

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2550402
for a series of two marks Mercury/MERCURY by Mark James Holland**

**AND IN THE MATTER OF Opposition No. 101262
by Mercury Wealth Management Limited**

**Appeal of the Applicant from the decision of
Mrs. Judi Pike dated 8 June 2011**

DECISION

1. This is an appeal against a interlocutory decision of Mrs Judi Pike, the Hearing Officer for the Registrar, dated 8 June 2011 the decision upheld the preliminary view of the Registry to the effect that the opposition to Mr Holland's trade mark application was undefended, and so the application was to be treated as abandoned under Rule 18(2) of the Trade Marks Rules 2008.
2. Mr Holland appeals from that decision so that he may defend the opposition proceedings. The Form 55 was filed on 27 June 2011 and the appeal was set down for a hearing before me on 19 October 2011. No-one attended that hearing. I had some concerns that Mr Holland, who had been acting in person, might not have understood that he needed to attend the hearing and enquiries were made of him via the Treasury Solicitors. Mr Holland responded that he had not received notice of the appeal hearing. Furthermore he indicated that it was his understanding that his trade mark application had proceeded to registration. He relied upon a letter which had been sent to him by the UKIPO dated 12 October 2011. That letter was headed

"UK Trade Mark No: 2550402 in Classes 35, 36, 45" and gave notice of a later trade mark application which the Office considered might be similar or identical to "the trade mark number shown above which you own." Mr Holland says that his understanding of the letter was that he was "acknowledged as being registered as the proprietor" of his mark, so that he did not need to pursue the appeal. He believes that the Registry is stopped from denying his proprietorship of the mark.

3. The letter of 12 October was in a standard form, giving notice to the proprietor of an earlier trade mark of a potentially conflicting later application. Such letters are sent to give notice to the owners of earlier registered trade marks of potentially conflicting later applications. They are also sent to owners of earlier pending trade mark applications, because both applications and registrations may (by reason of sub-section 6(2) of the Act) be relied upon for the purposes of relative grounds of refusal pursuant to section 5 of the Act. Despite the wording of the letter of 12 October, it did not and could not indicate that the decision of Mrs Pike had somehow been overturned, without going through the necessary appeal process, nor that the application had proceeded to registration despite the unresolved opposition. There is no estoppel. The Register clearly shows the application's status as an application subject to an outstanding opposition, due the pendency of this appeal.
4. In the circumstances, the Treasury Solicitor explained the position to Mr Holland. Mr Holland was asked whether he wished to pursue the appeal and, if so, whether he wished to attend a hearing, or make written submissions to me. He did wish to pursue the appeal but did not wish for a hearing and he provided me with

additional written submissions. These were forwarded by the Treasury Solicitor to the Opponent, which did not wish to respond with further submissions. I have therefore dealt with the appeal on the papers, as supplemented by Mr Holland's additional written submissions.

Background

5. Mr Holland applied to register his Mercury trade marks on 14 June 2010. After some discussion with the examiner, Mr Studley, of the breadth of the specification, and of potential conflicts with earlier marks the application proceeded in August 2010 for a specification of services in Classes 35, 36 and 45. Mr Studley had informed Mr Holland (*inter alia* by a letter dated 5 August 2010) that he would give notice of Mr Holland's application to the proprietors of at least 2 earlier trade marks, and that after publication an opposition might be lodged against it. Mr Holland was, therefore, aware that Mercury Wealth Management Ltd ("the Opponent") would be notified of the pending trade mark application, as the proprietor of one of the marks which had been identified by Mr Studley as potentially conflicting with it. The specification was changed slightly at Mr Holland's request in October 2010 and re-advertised. The specification on file is for

Class 35: Accountancy services, business management, consultancy and advice relating to the aforesaid services.

Class 36: Independent financial advice services; taxation consultancy services.

Class 45: Legal services, conveyancing services.

