

O/1065/25

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK3005814
IN THE NAME OF JAMES HERRIOT CO. LIMITED
FOR THE TRADE MARKS:

Herriot

Herriots

(Series of 2)

IN CLASSES 3,4,5,18,24,25,29,30,31,33,35,43 & 44

AND

THE LATE FILING OF FORM TM8(N) AND
COUNTERSTATEMENT
FILED IN DEFENCE OF THE ABOVE REGISTRATION
IN REVOCATION PROCEEDINGS
UNDER NO. 508638
BY WORLD OF JAMES HERRIOT LTD

Background

1. Trade mark number 3005814 ('the contested mark') shown on the cover page of this decision stands registered in the UK in the name of James Herriot Co. Limited ('the proprietor'). The application was filed on 14 May 2013 and was subsequently registered on 11 October 2013.

2. On 19 March 2025, World of James Herriot Ltd ('the cancellation applicant') filed Form TM26(N) (Application to revoke a registration or a protected international trade mark (UK) for reasons of non-use). The Form TM26(N) records that the cancellation applicant seeks to revoke the contested marks on the basis of non-use under section 46(1)(a) of the Trade Mark Act 2004 ('the Act'). The application for revocation is aimed against all of the goods and services for which the contested mark is registered.

3. On 31 March 2025, the Registry served the Form TM26(N) on the proprietor. The deadline for the proprietor to file its Notice of defence and counterstatement (Form TM8(N)) was set at 2 June 2025 which was communicated by the Registry in the serving letter. The Registry's letter included the following:

"Please find enclosed a copy of an amended TM26(N) filed against your registration.

If you wish to continue with your registration, you need to file a notice of defence and counterstatement by completing Form TM8(N) - please note the important deadline below. You will find a blank Form TM8(N) 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/trademark-forms-and-fees>

Rule 38(3) of the Trade Marks Rules 2008 require that you must file your notice of defence and counterstatement (Form TM8(N)) within two months from the date of this letter.

IMPORTANT DEADLINE: A completed Form TM8(N) MUST be received on or before 2 June 2025.

Rule 38(3) and (4) allows you to file evidence of your use of the mark at the same time as your counterstatement. If you wish to do this your counterstatement must at Section 7 on the TM8(N) specify the goods/services that the mark has been used on, or in relation to. The evidence **must** be cross-referenced to specific exhibits e.g. the mark has been used on, or in relation to 'cutlery' as shown at Exhibit MR1.

You do not have to file evidence of use with your counterstatement. If you do not, a further opportunity of two months will be given for that evidence to be filed.

Rule 38(6) of the Trade Marks Rules 2008 states that **“Where the proprietor fails to file a Form TM8(N) within the period specified in paragraph (3) the registration of the mark shall, unless the registrar directs otherwise, be revoked.”** It is important to understand that **if the deadline date is missed, then in almost all circumstances, the registration will be treated as revoked in whole or part.**

[...]

(original emphasis)

4. The proprietor did not file a Form TM8(N) by the deadline and so, on 12 June 2025, the Tribunal wrote to the proprietor again. In the letter, the Tribunal stated that:

“The official letter dated 31 March 2025 informed you that if you wished to continue with your registration you should file TM8(N) and counterstatement on or before 2 June 2025.

As no TM8(N) and counterstatement have been filed within the time period set, Rule 38(6) applies. Rule 38(6) states that:

“...the registration of the mark shall, unless the registrar directs otherwise, be revoked.”

The registry is minded to treat the proprietor as not opposing the application for revocation and revoke the registration 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, **26 June 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.

[...]

5. The proprietor wrote an initial email to the Tribunal on 15 June 2025 attaching a copy of medical records for Mrs Ann Kiely. A further email was received from Ms Jesse Kiely (daughter of Ann Kiely) on 25 June 2025. This email requested a small extension of time to submit the Form TM8(N) and accompanying witness statement until 30 June 2025. The Tribunal responded on 26 June 2025 granting the extension. The proprietor submitted their witness statement and Form TM8(N) on 30 June 2025.

6. The witness statement was by Ann Kiely, dated 30 June 2025 and sets out the reasons for missing the Form TM8(N) deadline. The Tribunal wrote to the parties on 14 July 2025 giving a preliminary view that the reasons provided in the witness statement were not sufficient to permit the discretion to allow the late filed Form TM8(N).

7. A hearing was appointed on 11 September 2025 and the details were sent to the parties in an official letter on 15 August 2025. Both parties confirmed their attendance at the hearing.

