

O/0941/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3957559

IN THE NAME OF SANCHA CURRIE

**TO REGISTER THE FOLLOWING SERIES OF
TWO TRADE MARKS:**

**Coco7 - The Power To Create
Anything**

**COCO7 - THE POWER TO CREATE
ANYTHING**

IN CLASSES 3, 9, 16, 25, 35, 41 AND 44

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 445293**

BY CHANEL LIMITED

Background and pleadings

1. On 18 September 2023, Sancha Currie (**‘the applicant’**) applied to register the series of two trade marks as shown on the front page of this decision. It was accepted and published in the Trade Marks Journal on 13 October 2023. The applied for goods and services are set out in Annex 1 of this decision.

2. On 12 December 2023, Chanel Limited (**‘the opponent’**) filed a Form TM7A (Notice of threatened opposition), the effect of which was to extend the two-month opposition period prescribed in Rule 17(2) of The Trade Marks Rules 2008 (**‘the Rules’**) by a further month. The applicant was advised that a Form TM7A had been filed in an official letter of the same date.

3. On 15 January 2024, Simmons and Simmons LLP filed a Form TM7 (Notice of opposition and statement of grounds) on behalf of the opponent. The opposition was brought under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (**‘the Act’**) and was directed against all the goods and services in the application.

4. On 29 January 2024, the Tribunal served the TM7 on the applicant, by post and by email. 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 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.

...

IMPORTANT DEADLINE: A completed Form TM8 (or Form TM9c) MUST be received on or before 02 April 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.**”

5. The applicant’s Form TM8 was not received by the deadline of 2 April 2024. Instead, their representative, Akeem Famuyiwa, filed the Form TM8 by email on 19 April 2024. A witness statement dated 19 February 2024 of the applicant was also filed on the same date, along with exhibits A and B, outlining the reasons for the late filed TM8.

6. As the applicant did not file their TM8 by the deadline, the Tribunal sent an official letter dated 22 April 2024, noting that the witness statement of the applicant did not contain a signature and requesting that the applicant file an amended witness statement on or before 6 May 2024. The parties were notified that, upon receipt of a signed witness statement, the Registry will consider the request to allow the late-filed TM8 and counterstatement.

7. An amended witness statement was not received by 6 May 2024 and upon review of the case file, the Tribunal noted that whilst the Form TM8 and witness statement came from the applicant’s representative, it was received from an email address that was not held on record. The Tribunal subsequently sent an email to both email addresses attaching the official letter of 22 April 2024 and extending the applicant’s deadline to file an amended witness statement to 4 June 2024. The applicant was also requested to clarify which email address should be used for future correspondence.

8. On 4 June 2024, the applicant’s representative filed an amended witness statement and confirmed the correct email address to be used in all future correspondence. The relevant parts of Ms Currie’s amended witness statement read as follows:

“2. I am writing to explain my delayed submission of the TM8 Notice of Defence and counterstatement form which should have been filed 02/04/24. Since November 2023, I have been suffering from lower back pain such that medical attention was needed. Attached at exhibit A is a Statement of Fitness for Work issued by my doctor, indicating that I was not fit for work from 20 November 2023 to 1 January 2024. He prescribed me analgesia and referred me to physiotherapy.

3. Attached at exhibit B are email screenshots of confirmed physiotherapy appointments at Vita Health group sent by MSK Croyden- Physiotherapy on 24 January 2024 and 15 March 2024.

4. As a result, my medical condition has affected my ability to consistently communicate with Akeem Famuyiwa on my response towards Chanel Limited’s opposition. The ongoing condition of lower back pain has affected my movement, mobility and has caused me immense frustration. As such, I have been focused on recovering this entire period. I sincerely seek your understanding of my circumstances and I intend to fully respond to Chanel Limited’s opposition on substantial grounds with the TM8 attached.”

9. On 17 June 2024, the Tribunal acknowledged receipt of the amended witness statement and wrote to the applicant as follows (copied to the opponent):

“After careful consideration of the Witness Statement of Sancha Currie you have provided, it is the Registry’s preliminary view to refuse to allow the late-filed Form TM8 and counterstatement into the proceedings.

If either party disagrees with the preliminary view, they should request a hearing within 14 days from the date of this letter, being on or before, **01 July 2024**.

If no response is received within the time allowed, the preliminary view will automatically be confirmed, and the application will be abandoned.”

