BL O/0686/25

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK REGISTRATION NO.
UK0000 3313845

BOSSARON

IN CLASS 18
IN THE NAME OF
ZHANG YUAN XING
(formerly in the name of Lianhong Xie)

AND

IN THE MATTER OF INVALIDITY APPLICATION
NO. CA000507523 BY
HUGO BOSS AG

AND

IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY
HUGO BOSS AG
AGAINST A DECISION OF RAOUL COLOMBO
FOR THE REGISTRAR OF TRADE MARKS
DATED 29 JANUARY 2025

The Appellant did not appear.
MR DARREN MEALE of Simmons & Simmons appeared for the Respondent/Opponent

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DECISION

Introduction & Background

1. This is an appeal adopted by Zhang Yuan Xing ("the Proprietor") against a decision of Mr Raoul Colombo, acting for the Registrar of Trade Marks, dated 29 January 2025 by which Mr Colombo declared trade mark registration No. 3313845 ("the Contested Mark") invalid for want of the filing of a TM8/counterstatement within the two months specified by Rule 41(6) of the Trade Mark Rules 2008 ("the Rules").

2. The Contested Mark was originally registered in the name of one Lianhong Xie. The full background to the Contested Mark, and the circumstances leading to this appeal, are set out in Mr Colombo's

Decision of 29 January 2025. These facts are not in dispute and are set out in the Decision reproduced below:

> "DECISION
> The following trade mark has been registered under number UK00003313845 since 21 September 2018.
>
> BOSSARON
>
> The mark, which stands in the name of Lianhong Xie, was registered in respect of the following goods:-
>
> Class 18 - Briefcases; backpacks; handbags; shoulder bags; messenger bags; school bags; bags; wallets; suitcases; totes; purses; trunks and travelling bags.
>
> By an application filed on 10 July 2024, HUGO BOSS AG applied for a declaration of invalidity of this registration under the provision of Sections 47(2)(a) and 47(2)(b) of the Trade Marks Act 1994.
>
> A copy of the application for invalidity was sent to the registered proprietor by email and signed for delivery on 12 July 2024, with tracking number SP413188328GB, this was returned on 17 July 2024. A further copy of this application for invalidity was sent to the registered proprietor by email and royal mail standard post on 17 July 2024, this was returned by post on 30 July 2024.
>
> The registered proprietor did not file a counterstatement within the two months specified by Rule 41(6) of the Trade Mark Rules 2008. Neither party requested a hearing or gave written submissions in respect of the official letter of 02 October 2024 which was sent by email and signed for delivery, with tracking number SP665265697GB, this was returned on 07 October 2024. A further copy of this letter was sent to the registered proprietor by email and royal mail standard post on 27 November 2024, this was returned on 02 January 2025.
>
> Although the registered proprietor filed an email on 30 December 2024 expressing its desire to continue using the trade mark and attached images which were considered evidential content. However this request was disregarded as the proprietor did not, as advised in the official letter dated 27 November 2024, provide a late filed

counterstatement with full written reasons or request a hearing to challenge the preliminary view.

Such circumstances are covered by Rule 41(6) which states:
"…otherwise the Registrar may treat him as not opposing the application."

Under the provisions of the rule, the Registrar can exercise discretion. In this case, no reasons have been given why I should exercise this discretion in favour of the registered proprietor, and I therefore decline to do so.

As the registered proprietor has not responded to the allegations made, I am prepared to infer from this that they are admitted. Therefore, in accordance with Section 47(6) of the Act the registration is declared invalid and deemed never to have been made."

3. On 18 February 2025, Lianhong Xie filed an appeal under S.76 of the Act on 27 June 2024. The Grounds of Appeal were as follows:

"We missed the response time due to not receiving the email in a timely manner. We hope to file a lawsuit with the court to restore the continued use of the trademark BOSSARON (UK00003313845).

We hope to receive your correct guidance and specific operations.

We have been using the BOSSARON brand normally for more than 6 years. Since 2018, we have invested a lot of funds and various resources in this regard. We have explained and provided relevant evidence in our email replies.

Due to the malicious actions of our competitors and our negligence, we missed the time to reply to emails and provide evidence.

We hereby submit an appeal to the judge to restore the normal registration status of the BOSSARON (UK00003313845) brand.

Thank you."

4. The matter came on to be heard on 16 July 2025. Only the Respondent supplied a skeleton argument in advance and appeared before me represented by Mr Darren Meale of Simmons & Simmons,

solicitors. The Appellant did not appear. However, given the following email exchange concerning arrangements for the Hearing Bundle between Simmons & Simmons and Lianhong Xie on 9 July 2025 (which I accept into evidence for what it is worth), I am satisfied the Appellant was aware of the arrangements for the Hearing.

> "HI, Dear James: The materials for the hearing have been sent in the attachment. Please take a look at what materials are still missing ? XIE LIANHONG – DaVinci"

5. However, at the Hearing I was informed by Mr Meale that the Contested Mark had been assigned to one ZHANG YUAN XING on 3 July 2025, the assignment being recorded on 9 July. That information had not reached the Appeal case file by the time the matter came on to be heard. I therefore indicated to Mr Meale that I wished to review the procedural implications of this transfer on the Appellant's right to be heard.

