

O-842-22

TRADE MARKS ACT 1994

**IN THE MATTER OF A JOINT HEARING HELD IN RELATION TO
APPLICATION NO. 3664990
IN THE NAME OF ROMI SEMP
TO REGISTER THE FOLLOWING TRADE MARK:**

ULTRA HOLD

IN CLASSES 3, 21 AND 40

AND

**AN OPPOSITION THERETO UNDER NO. 430812
BY DEN-MAT HOLDINGS, LLC**

BACKGROUND AND PLEADINGS

1. On 6 July 2021, Romi Semp (“the applicant”) filed trade mark application number UK00003664990 for the mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 3 December 2021, in respect of the following goods and services:

Class 3 *Dentures (Preparations for cleaning -); Cleaning dentures (Preparations for -).*

Class 21 *Denture baths; Denture brushes.*

Class 40 *Custom manufacture of dental prosthesis and dentures.*

2. On 19 January 2022, Den-Mat Holdings, LLC (“the opponent”) filed a Notice of threatened opposition on Form TM7a, notifying the applicant of its intention to file an opposition against the application.

3. The opponent subsequently filed a Form TM7 (“TM7”) on 4 February 2022, opposing the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

4. On 22 February 2022, the Tribunal served the TM7 on the applicant, by post and by email. The postal and email addresses used in the letter were those given by the applicant in his application for the trade mark. The deadline for the applicant to file his Form TM8 (Notice of defence and counterstatement) (“TM8”) was 22 April 2022, communicated by the Tribunal in the serving letter.

5. The applicant did not file a TM8 by the deadline and so, in an official letter dated 26 June 2022, sent by post and by email, the Tribunal advised both parties of its preliminary view to deem the application as abandoned. Either party, if it disagreed with the preliminary view, was to provide full written reasons and request a hearing by 11 July 2022. The request was to be accompanied by a witness statement containing reasons for the late filing of the TM8.

6. On 28 June 2022, following a telephone conversation with the applicant, the Tribunal wrote to the applicant and included all previous correspondence. The correspondence was sent by post and by email. The Tribunal reiterated the deadline of 11 July 2022 to respond.

7. On 11 July 2022, the applicant filed the TM8 and a witness statement, giving the reason for the late filing of his TM8 as having not received the TM7. The witness statement further explained that the applicant had experienced problems receiving post in the past.

8. In an official letter dated 1 August 2022, sent to both parties, the Tribunal issued a preliminary view to refuse the late TM8, explaining as follows:

“The Registry notes the applicants’ (sic) comments regarding difficulties receiving post in the past, however upon investigation, the Registry has record of proof of delivery from the Royal Mail of the official letters dated 22 February 2022 and 26 June 2022, copies of which are attached.

Therefore, there appears to be no ‘compelling reasons’ or ‘extenuating circumstances’ that would permit the exercise of the Registrar’s very limited discretion.

You are referred to the following decisions of the Appointed Persons in this regard: Kickz AG and Wicked Vision Limited (BL-O-035/11) and Mark James Holland and Mercury Wealth Management Limited (BL-O-050/12).

[...]

As a consequence of the above, it is therefore considered that there are no grounds on which to allow the exercise of the Registrar’s discretion in this case.”

9. The proof of delivery documents referred to in the aforementioned letter are shown below:



Track your Item

Proof of delivery

Tracking number: DF094014111GB



Your item was delivered on **24-02-2022**.

Signed for by: ZEMP

Service used: Royal Mail Signed For™

Delivered at: 13:12, Thursday 24 February 2022



Track your Item

Proof of delivery

Tracking number: DF857962802GB



Your item was delivered on **28-06-2022**.

Signed for by: SEMP

Service used: Royal Mail Signed For™

Delivered at: 12:09, Tuesday 28 June 2022

10. In the same official letter, the parties were given until 15 August 2022 to request a hearing if they wished to challenge the preliminary view.

11. On 15 August 2022, the applicant requested a hearing. A hearing was scheduled for 8 September 2022, the details of which were sent by the Tribunal to both parties in an official letter dated 24 August 2022. Both parties confirmed attendance.

THE HEARING

Representation

12. The hearing took place before me, by conference call, on 8 September 2022. The opponent was represented by Barbara Cookson of Lucas & Co. The applicant was represented by Andrew Marsden of Wilson Gunn.

The skeleton arguments

13. The opponent filed skeleton arguments prior to the hearing, which consisted of six pages and included: a timeline of events in the proceedings; submissions in relation to the missing of the TM8 deadline; and reference to and application of the relevant statutory guidance. The opponent contended that no extenuating circumstances or compelling reasons were provided by the applicant and that the Tribunal's preliminary view to not admit the late-filed TM8 into the proceedings should be upheld.