10. On 21 June 2024, the applicant’s representative requested a hearing.

11. A hearing was appointed for 6 August 2024 and the parties were notified by way of official letters dated 9 July 2024. Both parties filed skeleton arguments prior to the hearing. I note that the deadline given for filing skeleton arguments was 2 August 2024 however, the applicant’s skeleton arguments were filed on 5 August 2024.

THE HEARING

12. On 6 August 2024, I began the hearing at the appointed time of 10:30am, by telephone conference. Only Ms Marisa Broughton of Simmons and Simmons LLP appeared on behalf of the opponent. Attempts were made to contact Mr Akeem Famuyiwa, the applicant’s representative, by telephone and email, but to no avail. I waited until 10:45am before deciding to adjourn the hearing. Shortly thereafter, it transpired that there was an error with Mr Famuyiwa’s calendar being set at GMT+2 instead of GMT+1. He had therefore attempted to join the telephone conference at 11.30am GMT.

13. A new date and time of 14 August 2024 at 10.30am was scheduled for the hearing and the parties were notified of this via email on 6 August 2024.

14. The rescheduled hearing took place before me on the newly arranged date, by telephone conference. The opponent was represented by Ms Marisa Broughton of Simmons and Simmons LLP and the applicant was represented by Mr Akeem Famuyiwa of Fractional IP.

15. At the hearing, and in the skeleton arguments provided, Mr Famuyiwa explained that the applicant was very ill which made it difficult for her to focus on what was required of her to be able to proceed with the filing of the TM8 and

counterstatement. Further, he added that she had an operation a few months ago, so the reason for the late filing was solely based on the fact that her condition affected her ability to consistently communicate with her legal representative.

16. I enquired as to the date that Ms Currie had her operation. Mr Famuyiwa responded saying that he did not know the exact date at the hearing however, shortly after the hearing, the Tribunal received an email from Mr Famuyiwa confirming that Ms Currie had the operation on 3 June 2024.

17. I brought the parties' attention to paragraph 9 of the applicant's skeleton arguments which stated that "If required, the applicant is willing to provide additional medical evidence or a more detailed account of her condition during this period." I asked Mr Famuyiwa if he could provide any further information about Ms Currie's health during the time period around the TM8 deadline and asked why this information wasn't provided at an earlier stage.

18. Mr Famuyiwa explained that, prior to her operation, Ms Currie was withdrawn from all work activities and needed the assistance of family members to support with childcare as she has two children. He stated that he believed the evidence already provided was sufficient.

19. I then turned to Ms Broughton for her submissions on behalf of the opponent. Ms Broughton began by highlighting that there were several deadlines missed by the applicant in addition to the TM8 deadline; the deadline of 6 May 2024 to provide the Tribunal with a signed witness statement, the deadline of 2 August 2024 to file skeleton arguments and the applicant's failure to attend the first scheduled hearing of 6 August 2024. Ms Broughton stated that whilst she did not wish to cast aspersions on the existence of a medical condition, there appeared to be a pattern of behaviour of the representative missing deadlines which may explain the reason for the late filing of the TM8.

20. Ms Broughton directed me to paragraph 9 of the applicant's skeleton arguments in which the applicant stated that they could provide further evidence if required. Ms Broughton submitted that the deadline of 4 June 2024 should have been

the date in which all supporting evidence was filed by the applicant and that she believed that the evidence filed by the applicant was not sufficient to justify a finding of extenuating circumstances as the reasons given did not fully explain how or why the applicant's medical condition made it difficult for her to meet the deadline given that she had legal representation and the filing of a TM8 is a fairly simple and straightforward matter.

21. Ms Broughton further submitted that the doctor's statement provided stated that the applicant was fit to work as of 1 January 2024 and that the applicant's witness statement did not provide any reasoning or evidence that the applicant was not fit to work on, or in the weeks leading up, to the deadline of 2 April 2024. Mr Broughton also noted that the applicant had not provided any explanation of the change of circumstances which prevented the applicant from meeting the deadline to file a TM8 but had allowed the applicant to instruct their representative to file the TM8 and counterstatement on 19 April 2024.

22. In response to Ms Broughton's submissions, Mr Famuyiwa stated that the applicant's medical condition was fairly severe and that she was seeing a physiotherapist for a long period of time and was dealing with other matters. Whilst he acknowledged that the filing of a TM8 is a straightforward process, he stated that he still needed to be able to communicate with his client in order to file the form.

