

BL O/0680/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION No. 4065699
IN THE NAME OF MATTHEW HUXLEY FORREST
TO REGISTER THE TRADE MARK:

ITZA

IN CLASSES 29, 35, 41 AND 42

-AND-

THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT
IN OPPOSITION PROCEEDINGS UNDER No. 451741
BROUGHT BY MEXMA FOODS BV

INTRODUCTION

1. This is a procedural decision relating to the late filing of a defence in opposition proceedings. Whilst a procedural hearing was listed in this matter, it did not in fact take place, therefore this decision is taken following a consideration of the papers before me. The procedural background involves multiple pieces of correspondence between the Registry and the Applicant, and various submissions made by the Applicant.

2. There are two preliminary views expressed by the Registry which I will be addressing in this decision, and the one requires a decision before moving on to the other. My approach shall therefore be to set out the background first; address any relevant preliminary issues; reach a decision on the preliminary view expressed by the Registry under rule 74 of the Trade Mark Rules 2008 (“**the Rules**”); if I confirm that preliminary view, I will move on to consider the preliminary view expressed under rule 18 of the Rules with regard to the late filing of a defence, and reach a decision as to whether discretion is warranted to permit a late-filed defence to be entered into the opposition proceedings.

3. In these proceedings Mexma Foods BV (“**the Opponent**”) is represented by Baron Warren Redfern; Matthew Huxley Forrest (“**the Applicant**”) represents himself.

BACKGROUND

4. On 19 June 2024, the Applicant applied to register the trade mark shown on the cover page of this decision in the UK in respect of goods and services in Classes 29, 35, 41 and 42. The application was accepted and published for opposition purposes on 4 October 2024.

5. On 3 December 2024, Baron Warren Redfern filed a notice of threatened opposition (Form TM7A) on behalf of the Opponent, a copy of which was emailed by the Registry to the Applicant.

6. On 6 January 2025, Baron Warren Redfern filed a Form TM7 Notice of Opposition and statement of grounds on behalf of the Opponent, partially opposing the application on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The opposition was directed solely against the goods applied for in Class 29.

7. On 13 January 2025, the Registry served the Form TM7 on the Applicant by email and by post. In accordance with rule 18 of Rules, the Applicant was informed that he had two months from the date of the official letter (i.e. on or before 13 March 2025) in which to file his Form TM8 'Notice of defence and counterstatement' (or Form TM9c). The Registry's serving letter contained the following information (original emphasis):

"If you wish to continue with your application, you need to file a notice of defence and counterstatement by completing Form TM8 - please note the important deadline below. You will find a blank Form TM8 on the IPO website, together with brief guidance on what happens after it is filed: <https://www.gov.uk/government/publications/trade-mark-forms-and-fees/trade-mark-forms-and-fees>

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 Form TM9c) MUST be received on or before 13 March 2025.

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.**"

8. The Applicant did not respond to the Registry's serving letter, therefore on 31 March 2025, after the expiry of the statutory deadline, the Registry wrote to the Applicant (again sending its correspondence by post and email), stating that (original emphasis):

"The official letter dated 13 January 2024 invited the applicant to file a TM8 and counterstatement on or before 13 March 2025.

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, **14 April 2025**. 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.

If no response is received the registry will proceed to deem the application abandoned.”

9. I pause here to note that as the opposition was a partial one, directed only at Class 29 of the trade mark application, a full abandonment of the trade mark was not proper in the circumstances, and the Registry should have specified that the abandonment would have only related to Class 29. I shall return to this point later.

10. On 3 April 2025, the Applicant emailed the Registry acknowledging receipt of the 31 March 2025 official letter. In his email the Applicant requested a hearing and requested that the Registry exercise its discretion under Rule 18(2), stating, *inter alia*, the following (the full text of the Applicant’s 3 April 2025 email is transcribed at Annex 1 of this decision) – my emphasis for clarity:

“1. Background of Delay – Strategic Legal Negotiations Already Underway

The delay in filing a TM8 was due not to neglect, but to the existence of active legal negotiations with Mexma Foods BV’s legal representatives, Baron Warren Redfern, including direct communications dated 21 March 2025 (I am sending all correspondence, once it becomes appropriate).¹ These communications aimed to resolve this matter commercially—given that Mexma and/or PepsiCo are fully aware of our long-standing prior rights, and have acknowledged our dominance in IP and brand scope.

Given that Mexma’s filing constitutes a second instance of bad faith activity, and **they knowingly advanced their position without disclosing our negotiations**

¹ I note that the Registry is not in receipt of “all these communications” and that the Registry is only in receipt of the Negotiation Correspondence between the parties which is dated from 5 December 2024 to 20 January 2025.

to the IPO, we submit that procedural fairness and justice require this matter be fully heard and not dismissed on a technicality.

[...]

[The Opponent] **failed to notify the IPO that commercial negotiations with the trademark holder were ongoing.**

[...]

This is not mere delay—it is an effort to allow a bad-faith opponent to secure a victory through concealment and legal manipulation.

3. Legal and Public Interest Considerations – Rule 18(2) Must Not Be Rigidly Applied

The courts and IPO have consistently affirmed that Rule 18(2) allows discretion, particularly in cases involving: Public interest; Bad faith filings; Systemic abuse of registry process.

Given that this case involves one of the largest consumer goods firms on Earth (PepsiCo), the potential consequences of allowing a bad-faith application to succeed are immense. The wider implications on the integrity of the UK IPO would be damaging.

4. Request for Direction – Fair Hearing and Rectification

Accordingly, I formally request:

That the IPO grants a hearing and **allows the filing of a counterstatement and TM8** (to be submitted immediately upon permission).

That the IPO acknowledges the exceptional commercial circumstances, the undisclosed strategic negotiations, and the bad faith tactics employed by the opponent and/or their agents.

That the IPO recognises this is no ordinary opposition—but one that targets a multi-sector IP kingdom with confirmed prior rights and commercial scale.

5. Correspondence for Context (from Mexma's Legal Team)

Sending over, once appropriate:

Including **letter sent 21 March 2025 to Mexma’s legal agents** (Baron Warren Redfern), detailing the full commercial position and the offer to resolve.

[...]

7. Final Summary

I respectfully urge the Registrar to allow the late filing of TM8 and Counterstatement and grant a hearing on this matter. **To do otherwise would allow a systemically flawed opposition to succeed—when all the facts, correspondence, and strategic record show that it should fail.**

Should this request be denied, it will immediately escalate into judicial review, public exposure, and further regulatory complaint.”

11. I note that, as will become apparent, the Applicant mentions his correspondence of 21 March 2025 on several occasions. He states that he would send it to the Registry “*once appropriate*”. However, he did not in fact send a copy of this correspondence to the Registry, therefore it does not form part of the papers before me. In any event, the 21 March 2025 falls after the 13 March 2025 statutory deadline.

12. The Applicant’s 3 April email however included, *inter alia*, other ‘without prejudice’ correspondence between the parties, which the Applicant states is “*proof of ongoing negotiations*” between the parties (hereinafter referred to as “**the Negotiation Correspondence**”). The Negotiation Correspondence consists of pre-action and post-action correspondence and is dated from 5 December 2024 to 20 January 2025 (the latest date falling a week after the Form TM7 was served). I shall return to the ‘without prejudice’ Negotiation Correspondence later in my decision. The email did not however include a completed Form TM8 and it did not include a witness statement from the Applicant.

13. The Registry replied on 4 April 2025 stating as follows (original emphasis) – I note that the Registry maintained the original 14 April deadline for the Applicant to respond:

“I acknowledge receipt of your email of 03 April 2025 requesting a hearing in relation to no form TM8 being filed in the above detailed proceedings.

As set out in the official letter of 31 March 2025, a request for a hearing 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.

Guidance on the appropriate format of a witness statement can be found in the IPO website: <https://www.gov.uk/government/publications/filing-evidence-about-an-application-or-in-tribunal-proceedings>.

Please refile your comments in the format of a witness statement and file a completed form TM8 on or before **14 April 2025**.

The requested Hearing will be appointed once the required documents are received.”

14. The Applicant replied to the Registry on 7 April 2025 attaching a witness statement in the name of Matthew Huxley Forrest, dated 6 April 2025 (“the Applicant’s First Witness Statement”). In his email, the Applicant states that his witness statement includes **“a detailed explanation of why the TM8 and counterstatement are being submitted beyond the original deadline”** and he states as follows (my emphasis for clarity):

“I trust that this now satisfies the requirement under Rule 18(2) and respectfully request that you:

1. Accept the attached witness statement as filed within context of exceptional circumstances.
2. Confirm acceptance of the **accompanying TM8 and counterstatement**.
3. Proceed to schedule the requested hearing, as per your standard procedure.”

