

O/0687/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003876016

IN THE NAME OF DM ORGANIC

FOR THE FOLLOWING TRADE MARK:

DM ORGANIC

IN CLASS 5

AND

THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT

IN DEFENCE OF AN OPPOSITION

UNDER NO. 441309

BY DR ORGANIC LIMITED

BACKGROUND

1. On 8 February 2023, DM Organic Ltd ('the Applicant') applied for the trade mark no. 3876016 in the UK. Registration is sought for the following goods in class 5:

Vitamin and mineral supplements; Mineral nutritional supplements; Vitamin and mineral food supplements; Vitamin and mineral supplements for pets; Mineral dietary supplements for humans; Vitamin supplements; Anti-oxidant supplements; Liquid herbal supplements; Liquid dietary supplements; all the aforesaid goods being of organic origin.

2. On 12 June 2023, Dr Organic Limited ('the Opponent') opposed the application by way of filing a notice of opposition and statement of case ("Form TM7"). The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ('the Act') and both grounds are directed against the application in its entirety. The Opponent relies on the earlier trade mark shown below, registration UK00907561641, which is a comparable mark based on EUTM 007561641, for both grounds:

DR ORGANIC

3. On 6 July 2023, the Registry served the Form TM7 on the Applicant by email and regular using the addresses provided by them. That letter contained the following paragraphs:

"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 06 September 2023.

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.**” (original emphasis)

4. On 5 September 2023, a Form TM9C¹ was filed. A cooling off period was granted until 8 April 2024 by way of an official letter of 5 October in the following terms:

“I refer to the TM9c dated 05 September 2023 indicating that the parties wish to enter into a cooling off period.

In accordance with Rule 18(4) of the Trade Marks Rules 2008, this period will expire on **08 April 2024**.

The Registrar, may on request, extend the cooling off period for a further nine months where such request is filed on TM9e and with the agreement of both parties. Please note that the TM9e should be received on or before **08 April 2024**.

If no such request is made, the TM8 and counter-statement should be filed on or before **08 April 2024** or the application shall, unless the Registrar otherwise directs, be treated as abandoned in whole or part, in accordance with Rule 18(2) of the Trade Marks Rules 2008.

¹ Request for a cooling off period.

If the opponent wishes at any time to terminate the cooling off period they should submit a TM9t. The applicant can terminate the cooling off period at any time by filing the TM8 and counterstatement.” (original emphasis)

5. On 11 April 2024, a Form TM8 was filed by the Applicant.

6. On 16 April 2024, the Registry wrote to the parties in the following terms:

“The official letter dated 07 September 2023 invited the applicant to file a TM8 and counterstatement on or before 08 April 2024.

As the TM8 and counterstatement have been filed outside of the time period set, on 11 April 2024, 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, 30 April 2024**. 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.” (original emphasis)

7. On 14 May 2024, the Applicant filed the Witness Statement, bearing the aforementioned date, of Mr Kevin Hanson, solicitor and director of the Applicant’s legal representative. Mr Hanson stated the following:

“The deadline to file the TM8 and counterstatement was 8 April 2024. These were filed outside of the prescribed period due to an error in our Case Management System in accurately recording the deadline following conclusion of the cooling off period.

The TM8 and counterstatement were correctly filed on 11 April, only 3 days after the original deadline.

As the attorney of record, I was only made aware of this filing error just before the deadline for filing the witness statement, which I intended to meet but was unable to do so due to dealing with personal issues.

I therefore request that the late filed TM8 and counterstatement be accepted into the proceedings and request a hearing for this purpose.”

8. On 20 May 2024, the Registry wrote to the parties in the following terms:

“As the Form TM8 and counterstatement for the above matter had been filed outside of the prescribed period, the letter from the Registry dated 16 April 2024 gave the preliminary view that the application was deemed abandoned.

Should you disagree with the preliminary view given, a deadline of 30 April 2024 was given for you to file a Witness Statement setting out the reasons why the Form TM8 and counterstatement were filed outside of the prescribed period.

I acknowledge receipt of your correspondence dated 14 May 2024 which contained a Witness Statement of Kevin Hanson providing the reasons why the Form TM8 was filed outside of the prescribed period.

After careful consideration of the Witness Statement of Kevin Hanson you have provided it is the Registry’s preliminary view to refuse to allow the late-filed Form TM8 and counterstatement into the proceedings.

If either party disagrees with the preliminary view they should request a hearing within 14 days from the date of this letter, i.e. on, or before, **3 June 2024**.

If no response is received within the time allowed, the preliminary view will automatically be confirmed and the application will be abandoned.” (original emphasis)

9. On 31 May 2024, the director of the Applicant company, Mr Dev Mighton, telephoned the Registry to ask what he could do about the 3 June deadline and explained that he had not heard from the Applicant’s legal representative.

10. On 3 June 2024, Mr Mighton emailed the Registry in the following terms:

“Please request a procedural hearing because we have not received a response from our representation in due time and we disagree with the preliminary view.

Our representation had failed to meet the deadline for our TM8 filing by just under a month late.

