O-380-16

TRADE MARKS ACT 1994

IN THE MATTER OF

APPLICATION NO 3128095

BY PHILIP FENNINGS

TO REGISTER THE FOLLOWING SERIES OF TRADE MARKS:

brickagram

&

BrickaGram

IN CLASSES 09 & 35

AND

OPPOSITION THERETO (UNDER NO. 405873)

BY

INSTAGRAM, LLC

BACKGROUND

1) On 22 September 2015, Philip Fennings ('Mr Fennings/the applicant') applied to register the series of trade marks shown on the cover page of this decision for certain goods and services in classes 09 and 35. The application was published on 16 October 2015 in the Trade Marks Journal and notice of opposition (Form TM7) was subsequently filed by Bristows LLP ('Bristows') on behalf of its client, Instagram, LLC ('the opponent'), on grounds under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ('the Act').

2) On 01 February 2016, Form TM7 was served on Mr Fennings. The accompanying letter stated, inter alia:

> "The TM8 and counterstatement or TM9c must be received on or before **1 April 2016**.
>
> If you choose not to file a TM8, or a TM9c to continue with your application, you should be aware that your application shall unless the Registrar otherwise directs be treated as abandoned in whole or part, in accordance with Rule 18(2) of The Trade Marks Rules 2008."

3) As no Form TM8 and counterstatement or Form TM9C was received by the deadline requested, on 13 April 2016 the Tribunal wrote to Mr Fennings in the following terms:

> "The official letter dated **1 February 2016** invited the applicant to file a TM8 and counterstatement on or before **1 April 2016.**
>
> As no TM8 and counterstatement has been filed within the time period set, Rule 18(2) applies. Rule 18(2) states that the application:
>
> "…….shall, unless the registrar otherwise directs, be treated as abandoned."
>
> The Trade Marks Registry is minded to deem the application as abandoned as no defence has been filed within the prescribed period.

If no response is received on or before **27 April 2016** the Registrar will proceed to deem the application abandoned."

4) On 18 April 2016, the Tribunal received an e-mail from Anderson & Moores Consultancy and Mediation Services ('AM'), stating the following:

> "We write to inform you that we are awaiting consent on the TM9 from the Opponent on this matter. We are currently in discussions with Mr David Kemp and Mr Gregory Evans at Bristows LLP and are simply waiting for Bristows to obtain instructions from their client.
>
> We intend to file the TM9 by 27th April 2016. If this is not possible, a TM8 will be filed.
>
> The application should not be deemed to be abandoned."

5) On 03 May 2016, a further e-mail from AM was received, stating:

> "We have still not received a response or consent from the Opponent. Can you confirm that this matter has not been deemed to be abandoned.
>
> We are willing to provide the Opponent with 2 further working days to consent (TM9) if we do not hear from them by 6th May 2016 the TM8 will be filed."

6) The Tribunal's letter of 17 May 2016 acknowledged receipt of the two e-mails above from AM and stated:

> "If you wish the Registrar to consider the late TM8, you should file the Form TM8 and counterstatement together with a Witness Statement giving reasons for the late filing of the TM8, on or before **31 May 2016**. Guidance on the format for witness statements is available on our website at www.ipo.gov.uk
>
> The Registrar will then consider the request for discretion and issue a preliminary view on the matter.

If no such response is received within this time, the Registrar will proceed to deem the application abandoned.

It is noted that Anderson & Moores are not the address for service on record for the applicant. If it is the case that the applicant has appointed a new agent, under Rule 60(2), an agent appointed in substitution for another shall file a Form TM33, available from the IPO website."

7) On 18 May 2016, Mr Fennings' Form TM8 and counterstatement and witness statement were filed by AM. The pertinent points from Mr Fennings' witness statement are set out below:

"I am represented by Lauren Anderson at Anderson & Moores Consultancy and Mediation Services.

I have been informed that the TM9 was sent to the opponent (David Kemp at Bristows) on 22 March 2016. The opponent did not respond and refuse to the TM9 and proposal for settlement until 3rd May 2016 at 16:06 hours. The opponent's representatives have explained that they had some IT server issues and delays due to the fact that they are based in the UK and the Opponent is based in California.

My solicitor has informed me that she regularly e-mailed the Opponent to ascertain the position, on 31st March 2016, 4th April 2016, 18th April 2016 and 3rd May 2016.

The delay to file the TM8 is solely due to the Opponent.

I have requested cooling off period, attempted to mediate this matter and have offered realistic and sensible proposals which to date have been refused. The delay could not have been avoided."

