

O/0759/24

TRADE MARKS ACT 1994

IN THE MATTER OF
REGISTRATION NO. WO0000001777116
BY C98 COMPANY LIMITED
TO REGISTER:



AS A TRADE MARK
IN CLASSES 9 AND 42
AND
IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 447972
BY RAMP BUSINESS CORPORATION

BACKGROUND AND PLEADINGS

1. On 19 October 2023, C98 Company Limited (“the IR Holder”) applied to have its mark on the cover page of this decision registered in the UK. The IR holder applied to register the mark for the goods and services in classes 9 and 42 which can be seen in the Annex to this decision.

2. The IR holder’s mark was published for opposition purposes on 8 March 2024. On 8 May 2024, Lane IP Limited¹ filed a Form TM7a (notice of threatened opposition) on behalf of Ramp Business Corporation (“the opponent”), as a result, the deadline for the filing of the Form TM7 was extended to 10 June 2024.

3. On 11 June 2024, the Registry received an email from the opponent with the Form TM7 attached. On 27 June 2024, the Registry contacted the parties to state that the preliminary view from the Registry was that the Form TM7 was not acceptable. In the official letter, sent to both parties, the Registry stated:

“ I refer to the TM7, notice of opposition, filed against the above application on 11 June 2024.

In line with Rules 17(3) and 17(4) of the Trade Mark Rules 2008, the period allowed to file an opposition is two months beginning immediately after the date which the application is published. This period can be extended to three months by the filing of a Form TM7a.

The application was published on 8 March 2024 and a Form TM7A was received on 8 May 2024, extending the period for filing the notice of opposition to 10 June 2024.

It is the Registry’s preliminary view that as the notice of opposition was filed outside of the statutory deadline it cannot be permitted into the proceedings.

If either party disagrees with the preliminary view, they should submit any comments in writing within 7 days, that is by 4 July 2024. If no response is

¹ Now known as Abion

received by this date, the preliminary view will automatically be confirmed www.gov.uk/ipo meaning the opposition will be deemed not filed and a refund of the opposition fee will be arranged.”

4. On 4 July 2024, an email was received from the opponent’s representative with a witness statement and evidence attached. The witness statement stated:

