

O-457-19

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION (No. 3337858)

BY CRYPTOCARBON GLOBAL LIMITED

TO REGISTER AS A TRADE MARK FOR SERVICES IN CLASSES 35 and 36:

CRYPTOBACK

AND

THE LATE FILING OF FORM TM8

IN DEFENCE OF THAT APPLICATION

IN OPPOSITION PROCEEDINGS (No. 415073)

BROUGHT BY

WIREX LIMITED

Background

Trade mark application and publication:

1. On 12 September 2018, Cryptocarbon Global Limited (“**the Applicant**”) filed an application (No. 3337858) to register as a UK trade mark the word “CRYPTOBACK” in respect of extensive lists of services in Class 35 and 36. The application was published for opposition purposes on 12 October 2018, at which point the registry explained to the Applicant that the end of the opposition period date would be 12 December 2018, but that the opposition period may be extended to three months if a third party were to file an electronic Form TM7A ‘Notice of threatened opposition’ before that date.

Notices of threatened / opposition:

2. On 17 October 2018, Wirex Limited (“**the Opponent**”) filed an electronic Form TM7A. In relaying that notice of threatened opposition, the registry letter of the same date confirmed to the Applicant that the period for the filer of the Form TM7A to oppose the Applicant’s trade mark had been extended to three months (from the application’s date of publication). The notice of opposition (Form TM7) opposing the application was filed within the extended opposition period.¹ The statement of grounds in the notice of opposition set out in full and clear terms the bases for the claims. It also stated (at paragraph 16) that the Applicant had been made aware of the Opponent’s intention to oppose not only through the filing of the Form TM7A, but “*through the Opponent’s representatives (Brown Rudnick LLP) sending various correspondence to the Applicant, and its legal representatives, including a letter of claim dated 25 October 2018.*” It stated that “*as such, the Applicant was and is on notice of the Opponent’s Earlier Rights prior to filing of the Opposition.*”

Bases of opposition:

3. The opposition is based on three grounds: sections 5(1), 5(2)(a) and 3(6) of the Trade Marks Act 1994 (“**the Act**”). For its sections 5(1) and 5(2)(a) claims, the Opponent relies on its registered trade mark No. 3307327 for the same word “CRYPTOBACK”, filed on 28 April 2018 and registered on 27 July 2018 for goods and services in Classes 9, 36 and 42. The opposition under sections 5(1) and 5(2)(a) is directed against only parts of the

¹ (A three-month deadline date would have been 12 January 2019, which was a Saturday. Where a deadline falls on a weekend, filing on the next working day is automatically permitted – in this case Monday, 14 January 2019.)

specifications under the application.² The section 3(6) claim opposes the whole of the application.³

Service of opposition / Form TM8 deadline:

4. The registry served the notice of opposition on 21 January 2019, with a covering letter that informed the parties that if the Applicant wished to continue with its application, it had until 21 March 2019 to file a Form TM8⁴ and counterstatement. The letter emphasised in bold the importance of the deadline under the Trade Marks Rules 2008 (“**the Rules**”) and stated as follows:

“Rule 18(2) of the Trade Marks Rules 2008 states that “where an applicant fails to file a Form TM8 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.”

It is important to understand that if the deadline date is missed, then in almost all circumstances, the application will be treated as abandoned.”

5. The registry’s letter serving the Form TM7 notice of opposition was sent to the Applicant’s registered office address as well as by email.

Missed TM8 deadline and request for reasons:

6. The Applicant did not file a Form TM8 by the stipulated deadline date of 21 March 2019; therefore, on 3 April 2019, the registry informed the parties by letter that in line with rule 18(2) the registry was minded to treat the application as abandoned. The letter gave the Applicant until 17 April 2019 to challenge that position by requesting a hearing and by setting out full reasons in a witness statement why the Form TM8 and counterstatement were being filed outside of the prescribed period. It also stated that if no response were received the registry would proceed to deem the application abandoned

² Examples of which terms the Opponent highlighted in its statement of grounds and indicated more thoroughly in the Schedule thereto.

³ (To list in the Schedule to the Form TM7 the Applicant’s goods and services occupies 20+ pages.)

