

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN INTERLOCUTORY HEARING HELD IN RELATION TO  
OPPOSITION NO: 90599 BY UNITERS S.P.A. TO TRADE MARK APPLICATION  
No: 2199661A IN THE NAME OF K.M.L. INVEST AB**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF** an Interlocutory Hearing  
held in relation to Opposition No: 90599 by Uniter  
S.p.A. to trade mark application No: 2199661A in  
the name of K.M.L. Invest AB

### **BACKGROUND**

1. On 6 May 1999, K.M.L. Invest AB of Sweden applied for the registration of a series of three trade marks in Classes 2, 3 and 37. Following examination the first mark in the series was deleted and the application divided into two parts. The B element of the application (No: 2199661B) is in Class 37 and is currently status 'pending examined'; it is not relevant for present purposes and I need make no further mention of it in this decision. The A element of the application (the trade marks in dispute in these proceedings) were published in the Trade Marks Journal on 20 February 2002. The trade marks and the goods for which they were accepted are shown below:



#### **Class 2**

Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.

#### **Class 3**

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

2. I note that since the application was published the specification of goods in Class 3 has

been amended to read:

Perfumery and essential oils (not for personal use); soaps for use in respect of upholstery including leather and/or upholstered furniture; bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations.

Nothing turns on this amendment and I need make no further mention of it.

3. On 20 May 2002, Clifford Chance LLP on behalf of their clients Uniter S.p.A. filed Form TM7 together with a Statement of Grounds of Opposition. In an official letter dated 27 May 2002, and in keeping with the Trade Marks Registry's established practice of scrutinising pleadings (outlined in Tribunal Practice Notice 4 of 2000) the Trade Marks Registry wrote to Clifford Chance requesting further information. The additional information sought by the Trade Marks Registry was provided by Clifford Chance on 12 June 2002 in the form of an amended Statement of Grounds.

4. In an official letter dated 17 June 2002, the amended Form TM7 and Statement of Grounds was served on the applicants' professional representatives W.P. Thompson & Co. This letter contained the following paragraph:

"If you wish to continue with your application, you should complete the enclosed Form TM8 and return it with the counter-statement within **3 months** from the date of this letter. The TM8 and counter-statement should therefore be received on or before **17 September 2002** unless a cooling off period is entered into by the parties."

5. In a letter dated 17 September 2002, (which was sent by both facsimile transmission and post) W.P. Thompson & Co wrote to the Trade Marks Registry. They did so in the following terms:

"With reference to the official letter dated 17 June 2002, please find enclosed the counterstatement on behalf of our client in the above proceedings.

We confirm that a copy of the counterstatement has been forwarded to the agents for the opponent."

Attached to the letter was a counterstatement consisting of four pages and nine numbered paragraphs.

6. In an official letter dated 19 September 2002 the Trade Marks Registry wrote to W.P. Thompson & Co; the relevant parts of that letter are reproduced below:

"You have filed a counterstatement in support of the above application, dated 17 September 2002, but unfortunately no Form TM8 was filed alongside the counterstatement.

The official letter dated 17 June 2002 stated that you had a period of 3 months for the

filing of a Form TM8 and counterstatement, that period being non-extendable under rule 68(3) of the Trade Marks Rules 2000. The last day for filing the Form TM8 and counterstatement was 17 September 2002.

The consequence of not filing a Form TM8, is that you have not complied with rule 13(3) of the Trade Marks Rules 2000 (filing within 3 months), which brings into force rule 13(6), therefore the application will be deemed withdrawn in accordance with the rules.”

7. In response to the Trade Marks Registry letter, W.P. Thompson & Co in a letter dated 25 September 2002 commented as follows:

“With reference to the official letter 19 September 2002 which was received in this office yesterday, we submit that the applicant’s above trade mark application should not be deemed withdrawn.

In the official letter dated 17 June 2002, the applicant was requested to return the TM8 with counterstatement by 17 September 2002 unless a cooling-off period was entered by the parties.

On 17 September 2002 the applicant’s counterstatement was sent by fax to the Registry but due to an administrative error on our part, this was apparently not accompanied by the Form TM8.

