings Rule 41(6).

We will keep the Tribunal informed of progress with the BVC8 application to the Government Legal Department, which remains ongoing.”

12. However, TBL did not re-file a Form TM8 by the prescribed deadline of 2 June 2026, and so, on 25 June 2026, the Registry wrote to the intervener stating:

“Our letter dated 17 April 2026 invited you to re-file a Form TM8 and counterstatement on or before 2 June 2026.

As no TM8 and counterstatement have been filed within the time period set, Rule 41(6) applies. Rule 41(6) states that:

“The proprietor shall, within two months of the date on which a copy of Form TM26(I) and the statement was sent by the registrar, file a Form TM8, which shall include a counter-statement, otherwise the registrar may treat the proprietor as not opposing the application and registration of the mark shall, unless the registrar otherwise directs, be declared invalid.”

It is our preliminary view to treat the proprietor as not opposing the application for invalidation and to declare the registration invalid 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, **9 July 2026**.

If no response is received by this date, we will issue a written decision, declaring the registration invalid (to the extent that the application for invalidation has been made) because of the failure to file a defence.”

13. On the same day, TBL re-filed an amended Form TM8 defending the invalidation proceedings, and a witness statement of Permjit Hirani, Director of TBL.

14. The witness statement set out the reasons for missing the new Form TM8 deadline of 2 June 2026, the pertinent paragraphs stated as follows:

“REASONS FOR FAILURE TO FILE BY 2 JUNE 2026

4. I fully accept that the Form TM8 and counterstatement were not filed by the 2 June 2026 deadline directed by the Tribunal. I sincerely apologise for this failure and take full personal responsibility for it.

5. Following receipt of the Tribunal's letter of 17 April 2026, I made the decision to wait until after the 1 May 2026 objection window had passed before re-filing the TM8. My reasoning was that I wished to confirm that the Cancellation Applicant had not objected to the intervention before committing the counterstatement, as any successful objection might have affected the basis on which the TM8 should be filed.

6. The 1 May 2026 deadline passed without any objection from the Cancellation Applicant. However, I then failed to return to action the filing of the TM8 before the 2 June 2026 deadline. This was an oversight on my part for which I take full and unreserved responsibility. I am managing these proceedings without professional legal representation, navigating a complex and unusual set of circumstances including the bona vacantia ownership position and the BVC8 process, and I allowed the deadline to pass without filing.

7. I wish to make absolutely clear that at no point has Tiffin Beats Ltd intended to abandon its defence of this trade mark or to concede the cancellation application. The failure to file was entirely a matter of oversight, not intention.”

15. Having considered the reasons set out in the witness statement above, on 24 July 2026, the Registry informed the parties that its preliminary view was that the Form TM8 and counterstatement should not be admitted into proceedings. The relevant paragraphs of that letter are as follows:

“The official letter dated 2 April 2026 was sent to the Government Legal Department by email and via Royal Mail’s “Signed for” service, set a deadline of 2 June 2026 to file a completed Form TM8.

On 17 April 2026, a letter was sent to Tiffin Beats Ltd (Company number 14867418), notifying that the request to intervene in the proceedings was granted. The letter also stated that Tiffin Beats Ltd should re-file Form TM8 on or before 2 June 2026 for it to be considered.

Please note that Rule 41(6) of the trade mark Rules 2008 states: *“The proprietor shall, within two months of the date on which a copy of Form TM26(l) and the statement was sent by the registrar, file a Form TM8, which shall include a counter-statement, otherwise the registrar may treat the proprietor as not opposing the application and registration of the mark shall, unless the registrar otherwise directs, be declared invalid.”*

The Registrar can only utilise its very limited discretion in such cases where there exists either ‘compelling reasons’ or ‘extenuating circumstances’ to do so. The reasons presented confirm neither.

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

You are referred to the following decisions of the Appointed Persons in this regard: Kickz AG and Wicked Vision Limited (BL-O-035/11) and Mark James Holland and Mercury Wealth Management Limited (BL-O-050/12). Copies of these decisions can be found on the IPO website at:

<https://www.ipo.gov.uk/t-challenge-decision-results.htm>”

16. On 27 July 2023, TBL filed a notice of objection to the Registry’s preliminary view regarding the late filing of the Form TM8 in the respective proceedings, and consequently, a hearing was set for 22 September 2026 to discuss the admissibility of

the intervener's defence and counterstatement. Prior to the hearing both parties filed skeleton arguments.

The hearing

17. The hearing was attended by Mr Syed from Beck Greener LLP representing the TBL.³ Mr Pugh from The Trademark Helpline was also in attendance, representing the applicant.

18. At the hearing, Mr Syed expanded on his skeleton argument making the following points which I consider to be relevant to this decision:

- These proceedings are procedurally exceptional and unusual as can be seen by the history of the case and the fact that the Tribunal's letter dated 17 April 2026 referred to rule 74 which allows the correction of procedural irregularities connected with the proceedings. It was argued that this demonstrates an already complicated history.
- TBL had originally filed a Form TM8 (on 19 December 2026) within the initial deadline set by the Tribunal. It was highlighted that in the original letter the deadline for filing the Form TM8 and more importantly the consequences of missing the deadline were stressed as it was considered a strict deadline under section 41(6). In contrast this was absent in the letter dated 17 April 2026 which re-set the deadline for re-filing the Form TM8.
- TBL, in missing the deadline of 2 June 2026, only failed to execute the procedural step, in a procedurally complex case. TBL did not fail to engage or defend the proceedings initially. The absence of the warning typically given by the Tribunal in relation to the consequences of not filing the Form TM8 by the prescribed deadline would suggest that it was not a strict deadline for filing the Form TM8, but a procedural deadline for simply re-filing the Form TM8 that Tiffin Beats Ltd. had already filed prior to the change in circumstances regarding ownership.
- Alternatively this should be considered a procedural irregularity that should be rectified by the Tribunal.