⁴ (Or else a Form TM9C requesting an extension for a cooling-off period by mutual agreement.)

The Applicant's response

7. Despite the 17 April 2019 deadline, it was 19 April 2019 before the registry received the first response on behalf of the Applicant. The response was in the form of an email from Mr Subash Manuel to the caseworker, but which was not copied to the other party. Mr Manuel's email was fairly lengthy, making various points, including:
- (i) making reference to legal correspondence between the parties on related disputes, including the other side's pre-action protocol for legal action in the High Court in the same matter;
 - (ii) claiming that the Applicant owns unregistered trade mark rights that predate the Opponent's use of the disputed mark;
 - (iii) alleging "bad intentions" on the part of the Opponent in their registering the mark they rely on, because they applied with "clear knowledge of the Applicant's rights and goodwill";
 - (iv) referring to the Applicant having "other applications to make that will have direct impact on the outcome of the decision of the tribunal";⁵
 - (v) requesting 120 days in which, effectively, to marshal responses to the various proceedings.

The Form TM8 and counterstatement

8. Mr Manuel's 19 April email included no witness statement and gave no explanation as to why the Applicant had missed the deadline for filing its Form TM8 notice of defence and counterstatement. Indeed, the email made no mention at all of the Form TM8. However, Mr Manuel's email included as an attachment a PDF file entitled "Trade Mark Repl". Owing to an oversight on the part of the registry, that attachment was not uploaded to the case file and its existence was consequently overlooked for a period. However, it is clear that that attached document was in fact the Applicant's Form TM8 with counterstatement. It was therefore received on 19 April 2019, although the form itself is dated 16 April 2019.
9. The counterstatement, signed by Mr Manuel, included various points as to the Applicant's earlier use of the contested CRYPTOBACK sign, including specific claims as to its date of first use (November 2017), and as to the scale, cost and means of its promotion before the

⁵ This refers presumably to a cancellation application.

Opponent applied (on 28 April 2018) for the mark on which it relies in its opposition. It stated that by the time that the Opponent applied for its registered mark, the mark was widely associated with the Applicant in “associated press”. The Applicant claimed to have built up goodwill and reputation to sustain a claim in passing off. It also referred to the Opponent not having used its registered mark prior to its filing.

10. The counterstatement also claimed that the Opponent’s application for its registered mark was vulnerable to a bad faith challenge on the basis that the Opponent “will no doubt have been aware of [the Applicant’s] use” since they are competitors and considering the Applicant’s publicity. It contended therefore that the Opponent’s application for its mark fell below the expected standards in business. It also asserted that the Opponent registered its mark “for a very wide range of goods and services in circumstances where it appears extremely unlikely that it had any intention to make use of the registered mark in relation to many of the goods and services.”

Further correspondence and the Witness Statement

11. The registry was delayed in replying to Mr Manuel’s 19 April email, but did so by letter on 22 May 2019. The registry’s letter of 22 May 2019 referred back to the stipulations in its earlier letter of 3 April 2019 and noted that the email contained no mention of a Form TM8 and counterstatement, or why the deadline was missed. It also addressed, to the extent appropriate, the various points Mr Manuel had made in his 19 April email. It concluded by giving a further 14 days – until 5 June 2019 – for the Applicant to file a witness statement to explain the late filing of the Form TM8 and counterstatement.
12. Mr Manuel sent another email on 23 May 2019 highlighting that he had attached the Form TM8 to his previous email of 19 April 2019. On 5 June 2019, Franklins Solicitors LLP, acting for the Applicant filed a witness statement dated 4 June 2019 and signed in the name of Subash George Manuel. The Witness Statement included the following points:
 - (i) Identifying Mr Manuel as a director of the Applicant and that he made the witness statement on its behalf;
 - (ii) He requested a hearing to challenge the preliminary view of 3 April 2019 that the application should be treated as abandoned;

