

O/0420/25

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK REGISTRATION NO. 3949555
IN THE NAME OF UK VISION TRADE LTD
FOR THE MARK:**

The logo for UK VISION, featuring the letters 'UK' in a bold, red, italicized sans-serif font, followed by the word 'VISION' in a bold, grey, italicized sans-serif font.

IN CLASS 9

AND

**THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT
FILED IN DEFENCE OF THAT REGISTRATION
IN REVOCATION PROCEEDINGS UNDER NO. 507223
BY HANGZHOU HIKVISION DIGITAL TECHNOLOGY CO., LTD**

AND

**IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY UK VISION TRADE LTD
AGAINST A DECISION OF SARAH WALLACE
DATED 12 NOVEMBER 2024**

DECISION

Introduction

1. This is an appeal from a decision of Sarah Wallace acting for the Registrar, dated 12 November 2024, in relation to an application by Hangzhou Hikvision Digital Technology Co., Ltd (“**the Respondent**”) to have declared invalid under s.47 of the Trade Marks Act 1994 (“**the Act**”) UK trade mark under registration number 394955 shown on the front page of this decision (“**the Appellant’s Mark**”) owned by UK Vision Trade Ltd (“**the Appellant**”). The application was brought under ss.5(2)(b), 5(3) and 5(4)(a) of the Act, targeted at all of the goods of the Appellant’s Mark.
2. The Tribunal served Form TM26(l) on the Appellant by post and email on 7 May 2024 informing the Appellant that it had two months in which to file its Form TM8 and counterstatement. When no Form TM8 had been filed by the prescribed deadline of 8 July 2024, the Tribunal wrote to the Appellant stating that it was minded to treat the Appellant as not opposing the application for invalidation and to declare the registration as invalid. However, it invited the Appellant to provide full written reasons and request a hearing on or before 31 July 2024 together with a witness statement setting out the reasons why the TM8 and counterstatement were being filed outside of the prescribed period. On 22 July 2024, the Appellant provided its reasons, followed by a witness statement provided on 30 July 2024.
3. The Tribunal then issued its preliminary view that, as no Form TM8 had been filed and that there appeared to be no “*compelling reasons*” or “*extenuating circumstances*”, it would declare the Appellant’s Mark invalid. The parties were invited, if they disagreed with this preliminary view, to request a hearing on or before 16 August 2024, and that a Form TM8 should be filed. The Appellant filed a Form TM8 and notice of objection to the preliminary view on 6 August 2024, and so a hearing then took place before Ms Wallace.
4. At that hearing, the Respondent was represented by Ms Rebecca Swindells of Jones Day, and the Appellant was represented by Mr Sohrab Tavakkolee Tazehabadi, the owner of the Appellant.
5. The Appellant submitted that Mr Tazehabadi’s father, who lived in Iran, had been very ill such that Mr Tazehabadi had had to travel to Iran to care for him. He was in Iran between 15 January and 24 June 2024, with the exception of about one day when he was back in the

UK. In Iran, there was very poor internet service to receive emails and none of the Appellant's staff back in the UK were trained to deal with UKIPO or trade mark matters.

6. In addition, Mr Tazehabadi had also raised for the first time at the hearing that between 24 June and 8 July (the deadline for serving the TM8) he had been dealing with a sensitive matter involving social services, the police and his children which prevented him from responding to the Tribunal. He had only returned to work on 10 July 2024 and had had no contact with the Appellant's employees while he was absent from the business.
7. The Appellant had also submitted that while Mr Tazehabadi had been away, his employees had contacted the Respondent's representatives but had not received a response.
8. After the hearing, the Hearing Officer directed that the Appellant file evidence showing that letters or emails said by the Appellant to have been sent to the Respondent or its representatives prior to the deadline for filing the TM8 had been sent. The Appellant submitted an email sent by an employee of the Appellant to the Respondent's legal department dated 29 March 2024 (which the Respondent submitted was subsequently found in their "spam" folder), which responded to a letter before action, and a letter sent to the Respondent's address in China dated 8 April 2024, together with proof of posting.

The Hearing Officer's Decision

9. The Hearing Officer decided that there were no compelling reasons or extenuating circumstances which would justify the use of the registrar's discretion provided under Rule 41(6) of the Trade Mark Rules 2008 ("**the Rules**"). In particular, there had been a two week period prior to the deadline for filing the TM8 when Mr Tazehabadi had been in the UK, and there were other employees working for the Appellant who could have responded to the Tribunal. As a consequence, the Hearing Officer declared that the registrar's preliminary view was upheld, the late-filed TM8 would not be admitted in the proceedings, such that (pending any appeal) the invalidation proceedings would be deemed undefended and the Appellant's Mark declared invalid for all of the goods registered under the mark.