It is clear that the applicant’s counterstatement was in fact filed in due time, as confirmed by the official letter dated 19 September. As far as the TM8 is concerned, it is submitted that all necessary details requested by the Form TM8 were present in the heading of the counterstatement itself or in the accompanying letter:

- 1) The application number to which the counterstatement relates - 2199661A and both classes
- 2) the full name of the applicant - KML Invest AB
- 3) Opposition Number - 90599
- 4) name of agent W.P. THOMPSON & CO  
Coopers Building  
Church Street  
Liverpool  
L1 3AB
- 5) Trade Marks ADP No - (optional)
- 6) Reference No. JDM/JEG/WP/T407767GB
- 7) Declaration (see below)
- 8) Name - W.P. THOMPSON & CO
- 9) Date - 17 September 2002
- 10) Name and daytime telephone number of person to contact - J.D. McCall  
0151 709 3961 (as shown by the reference and letterhead).

All information was included in the counterstatement, allowing identification of the

proceedings to which the counterstatement related. The counterstatement in effect incorporated the Form TM8.

Arguably, the only point not covered was the declaration of the accuracy of truth of the matter contained in the statement. We confirm the accuracy and truth of the matter contained in the counterstatement which we filed on behalf of the applicant on 17 September 2002.

We respectfully request that the Registrar allows the applicant to continue with its application. The counterstatement as filed is a full response to the Opposition and it is therefore clear that it is the applicant's intention to defend the opposition.

We understand that the relevant provision in the Trade Marks Rules 2000 is Rule 13(8) which states the "where a notice and counter-statement are not filed within the period ... he shall be deemed to have withdrawn his application for registration". It is submitted that this only applies to clear cases where it is unquestionable that the applicant had no intention to defend the proceedings, unlike the present case. This is supported by the decision of the Appointed Person in OMITEC (Trade mark Application No. 1380020 by 11 OMI INTERNATIONAL P.C. and revocation application No. 12046 by EMITEC GESELLSCHAFT FUR EMISSIONSTECHNOLOGIE MBH) - BL (SRIS) O/018/02. An extract from the decision of the Appointed Person in respect of extensions of time under Rule 68 follows:

"The purpose behind the apparently draconian terms of Rule 68(3) is plain. Although I have only cited one of the rules that is referred to in that sub-rule, all the other rules mentioned are rules which set time limits for the commencement or continuation of proceedings. They are dates which are essential so that all the parties shall know whether or not trade marks are being opposed or are being defended. There is good reason for a formality to take place on a particular date so that everybody knows what the position is. I believe that the qualification in Rule 68(3) is important, where it puts in parenthesis: "(Time for filing counter-statement)." This is the essential step which shows that the proceedings are to be defended."

It is therefore submitted that the filing of the counterstatement within the prescribed period clearly demonstrates the applicant's intention to defend the Opposition proceedings.

Also in the same case:

"Mr. Knight did suggest that the Registrar felt she might have power to extend the time for filing the Form TM8"

If this is in fact the case, the applicant's filing of the counterstatement before the due date and the present filing of the Form TM8 should accordingly be accepted into the proceedings.

Further, it is to be noted that, unlike the non-extendible three-month period within which opposition must be filed, the period for filing the counterstatement may be extended by way of entering a cooling-off period. Even after the expiry of the cooling off period, the applicant is granted an additional month within which to file the counterstatement - Rule 13(5). Since neither the cooling off period itself nor extra month thereafter is not deemed to prejudice an opponent, we cannot see how allowing the admittance of a counterstatement (which was filed in due time) or the present filing of the actual Form TM8 would do so in the present case.

Should the Registrar decide to accept the counterstatement, there would be no prejudice to either party. The proceedings would simply proceed as normal. It would seem unfair to preclude the applicant from defending an action brought against its application by a third party simply on the basis of the omission by its agents of an administrative form, the details of which were filed in due time.

The prejudice which would be caused to the applicant by deeming its application withdrawn would be far greater than any potential detriment to any other party in allowing the opposition proceedings to proceed. The applicant is not seeking any advantage.

We therefore request that the counterstatement be accepted in these proceedings and for the sake of completeness, we attach hereto the Form TM8 which was intended to accompany it on 17 September.

In the event that the Registrar is not persuaded to allow the proceedings to continue, we request that a Hearing be appointed.”

8. In a letter to the Trade Mark Registry dated 26 September 2002, Clifford Chance commented as follows:

“We refer to the official letter dated 19 September 2002 addressed to W P Thompson & Co. and their letter to you dated 25 September 2002.

