

O-861-21

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION UK00003454058 IN THE NAME OF
MOHAMMAD HADI RAJABI IN RESPECT OF THE TRADE MARKS**

TRANSFORM DENTAL

TRANSFORM WHITENING

IN CLASSES 3 & 44

**AND AN APPLICATION OF INVALIDITY THERETO UNDER NO. 503376
BY TRANSFORM HOSPITAL GROUP LIMITED**

**AND THE REQUEST FOR A RETROSPECTIVE EXTENSION OF TIME IN WHICH
TO FILE A FORM TM55P LAUNCHED BY MOHAMMAD HADI RAJABI**

Background

1. Decision No. O-585-21 was issued on 5 August 2021. The parties were advised by the covering letter that any appeal against that decision should be filed on or before 2 September 2021. No such appeal, nor any request to extend the period for appeal, was received by that date.
2. Dr Rajabi ('the Registered Proprietor') wrote to the Registry on 23 September 2021 stating that he had received a letter from Debtcol asking him to make the costs award payment to Transform Hospital Group Limited ('the Cancellation Applicant'). He stated that he was shocked to receive the letter because it was the first that he had heard of the matter, adding that he travelled regularly and had just recently returned to the UK. On 24 September 2021, the Registry replied to the Registered Proprietor by letter setting out the timeline of the proceedings from 25 December 2019 (i.e. the filing date of the Registered Proprietor's trade marks) until 5 August 2021 (i.e. the date the decision was issued). The letter concluded by replicating the information on the appeal process included in the letter of 5 August 2021:

'The accompanying letter gave you the opportunity to appeal to the appointed person by filing;

a form TM55P, which incorporates the Statement of Grounds, and must be accompanied by the fee of £250.

Any appeal to the Appointed Person or to the High Court in England and Wales must be filed on or before 2 September 2021. To extend this period for appeals to the Appointed Person, detailed and compelling reasons must be submitted to the Registrar, on a TM9 with a fee of £100'.

3. On 27 September 2021, the Registered Proprietor emailed the Registry stating that he had heard nothing about his trade mark application, since the date it was filed, 'until a few months ago' when his assistant mentioned a communication whereby the 'Transform name may have been taken by another company'. The

Registered Proprietor again stated that he travelled regularly. The letter concluded by questioning why the invalidation was allowed given that 'the two month opposition period had passed long time before 07/10/2020'.

The Registry replied on 28 September 2021 clarifying that the proceedings were cancellation proceedings and not standard opposition proceedings. A copy of the letter sent by the Registry on 24 September 2021 was enclosed.

4. The Registered Proprietor telephoned the Registry on 6 October 2021. The note of the call records that: it was explained to the Registered Proprietor that the appeal period had expired and that costs would therefore need to be paid. Later that day, the Registered Proprietor emailed the Registry, acknowledging that the cancellation proceedings were now out of its hands, requesting the contact details of the appropriate person to whom he may speak about the proceedings.
5. On 7 October 2021, the Registered Proprietor filed a request for a retrospective extension of time in which to lodge a Notice of Appeal, against the decision dated 5 August 2021. Due to defects with the filing of the TM9R, that were subsequently rectified, the request was not processed until 12 October 2021. On 27 October 2021, the Registry wrote to the Registered Proprietor stating that it was the preliminary view of the Registry that the request should be refused, but concluding with the following:

'However, if you wish to be heard on this matter, please request a hearing within 14 days of the date of this letter. A copy of this letter has been sent to the other side'.

6. The Registered Proprietor disagreed with the preliminary view and requested a hearing.
7. A hearing took place before me on 22 November 2021. Dr Rajabi represented himself. Transform Hospital Group Limited, represented by Novagraaf UK, filed written submissions in lieu of attendance.

Decision

8. In relation to the filing of an appeal, Rule 71 of the Trade Mark Rules 2008 states that:

71. 1(A) Where the appeal arises in proceedings between two or more parties, notice of appeal to the person appointed under section 76 shall be filed on Form TM55P, which shall include the appellant's grounds of appeal and his case in support of the appeal.

(2) Forms TM55 or TM55P shall be filled within the period 28 days beginning immediately after the date of the registrar's decision which is the subject of the appeal ('the original decision').

9. In relation to extension of time requests, the Rules state that:

77.—(1) Subject to paragraphs (4) and (5), the registrar may, at the request of the person or party concerned or at the registrar's own initiative extend a time or period prescribed by these Rules or a time or period specified by the registrar for doing any act and any extension under this paragraph shall be made subject to such conditions as the registrar may direct.

(2) A request for extension under this rule may be made before or after the time or period in question has expired and shall be made—

(a) where the application for registration has not been published and the request for an extension relates to a time or period other than one specified under rule 13 and is made before the time or period in question has expired, in writing; and

(b) in any other case, on Form TM9.

(3) Where an extension under paragraph (1) is requested in relation to proceedings before the registrar, the party seeking the extension shall send a copy of the request to every other person who is a party to the proceedings.

