

O-208-17

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3154894
BY REGAL FOOD LTD
TO REGISTER**

REGALS DELIGHT

**AS A TRADEMARK
IN CLASSES 29, 30, 32, 35 & 43
AND
THE LATE FORM TM8 AND COUNTERSTATEMENT
FILED IN DEFENCE OF THAT APPLICATION
IN OPPOSITION PROCEEDINGS (NO. 407884)
LAUNCHED BY
REGAL VENTURES LTD**

BACKGROUND

1. On 14 March 2016, Regal Food Ltd ('the applicant') applied to register **Regals Delight** for various goods and services in classes 29, 30, 32, 35 and 43. The application was published on 12 August 2016. Further to the filing of Form TM7a (Notice of threatened opposition) on 11 October 2016, Form TM7 (Notice of opposition) was subsequently filed on 14 November 2016 by Regal Ventures Ltd ('the opponent') on the grounds of Section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). In addition, the opponent also filed forms TM7 at the same time to oppose the applicant's co-pending published marks **Regal Delights** (Opposition No. 407886) and **Regal Delight** (Opposition No. 407885).

2. The form TM7 was served on the applicant on 23 November 2016 setting a deadline of 23 January 2017 for the filing of a form TM8 and counterstatement. As no defence was received on 23 January 2017, the Tribunal wrote to the representative for the applicant on 31 January 2017 in the following terms:

“...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 **14 February 2017** the Registrar will proceed to deem the application abandoned.”

3. On the same date, 31 January 2017, the applicant's representative Wilson Gunn emailed the Tribunal informing them that a form TM8 had been filed for Opposition no. 407885 relating to the mark **Regal Delight** on 23 January 2017, however this was filed in error and the defence should have been filed on Opposition no. 407884

relating to **Regals Delight**. Wilson Gunn requested that the late filed TM8 should be admitted. The Tribunal caseworker explained to Wilson Gunn that as the deadline had been missed they would need to file a witness statement explaining the reasons for the delay, and that the Tribunal would then consider whether those reasons were sufficient to allow the late Form TM8 and counterstatement to be admitted.

4. In the subsequent witness statement dated 28 February 2017, Mr Terry Rundle of Wilson Gunn stated that the applicant had instructed them to defend opposition no. 407885 on 19 January 2017 which they actioned. The applicant had then subsequently realised he had made an error in his instruction on 26 January 2017 and informed Wilson Gunn. Action was then taken to file the defence for the correct opposition, i.e. no. 407884, on 31 January 2017. In total, the delay between the due date for filing the TM8 and the actual date of filing was 8 days.

5. The Tribunal acknowledged receipt of the witness statement and informed the parties that Mr Rundle's explanation was considered to be insufficient to allow the admission of the late Form TM8 and counterstatement. A deadline of 29 March 2017 was set for the applicant to request a hearing to challenge this view.

HEARING

6. A hearing took place before me on 25 April 2017 by telephone conference. The applicant was represented by Mr Rundle of Wilson Gunn and the opponent was represented by Ms Green of Clarion Solicitors.

7. I received skeleton arguments from both sides prior to the hearing. Mr Rundle reiterated the circumstances of the confusion with the defences and confirmed that it was a typographical error. He also stated that, whilst a typographical error may not, in and of itself, be considered an 'extenuating circumstance', when all of the factors in *Music Choice Ltd's Trade Mark* [2006] R.P.C. 13 ('*Music Choice*') are considered, there are sufficient reasons to justify the exercise of my discretion in the present case. In particular, he drew my attention to the short delay of 8 days, the lack of any real prejudice to the opponent caused by that short delay, the related opposition no. 407885 between the same parties and to the applicant's intention to file a new

application for the subject mark should I decide not to admit the TM8 which would cause further time and costs for both parties. Ms Green replied that she did not regard a typographical error as being either an extenuating circumstance or a compelling reason. In her view, the best factor in the applicant's favour is the risk that it will lose its trade mark application but this, she said, should not counterbalance the lack of any compelling reasons for missing the deadline. She also stressed that the opponent has been prejudiced by the delay and extra costs that it has incurred in dealing with this matter.

DECISION

8. With regard to the late filing of a form TM8, I must refer to Rule 18 of the Trade Marks Rules 2008 which states:

“(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)

9. 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.”

10. As there has been no error on the part of the registrar or the office, rule 77(5) is not relevant. 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 (adapted for an opposition case) 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 opponent’s allegations in its statement of grounds;
- (3) The consequences of treating the applicant as opposing or not opposing the opposition;
- (4) Any prejudice caused to the opponent by the delay;
- (5) Any other relevant considerations, such as the existence of related proceedings between the same parties.

11. Insofar as the first *Music Choice* factor is concerned, I note that the deadline was missed by 8 days and I must bear in mind the circumstances which led to the delay in filing the defence. There was evidently some confusion in the instruction that Wilson Gunn received from the applicant. On the basis of that incorrect instruction, a TM8 was filed on time (albeit on the wrong case) for opposition no. 407885. Once the error was identified, the correct TM8 was filed. In my view there was a degree of vigilance in that Wilson Gunn did act in time on the applicant’s initial incorrect instruction and sought to correct the error as soon as it was identified.

12. In terms of the second *Music Choice* factor, the grounds of opposition are based on section 5(2)(b) of the Act, as the opponent alleges the marks are confusingly similar.

13. Turning to the third *Music Choice* factor, the consequences for the applicant if discretion is not exercised in their favour are serious as their trade mark application would be deemed abandoned for want of a defence. By contrast, if discretion is exercised in their favour, then they would have the opportunity to defend the trade mark and a decision would be made on the merits of the case.

14. In terms of the fourth *Music Choice* factor, whilst I bear in mind Ms Green's comments, it seems to me that there has been no real prejudice to the opponent.

15. As regards the fifth *Music Choice* factor, I must consider the related, and still extant, opposition no. 407885 between the same parties involving very similar issues. Although Mr Rundle stated that the application subject to that opposition would be withdrawn should I allow the instant application to proceed, he could not confirm that it would be withdrawn should I refuse to allow the subject application to proceed. It follows that, as matters stand, the opponent still has opposition 407885 to deal with even if opposition 407884 were to fall away. Further, Mr Rundle indicated that if the subject application is deemed abandoned the applicant would file a new application for the subject trademark and would likely face the same grounds of opposition from the opponent in due course. This would evidently cause more delay and costs for both parties.

16. Having addressed each of the relevant factors in *Music Choice*, I must now decide whether there are sufficient extenuating circumstances to enable me to exercise my discretion. After careful consideration, my decision is that the necessary extenuating circumstances are made out. Whilst the reasons for missing the deadline, of themselves, are not particularly persuasive, I have borne in mind, in particular, the delay of just 8 days, the related extant opposition between the same parties and the applicant's stated intention to file a new application should the subject one be deemed abandoned leading to a further opposition having to be filed

which, in turn, would lead to further time and costs for both parties. **The late Form TM8 and counterstatement is admitted into the proceedings.**

COSTS

17. In the circumstances, I do not consider an award of costs to be appropriate.

Dated this 28TH day of April 2017

June Ralph

For the Registrar,

the Comptroller-General