23. At the conclusion of the hearing, I reserved my decision to give me an opportunity to properly reflect on the submissions put forward by the parties and all the circumstances of the case.

Additional evidence

24. After the hearing, Mr Famuyiwa emailed the Tribunal confirming the date of Ms Currie's operation and stating that she was hospitalised three weeks prior to that on 9 May 2024. Mr Famuyiwa also attached an undated letter from Ms Currie's consultant. The letter outlined that Ms Currie was seen by a consultant on 15 March 2024 and referred to the musculoskeletal team. I note that this date coincides with the

date provided in exhibit B of the witness statement of Ms Currie which showed confirmation of a physiotherapy appointment.

25. On 30 August 2024, the Tribunal wrote to the applicant stating that if they wished for the additional documentation to be considered as evidence, it would need to be filed as a witness statement with corresponding exhibits attached. The applicant was also notified that if a witness statement was not provided, the contents of their email would be treated as hearsay evidence and their attention was drawn to Tribunal Practice Notice 5/2009. A deadline of 6 September 2024 was provided for the applicant's response.

26. No response was received from the applicant however, while the consultant's letter confirms that Ms Currie suffers from back pain, it does not, for example, explain the severity of Ms Currie's condition during the two-month period for filing the TM8 apart from the date of 15 March 2024 as already confirmed in Ms Currie's witness statement. Consequently, none of the additional documentation would materially assist the applicant, even if the information provided had been properly formatted and executed.

DECISION

27. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by Rule 18 of 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 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 is the period of two months beginning immediately after the notification date.”

28. 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 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.”

29. There is no suggestion from either side that there has been any irregularity on the part of the Tribunal. 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).

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

31. In *Music Choice Ltd’s Trade Mark (“Music Choice”)*³, the Court indicated that a consideration of the following factors (underlined below) is likely to be of assistance in

¹ BL/O/035/11

² BL/O/050/12

³ [2005] RPC 18

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 parties' submissions to the extent that I consider it necessary to do so.

The circumstances relating to the missing of the deadline including reasons why it was missed and the extent to which it was missed;

32. 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 2 April 2024. However, the Form TM8 and counterstatement was filed on 19 April 2024. Therefore, the deadline was missed by seventeen days.

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

33. The opposition is brought under sections 5(2)(b), 5(3) and 5(4)(a) of the Act. Whilst it is not for the present hearing to determine the merits of the case, there is nothing to suggest that there is not an arguable case to be determined.

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

34. Should the defence be admitted into proceedings, the applicant will be permitted to defend the opposition, the proceedings will continue with the parties given an opportunity to file evidence and the matter will be determined on its merits.

35. If, however, the defence is not admitted into proceedings, the application will be deemed as abandoned, and the applicant will lose their filing date of 18 September 2023. It will remain open to the applicant to re-file their application which may, in turn, be opposed again by the opponent.

Any prejudice caused to the opponent by the delay;

36. In its skeleton arguments, the applicant submits that the opponent is a well-resourced company and would therefore not suffer any real prejudice by the admission of the late filing.

37. No specific prejudice was highlighted to me by the opponent, but I recognise that it is often the case in litigation that delays result in ongoing costs and continuing legal uncertainty.

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

38. I was not made aware of any other relevant considerations by either party.

Conclusions

39. 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 on the same terms 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.

40. The filing of a Form TM8 is a relatively simple task, capable of being successfully carried out, irrespective of whether an applicant is represented or not. In the present case, the pleadings are based on multiple earlier marks and multiple grounds so I acknowledge that the applicant may have wished to take a greater degree of care addressing each of the elements in pleadings. Nonetheless, the

deadline for filing a Form TM8 is a statutory one, and applicants (and their representatives) are made fully aware of the consequences if they fail to comply.

41. In *Gabriel Cesar Alvarado v Karl Robert Johnson* ('RESLOSOUND' trade mark),⁴ Professor Philip Johnson, sitting as the Appointed Person, stated:

"5. [...] It is also important to note that while the claimant in 'Solanki' [[2018] EWCA Civ 101] did not originally participate effectively in the proceedings [...], by the date of the request for the adjournment, the claimant had actively participated in proceedings and, in particular, witness statements had been filed on time.

[...]