We have carefully considered the points raised by the applicant’s agents. It is our and our client’s view that given the failure by the applicant to file a form TM8 within the prescribed period, the Registrar was correct in notifying the applicant that the above application is to be treated as having been withdrawn. We, further, submit that given the applicant has failed to file its Form TM8 in the prescribed form, there is no basis on which the Registrar should or could dispense with the requirement to file Form TM8 in the prescribed form or permit it to be filed out of time.

The relevant provisions are contained in Rule 13(3) and (6) of the Trade Marks Rules 2000 and not Rule 13(8) as suggested by the applicant’s agents.

Rules 13(3) and (6) provide:

“(3) *Subject to paragraphs (4) and (5) below, within 3 months of the date on which*

*a copy of the notice and Statement [i.e. Form TM7 and Statement of Grounds] is sent by the Registrar to the applicant, the applicant may file a Counterstatement, **in conjunction with Notice of the same on Form TM8**; where such a **Notice and Counterstatement** are filed within the prescribed period, the Registrar shall send a copy of the **Form TM8 and the Counterstatement** to the person opposing the Application.*

(6) *Where a **Notice and Counterstatement** are not filed by the applicant within the period prescribed by paragraph (3) or paragraph (5) [cooling off] as appropriate, he shall be deemed to have withdrawn his application for registration”* (Emphasis added).

Rule 68(1) and (3) are also relevant. These provisions provide (amongst other things) that the period prescribed in Rule 13(3) **cannot** be extended by the Registrar.

The requirement to use forms in the prescribed form (such as Form TM8) is fundamental and is a requirement for a number of very good reasons. They promote certainty for the parties (and for the Registrar) so that all parties concerned know exactly where matters stand. They also set out, in one place, all the information which the parties need without those parties having to piece together the necessary information from other documents. Were it to become unnecessary, for example, to use prescribed forms such as forms TM7 and TM8, parties would lose the certainty of knowing, for example, that their Application has been opposed or that their Opposition has been defended. The fact that the information necessary for the purpose of these forms maybe capable of being pieced together by the person entitled to receive the form is **not** a reason for allowing the other party to dispense with the forms. On the contrary, the fact that the information to be contained in the forms is information readily available to the party required to submit the form is a reason in favour of mandating their use.

The applicant’s agents have argued that all of the information necessary for Form TM8 is contained either in their letter and/or in their Counterstatement. Firstly, we submit that the Rules are plain: the Rules require the applicant to file a Counterstatement **and** Notice of the same **on Form TM8**. Secondly, and in any event, it is **not** the case that all of the necessary information is contained in the covering letter from the applicant’s agents to the Registrar and/or the Counterstatement.

In particular, Box 4 requires the applicant to give an address for service. While the applicant’s agents have indicated that their office address in Liverpool appears on their headed notepaper, so do a number of other addresses (in London, Letchworth, Hull and Munich). It is not clear which of the various office addresses (if any) is the address for service. It is not, for example, uncommon for the address for service to be different from the party’s agent’s address.

Further, Form TM8 (as well as Form TM7) requires the party submitting the form to make and sign a Declaration confirming the accuracy and truth of the matter contained in the accompanying Counterstatement. This is a fundamental requirement, again

designed to give the parties the certainty that matters contained in Statements of Case and Counterstatements are truthful and accurate. The “Specific Notes” on the reverse of Form TM8 emphasise the importance of the Declaration:

“b) *You must send us details of the grounds for this Counterstatement on a separate sheet of paper. **You are required to declare the accuracy and truth of the matter contained in the attached Counterstatement.***” (Emphasis added).

This Declaration is, as the applicant’s agents acknowledge, absent from their letter and Counterstatement.

The applicant’s agents have referred to the Decision of the Appointed Person in the OMITEC case. That case dealt with an application by the applicant in that case for an extension of time for filing evidence of use of its mark in circumstances where the prescribed Form TM8 had properly been filed within the due time. That case is **not** analogous to the present case.