6. On 29 November 2010, an opposition was filed on behalf of the Opponent, based upon sub-section 5(2)(b) of the Act, in reliance upon the Opponent's earlier UK Mark No. 2504754. That mark is registered for 'personal financial planning services for private individuals; retirement and inheritance tax planning for private individuals; wealth preservation; holistic financial planning for private individuals; fee-based financial planning services' all in Class 36. The Opponent's mark consists of the following sign:



7. The opposition under sub-section 5(2)(b) was based upon all of the services within the earlier registration, and was levied against all of the services in Mr Holland's application.
8. The opposition was also based upon sub-section 5(4)(a), on the basis that the Opponent had been using its mark in the north-east of England since February 2008 in relation to wealth management advice, and had acquired a goodwill in respect of its mark, such that the use of Mr Holland's mark on all of the services within his specification would have been liable at the relevant date to have been prevented by the law of passing off.
9. In order to contest and defend the opposition, Mr Holland should have filed a counter-statement with a Form TM8 by 14 February 2011. He was informed of that necessity by a standard official letter sent to him on 14 December 2010, enclosing

the TM7. The letter explained that failure to file the TM8 or to request a cooling off period on Form TM9c by 14 February 2011 would result in the application being treated as abandoned unless the registrar were otherwise to direct.

10. Mr Holland does not dispute that he received the letter of 14 December 2010 and the copy of the TM7 and he accepts that he did not file a TM8 or apply for a cooling off period by 14 February 2011.
11. On 2 March 2011, Ms Mackerness of the UKIPO wrote to Mr Holland referring to and quoting Rule 18(2); she informed him that the Registrar was minded to treat the application as abandoned because no defence had been filed. Her letter referred to the right to be heard under Rule 63(1) and set a period of 14 days for either party to request a hearing or file written submissions, failing which the application would be deemed abandoned.
12. The letter of 2 March led to an exchange of emails between Mr Holland and Mr Gittings at the UKIPO. Mr Holland's initial response in an e-mail of 9 March 2011 was to set out the substantive grounds upon which he sought to contest the opposition. He did not explain why he had not filed the TM8 in time. Mr Gittings replied, explaining that the purpose of the Registry's letter of 2 March was to ask whether there were reasons why the defence had not been filed in time, and asked him to provide such reasons by 16 March.
13. Mr Holland's response by email on 11 March was that the reason for the delay "was that I had answered the case in any opposition to Mark Studley. I also had urgent

court matters arising from my use of Mercury as a business name in Leeds and Tyne and Wear in July 2003 to April 2004... I trust you will confirm my right to be heard. I will post TM8 with my chain of correspondence pursuant to Rule 63(1)." He sent a further e-mail later the same day stating that the basis of the opposition was vexatious.

14. Then, on 15 March 2011, having it seems been told on the telephone that it would be necessary for him to file a witness statement setting out the details of the matters upon which he relied, Mr Holland provided a witness statement and filed a Form TM8 which was received by the office on 17 March. The Form included a counter-statement which dealt with the substance of the opposition. The witness statement made numerous points, most of which again related to the substance of the proposed defence to the opposition, but Mr Holland also set out certain reasons for his failure to file the TM8 in time. In summary, these were that:

- i. (at paragraph 7) "Mark Studley was very diligent and called me before any important deadlines in my application, Heather Mackerness called me just before her letter notifying me of my right to make a Rule 63 response to the opposition. I should have received a call a few days before the TM8 was due to remind me, as best practice."
- ii. (at paragraph 8) The TM8 was not filed "because I was distracted by other legal matters. I am currently in litigation with my former business partner for deceiving me and stealing my money in 2003-4. ... I find it difficult to apologise in this situation because my application is being prejudiced by a criminal act in another court. My Licenced Public Bar business has been burgled on 27 January causing further damage to my

life. I have an incident reference for it ... with ... Sunderland police ... That is one of four incidents reported to the police effecting my life at the time excluding the court action.”

- iii. (at paragraph 16) The application could not be deemed ‘abandoned’ because Mr Holland had responded to telephone calls and filed written submissions in response to the letter of 2 March.

15. Mr Holland provided the Registry with further written submissions dated 24 March 2011 on the question of whether the application should be deemed abandoned. Much of this again went to his arguments on the substance of the appeal, however, he reiterated point (iii) above and referred to the wording of Rule 33 and to TPN 1/2005 and 1/2006. He relied upon his position as “the victim of several crimes” as a compelling reason to permit the late filing of the TM8. He also made a number of points suggesting that the correspondence and contact with the UKIPO from 2 March 2011 onwards (i.e. after expiry of the deadline for filing the TM8) was sufficient to save the application from being treated as abandoned. Similarly, he appears to have thought (wrongly) that there had been no opposition to his application in Class 45, so the mark should have been registered in that Class. He did not wish to attend a hearing and asked that the decision be made on the papers.
16. By letter dated 30 March 2011 the Registry’s preliminary view was sent to Mr Holland, indicating that the TM8 would not be admitted out of time. It appears that Mr Holland then sought a full reasoned decision but still did not wish to attend a hearing. The Opponent (through its solicitors, Messrs Tilley Bailey & Irvine LLP) made some written submissions dated 26 April 2011; they contested the legal

points put forward by Mr. Holland and also stated that they had made contact with him prior in October 2010 and had warned him that the application would be opposed by the Opponent.