6. After the Hearing, the Appointed Person's Secretariat informed me of the following information, namely:

   a) notwithstanding the assignment of the Contested Mark to Zhang Yuan Xing (together with the recordal of a new address for service) the email contact details remained the same;

   b) following recordal of the assignment of the Contested Mark, the Registrar wrote to Zhang Yuan Xing on 14 July 2025 by emailed letter in the following terms:

   > "Dear Recipient,
   > I am writing to confirm that ZHANG YUAN XING is now recorded as the registered proprietor to these proceedings.
   >
   > In view of the assignment you should now confirm that as the new registered proprietor you:
   >
   > have had sight of any forms or evidence filed, (if not, arrangements will have to be made with the former proprietor)
   >
   > stand by the statements made in the counterstatement and confirm that where the name of the original proprietor appears, this should be read as though it is made in your name are aware of and accept the liability for costs for the whole proceedings in the event that the application is successful.

Confirmation of your agreement to the above undertakings should be submitted on or before 28 July 2025."

c) At 02.37 on 15 July 2025, the following response was received by the Registrar from the email address given by the new Proprietor:

"have had sight of any forms or evidence filed, (if not, arrangements will have to be made with the former proprietor) stand by the statements made in the counterstatement and confirm that where the name of the original proprietor appears, this should be read as though it is made in your name are aware of and accept the liability for costs for the whole proceedings in the event that the application is successful.

zhangyuanxing made sure about the content above.
--
DaVinci"
(sic)

7. DaVinci is an identifier which has been consistently used in responses from the Proprietor of the Contested Mark to email correspondence with both the IPO and the Respondent. I am therefore satisfied that notwithstanding the change in Proprietor this response can be taken to be that of or given on behalf of ZHANG YUAN XING.

8. In the circumstances I am satisfied that the ZHANG YUAN XING had due notice of the Appeal hearing and has adopted the proceedings and any associated liability in full. I also conclude that the Proprietor chose not to appear at the Appeal hearing and is content for me to proceed on the basis of the Hearing and the papers before me.

Standard of Review on Appeal

9. The standard of appeal is well-known. It is limited to a review, not a re-hearing, and I should only interfere with the Hearing Officer's findings if the decision was wrong. The judgment of Joanna Smith J. in *Axogen Corporation v Aviv Scientific Limited* [2022] EWHC 95 (Ch) commencing at [24] is an appropriate summation of the detail of the approach to be followed:

> 24. Although I was referred to numerous cases on the subject …. the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:
> i) The appeal is by way of a review, not a rehearing;

ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference;
iii) 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. Absent 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";
iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question. There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision", with decisions of primary fact at one end of the spectrum and multi- factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.
v) 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.
vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible;
vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal". Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts.
viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden". The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted. The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained.
ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account.

25. In the context of appeals relating to the likelihood of confusion, an evaluative issue described by Mr Iain Purvis QC sitting as an Appointed Person in ROCHESTER Trade Mark BL 0/049/17 at [31} as "indeterminate and open to debate", Mr Purvis QC went on to say this at [33 }:
" ... the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:
(i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case (ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person
(iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal
(iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with

confidence. Jacob J (as he then was) made this point in the passing off case *Neutrogena v Golden* [1996} RPC 473 at 482:

'It was certainly my experience in practice that my own view as to the likelihood of deception was not always reliable. As I grew more experienced I said more and more "it depends on the evidence. "' Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.

34. I shall therefore approach this appeal on the basis that in the absence of a distinct and material error of principle, I ought not to interfere with the decision of the Hearing Officer unless I consider that his view on the issue of likelihood of confusion was clearly wrong in the sense that it was outside the range of views which could have been reasonably taken on the established facts"".

10. This has been reinforced by the recent judgment of the Supreme Court in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8 at [49]-[50], per :

"49 . ... the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an 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 into account some material factor, which undermines the cogency of the conclusion.

50. On the other hand, it is equally clear that, for the decision to be "wrong" under CPR 52.21(3), it is not enough to show, without more, that the appellate court might have arrived at a different evaluation."

11. This was reiterated by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc and another* [2025] UKSC 25 and the Court took the opportunity to remind appellate bodies that there are constraints on their ability to interfere with a first instance judge's multifactorial evaluation and to emphasise that appellate intervention is not justified merely because the appellate court might have arrived at a different conclusion.

12. I also bear in mind that the Decision before me was arrived at in the exercise of the Registrar's discretion. In *Sangha v Amicus Finance PLC* [2020] EWHC 1074 (Ch) Zacaroli J held that:

"An appeal against an exercise of discretion can only succeed if it is established that the judge exceeded the generous ambit within which reasonable disagreement is possible, for example because the judge took into account or left out of account relevant or irrelevant material as the case may be."