20. It has been said, and I put it no higher, that 1 in 4 people have suffered depression at some point in their lives. The effects of this can be mild to severe and sometimes lead tragically to suicide and other forms of self-harm.

21. It is vital, therefore, where a person seeks to establish that health problems have affected his or her ability to participate in proceedings, that specific evidence from medical professionals is provided as to the effect it has had (or will have) on those proceedings. This is because a diagnosis of depression, for instance, can have a range of different outcomes. It may be that a person has greater difficulty participating in proceedings (but can do so) or it may be that the depression is so severe that they are unable to participate at all (or participation may exacerbate an existing condition or put them at risk).

22. I also accept that where a person suffers from ill health (whether mental or otherwise), it may be necessary for that person to make at least a partial recovery before they can provide such evidence to a tribunal; although in most (although not all) cases some form of contact can be made at least to inform the tribunal of a person's current difficulties.

⁴ BL O/378/18

23. [...] *The duty to file something within a two-month period is not an obligation to file it on the last day of that period. In other words, parties should be expected to allow for illnesses and other problems arising.*

[...]

24. *Where a person is chronically ill they might have a good day (or few days) and be expected to comply when they are well because such a person would be aware their illness might provide difficulties in the future.*

[...]

31. [...] *In my judgment, in the case of chronic illness, it is quite reasonable for the registrar to require medical evidence from a professional to support any case put forward and, further, that the evidence explains fully the impact the illness has on participating in proceedings.*

[...]

37. *As I mentioned before, there may be an in-between stage where a person was too ill to complete the form [TM8], but not too ill to tell (or ask someone else to tell) the registrar they were too ill to comply with the deadline.*

[...]

42. [...] *the tribunal must be confident that a person did not comply with a time limit wilfully and the failure was not caused by illness.*

[...]

44. *Furthermore, while reports from a party as to their own mental state are clearly admissible and relevant, it will rarely be the case that a statement from the party, unsupported by medical evidence, can be sufficient to provide an excuse to comply with a time limit."*

42. Although the above case is not on all fours with the present case, it provides helpful guidance when considering the matter of the failure to meet a deadline due to illness.

43. I have considerable sympathy for Ms Currie's position and have no doubt that her medical condition has caused her difficulties. However, a more detailed description of Ms Currie's condition and its impact at the relevant time would have

assisted the applicant's case. I acknowledge that the physiotherapy appointment of 15 March 2024 took place during the prescribed period in which to file a TM8, however, I also bear in mind that the doctor's note provided expired on 1 January 2024, well before the TM7 serving date of 29 January 2024. While I acknowledge that Ms Currie's condition may have affected her ability to communicate effectively, there is nothing to suggest that the condition was consistently affecting the applicant during the prescribed period to the extent that she was not capable of instructing her representative. It is unclear why Ms Currie was unable to meet the deadline of 2 April 2024 but was able to do so 17 days later and was also able to provide a copy of a consultant's letter on 14 August 2024.

44. Having carefully considered all the submissions made by both parties and having regard to 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 18(2).

CONCLUSION

45. The late-filed TM8 is not admitted into the proceedings and the applicant will be treated as not defending the opposition. Subject to any successful appeal, the application is deemed abandoned in respect of all goods and services applied for.

COSTS

46. As my decision terminates the proceedings, I must consider the matter of costs. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. I assess these as follows:

Official fee for filing the form TM7:	£200
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Preparing the statement of case and considering the counterstatement:	£250
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Preparing skeleton arguments and
attending the hearing: £500

Total: £950

47. I therefore order Sancha Currie to pay the sum of £950 to Chanel Limited. 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 1st day of October 2024