- (iii) The Applicant had filed an application for cancellation of the earlier mark relied on in the opposition and asked that those cancellation proceedings be joined with the opposition proceedings;
- (iv) The Applicant had always been interested in defending the opposition (mentioning his “unprompted enquiry with the registry” on 18 January 2019 as to whether an opposition had been filed);
- (v) The Opponent had threatened infringement proceedings, to which the Applicant’s solicitors responded by a letter dated 11 December 2018 indicating that the Applicant rejected the threats and contended that the Opponent’s registered trade mark was invalid because the Applicant had “earlier-established rights in passing off.” The witness statement included an exhibit marked SM1 that was a copy of the letter of 11 December 2018. The Applicant received no response to that letter.
- (vi) The Applicant denied receiving a hard copy of the registry’s service of opposition letter of 21 January 2019 (although by the hearing it was understood that the letter had been signed-for at the registered address on 22 January 2019).
- (vii) The email of 21 January 2019 attaching the letter and serving the opposition arrived surely in the correct email account, but as the central explanation for missing the TM8 deadline, Mr Manuel stated as follows:

“unfortunately, I did not deal with them at the time (and, given the Applicant’s size, there is no one else at the Applicant other than me who can deal with such matters). This was a regrettable oversight on my part; due to pressure of work and the large number of emails I receive meaning that I did not in fact notice the email until much later, when looking for it after receipt of the registry’s letter dated 3 April 2019. The problem was compounded by the fact that a large quantity of emails built up when I happened to be away on business in Dubai and India from 29 January 2019 to 16 February 2019, flying London to Dubai on 2 February, from Dubai to Bombay on 4 February and from Cochin to London on 16 February. Exhibit SM2 is a copy of my itinerary.”

- (viii) As to Mr Manuel’s also being late in responding to the registry’s letter of 3 April 2019, he stated that although he did receive that letter at the time it was sent, he *“unfortunately misconstrued the deadline of 17 April set out in that letter as 19 April. That is why I replied to the registry on 19 April (before receiving any further*

correspondence from the registry) and filed the TM8 on that date. These documents were prepared by me personally, as at that time Franklins were not under instructions from the Applicant (the Applicant is a small, start-up company, which cannot afford to expend large sums on lawyers).” Mr Manuel explained that since receiving registry’s further letter dated 22 May 2019, he had instructed Franklins and Counsel, seeking to put the proceedings in order.

(ix) The witness statement concluded with a number of points relating to the factors to be taken into account by the registrar in considering whether the Applicant should have the opportunity to defend the opposition despite missing the non-extendable deadline. I shall refer to those points where warranted later in this decision.

13. In signing the witness statement, Mr Manuel listed several legal qualifications, which informed the suggestion by the Opponent at the hearing that a greater degree of care might consequently be expected of Mr Manuel in his dealing with the matters at issue. I deal very briefly with this along with two other secondary issues below.

Other background matters – related proceedings

14. In addition to the subject trade mark application, a Form TM26(I) was filed on behalf of the Applicant on 6 June 2019 to commence cancellation proceedings (CA502632) against registration 3307327, of which the Opponent is the registered proprietor and on which it relies for its relative grounds claims under its opposition. The Applicant relies for its cancellation action on grounds under section 5(4)(a) and section 3(6) of the Act. The section 5(4)(a) claim is that the Applicant first used its applied-for mark (or unregistered sign) in the UK in November 2017 in relation to the short list of services below, such that when the Opponent/Registered Proprietor applied for its registered trade mark, use of that mark would have been liable to be prevented by the law of passing off.

Financial services, consisting more specifically of providing cryptocurrency-related financial services of various kinds including cashback services, payment administration services, payment processing services, payment transaction card services, and currency exchange and trading services.

For its section 3(6) ground, the Applicant repeats the same claims it had made in its counterstatement. The Form TM26(I) states that the Applicant informed the registered proprietor of its intention to invalidate their mark on 11 December 2018. The Applicant had also made essentially the same claims in previous open correspondence between the parties’ legal representatives.

