

O-888-21

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3577389
BY INFORM NUTRITION IRELAND LTD.
TO REGISTER



AS A TRADE MARK IN CLASS 1

AND

OPPOSITION THERETO

UNDER NO. 424847

BY HYPRED

Background and pleadings

1. On 11 January 2021, Inform Nutrition Ireland Ltd. (“the applicant”) applied to register the trade mark shown on the cover page of this decision.
2. The application was published for opposition purposes on 5 March 2021 for the following goods:

Class 1 Food preservatives; preservatives for foodstuffs; preservatives for animal feeds; enzymes to assist in digestion for use in the manufacture of animal feeds; enzymes for use in foodstuffs; enzymes for food or drinks; additives (chemical -) for use in the preparation of animal foodstuffs

3. On 5 May 2021, Boulton Wade Tennant LLP filed a Notice of threatened opposition (“Form TM7A”) on behalf of Hypred (“the opponent”). The effect of filing Form TM7A was to extend the period in which it could file an opposition until 7 June 2021. On 7 June 2021, the opponent opposed the application based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) by way of filing a Notice of opposition and statement of grounds (“Form TM7”).
4. On 11 June 2021, the Registry served the form TM7 on the applicant, allowing the applicant until 11 August 2021 to file a Notice of defence and counterstatement (“Form TM8”) or Request for a cooling off period (“TM9C”). The serving letter contained the following paragraphs:

“Rule 18(1) and 18(3) of the Trade Marks Rules 2008 require that you must file your notice of defence and counterstatement (Form TM8) within two months from the date of this letter. Alternatively, if both parties wish to negotiate to resolve the dispute, they may request a “cooling off period” by filing a Form TM9c, which will extend the 2 month period in which to file a Form TM8 by up to a further seven months. Form TM9c is also available on the IPO website (above). Please note both parties must agree to enter into cooling off.

IMPORTANT DEADLINE: A completed Form TM8 (or else a Form TM9c) MUST be received on or before 11 August 2021

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. As no TM8 was filed within the time period set, the Tribunal wrote to the applicant on 9 September 2021. The letter contained the following paragraphs:

“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 registry is minded to deem the application as abandoned as no defence has been filed within the prescribed period.

If you disagree with the preliminary view you must provide full written reasons and request a hearing on, or before, 23 September 2021. This must be accompanied by a Witness Statement setting out the reasons as to why the TM8 and counterstatement are being filed outside of the prescribed period.”

6. On 22 September 2021, the Tribunal received a Form TM8 and a letter from FR Kelly, the applicant’s representative, explaining the reasons why the

deadline was missed. The letter was also accompanied by a witness statement of Ms Sumithra Nadarajah, Trade Mark Attorney and Partner with FR Kelly, dated 22 September 2021 together with two exhibits. The relevant parts of Ms Nadarajah's statement are reproduced below:

“4. In the case of this opposition, the deadline of 11 August 2021 was identified by the central unit as relating to a Notice of Threatened Opposition deadline rather than as is usually the case, TM8 and Counterstatement or TM9C to be filed. As a result of human error, the deadline was moved on as the reference to a Notice of Threatened opposition having been filed and the deadline was the opposition deadline. I attach as Exhibit SN1 copies of an exchange of internal emails as evidence of this fact.

5. It will be noted in correspondence referred to below that this error was taken forward in the sense that the Opposition deadline was identified as 11 August 2021 in subsequent correspondence exchanged between this firm and the Applicant.”

7. Having considered the explanation, in an official letter dated 8 October 2021, the Tribunal issued a preliminary view in which it (i) refused to exercise its discretion in favour of the applicant and (ii) allowed until 22 October 2021 for a hearing to be requested. On 22 October 2021, the applicant requested a hearing. This request was accompanied by a letter that once again explained the reasons for missing the deadline and comprehensively addressed the relevant factors that would assist me in exercising a discretion.

THE HEARING

8. A hearing took place before me, by telephone conference, on 22 November 2021. Mr Paul Kelly of FR Kelly attended on behalf of the applicant who elaborated on the contents of his letter dated 22 October 2021. The opponent filed written submissions in lieu of attendance at the hearing in which they

agreed with the registry's preliminary view to refuse to admit the late filed Form TM8.

DECISION

9. The filing of a Form TM8 in opposition proceedings is governed by rule 18 of the Trade Mark Rules 2008 ("Rules"). The relevant parts read as follows:

"18. – (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."

10. 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 Rule 77(5) 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."

