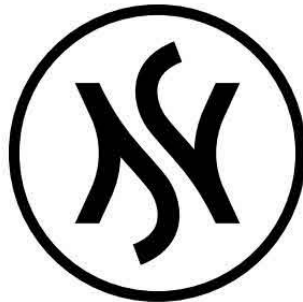


O/1180/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004074255
SHENZHEN HERBENSHE'S BRAND MANAGEMENT CO. LTD.
TO REGISTER:



AS A TRADE MARK IN CLASSES 25 AND 35

AND

NOTICE OF OPOSITION NO. 450544 BY
MAJOR LEAGUE BASEBALL PROPERTIES INC.

BACKGROUND AND PLEADINGS

1. On 11 July 2024, Shenzhen Herbenshe's Brand Management Co., Ltd. (“the applicant”) applied to register the figurative mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 26 July 2024. The applicant seeks registration for the following goods and services:

Class 25: Pajamas; brassieres; underclothing; underpants; corsets [underclothing]; clothing; Tee-shirts; Yoga pants; corselets; tights; swimsuits; waterproof clothing; Ball gowns; scarfs; girdles.

Class 35: Presentation of goods on communication media, for retail purposes; advertising; commercial administration of the licensing of the goods and services of others; providing business information via a website; provision of an online marketplace for buyers and sellers of goods and services; personnel management consultancy; website traffic optimisation; accounting; sponsorship search; wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies.

2. On 23 September 2024, Gowling WLG (UK) LLP (“Gowling”) filed a Form TM7A (Notice of threatened opposition) on behalf of the putative opponent, Major League Baseball Properties, Inc (“the putative opponent”), the effect of which was to extend the opposition period for the putative opponent until 28 October 2024.
3. On 28 October 2024, the putative opponent filed a Form TM7 (Notice of opposition), but the fee was not received until 29 October 2024.
4. On 5 November 2024, the Tribunal wrote to Gowling stating:

“Unfortunately, our finance department have confirmed that they did not receive the £200 bank transfer until 29 October 2024. Please note that while the form TM7 was received on 28 October 2024, the form is not deemed filed until the appropriate fee has been received.

Rule 4(2) of the Trade Marks Rule 2008 confirms that *'Any form required to be filed with the registrar in respect of any specified matter shall be subject to the payment of the fee (if any) prescribed in respect of that matter by those rules.'*

Application number UK00004074255 was published on 26 July 2024. The final date to file the TM7 along with the appropriate fee, taking into account the TM7a and the fact that the deadline fell on the weekend, was 28 October 2024.

Therefore, as the fee was not received until 29 October 2024 your notice of opposition has been filed outside of the statutory period set in accordance with Rule 17(3).

In view of this there is no course available for your opposition to be launched against the application. The application will shortly proceed to registration. You may wish to take alternative action against the mark once the mark is registered.

Your attention is drawn to the following link:

<https://www.gov.uk/government/publications/trade-marks-invalidation>

In view of this your fee of £200 will be refunded in due course."

5. Gowling was allowed until 19 November 2024 to comment upon the above approach.
6. On 7 November 2024, Gowling responded. The pertinent points of their letter are reproduced below:

Our client formally requests that the decision to void the Opposition is reversed and the Opposition is allowed to continue. Our Client requests this on the following basis:

- 1) **Avoidance of duplication/unnecessary work for the UKIPO:** Should the Opposition be void and the Application proceed to registration, we anticipate that we will be instructed to proceed to file an invalidation action. We are mindful that the UKIPO is currently facing unprecedented backlogs and delays due to the sheer number of opposition and examination work it is currently undertaking. Indeed, during my recent attendance at the CITMA Autumn Conference, a number of excellent UKIPO case workers spoke at Q&A sessions to explain the delays being faced at the UKIPO and how the industry could better understand and better assist with these delays. Accordingly, we are hopeful that the UKIPO can understand it would be more pragmatic and efficient to allow the Opposition to proceed. Such an action will ensure the UKIPO does not have to proceed with the substantial work required for registering the Application, to only then receive invalidation proceedings from our Client which may invalidate the mark.
- 2) **Evidence of receipt of the fee:** Our Client had prepared two oppositions with fees on the same day (28 October) in relation to two different applications. One of the oppositions was not then lodged as it became evident that the application in issue had been withdrawn. However, the fees payment for both were processed. Within correspondence received on 31 October, Tracey Ferris of the the UKIPO confirmed receipt of the opposition fees in question (see attached correspondence). We are investigating why the fee does not seem to have appeared in the UKIPO account until 29 October as it was requested and processed on 28 October and the Opposition lodged on the same day. Whilst we completely appreciate that there appears to have been a delay in the fee appearing in the UKIPO account, it is clear that our client was cognisant of the deadline, did file the requisite Form TM7 and make the fee payment. We do not believe that the short delay caused any disadvantage to the process or to the parties, other than to our Client given the refusal to accept the Opposition.