8. The hearing took place before me via telephone on 11 September 2025. Ms Jesse Kiely attended on behalf of the proprietor and Mr Ian Ashton attended on behalf of the cancellation applicant.

Skeleton Arguments

9. On 22 August 2025 the cancellation applicant sent their submissions via email. It confirmed that they believed the preliminary view of the Registry should be upheld and that the late Form TM8(N) should not be admitted into proceedings.

10. In those submissions, it was stated that the high bar for late filing had not been met as (i) the proprietor had not filed any medical certificate or letter from a doctor (2) the assertions made regarding Mrs Kiely's incapacity came from her daughter and not a legal representative (3) illness without evidence and without steps to appoint a representative or file a holding defence does not justify a late filing.

11. Further, it states that Mrs Kiely had regained some capacity by mid-June and therefore could have appointed a representative or lodged a minimal Form TM8(N).

12. The submissions go on to say that allowing the late filing would cause unnecessary delay, increase costs and undermine certainty in IPO proceedings.

13. The proprietor submitted a skeleton argument dated 7 September 2025. Within this, they provided a chronology of events as follows:

- 2.1. 31 March 2025** – IPO letter issued setting deadline of 2 June 2025 for filing TM8(N).
- 2.2. March–April 2025** – Mrs Kiely suffered acute pneumonia and bronchiectasis, treated by daily intravenous antibiotics via canular drip, leaving her bed-bound, severely fatigued, and with cognitive difficulties. GP requested memory and coordination testing.
- 2.3. 12 June 2025** – IPO issued a preliminary view of revocation for non-filing.
- 2.4. 15 June 2025** – Mrs Kiely, newly recovering, contacted the IPO, disclosed her medical situation, and supplied a scanned copy of her NHS medical records.
- 2.5. 26 June 2025** – Following her request, the IPO granted an extension of time until 30 June 2025 for filing a TM8(N) and witness statement.
- 2.6. 30 June 2025** – The Proprietor filed TM8(N), counterstatement, witness statement, and exhibits by the deadline set in the Registry's letter.
- 2.7. 14 July 2025** – IPO issued its preliminary view that discretion should not be exercised.
- 2.8. 28 July 2025** – Written request for hearing submitted with full reasons and chronology.
- 2.9. 28 August 2025** – GP provided formal letter corroborating the treatment history and incapacity.

14. Further, within the skeleton, Ms Kiely confirms that her mother's illness was "severe, sudden" and she was "medically incapacitated, bed-bound, and undergoing daily hospital and GP treatment".¹

15. The skeleton goes on to say that Mrs Kiely acted to contact the IPO as soon as she was medically able and rebuts the suggestion from the cancellation applicant that they should have instructed a representative sooner by stating that they did so as soon as Mrs Kiely was able to act.

16. Attached to the skeleton argument is a further letter from the Central Dales Practice listing the medical history for Mrs Kiely between 10 September 2024 and 24 July 2025. I do not propose to list all of Mrs Kiely's medical history for the relevant time period here, however, I note that the letter showed a lot of appointments, including a week of IV antibiotic treatment.²

17. On 10 September 2025 at 11:08 the cancellation applicant sent an email to the Tribunal stating that he had noted Ms Jesse Kiely had stated her mother was the sole director of the proprietor company however, he had enquired at Companies House and found that Ms Kiely herself was also listed as a director and had been appointed on 30 July 2013. He therefore stated that she would have had the authority to act on behalf of the company and file the Form TM8(N). He attached an undated screengrab from Companies House showing this information.

Hearing discussion

18. At the hearing, Ms Kiely was representing her mother, who she explained, as per the details within the skeleton argument was 73 and had been having some difficulties with her health. She further stated that her mother was indeed very ill around the time the proceedings started and they received the Form TM26(N) from the Registry and that she had continued to be ill and receiving treatment, as shown by the Central Dales

¹ Paragraph 4.1 of the Skeleton Argument of the proprietor

² I note that some of the submissions within the proprietor's Skeleton Argument should, perhaps, have been filed by way of a witness statement. However, Ms Kiely has subsequently filed a witness statement at my direction which covers some of the claims made in the skeleton

Practice Letter. Once her mother regained her cognitive abilities, she had realised that the Form TM8(N) deadline had been missed and spoke to a caseworker on the phone to explain what had happened and emailed across some notes from her doctor.