The Appeal

10. The Appellant filed a Notice of Appeal to the Appointed Person under s.76 of the Act. At the hearing before me, which was held remotely, the Appellant was again represented by Mr Tazehabadi, and the Respondent was represented by Mr Andrew Aistrup of Jones Day.

Standard of review

11. It is well established that in order to interfere with the decision of the Hearing Officer I must be satisfied that there was a distinct and material error of principle in the decision or that the Hearing Officer was wrong. The relevant principles were set out in *Axogen Corporation v Aviv Scientific Limited* [2022] EWHC 95 (Ch) at [24]. An appeal is by way of review, not a rehearing. Neither surprise at a Hearing Officer's conclusion nor a belief that she or he has reached the wrong decision will justify interference. The decision of the lower court will be "*wrong*" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. In the absence of an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "*outside the bounds within which reasonable disagreement is possible*" (*Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 at [80]). In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education v Pie Corbett Consultancy* [2017] RPC 17 at [52(iv)], *REEF Trade Mark* [2003] RPC 5 at [28] and *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11 at [50]-[51]).
12. In *Stitch Editing Limited v. TikTok Information Technologies Ltd* [2023] EWHC 1167 (Ch), Sir Anthony Mann said at paragraphs [6] to [8]:

"6. The correct approach to appeals such as this has recently been confirmed in the decision of Richards J in Instagram LLC v Meta 404 Ltd [2023] EWHC 436 (Ch). In that case (which was another trade marks appeal case) the judge followed the guidance to be applied in appeals generally and set out in Volpi v Volpi [2022] EWCA Civ 464.

"i) An appeal court should not interfere with the trial judge's conclusions on primary facts unless it is satisfied that he was plainly wrong.

ii) The adverb "plainly" does not refer to the degree of confidence felt by the appeal court that it would not have reached the same conclusion as the trial judge. It does not matter, with whatever degree of certainty, that the appeal court considers that it would have reached a different conclusion. What matters is whether the decision under appeal is one that no reasonable judge could have reached.

iii) An appeal court is bound, unless there is compelling reason to the contrary, to assume that the trial judge has taken the whole of the evidence into his consideration. The mere fact that a judge does not

mention a specific piece of evidence does not mean that he overlooked it.

iv) The validity of the findings of fact made by a trial judge is not aptly tested by considering whether the judgment presents a balanced account of the evidence. The trial judge must of course consider all the material evidence (although it need not all be discussed in his judgment). The weight which he gives to it is however pre-eminently a matter for him.

v) An appeal court can therefore set aside a judgment on the basis that the judge failed to give the evidence a balanced consideration only if the judge's conclusion was rationally insupportable.

vi) Reasons for judgment will always be capable of having been better expressed. An appeal court should not subject a judgment to narrow textual analysis. Nor should it be picked over or construed as though it was a piece of legislation or a contract."

7. So far as the decision below is evaluative, an appellate court should also approach the appeal with caution:

"76. So, on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out a balancing task afresh but must ask whether the decision of the judge was wrong by reason of some identifiable flaw in the judge's treatment of the question to be decided, "such as a gap in logic, a lack of consistency, or a failure to take account of some material factor, which undermines the cogency of the conclusion"." (Re Sprintroom Ltd [2019] EWCA Civ 932)

8. And last, as Richards J observed in *Instagram*, proper respect should be paid to the decision of an expert tribunal in the field in question:

"26. Finally, it is relevant to observe that this is an appeal from a tribunal with particular expertise. As Lady Hale observed in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49 at paragraph 30, the court should approach the appeal on the basis that it is probable that an expert tribunal, charged with applying the law in their specialist field, has probably got it right."