The decision under appeal

17. Mrs Pike made the decision under appeal on behalf of the Registrar on the papers.

Having referred to the contents of the letter of 14 December, Mrs Pike said:

“you should note that the statutory time period for filing a Form TM8 and counter-statement is not extensible (Rule 77(5) refers). There is no basis for *extending* the deadline for filing the defence. The discretion in Rule 18(2) is therefore a narrow one. I refer you to the decision of Geoffrey Hobbs C, sitting as the Appointed Person in *KIX Trade Mark O-035-11*, paragraphs 8 and 9”

Mrs Pike set out those paragraphs, as I do below, and continued:

"There are no extenuating circumstances in this case which justify an exercise of the narrow discretion in Rule 18 (2). You were plainly in receipt of the Form TM7 (notice of opposition). There is a statutory requirement that the correct statutory form is used for the filing of a defence (Rules 18(1) and 3(2) refer). You have failed to adhere to the procedure set out in the Rules. The Trade Marks Act 1994 is underpinned by the Trade Mark Rules 2008 which govern procedures before the Registrar. The CPR, to which you refer, are not binding on the Registrar ... You have stated that you were distracted by other legal matters but you have also referred to correspondence on your application file as containing

"important statements of case on [your] Mark." These cannot be taken in lieu of a properly filed defence. In particular, your e-mail of 11 March 2001, ... says:

"The reason for the delay in filing a Form TM8 was that I had answered the case in any opposition to Mark Studley."

Mr Studley was the trade mark examiner responsible for progressing your trade mark application to publication. He put you on notice that notifications would be sent to third parties (including the present opponent) which you disagreed with. This does not amount to a properly constituted defence to an opposition. Rule 18(1) specifically states that for a defence to an opposition to be mounted, a Form TM8 which shall include a counter-statement must be filed within the relevant period ... If there is nothing to identify a document as a Form TM8 and counter-statement, it cannot be said to comply with Rules 3(2) or 18(1). ... your correspondence with Mr Studley does not constitute a properly filed defence to the opposition. The consequence of the above is that the opponent has been successful in its opposition because there has been no defence."

Nature of the appeal

18. This appeal is, like most appeals from Hearing Officers, a "review" not a "rehearing". Furthermore, the appeal concerned an exercise of the Registrar's discretion with which this tribunal should only interfere if satisfied that the Hearing Officer acted unreasonably (*A. J. and M. A. Levy's Trade Mark* [1999] RPC 291) or was plainly

wrong (*Siddiqui's Application*, BL O/481/00). Mr Simon Thorley QC as the Appointed Person set out the position in *Siddiqui* at pp. 2-3:

"In *A.J. and M.A. Levy's Trade Mark* [1999] RPC 291 Matthew Clarke QC, sitting as the appointed person, said this at page 292, line 1: "It has to be borne in mind that in the present proceedings what we are concerned with is an appeal and not a rehearing of the merits or otherwise of the application for the extension. That means, in my view, that the Appointed Person is only entitled to interfere with the decision of the registrar if it can be demonstrated that the discretion has been exercised in, what might be described as, an unreasonable fashion."

My view coincides with his. My duty is to review the decision and the reasons for it and, if satisfied, it is wrong to reverse it. The position of the appointed person in this

tribunal is, to my mind, no different to that of the Court of Appeal in reviewing the exercise of discretion by a judge at first instance. There are many decisions on this but in the end they boil down, I think, to the simple proposition that one will only interfere where the exercise of discretion below was plainly wrong. I think it is important in considering the exercise of discretion to bear mind that the officers at the registry have very great experience in regulating the proceedings before them and in principle they should be allowed to regulate proceedings as their experience directs and this tribunal should be slow to interfere in case management issues of the sort unless and until it is satisfied that the exercise of discretion was plainly wrong."

Merits of the appeal

19. Mr Holland filed an appeal against Mrs Pike's decision, including lengthy grounds of appeal. I shall deal with these, and with the further submissions made to me by Mr Holland, below.