15. The reasons detailed in the Applicant’s First Witness Statement largely include the submissions already made in the Applicant’s 3 April 2025 letter, in addition it includes the following statements (again, my emphasis for clarity):

“1. Introduction

This statement is made in support of my application for the UKIPO to exercise discretion under Rule 18(2) of the Trade Marks Rules 2008, **to accept the late filing of a TM8 and Counterstatement** in relation to Opposition No: OP000451741. I respectfully request that this matter be heard and not summarily dismissed on a procedural basis.

2. Background of Delay – Active Legal Negotiations Underway

The delay in filing TM8 was not due to neglect or oversight, but rather **due to ongoing legal correspondence and commercial negotiations with the opponent’s legal representatives**, Baron Warren Redfern, on behalf of Mexma Foods BV and/or PepsiCo.

Notably, email correspondence dated 21 March 2025 and other recent exchanges detail the nature of those negotiations. I intend to submit this correspondence as supporting documentation once appropriate.

At the time of the deadline, my focus was on resolving the matter in good faith through a direct channel. The opponent was fully aware of these efforts yet failed to notify the IPO of this active engagement, thereby prejudicing the procedural fairness of the process.

[...]

5. Request for Discretion and Hearing

In view of the above, **I respectfully request:**

Permission to file TM8 and counterstatement immediately.

That the IPO grant a hearing to review the matter. [...]

7. Summary

The delay was reasonable, the cause was strategic, and the consequences of procedural dismissal would be disproportionate and unjust. [...]

16. A procedural hearing was appointed (originally listed for 15 May 2025). However, it was noted by the Registry that the Applicant’s email of 7 April 2025 did not in fact have an *“accompanying TM8 and counterstatement”* attached to it, therefore on 8 April 2025, the Registry asked the Applicant to send a copy of his completed Form TM8.

17. The Applicant did not reply to this request, therefore, on 15 April 2025, the Registry again wrote to the Applicant stating as follows (original emphasis):

“The 14 April 2025 deadline to respond has now lapsed and you have still failed to file a completed Form TM8 despite the Registry’s directions. You are informed that each day that lapses past the statutory deadline of 13 March 2025 is counted as an

additional late filing day, and unless and until a TM8 is actually received by the Registry, those late filing days will continue to accumulate.

You have requested to be heard on the matter of the late filing of your TM8. The purpose of the hearing appointed on 15 May 2025 is therefore for you to put forward your arguments as to why the Registrar should exercise its discretion to accept your TM8 past the non-extensible 13 March 2025 statutory deadline.

In order for the Hearing Officer to consider the admittance of a late filed TM8 at the appointed hearing, a form TM8 and counterstatement must be filed. With no TM8 filed the purpose of the hearing is moot.

The Applicant is therefore directed for the fourth time since the statutory deadline has lapsed to file the form TM8 and counterstatement. This must be sent to the Registry on or before **22 April 2025**.

[...]

Please note that the Hearing will be vacated if a TM8 is not filed by 22 April 2025 and the preliminary view will be upheld, i.e. your trade mark application will be treated as abandoned in accordance with Rule 18(2)."

18. The Applicant replied twice on 16 April 2025 (being little over a month after the statutory deadline for filing a defence had lapsed). In the first of his emails, he states that he intended to request proof of use and also states as follows (original emphasis):

"Thank you for your email dated 15 April 2025, and for allowing filing by 22 April. Both my chief PA and I have been unwell recently, so I was just about to request a short extension on this basis. Your message came at a welcome time, and I'm grateful for the opportunity to complete this submission.

Please find attached the completed **Form TM8**. I am soon sending a **Counterstatement** in relation to **UK Trade Mark Opposition No. OP451741**, concerning application number **4065699**, in light of new developments."

19. Attached to the Applicant's 16 April letter was a document he had labelled as 'TM8'. This document is included at Annex 2 of this decision for ease of reference – albeit it is dated 14 April 2025, it was not filed until 16 April 2025.

20. The Registry initially took the view that because the Applicant did not use the official form TM8, the document filed on 16 April did not constitute an attempt to file a

defence. The Registry therefore provided a further prompt to the Applicant to file a Form TM8 – on 16 April the Registry wrote to the Applicant and directed that he commit his defence to the Registry’s official Form TM8, and requested that he send it to the Registry by 22 April in readiness for the procedural hearing; the Registry sent the Applicant a direct internet link to the official Form TM8, stating in emboldened font “*this is the form you are required to complete*”; and notified him that: (1) his counterstatement is part of the form and must be completed and sent at the same time; (2) if he intended to request proof of use then he would have to fill in the relevant part of the form; and (3) this was his final opportunity to comply with the Registry’s directions on sending a completed Form TM8.

21. Furthermore, it was the Registry’s interpretation that the Applicant appeared to be under the impression that in requesting a copy of the Form TM8, the Registry had already exercised discretion and taken the decision to allow its late filing, and that the procedural hearing was actually an opportunity for him to present his substantive arguments in relation to the opposition. Therefore, in the Registry’s response dated 16 April 2025, the Registry clarified that a Form TM8 had not been admitted into proceedings and set out the purpose of the procedural hearing. The Registry stated as follows (original emphasis):

“[...] The consequences of your failure to comply [with the Registry’s directions] are set out in bold below and highlighted in yellow.

The Registry wishes to make it patently clear that the TM8 deadline is statutory and non-extendable. The non-extendable statutory deadline for you to file your TM8 and counterstatement lapsed on 13 March 2025. Therefore, please take note that the procedural hearing has been appointed because you disagree with the Registry’s preliminary view that your trade mark application should be deemed abandoned due to failure to file a defence. The procedural hearing is not an opportunity for you to argue the substantive matters of the opposition, it is merely an opportunity for you to put forward your arguments as to why the Registrar should exercise its discretion to accept your Form TM8 (which you have yet to provide) outside of the prescribed statutory deadline – the procedural hearing is confined to that matter only.

In order for the Hearing Officer to consider the admittance of a late filed TM8 at the procedural hearing, a completed Form TM8 must be provided, otherwise you are

asking for your defence to be accepted past the 13 March 2025 deadline without actually having provided it.

Failure to provide anything other than the appropriate completed Form TM8 'Notice of Defence and Counterstatement' by the 22 April 2025 will result in the procedural hearing being vacated (meaning that it will be cancelled) and your trade mark application will automatically be treated as abandoned."

22. I note that this was the fifth time since the expiry of the statutory deadline (the other four times being 31 March 2025, 4 April 2025, 8 April 2025 and 15 April 2025) that the Registry directed that the Applicant file a Form TM8. At this juncture in the 'background' narrative, I also wish to clarify, for the avoidance of any doubt, that after the expiry of the statutory deadline of 13 March 2025, in all instances where the Registry asked the Applicant to provide a copy of his Form TM8, the Registry was not re-setting nor extending the statutory deadline for filing that form; nor was it exercising the discretion afforded to it under rule 18, since the assessment for exercising such discretion was a factor to be determined at the requested procedural hearing. Furthermore, such hearing could not go ahead if no defence (even a late defence) had been filed at all.

23. The Applicant did not respond to the Registry's 16 April correspondence, therefore, on 28 April 2025, the Registry vacated the procedural hearing listed for 15 May 2025, and notified the parties of the same. On 2 May 2025 the Registry wrote to the Applicant confirming abandonment of his application.

24. A further chain of correspondence ensued between the Applicant and the Registry, namely, the Applicant wrote to the Registry twice on 2 May 2025. The first correspondence² preceded the Registry's letter of the same date – this was coincidental as the Applicant's letter had not yet been processed at the time the Registry's letter was sent. The Applicant's letter was nonetheless sent after the Registry had informed him on 28 April that the procedural hearing had been vacated.

25. The first of the Applicant's correspondence had three attachments, being: a letter from the Applicant to the Registry dated 1 May 2025 (but sent on 2 May); a further witness statement; and a copy of a letter marked 'without prejudice', from the Applicant

² Which had a time stamp of 3:36am on 2 May 2025.

to the Opponent, dated 1 May 2025. Notwithstanding the latter was marked without prejudice, the Applicant had put the Registry's Tribunal in copy.

26. The 1 May letter directed at the Registry had four headings, the first being "*TM8 validity*". Under that heading the Applicant states:

"The TM8 form was completed and submitted in substance and good faith.

Any technical rejection risks placing form over substance, which runs counter to the IPO's own guidance and the overriding objective of fair case determination.

I therefore respectfully reaffirm my position that the TM8 should be fully accepted into the record and considered valid."

27. The remaining three headings were as follows:

- Updated Witness Statement and Evidence
- Enclosure of "Without Prejudice" Letter to MEXMA
- Request for Adjournment – and Procedural Outcomes

28. Bearing in mind that at the time of writing his 1 May letter, the Registry had already vacated the procedural hearing, the Applicant proposes in his letter several options as a way forward, one of which is for the Registry to "*accept and consider all updated evidence and submissions (superseding older ones) in full at the hearing*".