14. The applicant also filed skeleton arguments, comprising two pages, in which the applicant maintained that he did not receive the relevant letters in the post and denied that the signatures on the Royal Mail proof of delivery documents belonged to him. In support of his submissions, the applicant included three images purporting to show the applicant's signature.

Hearing discussion

15. At the hearing, Mr Marsden clarified the sequence of events and explained that the applicant first had knowledge of the opposition on Sunday 26 June 2022 when he received an email from the Tribunal containing the letter which advised the parties that no TM8 had been received in the prescribed period. The applicant then made a telephone call to the Tribunal the following day: Monday 27 June 2022. On Tuesday 28 June 2022 he received copies of all previous correspondence by email. The applicant then instructed his representatives, who filed the witness statement and TM8 on 11 July 2022. Mr Marsden acknowledged that it appears from the Royal Mail documents that the relevant letters were delivered. Mr Marsden went on to explain

that the Royal Mail Signed For process is not watertight and referred to the applicant's signature included in the skeleton argument and it not matching what was recorded by Royal Mail; he suggested that a neighbour might have signed for the letters and not passed them to the applicant. Mr Marsden then stressed that the applicant took action as soon as he became aware of the opposition.

16. Ms Cookson agreed with Mr Marsden's chronology but explained that it is necessary to consider the events prior to the opposition being filed, specifically that the applicant provided an email for communication purposes in his trade mark application, which is why he received the Tribunal's email on 26 June 2022. Ms Cookson submitted that the signature samples provided by the applicant were trivial and that it seemed to be the applicant's argument that because the applicant did not personally sign for the documents, the TM7 was not served; she further submitted that Mr Marsden did not appear to be placing the blame on either the Tribunal or the postal service. There was a suggestion by Ms Cookson that the applicant should have a particular procedure in place for receiving post, something Mr Marsden disagreed with. Ms Cookson's submissions concluded with a reference to the case law to which I will refer later in this decision: that there are no compelling reasons or extenuating circumstances in order to exercise my discretion to admit the late-filed TM8.

17. Mr Marsden responded to some of Ms Cookson's submissions and explained that it is important to look at the actions taken by the applicant after he became aware of the proceedings and that from those actions it is reasonable to assume the applicant did not receive the relevant letters. Finally, Mr Marsden highlighted that the consequences of not admitting the TM8 are important: both parties will be put to further expense as a result of unnecessary duplicate proceedings.

DECISION

Statutory provisions

18. The filing of a TM8 in opposition proceedings is governed by Rule 18 of the Trade Marks Rules 2008 ("the 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 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 is the period of two months beginning immediately after the notification date.

[...]”

19. The combined effect of Rules 77(1), 77(5) and Schedule 1 of the Rules mean 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.”

20. There is no suggestion that there has been any irregularity on the part of the Tribunal and so I need not consider the provisions of Rule 77(5) further.

21. I must also consider whether there has been a failure in communication. Rule 76 of the Rules relates to delays in communication services and states:

“76. (1) The registrar shall extend any time limit in these Rules where the registrar is satisfied that the failure to do something under these Rules was wholly or mainly attributed to a delay in, or failure of, a communication service.

(2) Any extension under paragraph (1) shall be –

(a) made after giving the parties such notice; and

(b) subject to such conditions,

as the registrar may direct.

(3) In this rule “communication services” means a service by which documents may be sent and delivered and includes post, facsimile, email and courier.”

22. In sending the letter which served the TM7, the Tribunal used the Royal Mail Signed For service. I reiterate that the tracking information on the Royal Mail website shows the serving letter dated 22 February 2022 as being delivered at 13:12 on Thursday 24 February 2022.

23. Set against what I consider to be the compelling evidence above, the applicant says that he cannot identify the signature of the person who signed for the letter. The Tribunal relies upon the Royal Mail Signed For service as it is an effective way of tracking letters sent by post. There is no way for either the Royal Mail or the Tribunal to guarantee that a letter sent via this method is signed for by the intended recipient, only that it has been delivered to the correct address. Since the address used was the address provided by the applicant, and Royal Mail have provided documentary evidence that the relevant letter was delivered to that address, I am satisfied that the TM7 was served.

24. Even if the intended recipient, i.e. the applicant, did not receive the serving letter personally, it was also sent via email to the same email address at which the applicant received later correspondence. I can see from the electronic case file that the serving letter was sent by email to the applicant on 22 February 2022, with the TM7 included

as an attachment to the email. Electronic communications are governed by Rule 79 of the Rules which states that the delivery of electronic communications is deemed to be effected immediately upon the transmission of the communication unless the contrary is proved. Nothing was received after the transmission of the email to advise that it was undelivered and so I am satisfied that the TM7 was also effectively served by email.