19. Ms Kiely explained that her mother was still recovering but following the Registry's letter stating the Form TM8(N) deadline had been missed, realised they needed the small extension of time to file the witness statement and Form TM8(N) as requested by the Tribunal. This extension was granted, and they filed the witness statement and Form TM8(N) by the extended deadline. She stated she did not have much further to add to what had already been included within her skeleton argument, which I confirmed I had read prior to the hearing.

20. Mr Ashton started by reiterating his point that he did not believe the reasons supplied by the proprietor were sufficient to override Rule 38(6) of the Trade Marks Rules 2008 which states that failure to meet the Form TM8(N) deadline results in revocation in these types of proceedings. He said he did not believe this met the threshold of exceptional circumstances (as per the case of *Kickz AG v Wicked Vision Limited* and *Mark James Holland v Mercury Wealth Management Limited* (BL O-050-12)). He reiterated the points made within his previous submissions, that a minimal Form TM8(N) could have been filed in order to meet the deadline or a representative could have been appointed to do so.

21. He then asked whether I had received his email of the previous day. I confirmed I had indeed. He stated that as Ms Kiely was also listed as a director of the proprietor company, she could have filed the Form TM8(N) whilst her mother was unwell and there was no good reason why she did not do so.

22. I asked Ms Kiely for her submissions in response and it became apparent that the proprietor had not been copied in to the email sent by Mr Ashton on 10 September 2025 and therefore, she had no knowledge of this.

23. I therefore stated that Ms Kiely was entitled to respond to these submissions from the cancellation applicant and therefore, I directed that following the hearing, I would ask our Hearings team to forward on the email of 10 September from Mr Ashton and

she would have until 5pm on 15 September 2025 to provide a written response to the email. I said that this response should be copied to the cancellation applicant, and I will let the parties know if I require anything further from them at that stage.

24. There was a discussion around costs before I closed the hearing.

Post Hearing

25. Ms Kiely filed submissions on 15 September 2025 as directed. I have subsequently asked Ms Kiely to file these submissions in the form of a witness statement which she has done.

26. The statement explains that following the death of her father in 2022, both Ms Kiely and her mother were of the belief that her mother remained the sole director of the company. Further, she explained that her mother has always run the company and that she alone occupies the business office, uses the company computer and manages the email inbox where the IPO correspondence was received. Ms Kiely said that she herself does not have access to the email account and was not aware of any of the IPO correspondence received. She once again reiterated that her mother was ill with pneumonia and bronchiectasis during the defence period, leaving her unable to manage her affairs.

27. A further letter was sent by Mr Ian Ashton dated 15 October 2025 which reiterated the position of the cancellation applicant as above.

Decision

28. The filing for a Form TM8(N) in cancellation proceedings is governed by Rule 38 of the Trade Mark Rules 2008 which reads as follows:

“(3) The proprietor shall, within two months of the date on which he was sent a copy of Form TM26(N) by the registrar, file a Form TM8(N), which shall include a counter-statement.

(4) [...]

(5) [...]

(6) Where the proprietor fails to file a Form TM8(N) within the period specified in paragraph (3) the registration of the mark shall, unless the registrar directs otherwise, be revoked.”

29. The combined effect of rules 77(1), 77(5) and Schedule 1 of the Rules mean that the time limit in Rule 38(3), 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.”

30. There is no suggestion that there has been any irregularity on the part of the Registry. Therefore, the only basis on which the applicants 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 38(6).

31. When approaching the exercise of discretion here, I must take into account the decision of the Appointed Person in *Kickz AG v Wicked Vision Limited* and *Mark James Holland v Mercury Wealth Management Limited* (BL O-050-12) where it is set out that I have to be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the applicants’ favour.

32. In *Music Choice Ltd's Trade Mark* [2005] RPC 18, the Court indicated that a consideration of the following factors (underlined below) is likely to be of assistance in reaching a conclusion as to whether or not discretion should be exercised in favour of a party in default. That is the approach I intend to adopt, referring to the 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;

33. As mentioned above, the deadline for filing the Form TM8(N) was 2 June 2025. The Form TM8(N) was subsequently filed along with the witness statement on 30 June 2025. This means that the deadline was missed by 28 days. The main reason that the deadline was missed was because Mrs Kiely, a director for the proprietor, was very ill and receiving medical treatment throughout the two month defence period. This left her bed-bound and cognitively impaired and therefore, unable to deal with matters relating to these proceedings.

34. It is noted that the cancellation applicant has suggested that as Ms Jesse Kiely is also registered as an active director of the proprietor, that she could have undertaken the management of proceedings and submitted the Form TM8(N) herself.

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

35. The proceedings are brought under section 46(1)(a) of the Act. There is nothing to suggest the application for revocation is without merit.