29. With regard to the attached witness statement ("the Applicant's Second Witness Statement"), I note that it is undated, but signed, and is in the name of Matthew Forrest, the preamble states (my emphasis):

"In the Matter of Proven Copyright Infringement, Bad Faith Conduct, and Misappropriation of the "It's a Wrap!" and "ITZA" Brand Family by MEXMA

I, Matthew Forrest, the original creator of "It's a Wrap!" and "ITZA," make this statement as a complete and superseding account, replacing all prior statements in this matter."

30. The Applicant's Second Witness Statement does not address the procedural issue before the Registry with regard to the late filing of a defence in the instant opposition proceedings. It instead elaborates on the contentious matters listed in the preamble,

including the Applicant's assertion that he has prior intellectual property rights. The Applicant summarises the contents of his second witness statement as follows:³

- Reaffirms longstanding UK rights in "IT'S A WRAP!" (since 2003)
- Details the evolution of the ITZA brand family under common law
- Provides clear evidence of MEXMA's access, mimicry, and bad faith
- Contextualises imminent cancellation proceedings at UK and EU level
- This submission supersedes any earlier witness content and should replace it in its entirety."

31. Following receipt of the Registry's letter notifying the Applicant of the abandonment of his application, the Applicant wrote to the Registry (in a letter also dated 2 May 2025) contesting the decision. The Registry replied to the Applicant on 15 May 2025 and noted that the Applicant had still not provided a defence in the format of the Registry's official Form TM8; and that to date the Applicant had only provided a self-drafted document titled 'TM8' which was sent to the Registry on 16 April 2025 (at Annex 2 of this decision). However, upon review of the matter, the Registry concluded that a procedural irregularity existed to the extent that the document filed on 16 April should have at least been recognised as the Applicant's attempt to file a defence to the opposition (albeit late).

32. In its letter of 15 May, the Registry explained that the subsequent automatic abandonment of the trade mark application would therefore not have come about had the procedural irregularity not occurred; and that the Registry was of the view that the originally scheduled late Form TM8 hearing could have proceeded if it were not for that procedural irregularity, with the question of the actual format of the defence (i.e. the 'format' being use of the official form) being a matter that could have been addressed at that hearing – this is because the Registry nonetheless requires a defence to be filed on an official Form TM8.⁴

33. Using its powers under rule 74 of the Rules, the Registry issued a preliminary view on 15 May 2025 to rectify the identified irregularity, and listed a new procedural hearing for 4 June 2025, this is because, even proceeding on the basis of an acceptance that the document filed on 16 April 2025 was an attempt to file a defence, a hearing on its lateness would still nonetheless be necessary on the basis that, irrespective of format,

³ As per his letter dated 1 May 2025, received on 2 May 2025

⁴ See Rule 18(1) of the Trade Mark Rules 2008.

that document was filed a total of 34 days after the expiry of the statutory deadline for filing a Form TM8.

34. The Registry's preliminary view issued under rule 74 was as follows:

"[...] although the applicant failed to follow the Registry's directions to provide a completed official Form TM8, it is the Registry's preliminary view that the applicant is deemed to have, at the very least, attempted to defend the opposition by filing its self-drafted defence document on 16 April 2025."

35. In its 15 May letter, the Registry also clarified the following:

"New Procedural Hearing"

It still however would remain to be determined whether the applicant is permitted to defend the opposition past the non-extendable statutory deadline of 13 March 2025, and Rule 18(2) of the Trade Mark Rules 2008 would still apply.

A procedural hearing has therefore been scheduled for Wednesday 4 June 2025 at 14:00hrs. In order to avoid unnecessarily burdening the parties with multiple procedural hearings, if either party disagrees with the above preliminary view to rectify the irregularity in procedure then they are being given the opportunity to be heard on that matter at the scheduled procedural hearing which will also discuss the late filing of a defence.

The Registry wishes to make it clear that proceeding with a hearing does not discharge the applicant from its obligation to rectify the format of its defence in the event that it successfully satisfies the Registry that circumstances exist to allow the late filing of a defence."

36. Essentially, the Registry was informing the Applicant that even if the late Form TM8 procedural hearing found in his favour, and allowed a defence to be admitted into proceedings past the statutory deadline, the Applicant would thereafter still be required to transcribe his defence onto the official Form TM8 for it to be served.

37. Returning to my earlier point about the deemed abandonment of the trade mark application, given that this was a partial opposition directed at only Class 29, deeming the application as abandoned in respect of all applied-for classes represented a

procedural irregularity. The Applicant's trade mark application was therefore reinstated in full pending the outcome of the new procedural hearing listed for 4 June 2025.

38. The Applicant replied to the Registry on 15 May. However, the reply did not relate to the reasons why a defence was filed late; consequently the Registry responded with the following on 19 May 2025 (the salient points are replicated below):

“The actual contents/ arguments contained in the applicant's defence are not the subject of the upcoming procedural hearing, the purpose of which is to hear the applicant's reasons as to why it did not comply with the 13 March 2025 deadline. The hearing officer will also at the same time hear the parties on the matter of the preliminary view expressed in the Registry's official correspondence of 15 May 2025. The parties will have the opportunity to present their arguments on the actual format of the applicant's defence (i.e. the fact that it was not provided on the Registry's official Form TM8) at the hearing.

This procedural hearing is not a main hearing. [...] ⁵ these opposition proceedings are at the very initial stages (the TM8 stage) and they cannot jump directly to a main hearing on the substance of the opposition (which can only come after a Form TM8 is admitted into proceedings and served on the opponent, and after the sequential evidence rounds are held).”

39. The Applicant replied to the Registry on 19 May 2025. His letter raises several matters which the Registry replied to on 2 June 2025. However, on the topic of the filing of his Form TM8, he states, (my emphasis):

“Let me be unambiguous: this is not a minor matter of form. This is a multi-million pound and euro dispute, rooted in what may be the clearest and most documentable case of trademark infringement and bad faith to come before the Registry in years. The evidence trail is so strong — both in proving access and deliberate mimicry — that it could justifiably be described as the Fort Knox of evidentiary submissions.

And yet, this case is now being derailed — or worse, trivialised — over a formatting issue. **A TM8 response was submitted** in good faith, fully and **timely**, containing all substantive requirements. **To be dragged into a hearing over its format**, when the

⁵ Annexed to the Registry's letter was an opposition procedure flow diagram, taken from part 3.1.1 of the Tribunal Section of the Registry's Manual of Trade Marks Practice. The purpose of this inclusion was to assist the Applicant in visualising the various stages of opposition proceedings, and thus demonstrate where in the proceedings the Form TM8 stage lies.

content was beyond reproach, is legally disproportionate and procedurally indefensible. It borders on farce. This feels less like trademark law and more like punishment for using blue ink instead of black.”

40. The Registry’s 2 June 2025 response noted several matters with regard to the late filing of the defence, and the purpose of the procedural hearing, namely the Registry’s letter noted that:

- (1) the Applicant had not complied with the non-extensible statutory deadline of 13 March 2025 therefore no defence had been admitted into proceedings at present;
- (2) the Applicant’s First Witness Statement dated 7 April 2025 requested that the “*late filing*” of his TM8 be accepted;⁶
- (3) when the Registry asked the Applicant to provide a copy of his Form TM8 to accompany his witness statement, the Registry was not re-setting nor extending the statutory deadline for filing that form;
- (4) the purpose of the procedural hearing was to address the missed statutory deadline, clarifying that: when the Registry refers to a ‘late filing’ it refers to a filing made after the statutory deadline has passed; and it is not the contents of the defence (i.e. the reasons why the applicant denies the opponent’s claims) which are subject of this particular procedural hearing;
- (5) the procedural hearing sought to establish answers to the following questions:
 - (i) Why did the Applicant miss the statutory deadline of 13 March 2025?
 - (ii) Since filing his 7 April witness statement, why has the Applicant subsequently insisted that he did not file his defence late?
 - (iii) What are the reasons why the Applicant has been unable to provide a defence on the Registry’s official Form TM8?
- (6) the potential negative outcome of the procedural decision is that the opposition will be deemed undefended and, in accordance with Rule 18(2), the application for registration, insofar as it relates to the goods in respect of which the

⁶ Paragraph 1 of the witness statement.

opposition is directed (i.e. in this case goods contained in Class 29 only), shall be treated as abandoned.

41. Subsequent to the Registry's letter, the Applicant filed submissions on 2 June 2025 ahead of the procedural hearing (see table below at paragraph 44), and confirmed who would be attending the hearing i.e. the Applicant himself and a request was made for Philip Hirst (referred to by the Applicant as "*our legal representative and IP Legal Director*") to also attend.