10. In making my decision, I have borne in mind the guidance set out in the ‘Siddiqui’ case (BL O/481/00) by Mr Simon Thorley Q.C. acting as the Appointed Person when he emphasised the following factors:

‘1. It must always be borne in mind that any application for an extension of time is seeking an indulgence from the tribunal. The Act and the Rules lay down a comprehensive code for the conduct of prosecution of applications and for the conduct of oppositions. The code presumes a normal case and provides for it.

2. There is a public interest which clearly underlies the rules that oppositions and applications should not be allowed unreasonably to drag on.

3. In all cases the registry must have regard to the overriding objective which is to ensure fairness to both parties. Thus, it can grant an extension when the facts of the case merit it.

4. Accordingly, it must be incumbent on the application for the extension to show that the facts do merit it. In a normal case this will require the applicant to show clearly what he has done, what he wants to do and why it is that he has not been able to do it. This does not mean that in an appropriate case where he fails to show that he has acted diligently but that special circumstances exist an extension cannot be granted. However, in the normal case it is by showing what he has done and what he wants to do and why he has not done it that the registrar can be satisfied that granting an indulgence is in accordance with the overriding objective and that the delay is not being used so as to allow the system to be abused.’

11. The reasons for requesting an extension of time, as stated in the TM9R, were that:

‘Unfortunately, I was not been [sic] fully informed about the proceedings, by my personal assistant, who is no longer working for my company. I was not in the U.K. at the time the correspondence was made and at the time the deadline was set for. I only learnt of the whole proceedings after I arrived back in the U.K. which was after the deadline.’

12. In considering the request for an extension of time, I must bear in mind the reasons why the extension was requested and the reasons why it was filed late. In the hearing, Dr Rajabi submitted that he left the UK for Iran on 2 August 2021 and did not return until 31 August 2021. He went on to explain that he had an assistant to whom the trade mark matter had been delegated but that they had failed to attend to his correspondence or keep him informed about the matter while he was outside the UK. When I asked Dr Rajabi what the scope of his assistant’s role was, he replied that they managed his professional diary but that they would not have opened letters addressed to him and that they ‘sometimes left emails unread’. He submitted that he had not had any contact with his assistant for the duration of his absence from the UK because email use in Iran is extremely difficult due to connectivity issues. When I asked Dr Rajabi whether he had any other means of contact with his assistant, he explained that the infrastructure in Iran was such that mobile telephone usage was also extremely difficult.

13. I asked Dr Rajabi when he had first had sight of the decision for which he is seeking an extension of time in which to appeal. He submitted that he had opened his mail on either 5 or 6 September 2021, upon his return to work as a dentist. I asked Dr Rajabi why he didn’t contact the Registry until 23 September 2021, some 17 days after first having sight of the cancellation decision. He submitted that he had never had dealings with a tribunal before and was therefore unfamiliar with the process. He explained that, upon learning of the cancellation decision against him and associated order for costs, he did not know what to do. He submitted that he then tried to find out what had happened in the

proceedings, and how the matter had got to the stage that it had, by, first of all, contacting Novagraaf UK, the representative for the Cancellation Applicant. Dr Rajabi submitted that he had filed his form TM9R as soon as he realised that that was what he needed to do, and that there had been several exchanges between himself and the Registry before that point had been reached.

14. The Cancellation Applicant's written submission is, essentially, that the reasons provided by the Registered Proprietor are not compelling, and the delay in the request too lengthy, for the Tribunal to grant a retrospective extension of time in which to lodge a Notice of Appeal against the decision.

15. It is clear that the Trade Mark Act 1994 was complied with, and the Trade Mark Rules 2008 followed, and that the Registered Proprietor was given the requisite 28 day period ending on 2 September 2021 in which to lodge a notice of appeal against the decision of 5 August 2021.

16. I must have regard to the fairness of this matter to both parties and the seriousness of re-opening a case that has been considered 'closed' for over two months. I find that the fact that the Registered Proprietor was in Iran from 2 – 31 August 2021, almost the duration of the 28-day period within which to lodge an appeal, together with the accompanying difficulties in email and telephone correspondence particular to Iran, does amount to a compelling reason to allow an appeal to be lodged outside of the prescribed period. While the subsequent delay between Dr Rajabi first having sight of the Cancellation decision and eventually filing a TM9R is less than satisfactory, I accept that honest and earnest efforts were made by Dr Rajabi to try to understand his predicament and how to deal with it. Ideally, Dr Rajabi should have contacted the Registry in the first instance, rather than the Cancellation Applicant's representative; however, I accept Dr Rajabi's submission that he was unfamiliar with the Tribunal process and that he sincerely did not know what to do at the time.

Conclusion

17. The Registered Proprietor's request for a retrospective extension of time in which to file its grounds of appeal is granted. An extension of one week is granted until Wednesday 1 December 2021.
18. **The Registered Proprietor must file a form TM55P 'Notice of appeal to the Appointed Person', together with a fee of £250, on or before Wednesday 1 December 2021.**

Dated this 24th day of November 2021

**Mx N. R. Morris
For the Registrar,
the Comptroller-General**