Secondary issues

15. *Mr Manuel's status as a solicitor:* At the hearing the parties contested whether Mr Manuel was a legal professional. Immediately after the hearing, Mr Welch filed a witness statement in his own name, along with exhibits, that showed that Mr Manuel indeed appeared to be registered as a solicitor and to identify as a solicitor. Mr Hill responded by email to say that Mr Manuel's status is not relevant because his evidence was that he was not aware of the deadline for the Form TM8 until after it had passed. I find that the various errors made on the part of Mr Manuel are not made significantly more egregious on the basis of his legal qualifications, no more than a party's lay status would make such errors less significant. His errors are plain errors.
16. *Mr Manuel's status per his Witness Statement:* Having received Mr Manuel's witness statement only a day or two before the hearing, the Opponent's legal representatives filed a short supplementary skeleton argument in response, to highlight that, at odds with Mr Manuel's statement as to his status as a director of the Applicant, records at Companies House showed the termination of that position months before Mr Manuel's witness statement. Responding to that point, Christopher Buck, a solicitor acting for the Applicant, filed a witness statement on 4 July 2019, with relevant exhibits, confirming that Mr Manuel did resign as a director of the Applicant company on 4 January 2019. It explained, however, that (i) Mr Manuel remains a 90% shareholder in the Applicant company; (ii) Mr Manuel is the only director (appointed in 2012) and 100% shareholder of Bee International PVT Ltd, which company was appointed as a corporate director of the Applicant company on 18 April 2019. Mr Manuel's self-identification in these proceedings was therefore to be understood as a "shadow and/or de facto director of the Applicant company" as a person in accordance with whose directions the directors of the Applicant company are accustomed to act, regarding him as a director of the Applicant. I do not find Mr Manuel's self-description to have ultimately been a significant mis-statement.
17. *Failure to copy correspondence to the Opponent:* I also note that the Applicant has on repeated occasions neglected to copy in the Opponent/the Opponent's legal representatives when corresponding with the registry, including in relation to its filed Form TM8 and witness statement. Mr Welch raised this point of objection by email on 3 July 2019, ahead of the hearing; the Applicant's legal representatives responded by email on 4

July 2019 arguing that the Form TM8 was submitted by the Applicant when it was unrepresented and that he would have assumed that the registry would provide a copy to the Opponent. The Applicant's legal representatives also claimed that when they filed the Applicant's witness statement by 5 June 2019 there had been no direction in the registry's letter of 22 May 2019 that the witness statement be copied to the Opponent. On this latter point I note that the 22 May letter did in fact request that anyone corresponding with the tribunal by email should ensure their email is copied to the other party. Those are not insignificant oversights on the part of the Applicant and such lapses will have inconvenienced the Opponent. However, I accept that there was no intention to omit the Opponent or its advisors from the correspondence in the proceedings.

The hearing

18. In its witness statement the Applicant had requested a hearing to argue that the opposition should be treated as defended notwithstanding the late filing of the Form TM8. That hearing took place before me by telephone conference on Friday, 5 July 2019. Mr Jonathan Hill of Counsel attended on behalf of the Applicant and on the instruction of his legal representatives, Franklins Solicitors LLP. Mr Duncan Welch of Icen Law, attended on behalf of the Opponent and on the instruction of the Opponent's legal representatives Brown Rudnick LLP. In advance of the hearing a skeleton argument was duly filed on behalf of each party. I shall refer in this decision to points made by the parties, before, at and after the hearing, to the extent that I consider it warranted to do so.

The law

19. Rule 18 of the Trade Marks Rules 2008 ('the Rules') provides as follows:

"(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."

20. 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.”

21. It is clear that in this instance there has been no irregularity in procedure. Accordingly, I need not consider rule 77(5). The only possible basis on which I may allow the Applicant to defend the opposition proceedings is provided by the discretion inherent in the words “*unless the registrar otherwise directs*” in rule 18(2).

