

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO.

UK00003159619 TUTR

IN THE NAME OF

THOMAS WENTWORTH MARTIN MASON

AND IN THE MATTER OF UNDEFENDED REVOCATION

NO. CA000507316 BY TUTR LIMITED

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF MR

RAOUL COLOMBO DATED 17 SEPTEMBER 2024

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STRIKE-OUT DECISION AND ORDER

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**Introduction & Background**

1. This was to have been an appeal against decision the decision of Mr Raoul Colombo, sitting as a Hearing Officer on behalf of the Registrar of Trade Marks, dated 17 September 2024.
2. CA000507316 by Tutr Limited was an application under S. 46 (1) (a)/(b) of the Trade Marks Act 1994 (“the Act”) to revoke registration no. 3159619 TUTR on the grounds of non-use.
3. As recorded by the Hearing Officer, the Registered Proprietor (Mr Mason) did not file a counterstatement within the two months specified by Rule 38(3) of the Trade Mark Rules 2008 and neither party requested a hearing or gave written submissions in respect of the official letter of 17 July 2024 which was sent to Mr Mason by email and signed for delivery service, with tracking number SP 4131 8941 1GB and which was delivered on 18 July 2024.

4. However, on 16 August 2024 Mr Mason did contact the Registry confirming receipt of the relevant communication, saying “I have missed the response date due to not seeing the email” and asking “what the next course of action should be”.
5. As Mr Colombo recorded, in response the Registry issued an official letter which was sent by email and standard post on 22 August 2024 giving the registered proprietor a further 14 days in which to provide a form TM8N and counterstatement, with full written reasons as to why it was being filed outside the prescribed period and request a hearing.
6. Mr Mason did not respond to that letter so on 17 September 2024, exercising his discretion under R 38 (6) of the Trade Mark Rules 2008, Mr Colombo revoked Reg. No 3159619 under Section 46(1)(a) of the Act with effect from 9 July 2021.

### **The Appeal**

7. Mr Mason filed his appeal under S. 76 of the Act on 3 October 2024.
8. Shortly stated, the grounds of appeal were as follows:
  1. Mr Mason had a product in development for which the trade mark was intended, and revocation would disrupt these plans;
  2. Mr Mason is committed to utilizing the mark and revocation would be “premature and unjustified”;
  3. Revocation would delay the launch of his product and force a costly re-branding;
  4. Mr Mason had previously requested an extension to file a defense or counterstatement but was unable to meet the deadline due to unforeseen circumstances. These challenges had hindered his ability to submit a timely defense, which he believed had unfairly contributed to the decision to revoke the trademark.
  5. Mr Mason was committed to bring the mark into use and this commitment should be taken into account.
9. A Hearing was appointed for 10 January 2025.

### **The Response of the Cancellation Applicant**

10. In response to the appointment of a Hearing, the Cancellation Applicant’s trade mark attorneys, The Little IP Company, wrote to the Appointed Persons Secretariat on 19 December 2024, questioning

whether a Hearing was justified given that the cancellation application had been undefended. They suggested, instead, a Hearing on the papers.

11. Upon receiving that communication, I reviewed the Grounds of Appeal.
12. This appeal does not relate to a substantive decision of the Registrar on the merits of the case, but to a procedural decision arising from the failure of the Registered Proprietor to file a Defence and Counterstatement by the stipulated deadline.
13. In such cases, it is well settled that in order to succeed an Appellant must demonstrate that there are “extenuating circumstances” for the failure to observe the stipulated deadline to file the Form TM8 and that these are sufficient to justify setting aside the exercise of the Registrar’s discretion under R. 38(6) of the Trade Mark Rules 2008. It is also well settled that this is a high bar for an Appellant to clear, in particular where the Appellant has been the author of their own misfortune.
14. I therefore reviewed the Grounds of Appeal and in doing so, took the view that the only Ground relevant to the Decision under appeal was Ground 4, namely that there were alleged to be unforeseen circumstances which had prevented Mr Mason from filing his defence in a timely manner. The remaining grounds concerned the reasons for the non-use of the registration, which are not matters to which Mr Colombo’s decision was directed.
15. However, Ground 4 gave no details of the supposed “unforeseen circumstances” nor was the TM55 accompanied by any evidence thereof or a request to admit the same. Furthermore, in his email of 16 August 2024 to the Registry Mr Mason mentioned only that “I have missed the response date due to not seeing the email”. Clearly, simply not seeing an email falls far short of any “extenuating circumstance” sufficient to ground an appeal from the exercise of the registrar’s discretion to revoke in the absence of a defence. Furthermore, Mr Mason failed to file a defence even when given a further opportunity to do so.
16. It is within the Tribunal’s inherent jurisdiction of its own volition to strike out a statement of case or part of a statement of case if it appears that it discloses no reasonable grounds for bringing or defending a claim.
17. Given the absence of any particularisation of Ground 4, I therefore wrote to the parties on 2 January 2025 directing as follows:

