

**O-419-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF A JOINT HEARING HELD IN RELATION TO**

**APPLICATION NO 3132171**

**IN THE NAME OF ROMANA RAMZAN**

**AND**

**OPPOSITION THERETO UNDER NO. 600000388 BY**

**ISRAR AYUB**

## BACKGROUND

1. Application No. 3132171 is for the trade mark **Revaaj by Khan variety**. It stands in the name of Romana Ramzan, has a filing date of 29 October 2015 and was published in the *Trade Marks Journal* on 13 November 2015.

2. Following the filing of a Notice of Threatened Opposition on Form TM7a, on 12 February 2016, Israr Ayub filed a Form TM7F (Notice of FAST TRACK opposition). The opposition, which was directed against all of the goods in the application, was based upon grounds under sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 ("the Act").

3. On 1 March 2016, the Tribunal wrote to the parties. In that letter the Tribunal indicated that as the sole earlier right upon which Mr Ayub was relying had not achieved registration, the Tribunal intended to exercise its discretion under rule 62(1)(j) of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013 and in so doing convert the proceedings to a conventional opposition; the parties were allowed until 15 March 2016 to request a hearing if they disagreed with this approach; the parties did not respond to this letter.

4. In a letter dated 22 March 2016, the Tribunal advised the parties that the proceedings had been converted and it served the Notice of Opposition on Ms Ramzan by e-mail (her stated preference); she was advised that she had until 23 May 2016 to file either a Form TM8 or Form TM9c. The letter contained the following paragraph:

"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."

5. On 7 June 2016, the Tribunal wrote to the parties again. It indicated that as no Form TM8 had been filed within the period allowed, the Tribunal was minded to deem the application abandoned. Ms Ramzan's attention was again drawn to the

provisions of rule 18(2) of the Trade Marks Rules 2008 (“the Rules”) to which I will return below and she was allowed until 21 June 2016 to respond. Ms Ramzan was informed that a failure to respond would result in the Tribunal deeming her application abandoned.

6. On 20 June 2016, Ms Ramzan filed a Form TM8 accompanied by an e-mail which read as follows:

“Witness statement

To whom it may concern,

Firstly I would like to apologise for the delay in my response, I have been very confused it (sic) what I am actually doing, I am unable to afford a solicitor as I am a single parent. So I am having to make decisions without legal advice.

Rivaaj boutique have effected my business by trading under the same name, customers keep getting confused. We are also still getting there phone calls.

I feel that all my hard work and effort of 10 years is going down the drain due to Rivaaj boutique using the same name. I request that the IPO take this into account when making a decision on the issue of the trademark.

Kind regards,

Romana.”

7. In a letter dated 22 June 2016, the Tribunal allowed Ms Ramzan until 6 July 2016 to re-file the “witness statement” with a statement of truth. On 5 July 2016, Ms Ramzan filed a witness statement, paragraph 2 of which read as follows:

“2. I completed the paperwork for this application and due to high stress levels at work I completely forgot the date. This was an error on my part, but the application I have made still stands.”

8. In a letter dated 18 July 2016, the Tribunal issued a preliminary view indicating that in its view:

“the reasons provided are not sufficient for the registrar to exercise his discretion...”

The Tribunal added:

“I would point out that only in cases where there are “extenuating circumstances”, or “compelling reasons”, is the registrar able to exercise his discretion and admit a late filed Form TM8. It is the registrar’s view that the circumstances described in the witness statement are not sufficient justification to permit the use of his discretion.”

9. Ms Ramzan was allowed until 1 August 2016 to request a hearing if she disagreed with the preliminary view and on 1 August a hearing was sought.

### **The hearing**

10. A hearing took place before me, by telephone conference, on 24 August 2016, at which Ms Ramzan represented herself, as did the opponent, Mr Ayub. At the hearing, Mr Ramzan confirmed the facts mentioned above and accepted that the failure to file the Form TM8 by the specified deadline was the result of an oversight on her part. In response, Mr Ayub commented on what was, in his view, a more than adequate period allowed for Ms Ramzan to file a defence to the opposition and argued that the factors relied upon by Ms Ramzan did not constitute “extenuating circumstances”.

### **The decision at the hearing**

11. Having considered the written and oral submissions, my decision was not to admit Ms Ramzan’s late filed defence; I will now go and explain why I reached that conclusion.

### **The statutory provisions**

12. For the purposes of this decision, it is not necessary for me to set out all of the statutory provisions governing the conduct of opposition proceedings before the Tribunal. Suffice to say that the period allowed to an applicant to file a Form TM8 by

rule 18(1) is a non-extendable period governed by Schedule 1 to the Rules. Notwithstanding the above, the registrar may allow an applicant to file a Form TM8 late if he is satisfied it is appropriate to do so. This discretion is provided by rule 18(2) which reads as follows:

“18(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.” (my emphasis).