22. In order to promote consistency and fairness the registry must take account of relevant principles set out in previous decisions of appellate bodies such as the Appointed Persons. Sitting as the Appointed Person in *Kickz AG and Wicked Vision Limited* (BL-O-035-11) (*‘Kickz’*) Mr Geoffrey Hobbs QC held that the discretion conferred by rule 18(2) can be exercised only if there are “*extenuating circumstances*”. And sitting as the Appointed Person in *Mark James Holland and Mercury Wealth Management Limited* (BL-O-050-12) (*‘Mercury’*) Ms Amanda Michaels QC held that there must be “*compelling reasons*” to justify the registrar exercising that discretion. (I also note the consideration of the principles as expressed by Arnold J, as he then was, in *Cyprus v John & Pascalis*.⁶)

23. In considering relevant factors, Ms Michaels 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 opposition proceedings, are as follows:

- 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 the opponent’s allegations in its statement of grounds;

⁶ Permanent Secretary, Ministry of Energy, Commerce and Tourism v John & Pascalis Ltd [2018] EWHC 3226 (Ch)

- iii. The consequences of treating the applicant as opposing or not opposing the opposition;
- iv. Any prejudice caused to the opponent by the delay;
- v. Any other relevant considerations, such as the existence of related proceedings between the same parties.

24. I consider each of these factors in turn in reaching my decision.

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

25. Although I note that, on behalf of the Opponent, Mr Welch pointed to the period of five months between the Opponent's filing of its notice of threatened opposition (on 17 October 2018) and the deadline of 21 March 2018 to file a defence, the Form TM8 was filed on 19 April 2019, so the deadline was missed by approximately four weeks. I also note that the Applicant failed to meet the stipulations of the registry's letter of 3 April to provide full written reasons and a witness statement by 17 April 2019; however, such a time limit set by the Registrar is extendable and is not subject to the strictures of the TM8 deadline.

26. The Applicant invited the Registry to treat the opposition as contested, arguing that it always intended to contest the opposition and missed the deadline through inadvertence. I also note that before the registry served the notice of opposition, Mr Manuel had enquired with the registry as to whether an opposition had been filed. Mr Hill stated that this enquiry was in the context of an ongoing dispute between the parties about the trade mark and argued that that enquiry by Mr Manuel indicates the Applicant's interest in pursuing its application. I do not consider that a strong point. I accept that Mr Manuel's enquiry may fairly be interpreted that way, but it may equally be viewed more neutrally as simply an enquiry about whether there had been an opposition filed against the application. Either way, having actively contacted the registry by electronic means, it would have been in the Applicant's interests, and in line with normal expectations, for Mr Manuel to have been all the more on the lookout for a response, which was effectively given just days later when the registry proceeded to serve the Form TM7.

27. The reasons given for missing the deadline are essentially that email built up while Mr Manuel travelled overseas during part of the two-month period for filing the Form TM8 and

that Mr Manuel had overlooked and been unaware of the registry's email. Nor had Mr Manuel received the physical letter since it did not reach him personally, despite its having been demonstrably delivered to the Applicant's registered office. These are not reasons that might be considered in any way extenuating circumstances.

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

28. The Opposition has two bases: a challenge based on the earlier trade mark and a bad faith attack. Mr Hill argued that the grounds based on the earlier trade mark “*will plainly succeed unless the earlier trade mark is found invalid. Whether that will happen will be determined in the cancellation proceedings, not the opposition proceedings. The Applicant submits that it would be wrong to proceed to uphold the opposition on these grounds where the trade mark on which they are based may be found to be void ab initio...*”. In relation to the section 5(2)(a) ground, the Opponent's statement of grounds refers to “900,000 customers” and claims that the earlier mark has acquired “distinctive character” through use, the Opponent “having provided financial services since it was founded in 2014”. It also refers to reputation and goodwill and to extensive promotion of “the CRYPTOBACK programme in financial media in the UK in 2018”.
29. Mr Welch characterised the application as a “land grab” and the Opponent's position is that it “can find no evidence to suggest that the Applicant has used or intends to use any of the services, including those that relate to similar services to those covered by the Opponent's earlier mark – for example arranging the sale of loans, tax or insurance related services.” Mr Hill argued that a bad faith argument based purely on the breadth of services for which registration was sought is legally questionable and that Arnold J had referred a question on the validity of objections of that kind to the CJEU in *Skykick*.⁷ Mr Hill also referred at the hearing to the Applicant having done no more than tick the box for all services in Class 36, as offered by the application system.