13. In *Lidl Great Britain Ltd and another v Tesco Stores Ltd and another* [2024] EWCA Civ 262, Arnold LJ stated:

"16. It is common ground that, in so far as the appeals challenge findings of fact made by the judge, this Court is only entitled to intervene if those findings are rationally insupportable: *Volpi v Volpi* [2022] EWCA Civ 464, [2022] 4 WLR 48 at [2](v) (Lewison LJ). Equally, it is common ground that, in so far as the appeals challenge multi-factorial evaluations by the judge, this Court is only entitled to intervene if the judge erred in law or principle: compare *Magmatic Ltd v PMS International Group plc* [2016] UKSC 12, [2016] Bus LR 371 at [24] (Lord Neuberger of Abbotsbury) and *Actavis Group PTC EHF v ICOS Corp* [2019] UKSC 15, [2019] Bus LR 1318 at [78]- [81] (Lord Hodge), and see *Re Sprintroom Ltd* [2019] EWCA Civ 932, [2019] BCC 1031 at [72]-[78] (McCombe, Leggatt and Rose LJ), which was cited with approval by the Supreme Court in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8 at [49] (Lord Briggs and Lord Kitchin)."

14. I have borne those principles firmly in mind.

Grounds of Appeal

15. The Appellant's Form TM55P essentially set out two grounds of appeal, namely:

a. Ground One: Employee Response Time

The Appellant's staff were not adequately trained to handle complex tasks such as the filing of the TM8 and responding to the Tribunal, which required both careful attention and specific knowledge of the circumstances, and Iran's strict internet filtering made it difficult for Mr Tazehabadi to manage matters remotely. The Appellant submitted that these were "*extraordinary circumstances*". While not specifically identified, I assume that this ground alleged that the Hearing Officer failed to take appropriate account of this evidence in her Decision, since those arguments had previously been made at the hearing before the Hearing Officer.

b. Ground Two: Communication with the Respondent

The Appellant submitted that the Hearing Officer failed to give any consideration to the evidence demonstrating that the Appellant had attempted to resolve the dispute amicably with the Respondent.

Ground One

16. Rule 41(6) of the Rules states as follows;

The proprietor shall, within two months of the date on which a copy of Form TM26(l) and the statement was sent by the registrar, file a Form TM8, which shall include a counter-statement, otherwise the registrar may treat the proprietor as not opposing the application and registration of the mark shall, unless the registrar otherwise directs, be declared invalid.

17. The Hearing Officer correctly identified that the only basis on which the Appellant could now defend the invalidity application was if the Hearing Officer exercised her discretion to permit it to do so in accordance with Rule 41(6). In order to exercise that discretion, she had to be satisfied that there were "*extenuating circumstances*" or "*compelling reasons*" to do so. *KIX trade mark O/035/11* discussed the need for "*extenuating circumstances*" and *Mercury trade mark O-050/12* discussed the need for "*compelling reasons*" before the registrar would exercise the discretion not to treat an application as

abandoned for failure to file a Form TM8 in opposition proceedings. The registrar's discretion not to declare a registration invalid after a failure to file a Form TM8 had been considered by Mr Geoffrey Vos QC (as he then was) sitting as a Deputy Judge of the Chancery Division in *Music Choice Ltd's Trade Mark* [2005] RPC 1877, where he held that there must be "*compelling reasons for the proprietor to be treated as opposing the application, notwithstanding his failure to comply with an inextensible time limit*" (paragraph 65). He also laid down various factors which should be considered when deciding whether that discretion should be exercised (paragraph 67). The Hearing Officer in this case went through each of those factors in turn.

18. The first factor was "*the circumstances relating to the missing of the deadline including reasons why it was missed and the extent to which it was missed*". In this respect, having pointed out that Mr Tazehabadi had been in the UK for two weeks prior to the deadline for filing the Form TM8, but that he had only returned to work two days after that deadline due to the matter concerning his children, social services and the police, the Hearing Officer continued as follows (in paragraph 20 of her Decision):

"Whilst I sympathise with Mr Tazehabadi circumstances [sic], it cannot be ignored that during the hearing it was established that there were two to four other employees working for the business. It was claimed that these employees were not trained to deal with IPO or trade mark issues, although notably in Mr Tazehabadi's absence, they were able to telephone and write to the applicant in relation to the matter. As such, the proprietor has failed to provide adequate reasons why the employee(s) who telephoned and wrote to the applicant could not have responded to the Tribunal, at the very least setting out the situation of the proprietor in the absence of Mr Tazehabadi. Moreover, since the hearing, I have had the benefit of considering correspondence from the proprietor that was sent to the applicant to see whether there was clearly an intention to defend the invalidation application against UKVISION. I note that the correspondence was sent prior to the TM26(l) being officially served on the proprietor and a deadline being imposed. Further, it does not expressly state an intention by the proprietor to defend the opposition; rather, it outlines its wishes to discuss the matter and arrange a meeting. Therefore, it cannot be said that following the service of the TM26(l) the proprietor had expressed an intention to defend the invalidation proceedings against it. Finally, I observe that even after Mr Tazehabadi returned to work on 10 July 2024, the Tribunal was not contacted by the proprietor until 22 July 2024 and the Form TM8 was not filed until 6 August 2024; almost a month after the original deadline."