7. On 11 November 2024, the Tribunal responded to Gowling, stating:

“I refer to your correspondence received on 07 November 2024 which contained information in two parts:

- i) Avoidance of duplication/unnecessary work for the IPO
- ii) Evidence of receipt of fee

Please note the amount of work we currently have has no bearing on whether we accept a late-filed form. In accordance with Rule 4(2) of the Trade Marks Rule 2008, the form will not be accepted until the fee has been paid.

It is further noted that the email from Tracey Ferris dated 31 October 2024 advises the parties that two TM7s were received on 28 October 2024 however, and as the opponent was advised in the letter dated 05 November 2024, the fee was not received until 29 October 2024 (confirmed by our Customer Accounts team), which means the TM7 was filed out of time.

Please can you confirm in writing if the opponent wants a hearing on the matter. Your response should be submitted on or before 19 November 2024.”

8. Gowling subsequently requested a hearing on 15 November 2024.

THE HEARING

9. The hearing took place before me via Microsoft Teams on Wednesday 4 December at 10.30am.

10. Lucy Singer and Kate Swaine of Gowling appeared on behalf of the putative opponent. The applicant did not attend, nor did it file written submissions in lieu.

11. At the hearing, Ms Singer outlined a timetable of events which is as follows:

23 September 2024- The putative opponent filed a Form TM7A.

24 October 2024- The putative opponent sent a letter to the applicant and their representatives but did not receive any response to those letters.

28 October 2024- The putative opponent filed a Form TM7 and at the same time instructed for the finance transfer to take place for the fee. This was confirmed on their internal systems.

31 October 2024- The putative opponent received an email from a member of the IPO's finance team notifying the putative opponent that they had paid two fees in error. The putative opponent clarified that they had prepared two oppositions with fees on the same day (28 October) in relation to two different applications. One of the oppositions was not lodged as it became evident that the application in issue had been withdrawn. However, the payment for both oppositions were processed.

5 November 2024- The putative opponent received a letter from the Tribunal as outlined above in paragraph 4.

12. Ms Singer also summarised the putative opponent's position on the matter submitting that they had acted in good faith having actioned the payment on 28 October however Ms Singer accepted that the fee was not received by the office until the 29 October and stated that she could not explain why. Nonetheless, it was submitted that there would be no prejudice to the applicant if the Tribunal

were to accept the TM7 and that it would be entirely proportionate given the circumstances already outlined. Further, Ms Singer stated that the putative opponent would proceed with an invalidation action should the Tribunal refuse the TM7 so, in terms of efficiency and considering the current workload at the IPO, Ms Singer requested that the Tribunal exercised its discretion to allow the TM7 to proceed.

DECISION

13. The relevant part of Section 38 of the Trade Marks Act 1994 (“the Act”) reads:

“38 (1) When an application for registration has been accepted, the registrar shall cause the application to be published in the prescribed manner.

(2) Any person may, within the prescribed time from the date of the publication of the application, give notice to the registrar of opposition to the registration. The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.”

14. Section 79(1) of the Act states:

“There shall be paid in respect of applications and registration and other matters under this Act such fees as may be prescribed.”

15. Rules 4(1) and (2) of the Trade Marks Rules (“the Rules”) provide:

“4(1) The fees to be paid in respect of any application, registration or any other matter under the Act and these Rules shall be those (if any) prescribed in relation to such matter by rules under section 79 (fees).