Catrin Williams
For the Registrar

Annex 1

Class 3: Personal care and beauty products; bathing gels, foams, and liquids, as well as bathing soaps for a refreshing bathing experience, perfumery, essential oils, cosmetics, and hair lotions, perfumes, scents, fragrances, eau de parfum, and eau de toilette, cosmetic kits comprising makeup essentials like lipsticks, mascara, eyeliners, bronzers, concealer, blushers, foundations, eye shadows, lip-gloss, and lip liner; balms, cologne, creams, gels, and milk, offering an indulgent skincare experience, scented body spray, after-sun blocks, lotions, creams, gels, milks, and balms, hair shampoo, conditioner, heat protection sprays, hot oil treatments, and hair serums; body care products and preparations, including moisturizers, exfoliating waxes, exfoliating treatments, anti-wrinkle creams, skin firming creams, cleansers, toning creams, hand creams, cuticle cream, cuticle conditioners, nail creams, nail softeners, and nail hardeners; body washes, body scrubs, body gels, body emulsions, and body masks; Facial care with facial scrubs, shower gels, fake tan treatments, self-tanning treatments, age retardant gel, and lotions, along with anti-aging creams, aromatherapy creams, aromatherapy oils, and aromatherapy lotions; beauty creams, lotions, gels, masks, and serums, offering a complete range of beauty solutions. For hair and body preparations, exfoliant creams, and a variety of facial cleansers, concealers, masks, and washes are included, providing thorough and effective skincare routines; Personal hygiene is covered with antiperspirants, deodorants, fragranced antiperspirants, and fragranced deodorants for personal use; hair dye, hair styling gels, lotions, and hair styling mousse; providing a classic and essential grooming product.

Class 9: Databases, Downloadable multimedia files, Downloadable media, music and recorded content, Downloadable music files, Media content, recorded music, media etc, downloadable videos, Musical video and sound recordings, Downloadable music sound recordings, Digital music downloadable provided from a computer database or the internet; Multi-media recordings, Digital Media streaming device, Audio Visual recordings Apparatus for recording, transmitting, storage or reproduction of sound, music, images, data and videos; sound, music, image, data and video recordings; digital sound, music, image, data and video recordings; recording materials used for storage and transmission of digital and analogue data, images, videos, sounds and

recordings; application software for mobile devices, tablet computers, mobile computers, handheld computers and smartphones; downloadable digital music or sound files provided from the Internet; downloadable electronic media; publications downloaded in electronic form from the Internet; downloadable electronic publications provided from databases or the Internet; e-books; ;Downloadable digital image files authenticated by non-fungible tokens (NFTs).

Class 16: Printed matter; printed publications; stationery; books; novels; pamphlets; magazines; postcards; pictures; posters; diaries; drawing instruments; greeting cards; address books; catalogues; brochures; souvenir event programs; tickets; photographs; pictures, portraits, paintings calendars; newspapers; newsletters; notelets; note pads; notebooks; stickers; decalomania; paper files; periodicals; instruction manuals; instructional and teaching materials; writing implements; pens; ballpoint pens; fountain pens; pencils; rulers; erasers; pencil sharpeners; pen and pencil cases; picture cards; picture books; cardboard and paper badges; paper flags; record, tape; wrapping paper; cards; songbooks.

Class 25: Headgear, Caps, Hats, Headbands for clothing, clothing, all clothing ranges, Hoods, footwear; belts for clothing, Head scarf, jewellery, tights, tracksuits, night wear, lounge wear, dresses, avantgarde outfits, catsuits, jumpsuits, t-shirt, shirt, trousers, leggings, jumpers, gowns, couture gowns, lingerie, trainers, boots, belts, jackets, coats, blazers, polo neck, polo shirts ;Clothing authenticated by non-fungible tokens [NFTs].

Class 35: Business management organisation; Business management of entertainers; Management of a retail enterprise for others; Management of performing artists; Business management of performing artists; Business management of musicians; Business organization and management consultancy including personnel management; Business organisation and management consultancy in the field of personnel management; Business management; Business management services relating to electronic commerce; Provision of online marketplaces for buyers and sellers of goods and services which are authenticated by non-fungible tokens;

Provision of an online marketplace for buyers and sellers of downloadable digital image files authenticated by non-fungible tokens [NFTs].

Class 41: Arranging beauty contests, cultural events, Arranging of entertainment shows, Arranging of festivals for entertainment and cultural purposes, Arranging musical events, Arranging pageants, Artistic direction of performing artists, Artistic management of entertainment and music venues, Artistic management of performing artists, Booking for entertainment, Entertainer services provided by musicians, Entertainment like fashion shows and beauty pageants, Music entertainment services, Organisation of shows, Providing online downloadable entertainment services, Song publishing, Publishing of music and its works.

Class 44: Hygienic and beauty care for human beings; Application of cosmetic products to the face; Application of cosmetic products to the body; Advisory services relating to hair care, beauty, beauty treatment, beauty care, cosmetics, Beauty care, Beauty information services, Consultancy relating to cosmetics.