We also do not hold the details of the opposition “DR ORGANIC” as we have not been able to make contact with our representation so please forward this email to them.”

11. On 5 June 2024, the Registry emailed the Applicant in the following terms:

“Please note that our records show that you are currently represented by Panoramix Limited. Therefore, we are unable to process this hearing request unless it is received from your representatives.

However, if you are no longer represented, please can you notify the registry to allow us to update our records and process your request.

Please can you respond **on or before 2 June 2024**, to allow us to process your hearing request.

Please note a copy of this email and your hearing request is being sent to the Opponent.” (original emphasis).

12. A copy of the Applicant’s email, together with the Registry’s response, was subsequently forwarded to the Applicant’s legal representative on the aforementioned date.

13. On 19 June 2024, the Registry wrote to the Applicant in the following terms:

“I refer to the above proceedings and to the email sent to you on 05 June 2024 (a copy of which is enclosed), in which you were requested to provide a response on or before 12 June 2024.

The Registry has not received any further communication from you regarding this matter. The Registry’s records still show that you are currently being represented by Panoramix Limited, as such we are unable to process your hearing request unless it is received from your representatives.

However, if Panoramix Limited are no longer representing you please can you notify the registry to allow us to update our records and process your hearing request. This can be done by sending email confirmation to tribunalsection@ipo.gov.uk.

A copy of this letter is being sent to you via The Royal Mail and via email to: **dmorganic1224@gmail.com**. The Registry has also sent correspondence to Panoramix Limited asking them to clarify if they are to remain as your representatives in this matter. In the circumstances a further period of 14 days **that is on or before 3 July 2024**, is allowed for you to respond.

If you or Panoramix Limited do not respond within the time allowed the Registry

will proceed to deem your application as abandoned in accordance with Rule 18(2) of the Trade Marks Rules 2008.” (original emphasis).

14. Panoramix Limited replied on the same day, 19 June 2024, requesting a hearing. On 20 June 2024, the Registry wrote to the parties to confirm that a hearing had been scheduled for Friday 5 July 2024 at 10.30am. This was subsequently re-scheduled to 9 July 2024 at 10:30am, which was also confirmed to the parties on 20 June 2024.

THE HEARING

15. A joint hearing took place before me, by telephone conference, on 9 July 2024. Mr Kevin Hanson, of Panoramix Limited, attended on behalf of the Applicant. Mr Liam Peters, of Wynne-Jones IP Limited, attended on behalf of the Opponent. Mr Dev Mighton, Director of the Applicant company, was present to observe. Both parties filed skeleton arguments in advance of the hearing.

16. As a preliminary matter, Mr Mighton confirmed that Mr Hanson was engaged as the Applicant’s legal representative.

17. Given that both parties were present at the hearing, I do not propose to set out their submissions in great detail. The essence of Mr Hanson’s submission was that the circumstances preventing timely filing of the Form TM8 were two-fold. Firstly, the Applicant had engaged its legal representative via an intermediary platform called ‘Law Briefs Limited’ for which Panoramix was a consultant. Mr Hanson explained that Law Briefs Limited suffered financial difficulties from circa February 2024 which culminated in the cessation of its trading activities. As a consequence, correspondence sent by the Applicant (and indeed many other clients) via the intermediary failed to reach Panoramix. Furthermore, the intermediary’s online platform for managing deadlines was also affected. As a result, Panoramix had been dealing with a massive influx of work. Mr Hanson submitted that, to compound matters, Panoramix’s own in-house docketing system had failed to flag up the impending TM8 deadline in the instant case.

18. Mr Hanson submitted that, secondly, he had experienced personal difficulties, due to the longstanding and serious illness of a close relative to whom he had ongoing caring obligations, which had also impacted his ability to observe the TM8 deadline. Mr Hanson explained that he was the only qualified attorney working with Panoramix and, therefore, the only person able to deal with the Applicant's case.
19. I now address Mr Peters' submissions in reply. The main point that Mr Peters made was that, as stated by Mr Hanson in his Witness Statement, he was aware of the impending deadline a few days in advance and, in spite of that, the Form TM8 was not filed in time. Mr Peters argued that the failure to observe the 8 April 2024 deadline was the third time that the Applicant had missed a deadline; the others being for the filing of the Witness Statement and the filing of the Applicant's skeleton argument. Mr Peters argued that this demonstrated a pattern of 'disregarding' deadlines.
20. I will refer further to the parties' submissions, where appropriate, under the relevant *Music Choice*² factors below at [25] – [33].

DECISION

21. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by rule 18 of the Trade Marks Rules 2008 ('the Rules'). The relevant parts read as follows:

"18. – (1) The applicant shall, within the relevant period, file a Form TM8, which shall include a counter-statement.

(2) Where the applicant fails to file a Form 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.

² *Music Choice Ltd's Trade Mark* [2005] RPC 18.

(3) Unless either paragraph (4), (5) or (6) applies, the relevant period shall begin on the notification date and end two months after that date.”