42. I note that the Opponent had not indicated whether it would be attending the hearing listed for 4 June 2025, but in previous correspondence to the Registry in relation to the hearing listed for 15 May, the Opponent's representatives had confirmed that they would not be attending, nor filing submissions in lieu of attendance, stating that "*This is because the matter to be discussed is solely the Applicant's failure to file its TM8 and counterstatement on time. The Opponent is satisfied to accept whatever the UK IPO's decision is on the matter.*"⁷

43. The procedural hearing was scheduled to commence at 2:00pm on 4 June 2025. On the morning of 4 June, the Applicant informed the Registry that neither he, nor his "*appointed IP advisor, Mr Philip Hirst*" would be attending. In lieu of his attendance, the Applicant filed written submissions (see table below at paragraph 44) which he stated "*shall represent me fully and faithfully, and should be treated as my direct presence in the room. No live questioning, elaboration, or additional explanation would enhance the tribunal's understanding.*" He also noted (my emphasis) "*that while it would have been appropriate and equitable for both myself, as trademark holder, and Mr Hirst, as experienced IP counsel, to contribute at a hearing concerning a multi-layered procedural dispute, I recognise that this particular hearing is narrowly framed and not designed to examine the full merits of the dispute at this time*".

The Applicant's submissions dated 2 and 4 June 2025

44. I have included the submissions below to the extent that is necessary, using the Applicant's headings for ease of reference (the emboldened font is my emphasis):

⁷ See the Opponent's letter dated 11 April 2025.

2 June 2025	4 June 2025
<p><u>1. On the TM8 and Its Validity</u></p> <p>A TM8 was completed, signed, and submitted in accordance with the essential criteria laid out in Tribunal Practice Notices and relevant UKIPO procedure. It was produced in good faith by a legal assistant using a functionally identical version (a "clone") of the TM8 downloaded from the IPO website. It contained all required content, including:</p> <ul style="list-style-type: none"> • Identification of parties • Clear statement of defence • Proper case references • Signed verification <p>There is no rule at law or practice stating that a TM8 submitted via an exact template—as opposed to an IPO-stamped file—is inadmissible. If rejection is based on format or perception of informal layout, that would be akin to dismissing a legally complete form because it was printed in blue ink rather than black. Such logic has no grounding in law and certainly fails any test of justice.</p>	<p><u>1. On TM8 Submission – Format vs Substance</u></p> <p>The TM8 filing in question has been improperly challenged not on content, but on cosmetic grounds. The submitted document included all requisite sections, responses, and intentions. It is, by every practical and functional measure, a direct clone of the official form. To reject a fully complete document on the basis that it was not submitted using the exact IPO-provided interface is not only pedantic but contrary to the spirit of procedural fairness.</p> <p>It is clear that the TM8 was submitted in good faith and delay arose only as a result of ongoing negotiations and misrepresentation of procedural urgency. It fulfilled its purpose: to state the opposition clearly and on time, save for the formatting technicality.</p>
<p><u>2. Why the Deadline Was Missed</u></p> <p>The delay was not negligent. It was the result of active, documented, good faith negotiations between myself and Mexma Foods BV's legal team, Baron Warren Redfern. These included correspondence as recent as 21 March 2025, which both parties acknowledged. These negotiations gave every impression that a commercial resolution was imminent, rendering an immediate TM8 filing procedurally and commercially inappropriate at that time.</p> <p>Mexma then proceeded to intentionally run down the clock—failing to inform the IPO of the negotiations, and thereby constructing a</p>	<p><u>2. On Maxima's [sic] Procedural Conduct – Strategic Silence and Intentional Delay</u></p> <p>It is now overwhelmingly evident that Maxima's [sic] legal team employed a deliberate strategy to run the clock. The pattern is clear:</p> <p>Constructive discussions took place initially, with implied intent to resolve the dispute amicably.</p> <p>At a critical moment, Maxima [sic] withdrew communication, initiating what can only be described as intentional ghosting.</p> <p>No communication was made to the IPO, which would have demonstrated</p>

<p>procedural trap. This is not speculation—it is evidenced by emails, legal letters, and the opponent's strategic silence during a known dispute.</p>	<p>transparency or acknowledged that negotiations were active.</p> <p>Once the opposition window had lapsed, Maxima [sic] resurfaced, relying on the absence of a timely TM8 as a procedural shield — an act that, taken in context, was premeditated and executed in bad faith.</p> <p>Their silence was not accidental — it was instrumental to their legal positioning. This is not the behaviour of a party acting in good faith.</p>
<p><u>3. This Hearing is Misframed</u></p> <p>This hearing is being conducted on the premise that:</p> <ul style="list-style-type: none"> • The TM8 was never filed; and • No justification exists for its late filing. <p>Both are factually and legally incorrect. The TM8 was filed in good time if measured from the context of Rule 18(2) discretion, and exceptional circumstances exist in both fact and ethics.</p> <p>The hearing should not focus on formality, but on procedural justice and good faith. The IPO’s own guidance is clear: discretion exists precisely for these kinds of complex, multi-party, high-value disputes.</p>	<p><u>5. On the Cost to Public Process</u></p> <p>This hearing, if solely focused on the formatting of a TM8, would ignore the central issue: a coordinated, bad faith trademark hijack involving cloned names, trademark misdirection, and procedural manipulation.</p> <p>To focus judicial resources on whether the font or format of a timely and substantive TM8 clone was IPO-standard — while a multi-million-pound dispute over prior use, brand ownership, and intentional deception unfolds — risks undermining public confidence in the purpose of trademark protection systems.</p>
<p><u>6. Final Observations</u></p> <p>This is not merely about whether a form was submitted “on the right template.” This is a multimillion-pound IP conflict that implicates international branding rights, commercial ethics, and systemic regulatory fairness. [...]</p>	<p><u>6. On Future Pathways and Additional Proceedings</u></p> <p>Even in the event that this hearing results in loss of Class 43 from the ITZA registration, it must be understood and recorded that this does not end the matter. The following legal remedies remain viable and will be pursued:</p>

	<p>Invalidation proceedings against Maxima's [sic] ITZA mark, based on bad faith and prior rights;</p> <p>New filing and reinstatement of Class 43 (food and drink) under a new application with extensive proof of historical and commercial use;</p> <p>Civil action for passing off and damages, if applicable;</p> <p>Judicial Review of UKIPO's handling, if systemic failures or procedural bias are evident.</p> <p>[...]</p>
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45. I note that, contrary to the Applicant's 4 June submissions, the contested application does not cover Class 43 services.

Summary of the background

46. The order of events leading up to this procedural decision are summarised below:

- (1) The two-month defence filing period lapsed and no defence was filed;
- (2) the Registry issued a preliminary view under rule 18 (because no defence had been filed);
- (3) the Applicant contested that preliminary view and requested a procedural hearing;
- (4) the Applicant filed a witness statement in support of that challenge but did not file a Form TM8;
- (5) the Registry repeatedly requested that he file a Form TM8 ahead of the procedural hearing originally listed for 15 May 2025;
- (6) on 16 April 2025 the Applicant filed a self-drafted 'TM8' defence;
- (7) the Registry rejected that defence because it was not on the official Form TM8 and asked that he use the official form giving a deadline by which to respond;
- (8) the Applicant did not respond – consequently the Registry vacated the hearing and implemented the preliminary view to deem his trade mark application as abandoned due to failure to file a defence on time in accordance with rule 18;
- (9) the Applicant challenged the action taken by the Registry;
- (10) the Registry, upon review, concluded that it should have accepted the 16 April 2025 document as an attempt to file a defence, and issued a preliminary view

under rule 74 with words to that effect. Consequently, the trade mark application was reinstated in full (as it should have only been partially abandoned in the first place), pending the outcome of a new hearing which had been listed for 4 June 2025. The format of the defence therefore no longer became a factor influencing the decision to accept the 16 April 2025 as the date the Applicant attempted to defend the opposition (albeit that filing was in itself a late filing);

- (11) the Registry elected to proceed on the basis that if the preliminary view expressed under rule 74 were confirmed, then the Registry would address the preliminary view under rule 18 as to whether such late filing could be accepted (if the late filing were to be accepted, then the Registry would direct that the Applicant transcribe his defence onto the official Form TM8 so it could be served).

PRELIMINARY ISSUES

47. Despite having initially admitted he did not file his defence on time, the Applicant subsequently proceeded to advance submissions that his 16 April 2025 filing was *“timely”*. As a consequence, he submits that the Registry is rejecting the *“timely”* filing of his ‘TM8’ on the basis that it was not filed on the Registry’s official Form TM8; and that *“the TM8 filing in question has been improperly challenged not on content, but on cosmetic grounds”*.

48. In other words, he does not consider the timeliness to be in dispute and has assumed that the remaining matter disputed by the Registry is that of the ‘format’, which he essentially submits is pedantic and he accuses the Registry of placing *“form over substance”*.