### **How the discretion should be approached**

13. At the hearing, I explained that in approaching the discretion provided by the use of the words: “...unless the registrar otherwise directs” in rule 18(2), the Tribunal takes into account the decisions of the Appointed Person (“AP”) in *Kickz AG and Wicked Vision Limited* (BL-O-035-11) and *Mark James Holland and Mercury Wealth Management Limited* (BL-O-050-12) i.e. I had to be satisfied that the various factors identified by Ms Ramzan (whether individually or collectively) constituted extenuating circumstances sufficient to justify the exercise of discretion in her favour.

14. In this regard, I noted that the first document provided by Ms Ramzan on 20 June 2016 was never formalised into a properly constituted witness statement. However, as this procedural defect could be easily remedied if, on appeal, my decision was found to be wrong, in reaching a decision I took all of the factors outlined in this document into account. I noted that Ms Ramzan explains that she was confused by the process and unable to afford legal advice. In her actual witness statement, she further explained that while she had “completed the paperwork” high stress levels at work had caused her to forget the deadline.

15. When testing whether the factors outlined by Ms Ramzan constituted “extenuating circumstances”, I am guided by, inter alia, the comments of the AP in *Mercury* in which (by reference to the comments of Mr Geoffrey Vos Q.C. in *Music*

*Choice Ltd's Trade Mark* [2006] RPC 13) and adapted to the matter at hand, Ms Michaels agreed the following factors were relevant:

- (i) The circumstances relating to the missing of the deadline including reasons why it was missed and the extent to which it was missed;
- (ii) The nature of Mr Ayub's allegations in his statement of grounds;
- (iii) The consequences of treating Ms Ramzan as defending or not defending the opposition;
- (iv) Any prejudice caused to Mr Ayub by the delay;
- (v) Any other relevant consideration such as the existence of related proceedings between the parties.

16. In relation to point (i), the Form TM8 was received on 20 June i.e. a little under a month after the deadline had expired. While I understand that the defence of a trade mark opposition might be somewhat confusing for those unfamiliar with the process, the fact remains that every year many litigants-in-person are able to defend their trade mark applications before the Tribunal without professional representation and do so in a timely manner. Similarly while I am sympathetic to the stress Ms Ramzan was under during the preparation of her defence to the opposition, stress is, I am afraid, a fact of modern life encountered to a greater or lesser extent by many. In short, I was not satisfied that either constituted "extenuating circumstances".

17. In relation to point (ii), it is not appropriate for me to express a view. However, it appears to me that the opposition is not without merit. While at the hearing Ms Ramzan indicated that she had discussed the matter with Mr Ayub, there are, I was told, no on-going related proceedings between the parties; point (v) is not, therefore, relevant. That leaves points (iii) and (iv) to be considered. In my view, the best point in Ms Ramzan's favour is that there is obviously prejudice to her if she not allowed to defend the opposition and there was no indication at the hearing that the delay which

had occurred would, at least to any material extent, prejudice Mr Ayub. However, these factors do not (to use the words of the AP in *Mercury*):

“...counterbalance the lack of any compelling reason [for Ms Ramzan] to be treated as defending the opposition, notwithstanding [her failure] to comply with the inextensible time limit in Rule 18” (paragraph 36 point (v) of the decision in *Mercury* refers).

18. As I explained to Ms Ramzan, her position was, in my view, best summed up by the comments of the AP in *Kickz* i.e. she was the author of her own misfortune.

**19. In summary, having considered the competing written and oral submissions and the decisions in *Kickz* and *Mercury*, my decision was not to exercise the discretion available under rule 18(2) in Ms Ramzan’s favour. The consequence of that decision is that subject to any successful appeal, her application will be treated as abandoned.**

## **COSTS**

20. As my decision concluded the proceedings, I must now go on and consider the matter of costs. Awards of costs are dealt with in Tribunal Practice Notice (“TPN”) 4 of 2007. Bearing the guidance in that TPN in mind, and reminding myself that Mr Ayub has not been professionally represented, I award costs to him on the following basis:

Opposition fee:	£100
Preparing a Notice of opposition:	£100
Reviewing the late filed Form TM8 and document/witness statement;	£50
<b>Total:</b>	<b>£250</b>

21. I order Romana Ramzan to pay to Israr Ayub the sum of **£250**. 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 1st day of September 2016**

**C J BOWEN**

**For the Registrar**

**The Comptroller-General**