(2) Any form required to be filed with the registrar in respect of any specified matter shall be subject to the payment of the fee (if any) prescribed in respect of that matter by those rules.”

16. Further, the Fees Rules state:

“1(2) These Rules shall be construed as one with the Trade Mark Rules (2008).”

17. Under the heading “Fees Payable”, Rule 2 of the Fees Rules states:

“...(2) In any case where a form specified in the Schedule as the corresponding form in relation to any matter is specified in the 2008 Rules, that form shall be accompanied by the fee specified in respect of that matter (unless the 2008 Rules otherwise provide).”

18. The combined effect of the above provisions is that, in order to give notice to the registrar of an opposition, an opponent who has filed a Form TM7a must file a Form TM7 within three months from the date the application was published for opposition purposes¹ and, in accordance with Rule 2 of the Fees Rules, the form shall be accompanied by the fee.

19. Regarding payments made to the office via bank transfer, I note the comments of the Hearing Officer in BL-O-132-16 which states:

“22. Whilst a cheque is regarded as payment, a bank transfer is not. It is an instruction given to a bank to pay a sum in the recipient’s bank account. It is not regarded as a ‘payment’ until the funds are actually cleared into the recipient’s bank account. Although there is no clear provision to this effect in the Trade Mark Directive, a similar position is outlined in the Community Trade Mark Fees Regulation at Articles 5(1)(a) and 8(1)(a), which state that in relation to fees paid by payment or transfer to a bank account held by the Office “the date on which payment shall be considered to have been made to the Office” is “the date on which the amount of the payment or of the transfer is actually entered in a bank account held by the Office”. (both are my emphasis).

¹ In accordance with Rules 17(2) and (3) of the Rules.

20. Gowling filed the Form TM7 on 28 October 2024 and the process to pay the official fee was initiated on the same date. Although Gowling had initiated the bank transfer on 28 October 2024, the IPO's finance team did not receive the payment until 29 October 2024. As a consequence, the "effective date" of the Form TM7 became 29 October 2024. I note that Gowling does not dispute this sequence of events and accepts that the fee was not received by the office until 29 October 2024.

21. Whilst I note Gowling's submissions regarding the avoidance of duplication/unnecessary work for the IPO and any prejudice caused to the applicant, any potential impact on office workloads and prejudice to the applicant has no bearing on my decision as the filing of a Form TM7, including the payment of the fee, is subject to a non-extendable deadline.

22. I also wish to address the email Gowling received from the IPO's finance team on 31 October 2024. The contents of that email read:

"On Monday 28th October 2024 we received a form TM7 - UK00004074255: TM7 [GOWLG-LEGAL02.666634.2782825]

But we now appear to have received two payments.

Can you please confirm if there is another form sent or to be sent."

23. Whilst this email confirms that Gowling filed a Form TM7 on 28 October 2024, it does not confirm that the office received the fee on the same date. Further, the Tribunal Casework Examiner is responsible for implementing formalities checks of the Form TM7 including the date of filing and receipt of payment. This is why the IPO's finance team did not raise the issue with Gowling in their email. Instead, the matter of the late payment was raised by on 5 November 2024 in the Tribunal Casework Examiner's letter to the parties.

24. Taking into account all the relevant factors, I have found no single reason or combination of reasons sufficient to enable me to admit the Form TM7 into these proceedings. Although I agree that the putative opponent has acted in good faith and initiated payment proceedings on 28 October 2024, the payment was not received by the office until a day later and as such they have still failed to fulfil the procedural requirement (one that the professional representatives would have been entirely familiar with). I am sympathetic to the putative opponent's position; however, I consider that the strict adherence to the procedural requirement outweighs the opponent's interest in having the matter determined via opposition proceedings. Although the approach I have adopted may appear harsh, the prejudice to the putative opponent is mitigated by the alternative remedy of being able to seek to invalidate the mark once registered.

OUTCOME

25. I refuse to admit the Form TM7 and the application shall proceed to registration.

26. I note the opponent has received a refund for the opposition fee (£200), this is subject to any appeal against this decision.

COSTS

27. In the circumstances, I make no award of costs.

Dated this 16th day of December 2024

Catrin Williams
For the Registrar