49. There are three issues to address in relation to those submissions. The Applicant is submitting that he filed his Form TM8 on time when he filed it on 16 April 2025 (that is the first issue), and that the Registry is rejecting that *“timely”* filing on the basis that it is not on the official form (that is the second issue), without having taken into consideration the content of the defence i.e. the various arguments/ counterclaims he alleges (that is the third issue) – this is because he essentially submits that the content of his defence is reason enough to justify the Registry accepting his defence, rather

than dismissing it because it is not on the official form. I have addressed the three identified issues in turn below.

(1) Alleged timely filing

50. As regards timeliness, the Applicant has acknowledged that he missed the 13 March 2025 deadline. However, it is apparent to me from the Applicant's various subsequent submissions, that when the Registry asked the Applicant to provide a copy of his Form TM8 to accompany his witness statement (in readiness for the procedural hearing originally listed for 15 May 2025), the Applicant had erroneously assumed that the Registry had already exercised discretion and re-set/ extended the deadline for him to file his Form TM8 (being a deadline of 14 April 2025 – which he missed; and 22 April 2025).

51. It also appears to me that, based on this assumption (which the Registry had clarified was erroneous), the Applicant has proceeded to assert that he filed his defence in a "*timely*" manner, because he had filed his self-drafted 'TM8' document on 16 April 2025 (or as the Applicant has referred to it – a "*clone*" TM8).

52. Consequently, I must address the 'timeliness' point as a preliminary issue and confirm that the non-extensible deadline for filing the Form TM8 was 13 March 2025. Regardless of format and/or content, the fact remains that the Applicant did not file a defence on time since he would have had to have filed it on or before 13 March 2025. Therefore, the timing issue transcends the issues as to format and substance because fundamentally, a defence was not filed in these proceedings during the prescribed statutory two-month period. I therefore reject any argument advanced by the Applicant that his defence was filed on time and shall proceed on this basis.

53. To reiterate a point already made, in all instances when the Registry asked the Applicant to provide a copy of his Form TM8 after the expiry of the statutory deadline, the Registry was not re-setting, nor extending, the statutory deadline for filing that form, since any exercise of discretion remained to be determined, and it is something I shall proceed to address in this decision.

(2) Format of the defence – use of the official Form TM8

54. Making a decision under rule 18 requires a Hearing Officer to address whether they consider reasons exist which justify a defence being filed outside of the prescribed statutory period. The Applicant would therefore first need to overcome the fact that he did not file a defence by 13 March 2025. If the Applicant is able to overcome that fundamental obstacle, then the issue as to the format of the document he filed on 16 April, is an easily resolvable issue, whereby, I can direct, using the Registry's powers under rule 62, that the Applicant transcribe his defence onto the official Form TM8 ready for service. Rule 18(1) of the Rules makes it clear that a defence is to be filed on a Form TM8 i.e. the Registry's official Form TM8, therefore the Applicant's submissions that use of the official form is unnecessary and pedantry are unfounded.

55. It is not lost on me that it took effort to produce the 16 April document, however, I cannot fathom why the Applicant did not use the official form in the first place, and instead went to the effort of replicating it, especially because, even after he filed that document, if he had proceeded to comply with the Registry's further directions to use the official form, it would have avoided the original hearing being vacated and the subsequent deemed abandonment of the application.

56. I note that the Applicant has not, at any point, provided any explanation as to why he did not use the Registry's official Form TM8, and as he ultimately elected not to attend the hearing, I was not able to question him on this issue either. For example, if it were a simple matter of him being unable to download the form from the Registry's website, the Registry would have been able to, on request, post the form to him.

(2) Substance of the Applicant's defence/ submissions

57. The Applicant has repeatedly advanced submissions and statements regarding the validity of the Opponent's trade mark, the assertion of the existence of his earlier rights, and has alleged the existence of various other counterclaims to the instant opposition, including an allegation of bad faith. These submissions are entwined with the Applicant's assertion that the 'TM8' should be accepted. It is apparent that the Applicant proceeded to make submissions not only on an erroneous assumption that he filed his defence on time (by filing it on 16 April) but also on another (erroneous) assumption that the case unfolding before the Tribunal is a case involving those

various alleged counterclaims to the opposition, and that the procedural hearing about a late filing of a defence was an opportunity to present those substantive submissions.

58. The Applicant has been informed that a procedural hearing relating to the late filing of a defence is not a main hearing and therefore not an opportunity to present substantive arguments in relation to the opposition.

59. As I have said, when an applicant files a defence late, the primary obstacle they face is that of overcoming the late filing. The validity and/or relevance of a defence is not a factor which is taken into consideration under rule 18. If a defence is filed late, regardless of its content, validity and/or merit, 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.

60. The only other point I wish to note on substance (although it does not relate to the decision before me) is that, even if I were to allow the late filing of the defence and the opposition proceedings were to continue, if the Applicant wishes to attack the validity or otherwise of the earlier mark as he appears to do, the provisions of section 72 of the Act would need to be taken into consideration, as would the finding of Ms Anna Carboni, sitting as the Appointed Person, in *Ion Associates Ltd v Philip Stainton and Another*,⁸ with regard to counterclaims based on alleged earlier rights.

DECISION – 16 April 2025 as the Filing Date of the Defence

61. As noted above, the Registry's preliminary view issued on 15 May 2025 under rule 74 of the Rules, in respect of the 'TM8' document at Annex 2 of this decision, is as follows:

"[...] although the applicant failed to follow the Registry's directions to provide a completed official Form TM8, it is the Registry's preliminary view that the applicant is

⁸ BL O/211/09. In this regard, I also note the provisions set out by the Registry in Tribunal Practice Notice 4/2009 and part 4.5 of the Tribunal section of the Registry's Manual of Trade Marks Practice i.e. "*Parties are reminded that defences to section 5(1) or (2) grounds based on the applicant for registration [...] owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration [...] wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark.*"

deemed to have, at the very least, attempted to defend the opposition by filing its self-drafted defence document on 16 April 2025.”

62. This preliminary view relates to the deemed filing date of the defence – embroiled in that matter is the issue of the use of the official Form TM8 i.e. the ‘format’ of the defence. I note that the purpose of the Registry’s preliminary view expressed under rule 74 was to address an irregularity in procedure, and that irregularity was that the Registry should have recognised that the Applicant had attempted to file a defence on 16 April 2025 rather than dismissing it because it was not on the official Form TM8.

63. In issuing its preliminary view, the Registry was indicating that it was recognising the 16 April 2025 as the date the Applicant filed a defence (albeit not on the official form), and subsequently reinstated the trade mark application in full, pending the outcome of this procedural decision, which would not only address that preliminary view, but also the preliminary view expressed under rule 18 of the Rules with regard to the late filing of a defence.

64. The Opponent has not made any challenge to the Registry’s preliminary view expressed on 15 May 2025.

65. The Applicant regards the 16 April 2025 document as his defence filing. I have already summarised above that the Applicant contends that such filing was timely; that the defence should be accepted in its current format; and that the Registry should not focus on format as a reason to reject his alleged timely filing of a defence, but rather it should take the substance of his defence into account.

66. For reasons I have mentioned in the preliminary issues section of this decision, the content of the defence is not what the Registry is taking issue with at this stage in the proceedings; and the format is something that can readily be resolved through providing directions. The Applicant’s subsequent “*form over substance*” criticisms are therefore misguided.

67. The Applicant, by his own admission, failed to meet the 13 March 2025 statutory deadline. As per the preliminary view, the Applicant’s self-drafted ‘TM8’ dated 14 April 2025, but filed on 16 April 2025, is considered to be an attempt to defend the opposition and I accept it as such. However, this was not “*timely*”, and it still represents

a late filing because it was made after the prescribed statutory two-month period had lapsed.

OUTCOME – 16 April 2025 as the Filing Date of the Defence

68. I uphold the Registry’s preliminary view issued on 15 May 2025 and accept the 16 April 2025 as the late filing date of the Applicant’s defence.

69. Having reached the above decision I can now proceed with addressing the preliminary view issued under rule 18 of the Rules with regard to late filing of a defence, and if the Applicant is successful in his challenge to that preliminary view, I will direct that he transcribes his defence onto the official Form TM8.

70. Thus, returning to my preliminary point about the format of the defence, I note, for the avoidance of doubt, that even if the current format of the defence were acceptable (regardless of content), such a finding could not overcome its late filing. Even in that scenario, I would still need to go on to consider whether there are any exceptional or extenuating circumstances for filing the defence contrary to rule 18(3) of the Rules.

DECISION – Late Filing of a Defence

71. It remains to be determined whether a late filing (regardless of content and format) is justifiable, given the circumstances surrounding that late filing.

Evidence

72. I now return to the ‘without prejudice’ Negotiation Correspondence which forms part of the papers before me. As I have previously noted, it was filed by the Applicant on 3 April 2025 and consists of pre-action and post-action correspondence between the parties, dated from 5 December 2024 to 20 January 2025 (the latest date falling a week after the Form TM7 was served). I note that the Opponent has not raised any objections to the Applicant having filed this correspondence.