“Reviewing the papers before me it appears that the only remotely viable Ground of Appeal is Ground 4 which refers to unspecified “unforeseen circumstances” affecting the Proprietor’s ability to defend the case.

I propose to proceed as follows. The Hearing scheduled for 10 January shall be vacated.

By 4pm on Friday 17 January 2025 the Proprietor shall file any evidence on which it wishes to rely in support of Ground 4, together with an application for that evidence to be admitted as fresh evidence on appeal. **IN THE ABSENCE OF ANY RESPONSE FROM THE PROPRIETOR/APPELLANT, THE APPEAL SHALL BE STRUCK OUT.**

By 4pm on Friday 24 January 2025 the Respondent shall, if it so wishes, file a response including, if it sees fit, any application for the Appeal to be struck out together with reasons therefor.

Depending on the parties’ response to this direction I shall, if appropriate, give further directions for the conduct of this matter, including if necessary a Case Management Conference.

I draw both parties’ (and in particular that of Mr Mason) attention to the Decisions in *BL-O/399/15 BOSCO*, *BL O/774/18 COW & PIG* and *Permanent Secretary v John & Pascalis Ltd (Halloumi Trade Mark)* [2018] EWHC 3226 (Ch) (attached).

**Please send responses to the AP secretariat, not to my above email.**

18. No response was received from Mr Mason by the stipulated deadline, nor has any been received in the intervening period leading up to this decision, notwithstanding the Direction emphasised the consequences of his failure to submit a timely response.

### **Decision**

19. In the absence of any response by Mr Mason to my Direction of 2 January, and given the repeated failure to file a Defence, the appeal has no reasonable prospect of success. Mr Mason has been the author of his own misfortune by failing to see and respond to correspondence in a timely manner, and he has not provided any evidence or particularisation of any other circumstance that might support his pleaded case. I therefore strike out the appeal.

### **Costs**

20. The Cancellation Applicant requested its costs. However, costs are discretionary and since the matter has been dealt with procedurally at a very early stage to the overall benefit of the Cancellation Applicant, I decline to exercise my discretion to award costs.

Philip Harris

Appointed Person

5 February 2025

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO.**

**UK00003159619 TUTR**

**IN THE NAME OF**

**THOMAS WENTWORTH MARTIN MASON**

**(Appellant)**

**AND IN THE MATTER OF UNDEFENDED REVOCATION**

**NO. CA000507316 BY TUTR LIMITED**

**(Respondent)**

**AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF MR**

**RAOUL COLOMBO DATED 17 SEPTEMBER 2024**

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ORDER

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**THE APPOINTED PERSON** having received submissions from the Respondent, and the Appellant having failed to respond to the Appointed Person's Direction of 2 January 2025

**DOES HEREBY ORDER THAT:**

- (1) The Appeal of Mr THOMAS WENTWORTH MARTIN MASON filed 3 October 2024 against the Decision of the Registrar's Hearing Officer Mr Raoul Colombo dated 17 September 2024 revoking registration No. UK00003159619 TUTR with effect from 9 July 2021 is struck out.
- (2) The Decision of Mr Raoul Colombo revoking registration No. UK00003159619 TUTR with effect from 9 July 2021 is confirmed and shall be implemented.

(3) No order as to costs.

**DATED this 5<sup>th</sup> day of February 2025**

**Philip Harris**

**APPOINTED PERSON**