19. Having gone on to consider the other *Music Choice* factors and summarise her application of those factors to the facts of this case, she set out her conclusions as follows:

“26. In reaching my decision, I consider that if discretion is not exercised in the proprietor’s favour, the applicant will automatically succeed, and the proprietor’s mark will be revoked, removing it from the register. However, as discussed above, I acknowledge that this is often the consequence of a failure to comply with the nonextensible deadline to file a Form TM8(N), and furthermore, the proprietor could choose to re-file an application to protect its mark. Therefore, this factor is not, in my view, determinative in isolation.

27. I take account of the circumstances that caused the late filed defence. Whilst I acknowledge that Mr Tazehabadi was absent from the business for several months, and indeed out of the country for almost 6 months, no sufficient reason has been forwarded for why another employee could not have filed the Form TM8 in his absence. It was asserted at the hearing that the remaining employees that were in charge of the day-to-day running of the business whilst Mr Tazehabadi was away from the business were not trained to deal with IPO or trade mark issues. However, I do not accept this as a justifiable reason. Many business directors or employees are unlikely to be routinely trained to deal with IPO or trade mark issues and it is reasonable to expect employees to respond to business correspondence, especially those left in charge whilst the owner is absent for prolonged periods. It is incumbent on businesses, even small ones, that they should be able to operate effectively in prolonged periods of absence by their directors/owners. It is not unreasonable to have expected some sort of correspondence from the proprietor prior to the deadline for filing the Form TM8, even if this was merely to communicate its intention to defend the invalidation proceedings and the situation with Mr Tazehabadi’s absence. Instead, the first the Tribunal heard from the proprietor was on 22 July 2024, 5 days after the Tribunal wrote to the proprietor informing UKVISION of the missed deadline. Furthermore, the Form TM8 was not filed until 6 August, almost a month after the prescribed deadline.”

28. Taking all of the above into account, I am not satisfied that the discretion provided under rule 41(6) should be exercised in the proprietor’s favour. Upon careful consideration of all the submissions made by both parties, the evidence provided, and the factors set out in the case law in Kickz, Mercury and Music Choice, I see no compelling reason or extenuating circumstance which would justify the use of the registrar’s discretion provided under Rule 41(6).”

20. In my view, the Appellant has not disclosed any reasons why these considerations and conclusions were unreasonable. I agree with the Hearing Officer that one of the Appellant’s employees could have taken some steps in response to the letters sent by post and email to the Appellant by the Tribunal to contact the Tribunal and the Respondent or its representatives to indicate that it did intend to defend the invalidity proceedings and to explain the difficulties which the Appellant was experiencing. For example, one of the Appellant’s employees had previously sent the email dated 29 March 2024 responding to the letter before action, and had signed the letter referred to above dated 8 April 2024, so they had shown that they were able to deal with previous correspondence relating to the dispute.

Ground Two

21. This ground does not help the Appellant on the issues which were the subject of the appeal. The attempts to correspond with the Respondent relied on by the Appellant as evidence that they were trying to resolve the dispute all pre-dated the commencement of these proceedings, and so were of no relevance to the reasons why the deadline which was the subject of this appeal was missed, or the other *Music Choice* factors.

Conclusion

22. The Appellant has not identified any error of law or principle made by the Hearing Officer in declining to exercise her discretion under Rule 41(6) of the Rules, nor was the Hearing Officer's consideration of the evidence "*rationaly insupportable*". Accordingly, the application for invalidation must be deemed to be undefended, such that the Appellant's Mark shall be declared invalid for all of the goods registered under it.

Costs

23. As the Appellant has been unsuccessful in its appeal, I order the Appellant to pay the sum of £650 to the Respondent in respect of the Appeal. This is in addition to the costs order of £1,000 made by the Hearing Officer in respect of the proceedings before her. I therefore order that the Appellant pay to the Respondent the sum of £1,650 within 21 days of the date of this decision.

Simon Clark
The Appointed Person
9 May 2025

Representation:

Appellant: Mr Sohrab Tavakkolee Tazehabadi.

Respondent: Mr Andrew Aistrup of Jones Day.