8) The Tribunal's letter of 08 June 2016 acknowledged receipt of the Form TM8 and witness statement and stated, inter alia:

> "It is the preliminary view of the Registry that the TM8 cannot be admitted into the proceedings.
>
> The Registrar's serving letter dated 1 February 2016 made clear that the TM8 or TM9C had to be filed on or before 1 April 2016. The reasons provided for the failure to meet the deadline are, given the established judicial guidance in *Kix* (BL-O-035-11) and *Mercury* (BL-O-050-12), insufficient to allow the TM8 to be admitted.
>
> I would refer you to the Tribunal Practice Notice 2/2011, and in accordance with paragraph 10, if either party disagrees with the preliminary view, they should request a hearing, in writing, within 14 days of the date of this letter, that is, on or before **22 June 2016**."

9) AM's letter of 21 June 2016 gave further explanation as to why the application should not be deemed abandoned and requested a hearing on the matter, at which, Mr Fennings would likely represent himself. The letter states, inter alia, the following:

> "We are aware that the TM8 had to be filed on or before 1st April 2016.
>
> The TM8 was filed on 18th May 2016 due to the delay from the Opponent. The Applicant had attempted to resolve matters and mediate with the Opponent. The TM9C was completed and sent to the Opponent within the deadline, with a view to postpone and extend the opposition for the cooling off period. The Opponent's representatives apologised for the delay in obtaining instructions due to IT server issues, colleagues on annual leave and the Opponent being based in California. The Opponent responded to the TM9C on 3rd May, following further emails chasing a response on 1st April 2016, 4th April 2016, 18th April 2016 and 3rd May 2016."

The Hearing

10) A hearing took place before me on 01 August 2016 by telephone conference. The opponent was represented by Mr Walsh of Bristows LLP; Mr Fennings represented himself.

11) At the outset of the hearing, Mr Fennings explained that he had been trying to contact AM for assistance in relation to the hearing to no avail. I explained that the official letter of 13 July 2016, giving notice of the hearing date, should have provided ample time to obtain any assistance required. Nevertheless, I asked Mr Fennings if he was content to proceed with the hearing. He confirmed that he was. Mr Fennings also expressed some concerns regarding the "late" filing of the opponent's skeleton argument which he stated he had not received until 27 July 2016. Having explained that it is standard procedure for skeleton arguments to be filed two working days prior to the hearing, he accepted that it had not been filed late. Given Mr Fennings' lack of experience in matters before the Tribunal I also explained the procedure for the hearing and stressed that he would need to explain what happened in the period between receiving Form TM7 and the deadline for filing Form TM8 and counterstatement ('defence')/TM9C.

12) Further to some considerable probing and intervention on my part to ascertain a clear chronology of events leading up to the deadline for filing a defence/TM9C, Mr Fennings confirmed that:

- He had received all correspondence from the Tribunal including the e-mail serving the Form TM7 and setting the deadline of 01 April 2016 for filing a defence or Form TM9C. He had then passed all of this correspondence on to AM.
- AM contacted Bristows by e-mail on 22 March 2016, enclosing Form TM9C and requesting that the opponent agree to enter into the cooling-off period.

- In light of no response being received, AM sent further e-mails to Bristows on 31 March, 4 April, 18 April and 03 May 2016. A response was finally received from Bristows on the 03 May 2016, refusing the request to enter into cooling-off.
- At no point leading up to, and including, 01 April 2016 did Bristows ever give any indication, either to Mr Fennings or AM, that the opponent may be agreeable to negotiating or entering into cooling-off.

13) Mr Fennings reiterated that the failure to file his defence within the relevant period was wholly due to the opponent's failure to respond to his requests to enter into cooling-off.

14) For his part, Mr Walsh submitted that the deadline for filing Form TM8 and counterstatement is non-extensible and referred me to the decisions of *Kickz AG and Wicked Vision Limited* (BL-O-035-11) ('*Kickz*') and *Mark James Holland and Mercury Wealth Management Limited* (BL-O-050-12) ('*Mercury*'). He argued that there are no "extenuating circumstances" or "compelling reasons" in this case which would allow me to exercise the narrow discretion available under rule 18(2). Mr Walsh also stated that Bristows did not, in any event, receive an e-mail on 22 March 2016, the first e-mail having been received, according to his records, on 31 March 2016 (one day prior to the deadline). He also drew my attention to the "significant delay" in the filing of the defence, which was not filed until 18 May 2016, nearly seven weeks after the deadline of 01 April 2016. Mr Walsh stressed that the applicant had been given no reason to believe that the opponent would agree to enter cooling off and that its failure to file Form TM8 on time appears to have been merely in the "hope" that the opponent would be amenable to such a request.