20. Rule 18 of the Trade Marks Rules 2008 provides:

“(1) The applicant shall, within the relevant period, file a Form TM8, which shall include a counter-statement.

(2) Where the applicant fails to file a Form TM8 or counter-statement within the relevant period, the application for registration, insofar as it relates to the goods and services in respect of which the opposition is directed, shall, unless the registrar otherwise directs, be treated as abandoned.

(3) Unless either paragraph (4), (5) or (6) applies, the relevant period shall begin on the notification date and end two months after that date.”

Paragraphs (4), (5) and (6) apply where the parties to the opposition have agreed to an extension of time for negotiation. They do not apply in this case as no such agreement had been reached.

21. Rule 77 of the 2008 Rules makes provision for the extension of certain procedural time limits, for which purpose the applicant for the extension of time must use Form TM9. However, some of the time limits in the Rules are not capable of being extended save in very special circumstances, and those time limits are listed in Schedule 1 to the Rules – the list includes the time limit imposed in Rule 18(1). Rule 77(5) provides:

“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.”

That sub-Rule does not apply in this case, in which no irregularity has been alleged or identified, so that Rule 77 does not apply to permit the extension of the time-limit by which Mr Holland should have filed his TM8. Mr Holland refers at various points in the Grounds of Appeal to a TM9, but there was no need or reason for Mr Holland to file a TM9, and failure to have filed such a Form has not affected his position.

22. Rule 43 provides an alternative remedy where an application for registration is treated as abandoned under Rule 18(2) and the applicant can demonstrate to the reasonable satisfaction of the Registrar that the failure to file Form TM8 within the period specified in the Rules referred to in paragraph (1) was due to a failure to receive the Form TM7. That is not Mr Holland’s case, so Rule 43 does not provide a remedy for him.

23. Mrs Pike was therefore plainly right to decide that the only route open to Mr Holland was to seek to persuade the Registrar not to treat his defence of the opposition as abandoned, pursuant to Rule 18(2). Under Rule 18(2) the Registrar has a discretion as to whether or not to treat the registered proprietor as not opposing the application, where there is a failure to file the counter-statement in

time. Mrs Pike referred to the decision of Mr Hobbs QC in *KIX trade mark O/035/11*. That was a case in which the applicant had failed to file the TM8 in time because the person responsible for dealing with the matter within its organisation had not been passed the official letter from the IPO enclosing the TM7. There was no irregularity on the part of the IPO, but a problem at the applicant's offices. Mr Hobbs held:

“7 . The deadline of 20 February 2010 for filing the Applicant’s Form TM8 and Counter-statement was not a ‘flexible time limit’ within the meaning of that expression as used and defined in Rule 77. It was a time limit prescribed by a Rule listed in Schedule 1 to the 2008 Rules. It was therefore governed by the restriction contained in Rule 77(5):

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.

Since there was no basis on which the Applicant could seek to invoke the power conferred upon the Registrar by Rule 77(5), the deadline of 20 February 2010 was final and binding upon it.

8. ... the Applicant failed to comply with the applicable deadline. The effect of such failure is spelled out in Rule 18(2) in the following terms (with emphasis added):

Where the applicant fails to file a Form TM 8 or counter-statement within the relevant period, the application for registration, insofar as it relates to the goods or services in respect of which the opposition is directed, *shall, unless the registrar otherwise directs, be treated as abandoned.*

9. The words I have emphasised enable the Registrar to provide an applicant for registration with the opportunity to defend an opposition that would otherwise be treated as well-founded for lack of any defence. They only enable the Registrar to make such an opportunity available if there are *extenuating circumstances sufficient to justify the exercise of his discretion in favour of doing so*. They do not enable the Registrar simply to extend the fixed period of two months within which an applicant for registration is entitled to file a defence as of right in accordance with the provisions of Rules 18(1) and 18(3).”

24. Mr Holland argued in his submissions to Mrs Pike and to me, that the discretion should be exercised in accordance with the IPO’s Tribunal Practice Notices 1/2005 and 1/2006. He submitted to me that those TPNs show that the Registrar’s discretion to extend time under Rule 18(2) is not limited in the manner suggested by Mrs Pike in the decision under appeal. Mr Holland complained that the Registry had erred in failing to apply its own practice as set out in those TPNs in his case. As the Opponent had pointed out, those TPNs relate to the extension of time periods in proceedings for revocation for non-use and invalidation proceedings, not to opposition proceedings. Hence they are not directly in point. Moreover, both of those TPNs relate to the regime for filing pleadings and evidence under the Trade Marks Rules 2000 (as amended), which were in different terms to the Trade Marks

Rules 2008. For those reasons, it does not seem to me that Mr Holland is justified in complaining that the UKIPO failed to follow its own practice as set out in those Notices in relation to his own case, as that practice does not relate to opposition proceedings.