73. The Applicant has claimed that the reason for the “*delay*” in filing his defence was due to “*ongoing negotiations*” between the parties and that the Negotiation Correspondence is “*proof of ongoing negotiations*” between them. Indeed, in his first witness statement he states that the Opponent failed to notify the Registry that those

negotiations were taking place, and that such failure on the Opponent's part has prejudiced the procedural fairness of the opposition.

74. The Applicant also alleges that the Opponent "*knowingly advanced their position without disclosing our negotiations to the IPO*" – which I interpret to mean that, after having filed a notice of threatened opposition, the Opponent 'advanced' its position by filing a notice of opposition but did not notify the Registry of the parties' negotiations.

75. Furthermore, the Applicant alleges that the Opponent, after having filed the opposition, fell silent on their negotiations as a strategy to run down the clock on the Applicant's time to file a defence; and after that time lapsed, the Opponent "*resurfaced relying on the absence of a timely TM8 as a procedural shield.*" The Applicant submits that this represents procedural unfairness.

76. Under ordinary circumstances, I would not take 'without prejudice' correspondence into account. However, part 4.20 of the Tribunal Section of the Registry's Manual of Trade Marks Practice addresses 'without prejudice' correspondence and the limited circumstances that would warrant it being taken into consideration. It states (my emphasis):

"In general, the principles of without prejudice correspondence applicable in the court will likewise be applied before the Tribunal. The public interest justification for without prejudice communications not being used as evidence is that parties should be at liberty to pursue negotiations and settlement without running a risk that documents relating to such discussions will be put forward in relation to the strengths or weaknesses of their substantive cases.

[...]

The without prejudice rule **can be excluded** in very limited circumstances which are set out in Unilever [PLC v The Procter & Gamble Company] and the CPR. They are as follows:

- [...]
- where the statement made would **explain delay** or apparent acquiescence

In Tribunal proceedings, for example, evidence of the fact that **negotiations have taken place** (and their state of play, insofar as this may be relevant to an application for an extension of time) **would be admissible.**"

77. In light of the above provisions, I shall take the ‘without prejudice’ Negotiation Correspondence into account only to the extent of determining whether it ‘explains’ the Applicant’s ‘delay’ in filing the Form TM8.

78. I note the following from the Negotiation Correspondence:

- (1) Subsequent to the filing of Form TM7A the parties both expressed they were in agreement to resolving the matter amicably;
- (2) On Friday 3 January 2025, the Opponent proposed that the Applicant delete Class 29 from its application and to provide signed undertakings, in return for which the Opponent would not pursue opposition against Class 29 of the trade mark application. The Applicant agreed to the terms of the Opponent’s proposal stating that “*we will need to notify the examiner also*”.⁹
- (3) In making its proposal dated 3 January 2025, the Opponent noted that its deadline for filing an opposition was Monday 6 January 2025, and put the Applicant on notice that “*in order to preserve its position, [the Opponent] will file an opposition against your application on Monday while we discuss the settlement. Once a settlement suitable for both parties has been reached and all necessary actions taken, our client will withdraw its opposition*”. The Applicant expressed that he was “*fine*” with this and looked forward to receiving the settlement proposal.
- (4) On 13 January 2025 (which I note is the same date the Form TM7 was served on the Applicant), the Applicant wrote to the Opponent’s representatives to check whether they had received his response to the Opponent’s proposals.
- (5) Two days later, on 15 January 2025, the Opponent’s representatives confirmed receipt and informed the Applicant that they were already in the process of preparing undertakings and approval of the same by the Opponent, and would revert to the Applicant shortly with those undertakings for the Applicant’s signature.
- (6) The Opponent’s representative followed up that email five days later with another, dated 20 January 2025 (being a week after the Form TM7 was served

⁹ I interpret this statement to mean that they would have to notify the trade mark application examiner.

on the Applicant). The Opponent's representatives attached the prepared undertakings ready for the Applicant's signature stating that *"it covers all points discussed and agreed by yourself and our client. Please could you sign, date and return the undertaking to me as soon as possible? Once we have received the signed undertaking and class 29 has been deleted from your ITZA application, we will withdraw the opposition."*

Legislation

79. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by rule 18 of the Rules which reads as follows (my emphasis):

"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**.

(4) This paragraph applies where—

(a) the applicant and the person opposing the registration agree to an extension of time for the filing of Form TM8;

(b) within the period of two months beginning on the notification date, either party files Form TM9c requesting an extension of time for the filing of Form TM8; and

(c) during the period beginning on the date Form TM9c was filed and ending nine months after the notification date, no notice to continue on Form TM9t is filed by the person opposing the registration and no request for a further extension of time for the filing of Form TM8 is filed on Form TM9e,

and where this paragraph applies the relevant period shall begin on the notification date and end nine months after that date.

(5) This paragraph applies where—

- (a) a request for an extension of time for the filing of Form TM8 has been filed on Form TM9c in accordance with paragraph (4)(b);
- (b) during the period referred to in paragraph (4)(c), either party files Form TM9e requesting a further extension of time for the filing of Form TM8 which request includes a statement confirming that the parties are seeking to negotiate a settlement of the opposition proceedings; and
- (c) the other party agrees to the further extension of time for the filing of Form TM8,

and where this paragraph applies the relevant period shall begin on the notification date and end eighteen months after that date.

(6) This paragraph applies where—

- (a) a request for an extension of time for the filing of Form TM8 has been filed on Form TM9c in accordance with paragraph (4)(b); and
- (b) the person opposing the registration has filed a notice to continue on Form TM9t,

and where this paragraph applies the relevant period shall begin on the notification date and end one month after the date on which Form TM9t was filed or two months after the notification date, whichever is the later.

(7) The registrar shall send a copy of Form TM8 to the person opposing the registration.

80. Rule 77 ('Alteration of time limits (Form TM9)') of the Rules is also applicable, and is to be read in conjunction with Schedule 1 of the Rules. The relevant parts read as follows (my emphasis):

Rule 77:

"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.

[...]

(4) The registrar shall extend a **flexible time limit**, except a time or period which applies in relation to proceedings before the registrar or the filing of an appeal to the Appointed Person under rule 71, where—

- (a) the request for extension is made before the end of the period of two months beginning with the date the relevant time or period expired; and
- (b) no previous request has been made under this paragraph.

(5) **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.

(6) In this rule—

“flexible time limit” means—

- (a) a time or period prescribed by these Rules, **except a time or period prescribed by the rules listed in Schedule 1**, or
- (b) a time or period specified by the registrar for doing any act or taking any proceedings; and

“proceedings before the registrar” means any dispute between two or more parties relating to a matter before the registrar in connection with a trade mark.

Schedule 1:

[...]

rule 18(1) (counter-statement in opposition proceedings)

[...]

81. The combined effect of rules 77(1) and Schedule 1 of the Rules mean that the time limit in rule 18, which sets the two-month period in which the defence must be filed, is not a *“flexible time limit”*, it is therefore non-extensible other than in the circumstances identified in rule 77(5) i.e. *“if and only if”* there has been an irregularity in procedure attributable to the Registrar.

Consideration of the application of rule 77(5)

82. I have already addressed the procedural irregularities that occurred after the expiry of the time limit to file the defence. They relate to the omission of the Registry to acknowledge the 16 April self-drafted TM8 document as an attempt to file a defence; and the subsequent error by the Registry to deem the trade mark application as abandoned. These procedural irregularities have been rectified and in any event, they were not the cause as to why the Applicant filed his defence late since those procedural irregularities occurred after 16 April 2025. There is therefore no suggestion that there has been any irregularity on the part of the Registry which caused the late filing of the defence, and I have accepted, in my above decision,¹⁰ the 16 April 2025 as the date the Registry was in receipt of the Applicant's defence document, confirming that it constitutes a late filing.

83. 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).

Consideration of the application of rule 18(2)

84. In approaching the exercise of discretion in these circumstances, I take into account the decisions in *Kickz AG v Wicked Vision Limited (“Kickz”)*¹¹ and *Mark James Holland v Mercury Wealth Management Limited (“Mercury”)*¹² i.e. I have to be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the Applicants' favour.

85. In *Music Choice Ltd's Trade Mark (“Music Choice”)*,¹³ 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 submissions made by the Applicant to the extent that I consider it necessary to do so.

¹⁰ See my paragraphs 61 to 68.

¹¹ BL O/035/11

¹² BL O/050/12

¹³ [2005] RPC 18

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

86. The stipulated deadline for the filing of the Applicant's Form TM8 and counterstatement was **13 March 2025**. The Applicant's defence (at Annex 2 of this decision) was eventually filed on **16 April 2025**, in response to a string of letters from the Registry dated 31 March 2025, 4 April 2025, 8 April 2025 and 15 April 2025. Therefore the deadline was missed by 34 days.