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

30. Mr Hill submitted that the Applicant would be seriously prejudiced if the opposition is deemed unopposed because it will lose the Application and be forced to make a new

⁷ Sky v Skykick [2018] EWHC 155 (Ch)

application, with consequent potential loss of priority. If the Applicant is treated as opposing the opposition, the parties' claims would proceed to be decided on their merits.

Any prejudice caused to the opponent by the delay

31. It was argued that the Opponent continues to be prejudiced by the uncertainty over the status of the opposition and the threatened adoption of the mark by a competitor. It also referenced having been put the expense of preparing for and attending the hearing requested by the Applicant and which arose from the Applicant's failure to comply with the registry's instructions. While I recognise those points, they are ultimately no more than the normal consequences of such circumstances. By contrast, it was argued on the part of the Applicant that no significant prejudice would be caused to the Opponent. The Opponent will of course retain its earlier trade mark, unless it is invalidated in the Applicant's cancellation proceedings, which will continue to conclusion irrespective of whether the Applicant is allowed to contest the opposition.

Any other relevant considerations / related proceedings

32. As to the fifth and final of the *Music Choice* factors, there are related proceedings between the same parties. Both parties made reference to pre-existing litigation-related communications, and more importantly, there are the related cancellation proceedings as set out in the background matters above.
33. The letter of 11 December 2018 from the Applicant's legal representatives describes itself as an open response to the letters from the Opponent's solicitors of 25 October and 13 November 2018; it expressly denies both the allegation of passing off and that the Opponent has any valid grounds for opposing the application, primarily because it claims the Applicant used the CRYPTOBACK sign before the Opponent and had built up its own right sufficient to found a claim for passing off and to invalidate the Opponent's registered mark on basis of section 46(2) of the Act in conjunction with section 5(4)(a). The letter included specific sums spent on promotion of the CRYPTOBACK sign between November 2017 and February 2018 and specific sums generated in revenue under the mark. The letter also enclosed examples in support of its claimed use and publicity. The letter also makes the same points that were later set out in the Form TM8, including as to the Opponent's not having used its mark until May 2018. The letter concluded by stating that

the Applicant noted the Opponent's notice of threatened opposition and that should it file an opposition, the Applicant would defend the opposition, apply to invalidate the Registered Mark and would request that the registry join both matters.

Decision

34. Having considered the various factors and matters in the round, I find that the circumstances in this case do give rise to compelling reasons for the Applicant to be treated as defending the opposition, notwithstanding the failure to comply with the inextensible time limit in Rule 18.
35. I reach this decision despite the inadequacy of the central reason put forward by the Applicant to explain the late filing. The parties have clearly disclosed to each other their respective positions; indeed the Applicant expressly indicated its intention both to defend the opposition and to initiate cancellation proceedings. The compelling reasons arise on the basis of the related proceedings between the parties where the cancellation action involves a challenge to the validity of the registered mark relied on by the Opponent. The central issue between the parties in relation to the relative ground dispute rests on which party has the earlier right to the contested mark. It will be procedurally efficient to resolve that central issue in the round, examining the extent to which any evidence filed may bear out the claims of use and goodwill on both sides. I also take into account the lack of specific prejudice to the Opponent and that whereas the priority of the Opponent's mark is secure (if its registration is valid) the Applicant would lose its own (later) priority date, meaning that if it is obliged to refile its application it may potentially find itself at a disadvantage in relation to a third party filer in the intervening period, which would be disproportionate if the Applicant is shown to have earlier rights arising from use/goodwill.
36. **Consolidation:** The Form TM26(I) in CA502632 filed by the Applicant against the Opponent's earlier registered trade mark was served on 16 July 2019, setting a deadline of 16 September 2019 for the registered proprietor to file a Form TM8 notice of defence. In the event that the Opponent / registered proprietor files a form TM8 in defence of the cancellation application, then the proceedings will clearly be apt for consolidation being between the same parties, and concerning the same application/registration

Costs

37. Although I make no award of costs at this stage, the matter of costs arising from this joint hearing should be assessed in light of the circumstances of set out above and be taken into account when the substantive issues between the parties are determined by decision in due course.

Dated this 7th day of August 2019

Matthew Williams

For the registrar
