

O/1066/24

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK REGISTRATION NO. 3949555
IN THE NAME OF UK VISION TRADE LTD
FOR THE MARK:

The logo for UK VISION, featuring the letters 'UK' in a bold, red, italicized sans-serif font, followed by the word 'VISION' in a grey, italicized sans-serif font.

IN CLASS 9

AND

THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT
FILED IN DEFENCE OF THAT REGISTRATION
IN REVOCATION PROCEEDINGS UNDER NO. 507223
BY HANGZHOU HIKVISION DIGITAL TECHNOLOGY CO., LTD.

Background

1. UK Vision Trade Ltd (“the proprietor”) is the registered proprietor of the UK trade mark displayed on the front cover of this decision, under registration number 3949555 (“the proprietor’s mark”). The proprietor’s mark was filed on 24 August 2013 and was registered on 24 November 2023. It stands registered in respect of the following terms in class 9.

Class 9: Closed circuit television systems (CCTV); Video surveillance cameras; Closed circuit TV [CCTV] software; Surveillance cameras; Security cameras; TV cameras; Network surveillance cameras; Network monitoring cameras for surveillance; Panoptic cameras; Cameras; Security surveillance robots; Conferencing cameras; Network monitoring cameras namely for surveillance; Motion-activated cameras; Video cameras; Security surveillance apparatus; Video surveillance systems; Network monitoring cameras; 360° video cameras; Shutters [for cameras]; Cameras shutters; 360° cameras; Photographic cameras; Infrared cameras; Television cameras; Security alarms; Keypads for security alarms; Gimbals for cameras; Video cameras for broadcasting; Cameras [photography]; Digital video cameras; Mirrorless cameras; Lenses for video cameras; Digital cameras; 35mm cameras; TV simulators for deterring burglars; Digital single-lens reflex (DSLR) cameras; Tripods for cameras; Tripods [for cameras]; Electric and electronic video surveillance installations; Dashboard cameras; Burglar alarms; Cameras (Cinematographic -); Cinematographic cameras; UV filters for digital cameras; View cameras; Bags for cameras and photographic equipment; Electronic burglar alarms; Underwater cameras; Retinal cameras [other than for medical use]; Viewfinders [for cameras]; Portable video cameras with built-in videocassette recorders; Video Conference cameras; Security alarm systems [other than for vehicles]; Photocells for use with security lighting; Electrical and electronic burglar alarms; Film cameras; Camera shutters; Disposable cameras; Motion sensors for security lights; Alarm monitoring systems; Multipurpose cameras;

Cameras for monitoring and inspecting equipment in a nuclear power station; Plate cameras; Intercoms; Video intercom apparatus; LCD projectors; Control panels for security alarms; TV monitors; Electronic article surveillance [EAS] software; Video conferencing equipment; Flash guns for cameras; Flash guns [for cameras]; Lenses for cameras; Closed circuit television cameras; LCD monitors; Fisheye lenses for cameras; Cameras for smartphones; Conference cameras; Anti-intrusion alarms; Cameras for vehicles; Videocameras [camcorders]; Photographic flash units [for cameras]; Photographic flash units for cameras; Onboard cameras; Video conferencing monitors; Television camera tubes; Theft alarms; Car video recorders; Endoscopy cameras for industrial purposes; Helmet cameras.

2. On 9 April 2024, Hangzhou Hikvision Digital Technology Co., Ltd. (“the applicant”) applied to have the contested mark declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”). The application is brought under sections 5(2)(b), 5(3) and 5(4)(a) of the Act and is targeted at all of the goods of the contested mark’s specification.

3. The Tribunal served the Form TM26(1) on the proprietor by both post and email on 7 May 2024. In accordance with rule 41(6) of the Trade Mark Rules 2008 (“the Rules”), the proprietor was informed that it had two months from the date of the official letter in which to file its Form TM8 and counterstatement. The pertinent paragraphs of the letter are as follows:

“Please find enclosed a copy of an amended TM26(1), application for invalidity, 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 - please note the important deadline below. You will find a blank Form TM8 on the IPO website, together with brief guidance on what happens after it is filed:

<https://www.gov.uk/government/publications/trade-mark-forms-and-fees/trade-mark-forms-and-fees>

Rule 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 8 July 2024.