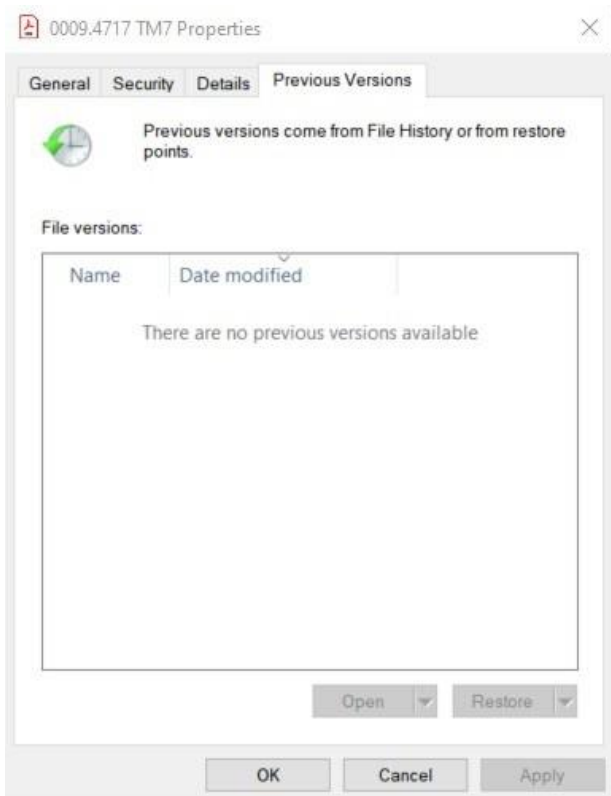
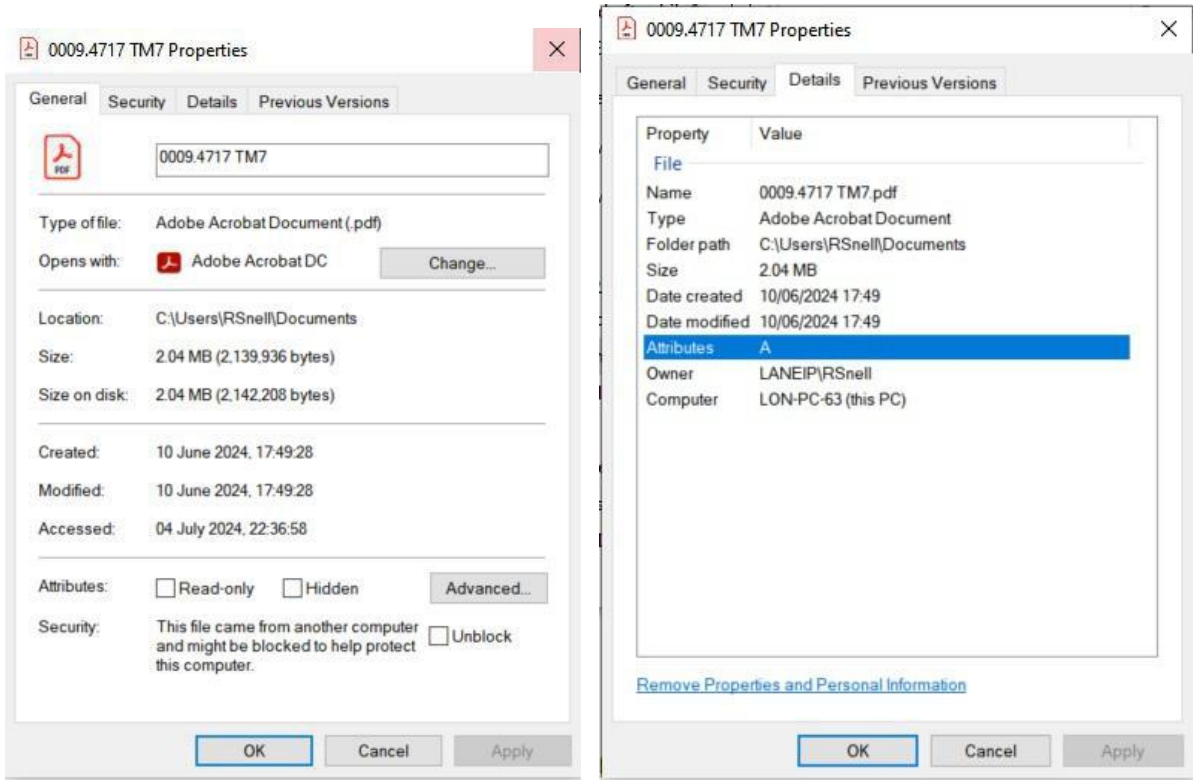
WITNESS STATEMENT OF ROBERT SNELL

I, Robert Snell, an employee of Abion UK Limited (formerly Lane IP Limited) (‘Abion’), The Forum St Paul’s, 33 Gutter Lane, London, EC2V 8AS, hereby say as follows:

1. I am a Chartered Trade Mark Attorney and Senior Associate and have been employed by Abion since 2016. I am authorised and competent to make this Witness Statement on behalf of Abion and I have access to the information relating to the subject matter of this Witness Statement. Unless indicated to the contrary, the content of this Witness Statement is based on my own knowledge and experience and/or information that has been provided to me by other employees of Abion and/or is publicly available.
2. On 10 June 2024, I prepared the necessary documentation for the filing of a Notice of Opposition (TM7) against the above-referenced application.
3. As demonstrated by the printouts contained within **Exhibit RS1**, I compiled these documents into a single PDF at 17.49pm on 10 June 2024 and there are no previous versions of this PDF.
4. I sent this PDF to the UKIPO via email very shortly thereafter but for reasons unknown, this email was not delivered to the UKIPO until the next morning, which was the point that I reopened Outlook.
5. I have consulted with the Abion IT department and they have confirmed to me that neither server-side tools available in Office 365, nor client-side tools such as those in Outlook, provide a definitive way to demonstrate that the email was stuck in my outbox.
6. Again, according to the Abion IT department, while Outlook can enable detailed logging that may provide some information on email delivery attempts and errors, these logs are not enabled by default (and this is the case in respect of Abion’s Outlook set-up). Even when enabled, they typically indicate errors or failed attempts to send rather than explicitly showing that an email was stuck in the outbox.
7. I do, however, point to the printouts contained within Exhibit RS1, as well as the 10 June date which is listed on the TM7 form (of which there are no previous versions), in support of the statement that the email was sent to the UKIPO on 10 June and that the most likely explanation is that the email was stuck in my outbox until the next morning (11 June), at which point it was delivered to the UKIPO..

I believe that the facts in this Witness Statement are true.

5. In the evidence attached to the witness statement, Mr Snell filed screenshots of properties of a PDF file he created, which can be seen below:



6. On 16 July 2024, a joint hearing was appointed to discuss the filing on the late Form TM7. The hearing was listed for 31 July 2024.