25. I am satisfied that there has been no failure of a communication service and I therefore reject the request to admit the late-filed TM8 on the basis of Rule 76.

26. Consequently, the only basis on which the applicant may be allowed to defend the opposition proceedings is if I exercise in his favour the discretion afforded to me by the use of the words “unless the registrar otherwise directs” in Rule 18(2).

27. In approaching the exercise of discretion in these circumstances, I take into account the decisions of the Appointed Person in *Kickz AG v Wicked Vision Limited* (BL O/035/11) and *Mark James Holland v Mercury Wealth Management Limited* (BL O/050/12) i.e. I have to be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the applicant’s favour.

28. In *Music Choice Ltd’s Trade Mark* [2005] RPC 18, the Court indicated that a consideration of the following factors (underlined below) is likely to be of assistance in reaching a conclusion as to whether or not discretion should be exercised in favour of a party in default. That is the approach I intend to adopt, referring to the parties’ submissions to the extent that I consider it necessary to do so.

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

29. The TM8 was due by 22 April 2022; it was received by the Tribunal on 11 July 2022. The reason given by the applicant for it being filed late was that the applicant had not received the serving letter and the accompanying TM7.

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

30. The opponent relied upon grounds under section 5(2)(b) of the Act. There is nothing to suggest that the opposition is without merit.

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

31. If the applicant is allowed to defend the opposition, the proceedings will continue with the parties given an opportunity to file evidence and the matter will be determined on its merits.

32. If, however, the applicant is not allowed to defend the opposition, his application will be deemed abandoned in respect of those goods and services against which this opposition is directed, and he will lose his filing date of 6 July 2021. It will remain open to the applicant to re-file his application, which may, in turn, be opposed again by the opponent.

Any prejudice caused to the opponent by the delay

33. No specific prejudice was outlined other than incurring additional costs.

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

34. There do not appear to be any other relevant considerations.

Conclusions

35. In reaching my decision, as noted above, I recognise that if the discretion is not exercised in the applicant's favour, the opposition will succeed and the applicant will lose his filing date in respect of all the goods and services in the application (since the opposition is directed against the application in full). I further recognise that it may be that the applicant will simply re-file his application and that this may, once again, be

opposed by the opponent resulting in opposition proceedings arising at some point in the future. However, as the loss of priority and possibility of further proceedings on much the same basis is often the consequence of a failure to comply with the non-extensible deadline to file a TM8, these are not factors that, in my view, are particularly compelling.

36. I have already found that there has not been any irregularity on the part of the Tribunal and that there has been no failure in a communication service. I therefore have to be satisfied that there are extenuating circumstances which justify the exercise of discretion in the applicant's favour. The circumstances are simply that the applicant contends that he did not receive the TM7, neither by post nor by email, and that he does not recognise the signature obtained by Royal Mail. The applicant claimed that he has experienced problems receiving post in the past, but no further details were provided at the hearing, nor was there any evidence to suggest the applicant had tried to rectify this issue. While I appreciate that the applicant himself may not have had sight of the TM7 by post, there is nothing to suggest it was not received by him by email and, the fact remains that it was posted via a tracked delivery method, the sole purpose of which was to follow the letter's journey to its destination and be satisfied of its delivery. The Tribunal discharged its responsibilities in serving the TM7 on the applicant at the correct address for service for which a signature was obtained. Whether the signature was that of the applicant is not relevant: someone signed for the letter at the address as shown in Royal Mail tracking information and the fact that the letter may not have been passed to the appropriate person is no fault of the Tribunal or the postal service.

37. Having considered the matter, noting the comments by both representatives at the hearing and taking into account the relevant case law and statutory guidance, I see no compelling reasons or extenuating circumstances which would justify exercising the limited discretion available to me under Rule 18(2).

38. The late-filed TM8 is not admitted into the proceedings and the applicant will be treated as not defending the opposition. The application is deemed abandoned in respect of all the goods and services applied for.

COSTS

39. As my decision terminates the proceedings, I must consider the matter of costs. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I assess these as follows:

Official fee for filing the Form TM7	£100
Preparing the statement of case	£200
Preparing for and attending the joint hearing	£400
Total	£700

40. I therefore order Romi Semp to pay Den-Mat Holdings, LLC the sum of £700. 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 28th day of September 2022

E FISHER (née VENABLES)

For the Registrar