25. Nevertheless, to the extent that those TPNs are broadly indicative of the manner in which the Registrar should exercise the discretion to permit a counter-statement to be lodged after expiry of a non-extensible deadline, they may indicate the sort of factors which the Registrar should take into account in exercising the discretion under Rule 18(2), which Mr Hobbs QC described in *KIX* as ‘extenuating circumstances.’

26. TPN 1/2006 in particular arose from the decision of Mr Geoffrey Vos QC (as he then was) sitting as a Deputy Judge of the Chancery Division in *Music Choice Ltd’s Trade Mark* [2006] R.P.C. 13, in which he distinguished an earlier decision of Patten J in *George Lowden and The Lowden Guitar Company Limited* [2005] R.P.C. 18. The apparent conflict between the various authorities was considered in TPN 1/2006 and the Registry indicated that it intended to exercise the discretion in Rule 31(3) on the basis indicated by Mr Vos QC in *Music Choice*. The relevant part of the TPN reads as follows:

“The use of the word ‘may’ appearing in Rules 31(3) and 33(6) has been the subject of judicial comment in *George Lowden and The Lowden Guitar Company Limited* [2004] EWHC 2531 , and in *Music Choice Limited and Target Brands, Inc* CH/2005/APP 0423/0749. The consequences of the decision in *LOWDEN* were, inter alia, dealt with in Tribunal Practice Notice 1/2005.

In LOWDEN, Mr Justice Patten held that the breadth of the discretion under Rule 31(3) was very limited and could only be exercised in relation to factual errors on the Form TM26(N) and/or statement of case. However, in *Music Choice*, Mr Geoffrey Vos QC sitting as a Deputy High Court Judge, held that in an invalidation case, the registrar had a general discretion under Rule 33(6), to treat the proprietor as either opposing or not opposing the application. In addition, Mr Vos expressed reservations about the correctness of the approach adopted in LOWDEN.

Given the apparent tension between these two decisions and, as the word 'may' appearing in the respective Rules should, in the Trade Marks Registry's view, be given the same meaning and scope, the Trade Marks Registry has reviewed its practice.

The Trade Marks Registry remains of the view that it is not permissible to allow the late filing of Form TM8. However, with immediate effect, where a late filed defence is filed in revocation or invalidation proceedings before the Trade Marks Registry, the Trade Marks Registry will (on request) now consider exercising the discretion in Rules 31(3), 32(3) and 33(6) on the basis indicated by Mr Vos in *Music Choice*. As the exercise of the discretion is a judicial function, it is anticipated that consideration of the exercise of the discretion will only be given by a hearing officer following a joint hearing, and not by the case work examiner dealing with the case administratively. In determining whether the proprietor will be treated as opposing the application, considerations of the sort outlined in *Music Choice* will be taken into account ..."

27. *Music Choice* was a case in which a trade mark proprietor which was the respondent to an application for a declaration of invalidity of two of its marks had filed counter-statements in time for both marks. The TM8s were filed 2 days later; one was in time, but the other was filed just one day late. The proprietor asked the Registrar to exercise her discretion and to treat the counter-statement for that mark as valid and admissible. That application was refused. The proprietor appealed. The position was that one invalidity application would have been opposed whatever the result of the appeal, whereas the 'sister Invalidity Application' would not unless the appeal succeeded.

28. Mr Vos QC held:

“65. Having decided that there is a general discretion in the registrar, it would be inappropriate to set out factors which would circumscribe the exercise of that discretion. Plainly, however, the discretion must be exercised on the premise that the time limit in r.33(6) is inextensible, and that *there must be compelling reasons for the proprietor to be treated as opposing the application, notwithstanding his failure to comply with an inextensible time limit.*” (emphasis added).

29. The phrase which I have emphasised by italics in paragraph 65 of Mr Vos QC's judgment is, in my view, of real significance here also: the deadline for filing Mr Holland's TM8 was inextensible, and to make sense of that concept, and distinguish it from Rules which set flexible deadlines, there must be shown to be compelling reasons to exercise the discretion which exists under Rule 18(2) in his favour.