The applicant’s agents have also referred to the statement by the Appointed Person in the OMITEC case that:

*“Mr Knight did suggest that the Registrar felt she might have power to extend the time for filing the Form TM8”.*

However, as can be seen from the enclosed extracts from the OMITEC case, the Appointed Person then went on to say:

*“I must say that, as presently advised, I have my doubts on this”.*

For the reasons given above, we submit that there is no basis on which the requirement to file a prescribed Form TM8 should or could be dispensed with and no basis on which the applicant could or should be allowed to file Form TM8 out of time.

The applicant’s agents refer to the possibility of entering into a cooling off period and extending time for filing of the Form TM8 and Counterstatement under Rule 13(5). We do not see that this has any relevance whatsoever. If an opponent agrees to enter into a cooling off period, there is normally a reason for this, such as ongoing settlement negotiations. If these break down or, for any other reason, the applicant decides that it wishes to proceed with its defence of the Opposition, it must file its Form TM8 and Counterstatement within the applicable time limits.

There has been no cooling off period entered into in this case. We do not see how the fact that the deadline for filing a Form TM8 and Counterstatement *may* be extended by agreement between the parties can provide any justification for the applicant seeking to dispense with, or file late, its Form TM8 within the prescribed time in this case.

The applicant’s agents suggest that, by requesting permission to file their Form TM8



out of time, they are not “seeking an advantage” and that, if granted, their request would not prejudice the opponent. It is, we submit, quite clear this is not the case. We believe it is quite clear that in seeking to file their Form TM8 out of time where this is expressly precluded under the Rules, the applicant is seeking an advantage and that, if granted, this would prejudice the applicant.

In all the circumstances, we respectfully submit that the Registrar should refuse the request contained in the penultimate paragraph of the letter from the applicant’s agents of 25 September. In the event that the Registrar is minded to allow the Application and proceedings to continue, we request that a Hearing be appointed.”

## **THE INTERLOCUTORY HEARING**

9. On 30 October 2002 an interlocutory hearing took place before me to consider the applicants’ request mentioned in paragraph (7) above. At the hearing, Mr Doug McCall of W.P. Thompson & Co represented the applicants for registration; the opponents were represented by Mr Simon Malynicz of Counsel instructed by Mr Gary Mills of Clifford Chance.

## **THE SKELETON ARGUMENTS**

### **The Applicants’ Submissions**

10. In their skeleton arguments the applicants submitted that: (1) there was no requirement for the prescribed form to be used; (2) that in so far as the statement of truth was concerned reference would be made to the previous version of the prescribed Form TM8 and how its use beyond the implementation of TPN 1/2000 is handled by the Trade Marks Registry; (3) with reference to the OMITEC case, Rule 68(3) of the Trade Marks Rules 2000 and TPN 1/2000, a further period should have been allowed for the filing of the Registry’s version of Form TM8; (4) that in the event that the applicants’ counterstatement is not also deemed to incorporate or function as the Form TM8, it should be permitted to file the prescribed Form TM8 to correct a procedural irregularity under rule 66 of the Trade Marks Rules 2000; (5) that the Registrar has the power under rule 57 to request its version of Form TM8 in the event that the documents supplied before the due date are held not to suffice and (6) due regard should be given to the Overriding Objective.

### **The Opponents’ Submissions**

11. In their skeleton arguments the opponents’ submitted that: (1) if the applicants are requesting the Registry to treat the counterstatement and the applicants’ accompanying letter (which were filed within the prescribed period) as a TM8, then such is contrary to rule 3(2) of the Trade Marks Rules 2000; (2) if the applicants are seeking permission to file the TM8 outside the prescribed period, then such is impermissible under rule 68(3) and (3) if it is some sort of general request that the Registry simply overlook the applicants administrative error and allow the applicants to continue with its application, then such contravenes rule 13(6).

## THE DECISION FOLLOWING THE INTERLOCUTORY HEARING

12. I communicated my Decision in the matter to the parties in a letter dated 4 November 2002, the relevant portion of which is reproduced below:

“Having considered the parties skeleton arguments and authorities together with the oral submissions at the Hearing, my decision is that as no Form TM8 was filed within the statutory period the application for registration will be deemed withdrawn.

In reaching this conclusion, I note that Section 66 of the Act and in particular Rule 3(2) of the Trade Marks Rules 2000 requires that any Form filed in proceedings before the Trade Marks Registry:

“.....is satisfied by the use either of a replica of that form or of a form which is acceptable to the registrar and contains the information required by the form as published and complies with any directions as to the use of such a form.” (my emphasis).

