

**O-510-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF A JOINT HEARING HELD IN RELATION TO  
APPLICATION NO. 3235026  
IN THE NAME OF VICTORIAN PLUMBING LTD**

**AND**

**OPPOSITION THERETO UNDER NO. 410334  
LAUNCHED BY VICTORIA PLUM LIMITED**

## BACKGROUND

1. 02 June 2017, Victorian Plumbing Ltd (“the Applicant”) applied to register the series of three marks shown below in respect of a range of goods and services in classes 11, 20, 21 and 35:



2. Following publication of the application in the Trade Mark Journal on 23 June 2017, DLA Piper UK LLP, acting as agents for Victoria Plum Limited (“the Opponent”), filed a Form TM7 and a statement of grounds. This was challenged by the Trade Mark Registry as not being sufficiently particularised and the opponent resubmitted the Form TM7 and amended statement of grounds on 29 September 2017. These were then served on the applicant’s agents, Urquhart-Dykes & Lord LLP, on 10 October 2017. The covering letter indicated that a period of time to **11 December 2017** was allowed for the applicant to file a Form TM8 and counterstatement or, alternatively, for the parties to request a cooling-off period by filing a Form TM9C. The Registry’s letter stated that if neither a Form TM8 nor TM9C were received within the timescale set, then in accordance with Rule 18(2) of the Trade Marks Rules 2008 (“the Rules”), the application would be treated as abandoned unless the Registrar otherwise directed.

3. A Form TM9C requesting to enter a cooling off period was filed on 20 October 2017. By way of a letter dated 26 October 2017, the parties were advised that the request had been granted. The letter went on to advise that the period would expire on **11 July 2018** and that it could be further extended for an extra nine months. It similarly repeated the point that if no Form TM8 were filed by that deadline (or there were no request for a further extension) the application would, unless the Registrar otherwise directed, be treated as abandoned, in accordance with Rule 18(2) of the Rules.

4. Nothing further was received from either party within the relevant period and thus, in a letter dated 20 July 2018, the Registry issued a preliminary view advising the

parties that as no Form TM8 and counterstatement had been filed within the period allowed, it was minded to deem the application as abandoned. A period expiring on 3 August 2018 was allowed for the receipt of any objection. The letter further stated that i) if the applicant disagreed with the preliminary view, it would need to request a hearing and to explain in a witness statement why the Form TM8 and counterstatement were to be filed outside of the prescribed period and ii) if no response were received by 3 August 2018, the Registry would proceed to deem the application abandoned.

5. The applicant replied by way of an email on 24 July 2018. The email enclosed a Form TM8 and counterstatement and was accompanied by a witness statement by Alan Fiddes, a partner at Urquhart-Dykes & Lord LLP, the firm of attorneys representing the applicant. Mr Fiddes stated that because of an administrative error, his firm had failed to request consolidation of the present opposition to two other oppositions (nos. 405362 and 407456), which, he explained, are proceedings between the same parties concerning the same the issues, and had consequently failed to file the Form TM8 within the deadline of 11 July 2018. As a result of the Registrar's preliminary view, Mr Fiddes also requested an interlocutory hearing on the matter.

6. That completes my review of the background. At the hearing held on 16 August 2018, the applicant was represented by Alan Fiddes and the opponent was represented by Rebecca Piper. I should add that I had the benefit of skeleton arguments from the applicant, though they were filed late.

### **The Interlocutory Hearing**

7. At the hearing, Mr Fiddes conceded that the failure to file the Form TM8 and counterstatement within the relevant deadline was nothing other than a mistake on the part of his firm. Any error, he said, was on the part of the applicant's representatives and it would be unfair to the applicant if the Form TM8 was refused because of its representatives' mistake. In his clear and succinct submissions, he advanced two interlinked points.

8. First, he argued that if the application were deemed abandoned, the applicant would simply file a new application which would be open to the opponent to object and would put all the parties to additional cost and inconvenience.

9. Secondly, although he recognised that the matter was within the Registry's discretion, he submitted that if the Registry allowed the Form TM8 into proceedings at this stage, the present opposition could be consolidated with oppositions nos. 405362 and 407456 and dealt with together. In this connection, I asked Mr Fiddes to comment upon these proceedings. He explained that they were substantially oppositions brought by the opponent against applications filed by the applicant and that all three actions involve marks sharing the same essential features.

10. According to Mr Fiddes, those considerations amount to "extenuating circumstances" and/or "compelling reasons" and would justify the exercise of the Registry's discretion in the applicant's favour.

11. Ms Piper commented only briefly. She said that her client "would not strongly object to the Form TM8 being allowed in".