30. In *Music Choice*, Mr Vos QC set out the factors which he considered should be taken into account in applying Rule 33 of the Trade Marks Rules 2000:

“67. The factors that are, in my judgment relevant to the exercise of the discretion in this case include:

- (1) The circumstances relating to the missing of the deadline including reasons why it was missed and the extent to which it was missed.
- (2) The nature of the applicant's allegations in its statement of grounds.
- (3) The consequences of treating the proprietor as opposing or not opposing the application.
- (4) Any prejudice caused to the applicant by the delay.
- (5) Any other relevant considerations, such as the existence of related proceedings between the same parties.”

On the particular facts of that case, he ruled that the extension of time should be granted.

31. In addition to that guidance, it seems to me that the manner in which a discretion to extend an *inextensible* deadline should be exercised may helpfully be contrasted with the way in which the Registrar exercises the discretion to extend an *extendible* deadline. In *Siddiqui (supra)* Mr Thorley QC said at p. 7 that it was incumbent on the party requesting the extension of a flexible deadline to put forward facts which merited the extension:

“In a normal case this will require the applicant to show clearly what he has done, what he wants to do and why it is that he has not been able to do it.

This does not mean that in an appropriate case where he fails to show that he has acted diligently but that special circumstances exist an extension

cannot be granted. However, in the normal case it is by showing what he has done and what he wants to do and why he has not done it that the Registrar can be satisfied that granting an indulgence is in accordance with the overriding objective and that the delay is not being used so as to allow the system to be abused.

... In principle matters should be disposed of within the time limit set out in the Rules and it is an exceptional case rather than the normal case where extensions will be granted."

As a result, a party seeking such an extension of time is expected to give full and detailed reasons for the request and, in particular, to explain the delay.

32. It is all the more incumbent on someone seeking an extension under Rule 18(2) to give full and detailed reasons for the request, to show what he has done, etc and to set out in proper detail any 'extenuating circumstances' relied upon.
33. In the light of all those matters, Mrs Pike had to decide whether there were compelling reasons to exercise her discretion in Mr Holland's favour in the light of the information provided by him.
34. Mrs Pike concentrated upon the procedural framework which the application was made and the issue of whether there were 'extenuating circumstances' sufficient to justify an extension of time, as suggested by Mr Hobbs QC in *KIX*. However, she dealt with the question of extenuating circumstances only briefly and, to my mind, without setting out her reasoning. First, she said that there were no extenuating circumstances justifying the exercise of the narrow discretion in Rule 18 (2) and

referred to Mr Holland's failure to adhere to the procedure set out in the Rules. She then said "You have stated that you were distracted by other legal matters" without giving any details of what Mr Holland had said in this regard, and without saying whether she thought that his explanation had any merit or justified having missed the deadline. Whilst Mrs Pike may well have considered the point, she failed to set out any reasoning about it. Presumably she thought that the explanation had no merit, but if that is the case she should have explained why that was her view. It seems to me that this is a defect in her decision. She then concentrated in her decision upon Mr Holland's point that he thought that he had already answered the opposition in his correspondence with Mr Studley, which she rejected for the reasons that she gave. As Mrs Pike was considering only the question of whether there were extenuating circumstances, and not the further aspects of exercise of her discretion listed by Mr Vos QC in *Music Choice*, she did not deal with any of those points.

35. In the light in particular of Mrs Pike's failure to explain her reasons for rejecting Mr Holland's reliance upon his 'other legal matters', I think that is right for me to consider afresh whether his witness statement disclosed sufficient compelling reasons for the exercise of the discretion under Rule 18(2) in his favour. In addition, I will take into account the additional factors set out in Mr Holland's correspondence with or submissions to the UKIPO prior to Mrs Pike's decision.

36. The reasons given by Mr Holland were:

i. That the substance of his defence had already been notified to the UKIPO. That point was thoroughly considered by Mrs Pike, and it seems to me that it does not provide a compelling reason to grant the necessary extension for all the reasons she gave.

ii. At paragraph 7 of the witness statement, Mr Holland said "Mark Studley was very diligent and called me before any important deadlines in my application, Heather Mackerness called me just before her letter notifying me of my right to make a Rule 63 response to the opposition. I should have received a call a few days before the TM8 was due to remind me, as best practice."