Clearly this rule indicates that in the absence of the use of a Form as published, a replica of the Form or a Form which is acceptable to the Registrar **and** which contains all the relevant information is acceptable. At the Hearing you conceded that a Form TM8 had not been filed in good time. The fact that your letter of 17 September 2002 and the Counterstatement contained (in your view) all the relevant information is not relevant. The fact remains that no Form TM8 or a suitable alternative thereto containing all the relevant information was filed in the statutory period and as such I reject your arguments on this basis.

If I was against you on the above point, you asked me to grant the applicants an extension of time (until 25 September 2002) for the Form TM8 attached to your firm's letter of the same date to be admitted into the proceedings. In my view the rules do not permit such an approach. Rules 13(3) and 13(5) both contain a reference to “the applicant may file a counterstatement, in conjunction with notice of the same on Form TM8” ie. both documents are required to constitute a properly filed defence. Rules 13(3) and 13(5) are both non-extendible under the provisions of Rule 68(3). You made submissions to the effect that as Rule 68(3) only mentions “time for filing counterstatement” it was permissible for me to extend time for the Form TM8 to be filed. In this respect, Mr Malynicz made submissions on how what he described as the “shorthand” notes appearing in Rule 68(3) should be interpreted. In my view Rules 13(3) and 13(5) are quiet clear. In order to defend an application one must file a counterstatement and a Form TM8. In this respect I agree with Mr Malynicz that the notes appearing in the text of Rule 68(3) are for guidance only and are not intended to limit the scope of Rule 13(3) and 13(5). Consequent upon that decision your request for additional time in which to file Form TM8 is refused as I have found that there is no power to extend the time for the filing of Form TM8 under Rule 68(3). Given the wording of Rule 13(6) and in particular the use of the word “shall” in that Rule, there is no discretion for me to exercise. You referred me to Rule 66 and suggested that I may be able to correct what you considered to be a procedural irregularity. I note that

Rule 66 is subject to Rule 68. In the absence of a procedural irregularity within the meaning of Rule 68(7) (which is not the case in these proceedings), this approach is clearly not appropriate.

Finally I heard submissions on costs, with Mr Malynicz arguing that costs should be awarded to his clients on a similar basis to that mentioned by Mr Knight in the *Firetrace* decision [2002] RPC 15. You argued that no costs award should be made to the opponents as this Hearing constituted an ex-parte matter between the Trade Marks Registry and the applicants for registration and as such the opponents did not need to be represented. Whilst I accept that the opponents may have felt it prudent to be present at the Hearing to represent their clients interests, I agree that their presence was not determinative of the outcome of the Hearing. Consequently I propose to make no award of costs.”

13. On 12 November 2002, W.P. Thompson & Co filed Form TM5 requesting a written statement of the grounds of my decision; I give this decision below.

### **GROUND OF DECISION**

14. Section 38 of the Trade Marks Act 1994 and Rule 13 of the Trade Marks Rules 2000 govern the manner in which trade marks are published and, where appropriate, opposed; the relevant portions read as follows:

#### **Section 38**

“**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.”

#### **Rule 13**

“**13.** - (1) .....

(2).....

(3) Subject to paragraphs (4) and (5) below, within three months of the date on which a copy of the notice and statement is sent by the registrar to the applicant, the applicant may file a counter-statement, in conjunction with notice of the same on Form TM8; where such a notice and counter-statement are filed within the prescribed period, the registrar shall send a copy of the Form TM8 and the counter-statement to the person opposing the application.

(4) Subject to paragraph (5), at any time before the expiry of the period prescribed in paragraph (3) above for filing of Form TM8 by the applicant the registrar may, on request, grant an extension of three months to that period where such request is filed on Form TM9c and with the agreement of both the applicant and the opposing party (the "cooling off period"); the registrar may, on request, extend the cooling off period for a further three months where such request is filed on Form TM9c and with the agreement of both the applicant and the opposing party.

(5) Within one month after the expiry of the cooling off period the applicant may file a counter-statement, in conjunction with notice of the same on Form TM8; where such a notice and counter-statement are filed within that one month period, the registrar shall send a copy of the Form TM8 and the counter-statement to the person opposing the application.