*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, the proprietor did not file a Form TM8 by the prescribed deadline of 8 July 2024. Consequently, on 17 July 2024 the Tribunal wrote to the proprietor stating:

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

“...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 registry is minded to treat the proprietor as not opposing the application for invalidation and declare the registration as invalid 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, 31 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.”

5. On 22 July 2024, the proprietor responded setting out its reasons for missing the prescribed deadline. This was followed up with a witness statement from the proprietor dated 27 July 2024, received 30 July 2024, which stated *inter alia*:

“3. Incident Description

We are aware that Hangzhou Hikvision Digital Technology Co Ltd is requesting the withdrawal of our trademark registration. We have received correspondence from their representative in the UK, specifically a TM26(I) form. Unfortunately, I was away for an extended period to care for my ill father and was therefore unable to respond to this matter in a timely manner. We have also made several attempts to open a direct line of conversation with the other party that were totally ignored by them.

Upon my return, I immediately sent an email to the Intellectual Property Office (IPO) indicating my intention to request a hearing at the earliest possible time.”

6. On the same day, the Tribunal informed the parties that as no Form TM8 had been filed and there appeared to be no “compelling reasons” or “extenuating circumstances” it was the preliminary view of the Registrar to declare the registration as invalid. The parties were advised that, if they disagreed with the preliminary view, a hearing should be requested on, or before, 16 August 2024, and that a Form TM8 should be filed. The relevant paragraphs of that letter are as follows:

“Thank you for your letter dated 22 July 2024 in which you explained why you did not file a Form TM8 and counterstatement within the period allowed. The Registry is also in receipt of your witness statement, received on 30 July 2024.

The case has been given consideration and given that the witness statement of Mr. Sohrab Tavakkolee Tazehabadi explained that the primary reason form TM8 was not filed was due to absence from work, it is the Registrar’s preliminary view to declare the registration as invalid.

Whilst the Registrar is very sympathetic to the applicant's personal circumstances, there appears to be no 'compelling reasons' or 'extenuating circumstances' that would permit the exercise of the Registrar's very limited discretion under Rule 41(6) of Trade Mark Rules 2008.

[...]

Given all of the above, a period of 14 days, that is, on or before 16 August 2024, is allowed for you to confirm if you still wish to request a hearing on this matter and to file a Form TM8 and counterstatement."

7. On 6 August 2024, the proprietor filed a Form TM8 and notice of objection to the Registrar's preliminary view. Consequently, a procedural hearing was set for 4 September 2024, to discuss the matter of the late filed defence.

The hearing

8. A joint hearing took place before me by video conference on 4 September 2024. At the hearing, Ms Swindells of Jones Day appeared for the applicant, while the proprietor was represented by Mr Tazehabadi, who identified himself as the owner of UK Vision Trade Ltd. Only the applicant filed a skeleton argument in advance of the hearing.

9. At the hearing, Mr Tazehabadi, confirmed the following:

- His company had been operating for 3 years. It was based in Wembley and had between two and four employees, none of which were trained to deal with IPO or trade mark matters.
- His father, who lived in Iran was very ill and bed-bound and Mr Tazehabadi had to travel there to care for him. The dates on which he travelled to Iran were 15 January 2024 to 27 February 2024. He was then in the UK for about a day before travelling again to Iran on 28 February 2024; arriving back to the UK on 24 June 2024. Whilst in Iran, there was very poor internet service to receive emails.

- Between 24 June 2024 and the deadline for filing the Form TM8 (8 July 2024), he was dealing with a sensitive matter involving social services, the police and his children, therefore he could not respond to the Tribunal. I acknowledge that this was raised for the first time at the hearing. He confirmed that he only returned to work on 10 July 2024 and did not have contact with his employees in the time that he was absent from the business.
- Whilst he was away in Iran, his employees contacted the cancellation applicant and or its representatives, but they did not receive a response. The details of this were unclear, but the proprietor stated that it could provide proof of this.