11. Neither party has indicated that there has been an irregularity, wholly or in part, on the part of the registrar. 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. 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). The factors are as follows:

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

12. The deadline for filing of a Form TM8 was 11 August 2021. However, the Form was filed on 22 September 2021, 6 weeks later. The circumstances are set out in the witness statement of Ms Nadarajah. According to Ms Nadarajah, the firm has a robust diary system whereby all official deadlines are captured and entered centrally. Ms Nadarajah states that due to human error, the deadline of 11 August 2021 was identified as a Notice of Threatened Opposition, and later as the opposition deadline. At the hearing, Mr Kelly submitted that due to the initial error concerning the deadline, all correspondence with the client were exchanged after 11 August 2021. He also stated that the firm only became aware of the missed deadline through the Registry’s letter dated 9 September 2021. As the Attorney with responsibility of the case was away for three weeks, the missed deadline was, therefore, brought to Mr Kelly’s attention who then reviewed the case and discovered the error.

The nature of the applicant’s allegations in its statement of grounds

13. The opposition is based on section 5(2)(b) and the opponent alleges that the marks are similar, and the goods are either identical or highly similar.

Consequences of treating the proprietor as opposing or not opposing the application

14. If the applicant is allowed to defend the opposition, the proceedings will continue, and the matter will be determined on its merits. However, if the applicant is not allowed to defend the application, the application will be deemed abandoned for want of defence. As rightly submitted by Mr Kelly, the applicant will lose the filing date and it will be put in a situation where the applicant will have to file a new application.

Any prejudice caused to the opponent by the delay;

15. At the hearing, Mr Kelly submitted there was no special prejudice beyond the additional costs the opponent will incur for a new opposition.

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

16. Mr Kelly asked that I consider that the applicant had not abandoned the application but there were explicit instructions to fight the opposition, and that the applicant should not be prejudiced due to an error having been made by the applicant's representative. Neither party indicated that there were any related proceedings ongoing between the parties.

Conclusion

17. The evidence shows that the firm (meaning the applicant's representatives) initially identified 11 August 2021 as the Notice of Threatened Opposition deadline. However, it was later identified and communicated to the client as the deadline to file the opposition. The evidence suggests that the firm received the instructions from the client on 30 August 2021 to defend an opposition, and Ms Nadarajah confirmed on 1 September 2021 that she can attend to the filing of

a statement of defence. Mr Kelly states that it was only upon receiving the registry's letter dated 9 September 2021 that the firm became aware of the missed deadline, and as soon as the firm noticed the error, it took steps to address it. However, I note there was a further delay of nearly 2 weeks before the Registry received the Form TM8. While I acknowledge that accidents happen, after careful consideration of the abovementioned events, my decision is that necessary reasons to exercise my discretion have not been made out. I am of the view that the firm failed to exercise a "minimal degree of vigilance" not only in recording the deadline as notice of threatened opposition in their diary system but also in communicating that deadline subsequently to the client as an opposition deadline. I understand that due to the initial error, all the correspondence with the client was exchanged after the deadline to file a defence.¹ However, the firm continued to fail to exercise a minimal degree of vigilance in discovering the actual deadline despite receiving instructions from the client to defend the opposition. Even when confirming to the client that it would attend to the filing of a defence, the firm failed to identify that it had already missed the deadline. The combined effect of the events described above meant there was 6 weeks delay in filing the Form TM8.

18. I recognise that the application if re-filed is likely to be opposed by the opponent in a fresh opposition proceeding. However, such consequences are most likely in circumstances where there is a failure to comply with a non-extensible deadline, and, therefore, that line of argument is not particularly compelling.

19. While it is clear that the applicant had an intention to defend the opposition, it is clear from the decisions mentioned earlier in the decision that Rule 18(2) provides only a narrow discretion that I may exercise in the applicant's favour. I have some sympathy with the position in which the applicant has found itself, from the reasons I described above, however, it does not appear that there exists an extenuating circumstance or a compelling reason to exercise such a discretion.

¹ *Kickz*

20. The late Form TM8 is not to be admitted into the proceedings. The application is treated as abandoned.

Costs

21. As my decision terminates the proceedings, I must consider the matter of costs. Awards of costs are set out in Tribunal Practice Notice (“TPN”) 2/2016. Using the guidance set out in the TPN, I award the opponent costs on the following basis:

Official fee: £100

Preparing a statement of case: £200

Preparing written submissions: £100

Total £400

22. I order Inform Nutrition Ireland Ltd. to pay Hypred the sum of £400 as a contribution towards its costs. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 8th day of December 2021

**Karol Thomas
For the Registrar
The Comptroller-General**