(6) Where a notice and counter-statement are not filed by the applicant within the period prescribed by paragraph (3) or paragraph (5) as appropriate, he shall be deemed to have withdrawn his application for registration."

15. Section 66 of the Act and Rules 3, 57, 66 and 68 are also relevant. The relevant portions read as follows:

### **Section 66**

"66.— (1) The registrar may require the use of such forms as he may direct for any purpose relating to the registration of a trade mark or any other proceeding before him under this Act.

(2) The forms, and any directions of the registrar with respect to their use, shall be published in the prescribed manner."

### **Rule 3**

"3. - (1) Any forms required by the registrar to be used for the purpose of registration of a trade mark or any other proceedings before her under the Act pursuant to section 66 and any directions with respect to their use shall be published and any amendment or modification of a form or of the directions with respect to its use shall be published.

(2) A requirement under this rule to use a form as published is satisfied by the use either of a replica of that form or of a form which is acceptable to the registrar and contains the information required by the form as published and complies with any directions as to the use of such a form."

### **Rule 57**

"57. At any stage of any proceedings before the registrar, she may direct that such documents, information or evidence as she may reasonably require shall be filed

within such period as she may specify.”

## **Rule 66**

“66. Subject to rule 68 below, any irregularity in procedure in or before the Office or the registrar, may be rectified on such terms as the registrar may direct.”

## **Rule 68**

“68. - (1) The time or periods-

(a) prescribed by these Rules, other than the times or periods prescribed by the rules mentioned in paragraph (3) below, or

(b) specified by the registrar for doing any act or taking any proceedings,

subject to paragraph (2) below, may, at the written request of the person or party concerned, or on the initiative of the registrar, be extended by the registrar as she thinks fit and upon such terms as she may direct.

(2) .....

(3) The rules excepted from paragraph (1) above are rule 10(6) (failure to file address for service), rule 11 (deficiencies in application), rule 13(1) (time for filing opposition), rules 13(3) and 13(5) (time for filing counter-statement), rule 13(4) (cooling off period) save as provided for in that rule, rule 23(4) (time for filing opposition), rule 25(3) (time for filing opposition), rule 29 (delayed renewal), rule 30 (restoration of registration), rule 31(2) (time for filing counter-statement), rule 32(2) (time for filing counter-statement), rule 33(2) (time for filing counter-statement), and rule 47 (time for filing opposition).”

16. Section 38 of the Trade Marks Act 1994 explains how one opposes an application but makes no mention of the manner in which an applicant is required to defend an opposition to their application for registration; however, the substance of how this is achieved is to be found in Rule 13 of the Trade Marks Rules 2000 and is, in my view, quite clear. If an applicant wishes to defend an opposition to their application for registration they must within three months of the date on which a copy of the notice and counterstatement is sent by the registrar to them (under the provisions of Rule 13(3)) or within one month of the expiry of the “cooling off period” (under the provisions of Rule 13(5)) file:

“.....a counterstatement, in conjunction with notice of the same on Form TM8..”

17. Where no such notice and counterstatement are filed within the prescribed period the applicant will (under the provisions of Rule 13(6)):

“.....be deemed to have withdrawn his application for registration.”

18. The Trade Marks Registry’s letter of 17 June 2002 allowed the applicants until 17 September 2002 to consider filing Form TM8 and counterstatement. W. P. Thompson & Co’s letter and the attached counterstatement mentioned above were received by the Trade Marks Registry (by facsimile) at 14.39 on 17 September 2002.

19. At the hearing Mr McCall said:

“I think there is no dispute in this matter that we did not file a document which said at the top of it, Form TM8.”

20. The Form TM8 was not filed because of: “an administrative error on our part..” (see W. P. Thompson & Co’s letter of 25 September 2002). In his skeleton argument and at the hearing, Mr McCall argued that this error need not be fatal. Asking me at all times to bear in mind the Overriding Objective, he argued his case under three main headings; these were;

- (1) that there was no absolute requirement for the Registry’s version of the prescribed Form TM8 to be used and that the information provided in his firm’s letter of 17 September 2002 and the attached counterstatement (save for the statement of truth) fulfilled the purpose of the TM8; and
- (2) that it was permissible to allow the applicants additional time to file the correct version of the Form TM8 and to include the statement of truth; and
- (3) that the error was capable of being corrected as a procedural irregularity under the provisions of Rules 57 and/or 66 of the Trade Marks Rules 2000.