The consequences of treating the proprietor as defending or not defending the application for revocation

36. Should the defence be admitted into proceedings, the proprietor will be permitted to defend its application, the proceedings will continue with the parties being given the opportunity to file evidence, and the matter will be determined on its merits.

37. If, however, the defence is not admitted into proceedings, there would, clearly, be serious consequences for the proprietor as its registration would be revoked in full; although that is always the case where the Tribunal makes a decision adverse to the proprietor because of a failure to file a defence in time.

Any prejudice caused to the opponent by the delay

38. The cancellation applicant stated within its submissions (and at the hearing) that the delays are likely to increase costs and undermine certainty in IPO proceedings.

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

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

Considerations

40. In reaching my decision, I consider that if discretion is not exercised in the proprietor's favour, the applicant will automatically succeed, and the proprietor's mark will be revoked, removing it from the register. However, as discussed above, I acknowledge that this is often the consequence of a failure to comply with the non-extensible deadline to file a Form TM8(N), and furthermore, the proprietor could choose to re-file an application to protect its mark. Therefore, this factor is not, in my view, determinative in isolation.

41. Considering the specific circumstances of this matter, the reason for missing the initial deadline for the filing of the Form TM8(N) was due to the ill-health of the proprietor, as shown in the NHS letters provided. It appears to me that there was clear medical involvement with Mrs Kiely throughout the defence period and I accept from the witness statement of her daughter that she confirms that her mother did not have capacity at the time to deal with the matter before her. Mr Ashton made the argument that a legal representative could have been appointed however, if I believe that Mrs Kiely did not have the capacity to complete the Form TM8(N) then it follows that she would also not have had the capacity to instruct legal representatives.

42. The next issue is the one raised by Mr Ashton, that Ms Jesse Kiely is registered as a director for the proprietor company and therefore, she could have filed the Form TM8(N) herself. Whilst her reasoning that she simply wasn't aware that she was a director is not particularly compelling in its own right, she also confirmed that the email address used for the proprietor is not one she has access to- and this is supported by the emails between herself and the Tribunal- which come from a different email address to that registered for the proprietor. Further, she confirms that she was caring for her mother during her period of ill health and was unaware of the ongoing proceedings. Therefore, she was not aware that this deadline existed.

43. The next thing to consider is the length of time it subsequently took the applicants to file the Form TM8(N) and witness statement. The deadline was missed by 28 days. It was discussed in the documents filed and at the hearing that Mrs Kiely was unwell until after the deadline had passed and once she was able, spoke to a caseworker on the phone to explain what had happened and emailed across some notes from her doctor and then she and her daughter filed the Form TM8(N) (although I note they did ask for a small extension to the deadline given for this). I note that the original deadline was 2 June and Mrs Kiely still had medical treatment detailed during and after this time and therefore, I do not feel like this length of time is unreasonable for her to have tried to subsequently file the Form TM8(N).

44. I note the opponent's comments that the delays are likely to increase costs and undermine certainty in IPO proceedings. Regarding the point on costs, there are no additional costs to the opponent in allowing this opposition to run to its conclusion save the costs incurred for the attendance at the late filed Form TM8(N) hearing which will be considered at the determination of the proceedings. I cannot see any other costs that would have arisen simply from awaiting the filing of a form by the other party. On the point of certainty in IPO proceedings, this is of course important but I am entitled to consider extenuating circumstances which affect a party's ability to comply with the deadlines set.

45. On the balance of all the information before me, I consider that the missing of the Form TM8(N) deadline was due to the extenuating circumstances of the proprietor's

serious ill health. I note the opponent's submissions regarding the position of her daughter to be able to file the form however, I also accept her explanation that she does not have access to the proprietor's emails and was not aware of the ongoing proceedings as well as being concerned for the health of her mother rather than running the company on her behalf. I am also aware that the proprietor might simply re-file their mark and end up in further proceedings before the Tribunal. Therefore, on consideration of all the above factors, I am exercising the discretion provided under rule 38(6) in the applicants' favour.

Outcome

46. The consequence of the above finding is that the applicants' Form TM8(N) and counterstatement will be admitted into the proceedings and assessed accordingly. Providing no anomalies are identified, it will then be formally served upon the cancellation applicant and a timetable will be set for filing evidence.

Costs

47. As I have admitted the proprietor's defence into the proceedings, and the revocation proceedings are allowed to continue, costs will be considered at the final determination of the case.

Dated this 14th day of November 2025

L NICHOLAS
For the Registrar