10. In response, Ms Swindells confirmed that Jones Day had not received any emails or letters from the proprietor. It was confirmed during the hearing that the applicant had not either. Ms Swindells submissions mainly followed the points raised in the skeleton argument, including:

- Businesses have to function and comply with their corporate obligations, irrespective of care commitments of UK Vision's personnel, particularly in a setting where there are two or four other employees available. There has been no forthcoming explanation regarding why other members of the business were not able to respond to the letters of the IPO.
- The threshold and strict scope of rule 41(6).
- The delay to the applicant would result in prejudice to the applicant not only for costs for providing a skeleton argument and attending the hearing, but also potential prejudice in delaying infringement proceedings to the High Court.

11. In relation to costs Ms Swindells requested that in the event that the Form TM8 was not admitted into proceedings, costs should be issued for providing a skeleton argument and attending the hearing.

12. At the hearing I directed that:

- (1) The registered proprietor files evidence showing that letters or emails were sent to the cancellation applicant or its representatives prior to the deadline for filing the TM8. These are to be filed on, or before, 11 September 2024.

(2) The cancellation applicant will then have 5 working days, i.e. until 18 September 2024, to make any comments in reply, if it so wishes.

13. Following the hearing, I received evidence from the proprietor of the following:

- An email sent to the applicant's legal department on 29 March 2024, in response to a letter before action.
- A letter sent to the applicant's address in China, as recorded on the UK trade mark register, bearing two dates: 1 April 2024 and 8 April 2024, along with proof of postage.

14. In accordance with directions, the applicant also provided:

- Further submissions addressing the evidence provided by the proprietor.
- Evidence that it claims demonstrates Mr Tazehabadi was able to sign and file accounts with Companies House for UKVISION on 8 May 2024, i.e. within the prescribed 2 month deadline for filing the Form TM8 and counterstatement.

DECISION

15. The filing of the Form TM8 and counterstatement in invalidation proceedings is governed by rule 41 of the Rules. The applicable parts to these proceedings read as follows:

"41. -(6) The proprietor shall, within two months of the date on which a copy of Form TM26(1) 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."

16. 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.

17. There is no suggestion that there has been any irregularity on the part of the Tribunal. Consequently, the only basis on which the proprietor may be allowed to defend the application for revocation is if I exercise in it's favour the discretion afforded to me by the use of the words “unless the registrar directs otherwise” set out above in rule 41(6).

18. In approaching the exercise of discretion in these circumstances, I take into consideration 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 have to be satisfied that there are extenuating circumstances or compelling reasons which justify the exercise of the narrow discretion afforded to me in the proprietor's favour.

19. Furthermore, in *Music Choice Ltd's Trade Mark (“Music Choice”)*,³ the High 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, addressing each factor below in turn, and referring to the parties' submissions to the extent I consider necessary.

¹ BL/O/035/11

² BL/O/050/12

³ [2005] RPC 1877

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

20. The proprietor has never suggested that it had not received the registry's letter dated 7 May 2024. Rather, it is argued that Mr Tazehabadi, the director/owner of the proprietor's company, was preoccupied as he was outside the country caring for his ill father in Iran, which prevented him from responding to the letter of the Tribunal and resulted in the proprietor not filing the Form TM8 by the prescribed deadline. It was also suggested that there was poor internet service in the area in which he was caring for his father. The two-month deadline for filing the Form TM8 was between 7 May and 8 July 2024. The periods within which Mr Tazehabadi was outside the UK caring for his father were from 15 January 2024 to 27 February 2024 and, after being in the UK for about a day, from 28 February until 24 June 2024, meaning that there was a two-week period prior to the deadline for filing the Form TM8 when Mr Tazehabadi was in the UK. When this was explored at the hearing, Mr Tazehabadi explained, for the first time, that he had to contend with a matter concerning his children, social services and the police and that he did not return to work until 10 July 2024. Whilst I sympathise with Mr Tazehabadi circumstances, it cannot be ignored that during the hearing it was established that there were two to four other employees working for the business. It was claimed that these employees were not trained to deal with IPO or trade mark issues, although notably in Mr Tazehabadi's absence, they were able to telephone and write to the applicant in relation to the matter. As such, the proprietor has failed to provide adequate reasons why the employee(s) who telephoned and wrote to the applicant could not have responded to the Tribunal, at the very least setting out the situation of the proprietor in the absence of Mr Tazehabadi. Moreover, since the hearing, I have had the benefit of considering correspondence from the proprietor that was sent to the applicant to see whether there was clearly an intention to defend the invalidation application against UKVISION. I note that the correspondence was sent prior to the TM26(I) being officially served on the proprietor and a deadline being imposed. Further, it does not expressly state an intention by the proprietor to defend the opposition; rather, it outlines its wishes to discuss the matter and arrange a meeting. Therefore, it cannot be said that following the service of the TM26(I) the proprietor had expressed an intention to defend the invalidation proceedings against it. Finally, I observe that even after Mr Tazehabadi returned to work on 10 July 2024,