87. The Applicant's explanation as to why the deadline was missed is summarised above, i.e. the Applicant maintains that the "*delay*" in him filing his defence was due to ongoing negotiations between the parties. He submits that the Opponent failed to notify the Registry that those negotiations were taking place (thus "*prejudicing the procedural fairness of the process*"), and proceeded to file the opposition anyway. He submits that the negotiations between the parties rendered "*an immediate TM8 filing procedurally and commercially inappropriate at that time*"; and alleges that the Opponent, after having filed the opposition, fell silent on their negotiations as a strategy to run down the clock on the Applicant's time to file a defence.

88. The above reasons are reasons provided as to why the statutory deadline was missed in the first place, and I note that the Applicant has not advanced any explanation as to why, following the multitude of letters sent to him by the Registry post-expiry of the statutory deadline, he failed to file anything until 16 April 2025, other than to say on 16 April that he had 'recently' been unwell and was going to ask for an extension.

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

89. The opposition is brought under section 5(2)(b) of the Act. There is nothing to suggest that the opposition is without merit on the basis that due to its earlier filing date, the mark relied on is an earlier mark within the meaning of section 6 of the Act, and it stands registered for goods in Class 29.

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

90. If the Applicant is permitted to defend the opposition by the acceptance of a late filed defence, the proceedings will continue. The Applicant will then be directed to commit his defence to the Registry's official Form TM8, and (providing there are no other issues with the form), the defence will be served and the parties will be given an opportunity to file evidence and the opposition will be determined on its merits.

91. However, if the Applicant's is not allowed to defend, his application will be treated as abandoned insofar as it relates to the goods in respect of which the opposition is directed (i.e. in this case goods contained in Class 29 only), and the Applicant's mark will lose its filing date of 19 June 2024 in respect of its Class 29 goods only. The application would however be allowed to proceed to registration in respect of the applied-for services in Classes 35, 41 and 42.

Any prejudice caused to the opponent by the delay

92. No submissions have been advanced regarding prejudice to the Opponent, and the Opponent has stated that it *"is satisfied to accept whatever the UK IPO's decision is on the matter."*

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

93. I have already addressed the Applicant's alleged counterclaims in the preliminary issues section of my decision. I also note that since 4 June hearing date, the Applicant has written to the Registry to put the Registry on notice that it intends to file various claims against the Opponent including an attack on the Opponent's registration. However, at the time of writing this decision there do not appear to be any other related proceedings between the parties that I am aware of, nor other relevant considerations (beyond the ones I have already addressed) as to why the statutory filing deadline was missed.

94. Even if the parties have subsequently entered into other proceedings since this procedural issue occurred, I see no apparent adverse effect on other proceedings being allowed to continue, as the applied for mark would be a later mark that could not

be used to challenge an earlier right of the Opponent's. Therefore those proceedings would be able to continue regardless.

Conclusions on the exercise of discretion

95. It is important to be clear as to what is really sought when a request is made for the Registry to exercise its discretion: it is an application for an extension of time to a non-extendable deadline. These extensions are therefore only granted exceptionally where there are compelling reasons and/ or extenuating circumstances for missing the deadline, which justify exercising that discretion.

96. In reaching my decision, I recognise that if the discretion is not exercised in the Applicant's favour, the application will be treated as abandoned in relation to the Class 29 goods, and the Applicant will lose the filing date for its mark in relation to those goods only. I further recognise that it remains open to the Applicant to re-file an application in Class 29, 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 a filing date and the possibility of further proceedings on much the same basis are often the consequences of a failure to comply with the non-extendable deadline to file a Form TM8, these are not factors that are particularly compelling, nor do they constitute extenuating circumstances sufficient to permit the Registrar to exercise its discretion. I must instead consider the specific circumstances at hand.

97. As I have already noted, the Applicant has admitted that he missed the statutory deadline. His reasons for having missed that deadline are that there were ongoing negotiations between the parties. It is my interpretation that the Applicant believes that entering into negotiations with the Opponent would have discharged him from the requirement to file his Form TM8 by the statutory deadline; and that he believes that the Opponent was under an obligation to disclose those negotiations to the Registry in order to 'stop the clock' on the filing period. In other words, it appears to me that the Applicant thought the negotiations offered a shield to him having to file a Form TM8, and that he thought it was the Opponent's responsibility to pause the proceedings because of those negotiations. However, the fact remains that he failed to comply with the Registry's "*IMPORTANT DEADLINE*" and failed to take heed of the Registry's explicit warning that "*if the deadline date is missed, then in almost all circumstances,*

the application will be treated as abandoned".¹⁴ The Applicant was given fair warning of the consequences of not complying with the deadline.

98. Having reviewed the Negotiation Correspondence, I conclude that it shows that the parties were in advanced negotiations since undertakings had been drawn up – the terms of which were understood by the Opponent to have been agreed by the Applicant – or at the very least the Applicant had in principle agreed to delete Class 29 from his trade mark application in exchange for the withdrawal of the opposition. It is clear from this evidence that in order not to prejudice its position, the Opponent complied with the Registry's strict deadline to file its Form TM7 whilst still attempting to resolve the matter amicably with the Applicant. The Opponent was upfront with the Applicant as to why it needed to file the opposition.

99. I note that there is no onus on the Opponent to disclose to the Registry that negotiations between the parties are taking place and the existence of negotiations does not, in any event, discharge the parties from adhering to statutory deadlines. Just because parties enter negotiations, it does not mean that they can ignore those deadlines.

100. Furthermore, taking the Negotiation Correspondence into account, I consider it untenable to apportion blame on the Opponent for the Applicant's failure to protect his legal position merely because the parties were negotiating a settlement. This is because I do not consider this evidence shows anything other than the fact that the parties were negotiating around the time of the filing, and serving of, the Form TM7. The evidence does not '*explain the delay*' in filing the Form TM8, particularly since the evidence shows that the agreement was sent to the Applicant for his signature on 20 January 2025, well in advance of the 13 March statutory deadline for filing a defence, i.e. the Applicant still had almost the full two months left to file his defence when the Opponent had sent the agreement for his signature; and it evidences that the Applicant was in principle, in agreement to delete Class 29 from his application, which would have meant that the opposition would have fallen away had he done so. Further, it appears to be the Applicant himself that was responsible for the delay prior to the deadline of 13 March as the correspondence shows that the parties were waiting upon the Applicant to sign and comply with the agreement.

¹⁴ See the Registry's letter of 13 January 2023, serving the Form TM7 on the Applicant.

101. Whilst the Applicant has submitted that **he** sent a negotiation letter on 21 March 2025 to the Opponent's representatives, the fact is that the filing deadline was already missed by that point. Furthermore, the assertion that the Applicant sent a negotiation letter on 21 March raises the question as to why the Applicant was actively able to engage in discussions about the opposition proceedings with the Opponent, but yet was not actively able to engage in the proceedings with the Registry, choosing not to respond to the Registry by the 13 March deadline.

102. Whilst it is clear from the evidence that negotiations were underway, there is no suggestion before me that the parties contemplated entering into a cooling off period – in its Form TM7 serving letter, the Registry noted that a Form TM9c could be filed. From the Negotiation Correspondence it is apparent that the parties were amicable at the time, therefore I find it unusual that a cooling off period could not have been agreed had that option been contemplated, and I merely mention it as a matter of completeness.

103. A Form TM8 deadline is statutory and non-extendable, consequently, a Form TM8 should be filed to protect an applicant's position, even if the parties are negotiating a settlement. Furthermore, the very real possibility that negotiations can, and often do, go awry and break down, is even more reason for the parties to protect their respective positions by complying with the Registry's statutory deadlines.

104. It is open to parties, and it is even encouraged by the Registry, that parties in opposition proceedings try to reach a settlement between them, and negotiations can take place at any time during proceedings, not just at pre-action stages. There is nothing before me which evidences that the negotiations explain the delay, particularly as the Negotiation Correspondence does not evidence that the Opponent was delaying those negotiations. I do not accept the Applicant's line of argument on this point, therefore I find that the Applicant's failure to protect his position by failing to file his defence on time by the 13 March 2025 deadline, cannot be blamed on the negotiations nor the Opponent.

105. The reasons for the missed deadline do not represent extenuating circumstances. Nor is it an extenuating circumstance that the Opponent did not notify the Registry that the parties were negotiating with each other; and neither is the validity/merit of a defence an extenuating circumstance. In general terms, an applicant

could have a completely valid defence, but if that defence is filed late, that defence will, in almost all circumstances, be rejected unless there are compelling reasons and/or extenuating circumstances which justify exercising discretion to allow its late filing.