This paragraph seeks to suggest that it was in some way the fault of the UKIPO that Mr Holland missed the deadline for submitting his TM8. However, he had been given a clear warning in the letter of 14 December 2010 of the need to comply with the deadline.

It does not seem to me that Mr Holland can properly complain that he should have been given an additional warning that the deadline was approaching. There is no such general obligation upon the UKIPO to remind parties to proceedings, whether represented or not, of impending deadlines. In my view, this is not a compelling reason to grant the extension needed.

iii. At paragraph 8 of the witness statement, Mr Holland said that the TM8 was not filed "because I was distracted by other legal matters. I am currently in litigation with my former business partner for deceiving me and stealing my

money in 2003-4. ... I find it difficult to apologise in this situation because my application is being prejudiced by a criminal act in another court. My Licenced Public Bar business has been burgled on 27 January causing further damage to my life. I have an incident reference for it ... with ... Sunderland police ... That is one of four incidents reported to the police effecting my life at the time excluding the court action.”

In his written submissions dated 24 March 2011, Mr Holland added “The crime disrupts my life and my attention to my trade mark. A Court of law has extended time for illness and conflicting business meetings and appointments crime [*sic*] and risk to property and life or cooperating with the police in criminal matters overrides this Intellectual Property Office matter as a matter of public duty.” A number of other comments are made to the same effect, e.g. in the Grounds of Appeal itself, Mr Holland says that the delay was caused by “very serious public safety reasons”. However, Mr Holland failed to provide any supporting documentation to show the nature and impact of the legal matters or court cases on which he relied, still less to prove that they were individually or cumulatively such as to prevent him from having the time to deal with the opposition to his trade mark application.

Bearing in mind the matters which Mr Thorley QC said in *Siddiqui* were relevant to an extension of time, in my view it is significant that Mr Holland did not suggest that he had even tried to comply with the deadline and take any steps towards the drafting of his TM8 and counter-statement. Even making due allowance for Mr Holland's status as a litigant in person in the

opposition proceedings, completing the TM8 and counter-statement need not have taken more than a few hours.

Mr Holland said that he was 'distracted by other legal matters' but the description of the nature of those matters is wholly inadequate to explain why they made it impossible for him to comply with the deadline set by the letter of 14 December 2010. Nothing that Mr Holland says shows that it would not have been possible for him to find the time necessary to file his TM8 and counter-statement between 14 December 2010 and 14 February 2011, by reason of his other legal matters, or any disruption or ill-health connected with or arising from them. Mr Holland has failed in my view to show that any such matters amounted to or gave rise to a compelling reason to grant an extension of time pursuant to Rule 18(2).

iv. Next Mr Holland argued that the application could not be deemed 'abandoned' because he had responded to telephone calls and filed written submissions in response to the letter of 2 March. This was a point raised in paragraph 16 of the witness statement and in paragraphs 14-15 of his written submissions, where Mr Holland suggested that the only reason not to allow a late filing of a TM8 would be if the application was genuinely abandoned. That is in my view a misunderstanding of the position, as demonstrated by the facts of *Music Choice* and *KIX*. On the contrary, it is clear that the trade mark application will be deemed abandoned unless the Registrar exercises the discretion to permit late filing of the TM8, which will only be done where the circumstances justify an extension of the otherwise inextensible deadline.

v. Mr Holland went on in his written submissions to deal with points (2) to (5) of the list of considerations quoted above from paragraph 67 of *Music Choice*. He suggested, for example, that there were no merits in the opposition and that it would be wrong to treat the opposition as not defended and the application as abandoned because there was no opposition to the application in Class 45. It seems to me that the merits of the opposition cannot simply be dismissed, as Mr Holland suggests, because it is based upon sub-sections 5(2)(b) and 5(4), not sub-section 5(1), whilst he is wrong about opposition to Class 45. The best point in Mr Holland's favour, in my view, is that there is plainly prejudice to him in not being able to defend the opposition and there is no evidence that a short delay in proceeding with the opposition would have caused prejudice to the Opponent. However, this point does not in my view counterbalance the lack of any compelling reason for Mr Holland to be treated as defending the opposition, notwithstanding his failure to comply with the inextensible time limit in Rule 18.