I shall deal with each of these submissions in turn.

21. In relation to point (1) above, in so far as there is no absolute requirement to use the Trade Mark Registry’s version of any form this is without doubt correct. Rule 3(2) provides that the requirement to use a form as published is satisfied by the use:

“... either of a replica of that form or of a form which is acceptable to the registrar and contains the information required by the form as published and complies with any directions as to the use of such a form.”

22. In order to defend an opposition to an application for registration it is necessary for an applicant to file a counterstatement together with a notice of same on Form TM8; both documents are required to constitute a properly filed defence. It is accepted that no Form TM8 was filed by the applicants. Can then the information provided in the agent’s letter of 17 September 2002 and counterstatement be considered to include the Form TM8 given the provisions of Rule 3(2)? In my view it cannot.

23. In his skeleton argument and at the hearing, Mr Malynicz pointed out that the letter of 17 September 2002 and the counterstatement did not include either a statement of truth (a point

Mr McCall conceded) or a readily identifiable address for service (with which Mr McCall disagreed as, I must say do I; if anything as Mr McCall pointed out at the hearing more information was provided than was actually needed). However, in so far as the former is concerned, paragraphs 27 and 29 of Tribunal Practice Notice 1 of 2000 read as follows:

**“Confirming accuracy and truth of a statement of case**

27. The Office has decided to adopt Lord Woolf’s recommendation that claims and defences should contain a declaration on behalf of the parties confirming the accuracy and truth of the matter contained in them. Such a declaration is required for trade marks proceedings and encouraged in other proceedings. It should be noted that such a declaration is necessary if a party wanted, in any subsequent appeal to the High Court, a statement of case to be taken into account as evidence.

28.....

29. If, in the event, a statement or counterstatement proves to be inaccurate or untrue then, in the absence of any clear and justified explanation for the breach, the Hearing Officer will take this into account when making an award for costs.”

The requirement to include a statement of truth is clearly an important one.

24. Mr Malynicz also argued that there were sound reasons of principle that underpin a strict approach to the use of forms citing *M’s Application* [1985] RPC 249 in support of this proposition. In that case Falconer J said:

*“As to this argument, I first of all cannot accept the submission that the objections are not objections of substance. As Mr Laddie pointed out, if one looks at section 18(1) it is mandatory that the request for the examination be in the prescribed form; and, as he pointed out, that is a sensible provision-not that that matters from the point of view of the what I have to decide, as I have to decide upon the statute as it stands. But he did point out that it was a sensible provision, because it means that the office knows at once how to process a document coming in. If there were not prescribed forms for the very many steps which have to be taken, an application or a step in an application might be taken in any form at all and, as it was put, the office could not as a practical matter operate, and the only sensible system is to have prescribed forms for the various steps which have to be taken, as a matter of practicality and, indeed, workability. However that may be, under the statute it is mandatory that the prescribed form shall be used, and it is mandatory that you pay the prescribed fee; and I cannot regard mandatory requirements under the statute as being matters of form and not of substance.”*

25. In my view this is a powerful point. The Trade Marks Registry’s Law Section (who deal with *inter alia* trade mark oppositions) handle many hundreds of pieces of correspondence every day; the requirement for parties to file the correct form or a replica of that form or a

form which is acceptable to the Registrar and which contains all the necessary information is a straightforward and sensible one; it allows certainty for all concerned. To expect the Trade Marks Registry to piece together information from a variety of different documents when a prescribed form already exists would result in unnecessary additional work for the Trade Marks Registry and would create uncertainty for all users of the trade mark registration system.

26. Whilst I have little doubt that if a replica form or a form acceptable to the Registrar was filed in good time the Trade Marks Registry may allow minor amendments to be made to that form, that is not the case here. No Form TM8 or equivalent was filed in the statutory period allowed; had the counterstatement and covering letter been provided somewhat earlier than the afternoon of the final day of the opposition period the Trade Marks Registry may have been in a position to alert the applicants' agents to their omission and the error could have been corrected; regrettably this was not the case.

27. In short, as no Form TM8 (or a replica thereof or a form acceptable to the Registrar and which contained all the necessary information) was received in the statutory period allowed, the consequences envisaged by Rule 13(6) come into effect and the applicant is deemed to have withdrawn his application for registration.