22. The combined effect of rules 77(1), 77(5) and Schedule 1 of the Rules means that the time limit in Rule 18, which sets out the period within which the defence must be filed, is non-extendable other than in the circumstances identified in Rule 77(5), which states:

“A time limit listed in Schedule 1 (whether it has already expired or not) may be extended under paragraph (1) if, and only if –

(a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the registrar, the Office or the International Bureau; and

(b) it appears to the registrar that the irregularity should be rectified.”

23. There has been no suggestion of any irregularity on the part of the Tribunal. Consequently, the only basis upon which the Applicant may be allowed to defend the opposition proceedings is if I exercise in their favour the discretion afforded to me by the use of the words ‘unless the registrar otherwise directs’ in Rule 18(2).

24. In making my assessment as to whether to exercise my discretion to admit the Applicant’s defence in the instant case, I will take into account the decisions of the Appointed Person in *Kickz AG v Wicked Vision Limited* (BL O-035-11) and *Mark James Holland v Mercury Wealth Management Limited* (BL O-050-12) i.e. I must be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the Applicant’s favour.

25. In *Music Choice Ltd’s Trade Mark* [2005] RPC 18, the Court indicated that a consideration of the following factors (underlined below) is likely to be of assistance

in reaching a conclusion as to whether or not the discretion should be exercised in favour of a party in default. That is the approach that I will adopt.

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

26. As noted above, the stipulated deadline for filing the Form TM8 was 8 April 2024. The Form TM8 was filed on 11 April 2024. The deadline was therefore missed by 3 days.

27. The explanation provided by the Applicant is that the late-filing of the Form TM8 was, in essence, the result of: a combination of administrative disruption due to the collapse of the intermediary through which the Applicant communicated with its legal representative; administrative oversight related to the legal representative's internal calendar; and compounded by personal difficulties suffered by the only member of the legal representative firm being competent/authorised to attend to the Applicant's case.

28. I note Mr Hanson's submission that the failure to observe the prescribed deadline was not in any way the fault of the Applicant itself but was due to circumstances affecting its legal representative.

The nature of the Opponent's allegations in its Statement of Grounds;

29. The opposition is based upon sections 5(2)(b) and 5(3) of the Act, the earlier right being subject to the proof of use provisions, proof of use having been requested by the Applicant. Should the proceedings continue, the Opponent will be expected to adduce evidence to i) support its allegations pursuant to section 5(3) and ii) to demonstrate genuine use of its earlier registration.

The consequences of treating the Applicant as defending or not defending the opposition;

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

31. If, however, the Applicant is not allowed to defend the opposition, the application will be deemed abandoned in respect of all of the goods applied for and the Applicant will lose its filing date of 8 February 2023. It will remain open to the Applicant to re-file its application, which may, in turn, be opposed again by the Opponent (or any other party).

Any prejudice caused to the Opponent by the delay

32. Mr Peters submitted that the Opponent had suffered prejudice by reason of the resulting delay caused by the three occasions on which the Applicant failed to observe deadlines set by the Registry. He underlined the fact that costs awards are contributory rather than compensatory and questioned whether the Opponent could be confident about recovering any costs given the aforementioned missed deadlines.

33. Mr Hanson replied that the missed deadlines had no bearing on the ability of the Applicant to pay any costs award against it and that, should such an award eventuate, the sum would be covered by the legal representative anyway. Mr Hanson stated that he could readily provide an undertaking in costs for his firm, should it be required.

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

34. I was not made aware of any other relevant considerations.

Conclusions

35. In reaching my decision, as noted above, I recognise that if the discretion is not exercised in the Applicant's favour, the opposition will succeed in full, and the

Applicant will lose its filing date. I further recognise that it may be that the Applicant will simply re-file its application and that this may, once again, be opposed by the Opponent, resulting in opposition proceedings arising at some point in the future. However, the loss of priority and possibility of further proceedings on much the same basis are often the consequence of a failure to comply with the non-extendable deadline to file a Form TM8.

36. I bear in mind Mr Hanson's clear submission that the Applicant's legal representative accepts full responsibility for the failure to file the Form TM8 in a timely fashion. I also appreciate that the Form TM8 was filed just three days after the prescribed deadline, a short time period which, in my view, is unlikely to be particularly prejudicial to the Opponent. The continuation of the instant proceedings would not, in my view, be any more burdensome for the Opponent than it would otherwise have been had the Form TM8 been filed on time, just three days earlier. It is my view that, in the instant case, taking all relevant circumstances into account, it would not be appropriate to ascribe the omission made by the Applicant's legal representative to the Applicant itself, effectively 'punishing' the Applicant for circumstances beyond its control.

37. Having considered the Applicant's submissions and taken account of the factors as set out by the case law in *Kix*, *Mercury* and *Music Choice*, I find that compelling reasons and extenuating circumstances were provided sufficient to justify the use of the Registry's discretion as provided by Rule 18(2).

Outcome

38. The consequence of the above finding is that the Applicant's late-filed Form TM8 and counterstatement will be examined. Providing that no defects are identified, they will then be formally served upon the Opponent and a timetable will be set for the filing of evidence.

Costs

39. Costs will be considered at the final determination of the opposition proceedings.

Dated this 18th day of July 2024

N. R. MORRIS
For the Registrar