37. For those reasons, in my view Mrs Pike was right to refuse to exercise her discretion to permit the late filing of the TM8 and counter-statement.
38. Mr Holland raised a good number of additional points in his Grounds of Appeal and further points were raised in the written submissions which he submitted to me. Most of these points are, in my view, either irrelevant to the appeal or simply without merit, but I will deal with them briefly below:

- i. Mr Holland's first point in the Grounds of Appeal was that his application could and should have proceeded in relation to the services in Class 45 of his specification. He appears to believe that his application to register his mark in relation to those services was not opposed by the Opponent. That is not the case. The Opponent opposed those services as well as the services in Classes 35 and 36. In the circumstances, the opposition affected the Class 45 services just as much as the services in Classes 35 and 36, and the application cannot proceed for any of those services. A number of additional points in the Grounds of Appeal were based upon the same misunderstanding of the scope of the opposition.

- ii. Next, Mr Holland argued that he had a *right* to extend the time for filing his TM8, indeed he claimed that the Registrar had to accept the reasons given for the delay, as that was his right. For the reasons I have set out above, that is not a correct reading of the Rules, given the interplay between Rules 18 and 77.

- iii. Mr Holland complained that by reason of Mrs Pike's decision, he had been denied a fair hearing in breach of his human rights. I do not agree. Mr Holland was offered a hearing by the letter of 2 March 2011. That in my view provided appropriate compliance with his right to a fair hearing under Article 6 of the European Convention for the Protection of Human Rights and Fundamental Freedoms. See the comments of Mr Richard Arnold QC sitting as the Appointed Person in *Applied Technologies trade*

mark, BL O-348-04, 11 November 2004 at paragraph 40, in respect of a similar point arising under the 2000 Rules.

Moreover, in *Music Choice* Mr Vos QC held:

“71 If the Rules, properly construed, had provided an inextensible deadline for the filing of a TM8, and either no discretion or a restricted discretion to treat the register proprietor as opposing the application, it seems to me that such a position could well have been regarded as reasonably proportionate and in pursuit of the legitimate aim of ensuring that invalidation applications are dealt with timeously.

72 As [17]–[19] of Brooke L.T.'s judgment in *Cachia v Faluyi* [2001] 1 W.L.R. 1966 , and [35]–[47] of his judgment in *Goode v Martin* [2002] 1 W.L.R. 1828 demonstrate, it is only if the statute has the effect of unreasonably depriving a person of access to the Courts that the Human Rights safeguards should bite. This would not, at least *prima facie*, be the effect here.”

That argument applies equally to Mr Holland’s case.

- iv. Mr Holland argued that letters which he had sent to the UKIPO in June and July 2010 should have been treated as if they were a defence to the opposition, because they set out arguments why he considered the Opponent’s Mark did not conflict with his own application. However, in my judgment those letters, sent before the opposition was lodged and

before its terms and scope were known, cannot be considered as a pre-emptive TM8. Moreover, the need for a formal TM8 had been notified to Mr Holland. As I have said above, Mrs Pike dealt with this point in her decision, in my view, correctly.

- iv. Mr Holland made a number of points about the merits of the opposition itself. He cited to me a large number of cases, all of which related to the position under earlier Trade Marks Acts, in support of his arguments that the Opponent's registered mark did not constitute a bar to the registration of his mark, in particular because the two marks are distinguishable. In my judgment, none of those cases show that there is necessarily a defence to the opposition, bearing in mind in particular that sub-section 5(2)(b), upon which the Opponent relies, applies where an opposition is based upon a similar mark, and there is clearly at least a level of similarity between the marks here.
- v. Mr Holland also argued that the Opponent should not be entitled to restrain his business activity under his mark. Even if that is right (as to which I make no comment), it would not necessarily mean that Mr Holland has a right to register his mark.
- vi. Mr Holland sought a reference to the CJEU on a number of grounds and (if I have correctly understood the points he raises) in particular upon the basis that Rules 18(1) and (2) are incompatible with the European Union Treaty provisions relating to the freedom of establishment. However, the

points which he relies upon in this regard are in essence those which I have discussed at paragraph (v) above. In the circumstances, I do not consider that there is any point of law in this case which requires such a reference and I decline to make a reference to the CJEU.

39. For all of these reasons, the appeal is dismissed. The Opponent took no part in the appeal and did not provide me with any written submissions. I will make no order as to the costs of the appeal. Mrs Pike's costs ruling stands and the relevant sum should be paid within 7 days of the date of this ruling.

Amanda Michaels
3 February 2012