106. Another factor against the Applicant which I also take into account, is that the Applicant's eventual filing of a defence on 16 April 2025 is that it was reactive as opposed to proactive, since the filing was eventually prompted following multiple requests from the Registry. Indeed, for all intents and purposes, a hearing should not have been appointed at all in the first place until/unless the Applicant had filed his defence. The hearing was only appointed because it was believed that the Applicant had, through oversight, omitted to attach his Form TM8 to his 7 April email (because he had stated the words "*accompanying TM8 and counterstatement*"), I therefore consider the Registry has been extremely generous by proceeding to provide the Applicant with ample opportunity to rectify his omission to file his defence in readiness for the late Form TM8 procedural hearing, and had it not been for those prompts from the Registry, I am sceptical as to whether the Applicant would have even filed anything by 16 April 2025.

107. The deadline for filing a Form TM8 is a statutory one, and applicants are made fully aware of the consequences if they fail to comply. The fact of the matter remains that the Applicant failed to comply with that deadline. Taking all of the above into account, I am not satisfied that the reasons why a defence was filed 34 days late are particularly compelling, nor do they constitute extenuating circumstances sufficient to permit the Registrar to exercise its discretion under rule 18(2). I therefore find that the Applicant was clearly the author of his own misfortune.¹⁵

OUTCOME – Late Filing of a Defence

108. The Registry's preliminary view is upheld. The Applicant's late filed defence shall not be admitted into proceedings and consequently the opposition against Class 29 of the application is deemed as undefended. Trade mark application number 4065699 will, subject to any appeal, be treated as abandoned in respect of Class 29 only, and shall be permitted to proceed to registration in respect of the unopposed services in Classes 35, 41 and 42.

¹⁵ See *Kickz*, paragraph 15.

Final remarks

109. Given the outcome, it is unnecessary to make directions that the Applicant's defence be transcribed onto an official Form TM8.

COSTS

110. The outcome of my decision not to allow the late filing of the defence has terminated the proceedings. The Opponent is therefore entitled to a contribution towards its costs based on the scale set out in TPN 1/2023. The sum is calculated as follows:

Official fee	£100
Preparing the statement of grounds	£250
TOTAL	£350

111. I therefore order Matthew Huxley Forrest to pay Mexma Foods BV the sum of **£350**. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 23rd day of July 2025

Daniela Ferrari
For the Registrar

Annex 1

Transcription of the Applicant's 3 April 2025 email to the Registry (excluding Appendices and Annexures)

I acknowledge receipt of your letter dated 31 March 2025 regarding the matter of Opposition No: OP000451741 in relation to UKTM No. 4065699.

I now formally submit a request for hearing [sic] and respectfully ask that the IPO exercise discretion under Rule 18(2), given the exceptional circumstances in this case and the overwhelming evidence of bad faith conduct [sic] by the opponent.

1. Background of Delay – Strategic Legal Negotiations Already Underway

The delay in filing a TM8 was due not to neglect, but to the existence of active legal negotiations with Mexma Foods BV's legal representatives, Baron Warren Redfern, including direct communications dated 21 March 2025 (I am sending all correspondence, once it becomes appropriate). These communications aimed to resolve this matter commercially—given that Mexma and/or PepsiCo are fully aware of our long-standing prior rights, and have acknowledged our dominance in IP and brand scope.

Given that Mexma's filing constitutes a second instance of bad faith activity, and they knowingly advanced their position without disclosing our negotiations to the IPO, we submit that procedural fairness and justice require [sic] this matter be fully heard and not dismissed on a technicality.

2. Grounds for Hearing – Bad Faith, Abuse of Process & Undisclosed Negotiations

Mexma's original filing attempted to manipulate UK registry procedure:

They filed an opposition despite knowledge of ITZA's commercial presence dating back to 2003.

They failed to notify the IPO that commercial negotiations with the trademark holder were ongoing.

They altered their brand (from IT'ZA to ITZA) solely to manufacture legal conflict.

This is not mere delay—it is an effort to allow a bad-faith opponent to secure a victory through concealment and legal manipulation.

3. Legal and Public Interest Considerations – Rule 18(2) Must Not Be Rigidly Applied

The courts and IPO have consistently affirmed that Rule 18(2) allows discretion, particularly in cases involving:

Public interest.

Bad faith filings.

Systemic abuse of registry process.

Given that this case involves one of the largest consumer goods firms on Earth (PepsiCo), the potential consequences of allowing a bad-faith application to succeed are immense. The wider implications on the integrity of the UK IPO would be damaging.

4. Request for Direction – Fair Hearing and Rectification

Accordingly, I formally request:

That the IPO grants a hearing and allows the filing of a counterstatement and TM8 (to be submitted immediately upon permission).

That the IPO acknowledges the exceptional commercial circumstances, the undisclosed strategic negotiations, and the bad faith tactics employed by the opponent and/or their agents.

That the IPO recognises this is no ordinary opposition—but one that targets a multi-sector IP kingdom with confirmed prior rights and commercial scale.

5. Correspondence for Context (from Mexma's Legal Team)

Sending over, once appropriate:

Including letter sent [sic] 21 March 2025 to Mexma's legal agents (Baron Warren Redfern), detailing the full commercial position and the offer to resolve.

Prior warnings about regulatory exposure and Mexma's filing behaviour.

Confirmation of ITZA's status, use, and ownership long predating Mexma's interest.

6. A Note on Capability & Legal Precedent

Let me be clear. As the founder of ITZA, I am one of the UK's most dominant IP strategists. I've successfully dismantled legal opposition [sic] including:

The Premier League's photo agency, with two barristers present. A successful defence involving Navasco Enterprises vs Allsport Images. IP and branding constructs now forming part of the Getty Images framework.

I do not miss. Mexma/PepsiCo have walked into the wrong fight. And the evidence is now vast, varied, and already in the public domain. What is being requested is simple procedural fairness—not charity. Denying this would elevate bureaucracy above justice and enable a global player to suppress a sovereign UK brand (set to dominate all key markets, globally) using bad-faith filings.

7. Final Summary

I respectfully urge the Registrar to allow the late filing of TM8 and Counterstatement and grant a hearing on this matter. To do otherwise would allow a systemically flawed opposition to succeed—when all the facts, correspondence, and strategic record show that it should fail.

Should this request be denied, it will immediately escalate into judicial review, public exposure, and further regulatory complaint.

Yours sincerely,

Matthew Huxley Forrest

CEO, ITZA Global

Founder, ITZA AI Law

Annex 2

Applicant's document sent to the Registry on 16 April 2025, and referenced by the Applicant as his 'TM8'

Form TM8 – Notice of Defence and Counterstatement

No Fee

1. Trade Mark Number

UK00004065699

2. Opposition / Cancellation Number

Opposition Number: OP451741

3. Name of Applicant / Registered Owner

Matthew Huxley Forrest

4. Full Name of Person Filing Counterstatement

Matthew Huxley Forrest

Address for Service:

385 Blackpool Old Road

Highfurlong

Blackpool

FY3 7LX

United Kingdom

Email Address:

matthewhforrest@yahoo.co.uk

5. Interest in the Trade Mark

✓ Recorded Applicant / Owner / Holder of the Trade Mark

6. Related Proceedings

None

7. Request for "Proof of Use"

✓ Yes – The applicant formally requests that the opponent be required to provide evidence of genuine use of the mark "ITZA" in the United Kingdom.

Goods/Services for which Proof of Use is required:

All goods and services listed in the opponent's notice of opposition. It is noted that the opponent previously held a registration for "IT'ZA" (with apostrophe), which was subsequently allowed to lapse. It is therefore strongly questioned whether "ITZA" (without apostrophe) has ever been used in UK territory in line with the requirements of the Trade Marks Act.

The burden of proof for genuine commercial use of "ITZA" now rests with the opponent. The applicant believes it is unlikely that "ITZA" has been used at all, let alone specifically in the UK.

8. Counterstatement by the Defendant

The applicant denies the grounds of opposition in their entirety.

The opponent has re-applied for a mark that is confusingly similar in name, stylisation, phonetic structure and market position to the applicant's long-standing and protected trade mark "IT'S A WRAP!", first used commercially in 2003 and registered in various UK classes.

Prior communications show the opponent was aware of the applicant's brand. Their previous mark "IT'ZA" (with apostrophe) lapsed, and their attempt to re-register under "ITZA" (no apostrophe) was done without disclosure or effort to resolve potential conflict.

This, in combination with the strikingly similar brand visuals and business overlap, supports a claim of bad faith. The applicant contends the opposition should be dismissed outright on the grounds of:

Bad faith

Absence of genuine use of "ITZA" in the UK

Clear and substantial likelihood of confusion

A full witness statement and annexes will be submitted in support of this position.

9. Declaration

I believe the facts stated in this Notice of Defence and Counterstatement are true.

A handwritten signature in black ink, appearing to read 'Matthew Huxley Forrest', with a large, stylized flourish at the end.

Signature: Matthew Huxley Forrest

Date: 14 April 2025

10. Your Reference

Contact for Queries:

Matthew Huxley Forrest

matthewhforrest@yahoo.co.uk