the Tribunal was not contacted by the proprietor until 22 July 2024 and the Form TM8 was not filed until 6 August 2024; almost a month after the original deadline.

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

21. The application for revocation of the proprietor's mark is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act. Whilst it is not for me to determine the merits of the case at present, there is nothing to suggest that the application is without merit, and the case will require the filing of cogent evidence.

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

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

23. 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 applicant by the delay;

24. The applicant has identified within its skeleton argument that the delay had caused prejudice to the applicant by way of general uncertainty of Hikvision's rights, cost consequences of preparing for the procedural hearing and skeleton arguments, and a potential prejudice to further actions Hikvision may wish to take subsequent to these proceedings, such as infringement proceedings before the High Court.

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

25. None were identified by either party. Whilst the applicant has indicated that it may wish to seek infringement proceedings before the High Court, this is not a matter that currently exists and there do not appear to be any other related proceedings.

Considerations

26. 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.

27. I take account of the circumstances that caused the late filed defence. Whilst I acknowledge that Mr Tazehabadi was absent from the business for several months, and indeed out of the country for almost 6 months, no sufficient reason has been forwarded for why another employee could not have filed the Form TM8 in his absence. It was asserted at the hearing that the remaining employees that were in charge of the day-to-day running of the business whilst Mr Tazehabadi was away from the business were not trained to deal with IPO or trade mark issues. However, I do not accept this as a justifiable reason. Many business directors or employees are unlikely to be routinely trained to deal with IPO or trade mark issues and it is reasonable to expect employees to respond to business correspondence, especially those left in charge whilst the owner is absent for prolonged periods. It is incumbent on businesses, even small ones, that they should be able to operate effectively in prolonged periods of absence by their directors/owners. It is not unreasonable to have expected some sort of correspondence from the proprietor prior to the deadline for filing the Form TM8, even if this was merely to communicate its intention to defend the invalidation proceedings and the situation with Mr Tazehabadi's absence. Instead, the first the Tribunal heard from the proprietor was on 22 July 2024, 5 days after the Tribunal wrote to the proprietor informing UKVISION of the missed deadline. Furthermore, the Form TM8 was not filed until 6 August, almost a month after the prescribed deadline.

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

29. It is important to express that whilst I acknowledge the applicant's evidence regarding the filing of accounts by Mr Tazehabadi at Companies House on 8 May 2024, the proprietor has not had the chance to respond to this evidence, therefore I have given it little weight within my assessment.

CONCLUSION

30. The consequence of the above finding is that the Registrar's preliminary view is upheld and the proprietor's late filed Form TM8 will not be admitted into the proceedings. Subject to any appeal, the invalidation proceedings will be deemed as undefended, and the proprietor's mark will be declared invalid for all the goods registered under its mark.

COSTS

31. As my decision terminates the proceedings, I must consider the matter of costs. The applicant is entitled to a contribution towards its costs, based on the scale published in the TPN 1/2023.⁴ I therefore assess the costs as follows:

Official fee:	£200
Preparing the statement of case:	£250

⁴ As the invalidation proceedings were brought after 1 February 2023.

Preparing a skeleton argument and
attending the hearing: £550⁵

Total: £1,000

32. I therefore order UK Vision Trade Ltd to pay Hangzhou Hikvision Digital Technology Co., Ltd. the sum of £1,000. 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 12th day of November 2024

Sarah Wallace
For the Registrar

⁵ This is to include submissions filed after the hearing in response to the proprietor's evidence.