³ Beck Greener LLP being instructed by the intervener very recently in these proceedings.

- Since the initial Form TM8 was filed prior to the original deadline set by the Tribunal for TBL to file its defence, the applicant has been aware of TBL's intention to defend the proceedings. This was not a case where TBL has failed to engage in proceedings.
- The delay in meeting this procedural step was short and was immediately remedied by TBL and causes no prejudice to the applicant.
- It was suggested that not letting the re-filed Form TM8 into proceedings would set a precedent.
- Reliance was placed on the *Halloumi* case,⁴ (paragraph 35) and stressed that in that case the proprietor did not oppose the application, however that is different to the position here.

19. In response Mr Pugh contended:

- The letter dated 17 April 2026 which stated 'for it to be considered' is a clear indication from the Tribunal that this deadline needed to be adhered to if TBL wanted the Tribunal to consider its defence.
- The case in the intervener's skeleton argument, *Renaissance Hotel Holdings, Inc. v Oskia Skincare Ltd* (O-216-19), differs to the facts of this case, as in that case a filing had been made by the deadline but there was however a dispute about whether that amounted to a defence. In this case nothing was filed prior to the deadline of 2 June 2026.
- There is a distinction between the previous procedural complexity and the unusual procedural history which amounted to the reason why TBL was required to re-file a Form TM8 (giving another strict deadline for doing so), and the reasons for missing the deadline. It was emphasised that the reason for missing the deadline did not amount to compelling reasons or extenuating circumstances as it is admitted that it was an oversight.
- It was stressed that there was a known deadline, prepared documents and no impediment to filing those documents.

⁴ *Permanent Secretary of the Ministry of Energy, Commerce and Tourism, Republic of Cyprus v John and Pascal Ltd* [2018] EWHC 3226 (Ch)

- Finally, there was no attempt to file the Form TM8 until it was identified by the Tribunal.

DECISION

20. The filing of a Form TM8 in invalidation proceedings against the contested mark is governed by Rule 41(6) of the Rules. The relevant parts read as follows:

“(6) The proprietor shall, within two months of the date on which a copy of Form TM26(I) and the statement was sent by the registrar, file a Form TM8, which shall include a counter-statement, otherwise the registrar may treat the proprietor as not opposing the application and registration of the mark shall, unless the registrar otherwise directs, be declared invalid.”

21. The combined effect of rules 77(1), 77(5) and Schedule 1 of the Rules means that the time limit in rule 41(6), 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.

22. I note that TBL had already filed a Form TM8 on 19 December 2025, in response to the initial deadline set which was filed in time.

23. I accept that the letter dated 17 April 2026, which established the deadline for re-filing the Form TM8 did not cite rule 41(6) and omitted the warning regarding the consequences of failing to file a Form TM8.

24. However, more significantly, I note that the letter states, 'Accordingly, Tiffin Beats Ltd is required to **re-file** its Form TM8 on or before 2 June 2026 for it to be considered.' (My emphasis added). To my mind this makes it explicitly clear that the deadline was for the re-filing of the Form TM8 acknowledging that one had already been filed. Therefore, I am inclined to agree with Mr. Syed that the deadline was one to re-file the Form TM8 following the change in circumstances, rather than one setting out a non-extensible deadline to file the Form TM8 for the first time. Consequently, the re-filed Form TM8 should be allowed in proceedings.

25. I accept that TBL had demonstrated very early on in these proceedings that it intended to defend them.⁵ It was only as a result of the Registry realising that TBL was not the owner of the contested mark (after TBL had already filed the Form TM8 to defend the proceedings) that it was required to re-file the Form TM8 by the deadline of 2 June 2026. Further, whilst not raised by the parties, I note that in its Form TM27, TBL relied on its previously filed Form TM8. These actions are consistent with maintaining its position in defending the proceedings.

26. However, if I am wrong in concluding that 2 June 2026 deadline was merely a deadline for re-filing the Form TM8, then in my view, the letter dated 17 April 2026 would appear to contain procedural irregularities which would need to be corrected under rule 77(5) cited above. This is due to the letter using the wording '**re-file**' which could have led the deadline being interpreted as one not governed under rule 41(6). Further, I accept that the letter dated 17 April 2026 which TBL relied on did not cite rule 41(6) nor did it contain a full explanation of the consequences. I conclude that these errors contributed to TBL not understanding the importance of such a deadline, if it was indeed intended to be a strict, non-extensible deadline under the Rules rather than a procedural deadline for re-filing an amended Form TM8; this needs to be rectified. Therefore, based on rule 77(5) the Form TM8 will be admitted into proceedings. Consequently, as the Form TM8 is admitted under rule 77(5) there is no need to discuss the discretion to admit the late filed Form TM8 under rule 41(6).

⁵ I note to the credit of TBL that it has otherwise always acted in a timely manner. For example, on the same day it was informed that the mark was Bona Vacantia, it took steps to secure its position. Equally, further to the Registrar's letter acknowledging TBL to still be an interested party in the proceedings it again expediently (and well in advance of the deadline provided) filed the necessary form to protect its interest.

CONCLUSION

27. The Form TM8 has been admitted into the proceedings (subject to checks by the caseworker), and the invalidation will therefore be permitted to continue. This will result in the casework examiner setting deadlines for the filing of evidence and subsequently inviting the parties to request a hearing or to file submissions in lieu.

COSTS

28. As I have admitted TBL defence into the proceedings, the matter of costs will be considered at the final determination of the case.

Dated this 2nd day of October 2026

Sarah Wallace
For the Registrar