Merits of the Appeal

13. Rule 41(6) of the Trade Marks Rules 2008 states as follows:

> "The proprietor shall, within two months of the date on which a copy of Form TM26(I) 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".

14. In this case, the time limit imposed (after a reset to allow for service at the stipulated address for service by ordinary post) was 17 September 2024. This time limit could not be extended (save in the limited circumstances of an irregularity of procedure attributable to the Registrar - R 77 (5)).

15. As the Hearing Officer noted, under the provisions of Rule 41 (6), if the Form TM8 and counterstatement is not filed, the Registrar can nevertheless exercise discretion not to declare a registration invalid but in this case, no reasons were given as to why he should exercise this discretion in favour of the registered Proprietor.

16. It is well-settled that for the discretion to be exercised in favour of the Proprietor, there must be "extenuating circumstances sufficient to justify the exercise of (the Registrar's) discretion in favour of doing so" (*KIX trade mark* O/035/11 per Mr Geoffrey Hobbs QC (as he then was) at [9]).

17. Further, the Registrar's discretion not to declare a registration invalid after a failure to file a Form TM8 was 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* [2006] R.P.C. 13. He found 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".

18. The overwhelming difficulty for the Appellant here is that, notwithstanding its grounds of appeal, at the time of the Registrar's Decision no reasons of any kind had been put forward for the Proprietor's failure to file Form TM8 and counterstatement.

19. Instead, the Appeal before me seeks to put forward three reasons for the exercise of discretion, after the event.

20. First, it claims "We have been using the BOSSARON brand normally for more than 6 years." That may or may not be so, but it is not relevant to the question of why the relevant deadline was missed, or indeed to the invalidity case the Proprietor had to answer.

21. Secondly, it refers to unidentified "malicious actions of our competitors". Nothing of substance is put forward in support of this claim and, in any event, it was not raised at the time for the Registrar to consider.

22. Finally, and with notable candour, the Proprietor acknowledges the date was missed due to "our negligence". However, notwithstanding that candour, not only was this not put before the Hearing Officer at the time, but without much more by way of explanation it is highly unlikely it would have been considered an "extenuating circumstance" sufficient to justify a favourable exercise of the Registrar's discretion under R. 41 (6). The Proprietor is, in effect, conceding it was the author of its own misfortune.

23. In effect, the grounds of appeal are no more than the Proprietor's invitation to me to hear the matter *de novo* in lieu of the Registrar. As the authorities referred to above make clear, this I cannot do unless the Registrar erred in some way that has been pleaded on appeal[1]. Since the Hearing Officer was not presented with these explanations, let alone any other submissions, evidence, compelling reasons or extenuating circumstances for the failure to file the Form TM8/Counterstatement timeously and which would justify the exercise of discretion in the Proprietor's favour, the Hearing Officer's refusal to exercise the discretion in favour of the Proprietor was entirely correct.

24. It follows that this Appeal, seeking to overturn the Registrar's Decision under R. 41 (6) to treat the Contested Mark as invalid and deemed never to have been made, is dismissed. The Hearing Officer's Decision was correct for the reasons that he gave and is upheld in all respects.

Costs

25. The Applicant as the successful party is entitled to costs. The Applicant sought off-scale costs on the basis that:

a) the Appellant manifestly failed to engage with the Tribunal's rules and procedures, and admitted this is a result of the Appellant's own negligence.

b) the Appellant behaved unreasonably in each of the following instances and/or cumulatively by:
(a) causing unnecessary delays in the proceedings by repeatedly refusing to accept service of documents sent by the Registry to the Appellant's address for service;
(b) missing deadlines set by the Registry on at least three occasions, without credible or sufficient explanation being provided;
(c) launching a hopeless appeal, which the Respondent has little choice but to attend, but without providing any actual grounds for that appeal or reasons as to why the Decision is incorrect; and

[1] See, for example, BL O/399/15 *BOSCO,* at [11] per Geoffrey Hobbs QC (as he then was)

(d) failing promptly to respond to the Respondent's correspondence reminding the Appellant of its obligations to prepare the hearing bundle, leaving the Respondent in the position of needing to incur the costs of preparing this.

26. It was submitted that this was clearly "behaviour designed to delay, frustrate or unreasonably increase the costs/burden on the other party".

27. The Respondent sought costs amounting to £13,455, in effect costs on an indemnity basis.

28. I do not consider the Proprietor's conduct is so unreasonable as to merit off-scale costs. Whilst the Proprietor's conduct of the matter may not have been very good, especially when judged against professional standards, and it has no doubt been irritating and frustrating to the Respondent in a general sense, in the normal run of things without more a party, particularly a litigant in person, will not be acting unreasonably simply because it does not do a very good job.

29. Nevertheless, there is no doubt that the Proprietor's conduct has increased the costs to the Respondent of dealing with the matter, so an award to the higher end of the scale of costs is justified. Taking a rough-and-ready approach, I award the Respondent the sum of £3000, payable within 21 days from the date of issue of this Decision.

Philip Harris
Appointed Person
23 July 2025