THE JOINT HEARING

Representation

7. The joint hearing took place before me, by telephone. Only the opponent was in attendance represented by Mr Robert Snell. As the proceedings were only in the Form TM7 stage, the Registry only had the physical address for the IR holder, who is based in Vietnam. It is noted that according to the Royal Mail website it takes approximately a week for physical correspondence to reach Vietnam. Two weeks and one day was the time period that passed between the correspondence being sent concerning a hearing date and the hearing itself. Therefore, I am content that the IR holder had sufficient time and knowledge that a joint hearing was to take place to enable them to attend if they chose to do so. No response was received by the IR holder and they did not attend the hearing.

Hearing discussion

8. At the hearing, Mr Snell submitted that the Form TM7 was late because the email (which was sent on 10 June) was caught in his inbox and did not send until he logged on the next day at roughly 8 am. He submitted that there was a clear intention to submit the Form TM7 on time and the view was that the opposition should be allowed.

9. Drawing on the evidence from the PDF properties provided by the opponent, I noted that the opponent's PDF was created on 10 June at 17:59 and that the IPO search was conducted at 17:29. I referenced the submission that the PDF was sent shortly after, as mentioned by Mr Snell in his witness statement, and asked Mr Snell for an estimation of a quantifiable time of when he sent through the Form TM7 on 10 June 24. Mr Snell responded that it would have been roughly 6pm that the email was sent. He submitted that he would have logged off shortly after that. I asked whether, when logging off, Mr Snell had received a notification that the email had not been sent. He stated that he did not receive one.

10. I drew on the opponent's witness statement and enquired whether there was an IT issue within his firm that affected others – to which Mr Snell submitted that he was the only individual affected. When asked whether any other emails sent that evening were affected, Mr Snell responded that he had not sent any emails following that and that he had no indication that others were affected. I enquired as to how the IT issue experienced by Mr Snell was resolved the following day. Mr Snell stated that when he logged on the email was sent and the outlook system seemed to work and no intervention was required from his IT team to resolve the matter. Mr Snell elaborated on the IT system at his firm at the hearing, stating that the IT system within his firm did not generate detailed logging information about delivery attempts and errors. Therefore, he was unable to provide any evidence about what happened to the email. I informed Mr Snell, that if not already done so, it would be beneficial for those capabilities on the outlook system to be enabled to assist in any future instances where this situation may arise.

11. At the end of the hearing, I reserved my decision to give me an opportunity to reflect on the additional information provided by Mr Snell which was not disclosed in his witness statement and evidence.

DECISION

12. Opposition to the registration of an application is provided for by Section 38 of the Act. Section 38(2) states:

“Any person may, within the prescribed time from the date of the publication of the application, give notice to the registrar of opposition to the registration. The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.”

13. Rule 17(2) –(4) specifies that:

“ (2) Unless paragraph (3) applies, the time prescribed for the purposes of section 38(2) shall be the period of two months beginning immediately after the date on which the application was published.

(3) This paragraph applies where a request for an extension of time for the filing of Form TM7 has been made on Form TM7A, before the expiry of the period referred to in paragraph (2) and where this paragraph applies, the time prescribed for the purposes of section 38(2) in relation to any person having filed a Form TM7A (or, in the case of a company, any subsidiary or holding company of that company or any other subsidiary of that holding company) shall be the period of three months beginning immediately after the date on which the application was published.

(4) Where a person makes a request for an extension of time under paragraph (3), Form TM7A shall be filed electronically using the filing system provided on the Office website or by such other means as the registrar may permit.”²

14. The combined effect of rules 77(1), 77(5) and Schedule 1 of the Rules mean that the time limit in rule 17(3), which sets the period in which the defence must be filed, is non-extensible 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

² Rule 3 also refers: 3.—(1) Any forms required by the registrar to be used for the purpose of registration of a trade mark or any other proceedings before the registrar under the Act pursuant to section 66 and any directions with respect to their use shall be published on the Office website and any amendment or modification of a form or of the directions with respect to its use shall also be published on the Office website.

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

15. I note that there has been no default, omission or error by the Registry and no suggestion that there has been any irregularity on the part of the Registry. At the hearing, Mr Snell submitted that the Form TM7 was late because the email was caught in his outbox. He submitted that there was a clear intention to submit the Form TM7 on time and the view was that the opposition should be allowed. This, to my mind, undermines Rule 17(3). The fact of the matter remains that the Registrar has, in accepting the Form TM7a, allowed the opponent 3 months from the date of application to file its Form TM7 and in failing to send the form through in time opponent has not successfully filed its Form TM7.