28. Turning to Mr McCall's second submission, namely that additional time should be allowed for the Form TM8 attached to W.P. Thompson & Co's letter of 25 September 2002 to be admitted into the proceedings. Mr McCall based this submission on the wording of Rule 68(3) and the comments of Mr Simon Thorley QC acting in his capacity as the Appointed Person in the *OMITEC* case and the reference in that decision to the counterstatement as being:

“..the essential step which shows that the proceedings are to be defended”.

29. Rules 13(3) and 13(5) which allow for the filing of a counterstatement in opposition proceedings are specifically mentioned in rule 68(3) as being non-extendible. It was Mr McCall's submission as the wording of Rule 68(3) namely:

“... rules 13(3) and 13(5) (time for filing counter-statement)...”,

makes no specific mention of the Form TM8, the period for filing the form must be considered extendible. One recalls that in the *OMITEC* case (which was a revocation action) Mr Thorley allowed an extension of time for the filing of evidence. In that case he said:

“Mr Knight did suggest that the Registrar felt she might have power to extend the time for filing the Form TM8. I must say that, as presently advised, I have my doubts on this, but this is not a matter that arises for decision in these proceedings. Accordingly, I am satisfied that in an appropriate case, the Registrar does have power to extend the time for filing evidence, where the Form TM8 had been properly filed by the due date.”

30. It seems to me that notwithstanding the fact that Mr Thorley did not express a concluded



view on the point, it was his initial impression that the time for filing a Form TM8 could not be extended. What in my view is important, is that while Mr Thorley took the view that the period for filing evidence under rule 68(3) was extendable, he appeared to do so only when the initial defence to the application for revocation i.e. a Form TM8 and counterstatement had been correctly filed by the due date.

31. In this regard, one also has to bear in mind that in the case of revocation or invalidation proceedings (as opposed to opposition proceedings) the registered proprietors have the benefits of both Section 72 of the Trade Marks Act 1994 i.e. that registration is prima facie evidence of validity and the wording of Rules 31(3) and 33(3) which include the phrase "...the registrar may treat..." which confers upon the Registrar a discretion in their favour. No such discretion exists in the wording of Rule 13(6) which includes the word "shall" as opposed to "may". Consequently as in my view the period for filing the Form TM8 in opposition proceedings is not extendable, the Form TM8 provided with the letter from W.P. Thompson & Co dated 25 September 2002 cannot be admitted into the proceedings.

32. Finally I turn to Mr McCall's submissions to the effect that the Trade Marks Registry can treat his firm's error as a procedural irregularity utilising Rules 57 and/or 66. As Rule 66 is subject to the operation of Rule 68(3) on which I have commented above, this is clearly not a tenable option. In so far as the use of Rule 57 is concerned, as Mr Malynicz pointed out in his skeleton argument and at the hearing, the exercise of any inherent jurisdiction must be considered in the light of the comments of Pumfrey J in *Pharmedica GmbH's Trade Mark Application* [2000] RPC 536 when he said:

"Notwithstanding the fact that the registrar is, like the county court, a tribunal which is established by statute, I have no doubt that the registrar has the power to regulate the procedure before her in such a way that she neither creates a substantial jurisdiction where none existed, nor exercises that power in a manner inconsistent with the express provisions conferring jurisdiction upon her."

33. In Mr Malynicz's view, to exercise any discretion in the applicants' favour would, in the light of the express provisions of Rule 13(3), 13(5) and 68(3) fall foul of the *Pharmedica dicta*; a view with which I agree.

## CONCLUSION

34. In these proceedings I have reached the following conclusions:

- that the applicants did not file either the prescribed Form TM8, a replica of that Form or a Form which is acceptable to the Registrar and which contains all the necessary information within the statutory time period set by Rule 13(3); and
- that the time period set by Rule 13(3) is not extendable by virtue of Rule 68(3); and
- that in view of the above, the use of Rules 57 and/or 66 are not relevant.

35. The consequence of my decisions is that the applicants will be deemed to have withdrawn their application within the meaning of Rule 13(6) of the Trade Marks Rules 2000.

**Dated this 02 Day of April 2003**

**C J BOWEN**  
**For the Registrar**  
**The Comptroller General**