12. Both parties confirmed that there were ongoing negotiations and were considering a settlement agreement. They also confirmed that they were attempting to resolve the matter by 31 August 2018 and have been granted a stay for negotiations to proceed until that date. Both parties also agreed that if the Form TM8 were allowed in, the best course of action would be to consolidate the present case with oppositions nos. 405362 and 407456 and stay the proceedings until 31 August 2018.

13. At the hearing I reserved my decision. In making my decision, I have reviewed all of the papers on file and the parties' skeleton arguments and submissions, which I take into account.

## THE LAW

14. Rule 18 of 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.”

15. The period for filing a Form TM8 and counterstatement appears in Schedule 1 of the Rules and may only be extended under the following conditions, set out 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.”

16. Mr Fiddes admitted that the failure to submit the Form TM8 and counterstatement on time was due to an oversight on his firm’s part. Accordingly, Rule 77(5) does not apply and the only basis on which the applicant may be allowed to defend the opposition proceedings is if I exercise the discretion afforded to me by the use of the words “unless the registrar otherwise directs” in Rule 18(2).

## How should the discretion be approached?

17. In *Kickz AG and Wicked Vision Limited*, BL-O-035-11, Mr Hobbs QC sitting as the Appointed Person held that the discretion conferred by Rule 18(2) is narrow and can be exercised only if there are *extenuating circumstances*. In *Mark James Holland and Mercury Wealth Management Limited*, BL-O-050-12, 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. The five factors set out in *Music Choice*, which I take into account in my decision are:

*The circumstances relating to the missing of the deadline including reasons why it was missed and the extent to which it was missed.*

18. Mr Fiddes accepted both in his evidence and at the hearing, that it was entirely his firm's fault that the Form TM8 and counterstatement were filed out of time. The deadline was missed by less than two weeks. The Form TM8 and counterstatement were filed only four days after the applicant was notified that the deadline had been missed.

*The nature of the opponent's allegations in its statement of grounds*

19. It is not appropriate for me to comment on the particulars of the opposition, but it does not seem to me that it is wholly without merit.

*The consequences of treating the applicant as opposing or not opposing the opposition*

20. If the applicant is not allowed to defend the opposition, its application will be deemed abandoned and, as Mr Fiddes anticipated, it may result in the filing of another application on much the same basis. The prejudice to the applicant is obvious. If the applicant is allowed to defend the opposition, the case could be consolidated with oppositions nos. 405362 and 407456 and stayed until 31 August 2018.

Any prejudice caused to the opponent by the delay

21. The opponent did not identify any specific prejudice resulting from the delay in filing the Form TM8, nor can I see any material prejudice resulting from the short delay. Further, as there are ongoing settlement negotiations between the parties, even if the Form TM8 had been filed on time, the case would not be proceeding until 31 August 2018.

Any other relevant considerations, such as the existence of related proceedings between the same parties

22. At the hearing both parties agreed that this case should be consolidated with oppositions nos. 405362 and 407456. Having reviewed the official records of these potentially related cases, it appears that they are proceedings between the same parties, on the same legal basis, in relation to the same goods and services and in respect of trade marks which contain the words Victorian Plumbing. It also appears that oppositions nos. 405362 and 407456 have already been consolidated. It is obvious that strong connections exist between all three oppositions and in my view, there is a strong case for consolidating the present opposition to the other two cases.

**Considerations**

23. I accept that the applicant was clearly at fault in not monitoring the correct deadline. Whilst the applicant could file a new application, should I refuse the Form TM8, this would only lead to further delay, given that such application would be made on the same basis as the present one. Most importantly there are two closely related proceedings between the same parties which were subject to a stay shortly after the expiry of the deadline of 11 July 2018, which means that any prejudice caused to the opponent by the delay is illusory, as the case would not have proceeded in any event. Finally, I take into account the desirability for all concerned (including this Registry) that the matters are dealt with in tandem, which would prevent unnecessary expense for all parties.

24. Balancing all those factors I am satisfied that, collectively, they amount to “extenuating circumstances” and “compelling reasons” sufficient for me to exercise the discretion provided by Rule 18(2) in the applicant’s favour. My decision is therefore to allow the late filed Form TM8 to be admitted in to the proceedings and formally served upon the opponent.

25. I make no award of costs.

**Next steps**

26. These proceedings will be consolidated with opposition nos. 405362 and 407456 and suspended until 31 August 2018.

**Dated this 20<sup>th</sup> day of August 2018**

**Teresa Perks**

**For the Registrar**

**The Comptroller General**