The law

15) Rule 18 of the Trade Marks Rules 2008 ('the Rules') 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." (my emphasis)

16) The combined effect of Rules 77(1), 77(5) and Schedule 1 of the Rules means that the time limit in rule 18, which sets the period in which the defence must be filed, is non extensible other than in the circumstances identified in rules 77(5)(a) and (b) which states:

"A time limit listed in Schedule 1 (whether it has already expired or not) may be extended under paragraph (1) if, and only if—
(a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the registrar, the Office or the International Bureau; and
(b) it appears to the registrar that the irregularity should be rectified."

17) In *Kickz*, Mr Hobbs QC sitting as the Appointed Person held that the discretion conferred by rule 18(2) is a narrow one and can be exercised only if there are "extenuating circumstances". In *Mercury,* Ms Amanda Michaels, sitting as the Appointed Person, in considering the factors the Registrar should take into account in exercising the discretion under rule 18(2), held that there must be "compelling reasons". She also referred to the criteria established in *Music Choice Ltd's Trade Mark* [2006] R.P.C. 13 ('*Music Choice*'), which provides guidance applicable by analogy when exercising the discretion under rule 18(2). Such factors are:

(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.

DECISION

18) Given the chronology of events confirmed to me by Mr Fennings at the hearing, it is clear that there has been no irregularity in procedure. Accordingly, I need not consider rule 77(5). The only possible basis on which the late defence may be admitted is the discretion provided by the words “unless the registrar otherwise directs” in rule 18(2). As stated above, I must be mindful that the discretion available to me under that rule is a narrow one.

19) Dealing firstly with the second of the *Music Choice* factors, the grounds of opposition are under sections 5(2)(b) and 5(3) of the Act, both of which require careful consideration and a multifactorial assessment. As to the fifth factor, I have not been made aware of any related proceedings between the parties. As regards the fourth factor, Mr Walsh did not bring my attention to any specific prejudice which may have been caused to the opponent by the delay.

20) I now turn to consider the first *Music Choice* factor, noting firstly that the deadline for filing the defence was missed by almost seven weeks. The main thrust of Mr Fennings’ arguments at the hearing and in all of the written statements provide by him, or on his behalf by AM, is that the failure to meet the deadline was entirely down to the opponent’s failure to respond to requests to enter into cooling-off and so the late defence should be admitted on that basis. Having considered all of the circumstances, I am not persuaded by this, for the reasons given below.

21) Mr Fennings has confirmed that, at no time leading up to the deadline for filing a defence/Form TM9C, had the opponent given any indication that it may be agreeable to entering into cooling-off. There had been no settlement discussions at all between the parties during that time aside from the speculative e-mails sent by AM (on Mr Fennings’ behalf) to Bristows, requesting that the opponent agree to the filing of

Form TM9C. Given the absence of any prior indication from Bristows that the opponent was in any way interested in a potential settlement, there was, in my view, no reason for the applicant to believe that a positive response was likely or forthcoming. It seems to me that when no response at all had been received by 01 April 2016, this should have alerted the applicant to the need to file a defence in order to preserve the trade mark application. The fact that the applicant chose not to do so, is not the fault of the opponent. In those circumstances, I see no reason why the defence could not have been filed in time. I find that, despite the serious consequences for the applicant (the third of the *Music Choice* factors), i.e. it will lose its trade mark application, there are simply no "extenuating circumstances" or "compelling reasons" sufficient to satisfy me that the narrow discretion under rule 18(2) should be exercised.

22) I should add that in reaching this conclusion, I have not overlooked Mr Fennings' submissions to the effect that he has been unrepresented in these proceedings and is unfamiliar with the Tribunal process. However, as Mr Walsh pointed out, although AM have never officially been appointed as Mr Fennings' representative, it is clear that they have been assisting him in these matters and so Mr Fennings clearly has not been absent any legal assistance at all. Moreover, Mr Fennings has confirmed that he received the serving e-mail enclosing Form TM7. As the same e-mail also made clear the potential consequences of failing to meet the deadline of 01 April 2016, Mr Fennings should have been well aware of the importance of adhering to that deadline.

23) **The trade mark application is treated as abandoned under rule 18(2).**

COSTS

24) My decision means that the opponent has been successful in its opposition against the trade mark application. As such, and as I explained at the hearing, it is entitled to a contribution towards the costs it has incurred in dealing with these matters. Whilst I have borne in mind Mr Fennings' request made to me at the hearing that I take into account his limited income, I consider that an award made on the basis of the usual scale (set out in Tribunal Practice Notice 4/2007) is appropriate.

The award will, however, be at the lower end of that scale. I award the opponent costs on the following basis:

Official fee (TM7)	£200
Preparing the notice of opposition	£200
Preparing for, and attending, the joint hearing	£300
Total:	**£700**

25) I order Philip Fennings to pay Instagram, LLC the sum of **£700**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9TH day of August 2016

Beverley Hedley
For the Registrar,
the Comptroller-General