16. The tenability of the human error argument (albeit on the application of Rule 41(6) in relation to an invalidity application) was considered by Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *TESCON Trade Mark* [2020] FSR 33; BL O/240/20,³ as follows:

“32. I readily accept that human error is not necessarily inconsistent with the existence of extenuating circumstances or compelling reasons for permitting invalidity proceedings to be defended in the exercise of the discretion conferred by rule 41(6). I would, for example, regard it as appropriate for the discretion to be exercised in favour of permitting a claim for invalidity to be defended in circumstances where it was clearly established that the failure to comply with a filing deadline of (say) 12 February 2020 was the result of an unnoticed keystroke error which caused the due date to be incorrectly entered in an otherwise reliable record keeping system as (say) 21 February 2020. It is nonetheless clear that the test to be applied cannot be taken to permit or require all human errors to be treated as excusable for the purposes of rule 41(6). There must, in other words, be a fact specific evaluation for the purpose of determining whether the particular error in question should or should not be treated as excusable in the circumstances of the case at hand.

33. This is the point at which the Proprietor's request for relief under rule 41(6) ran into difficulty. The general tenor of the representations made on its behalf was that its attorneys had taken reasonable and proper steps to ensure that the required Form TM8 and Counterstatement were filed before expiry of the specified deadline, but were inadvertently deflected from doing so until after the deadline had expired. However, the Registrar was presented with assertions rather than evidence and materials of sufficient clarity and precision to substantiate that or any proposition to the like effect. In the end, as emphasised in the Respondent's Notice, the Hearing Officer was left with no satisfactory explanation for the default which had occurred."

17. Therefore, for similar reasons, I do not accept that the opponent's failure to comply with the procedure for filing the Form TM7 was due to an extenuating human error and this argument has any foundation given the circumstances surrounding the failure to satisfy the procedural requirement. There was no evidence to corroborate the claim that the opponent's IT system had failed, nor that it had failed at the material time, or that failure continued beyond the deadline.

18. The Form TM7 was due 10 June 2024, it was received by the Tribunal on 11 June 2024. Therefore, the deadline was missed by a day. The opponent's explanations as to why the deadline was missed is that IT issues resulted in the email being caught in Mr Snell's outbox. The Opponent relied upon grounds under sections 5(2)(b) of the Act. Whilst it is not for the present decision to determine the merits of the case, for the purpose of the criteria under consideration it is sufficient to note that there is an arguable case to be determined which requires a careful multifactorial assessment.

19. If the opponent is allowed to file the opposition, the proceedings will continue with the IR holder being given the opportunity to file a TM8. However, if the opponent is not allowed to file the opposition, the proceedings will not continue. The application will proceed to registration unchallenged. Whilst the IR holder did not attend the hearing, there is an arguable case that there may be a small element of prejudice which extends to the unnecessary delay in the progress of the case. However, I do

not consider that additional costs have been incurred by the IR holder. Beyond this opposition against the IR holder's mark, I am not aware of any related proceedings between the parties.

CONCLUSION

20. In reaching my decision, I recognise that if the discretion is not exercised in the opponent's favour, the opposition will be withdrawn, and the application will proceed to registration unchallenged. Further, I recognise that once the mark has been registered the mark maybe subject to cancellation proceedings by the opponent, resulting in further proceedings arising at some point in the future. However, as 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 Form TM7, these are not factors that are particularly compelling. At the hearing, Mr Snell expressed concern that failing to admit the Form TM7 would result in invalidation proceedings and the opponent would lose the benefit of a cooling off period, as cooling off periods only take place in opposition cases – however, I note that a stay can be filed for during invalidation proceedings to allow for negotiations. Further, whilst repeated proceedings, which I accept may be likely in this case, are, in my view, regrettable on the account of wasted cost and efforts of the parties, not to mention the further strain on the Registry's resources, I must consider the specific circumstances at hand.

21. It is worth noting, when asked when others were affected, Mr Snell said he was the only individual impacted. In response to whether there was a wider IT issue, Mr Snell stated that there was not. When I enquired as to how the matter was resolved the next day, Mr Snell stated that no interference or support was needed and the issue was just resolved. Whilst I note that Mr Snell has provided evidence of the generation of a PDF an IPO search, I am mindful that just because the PDF was created at 17:49 (and no other versions of the document were created) and the IPO Search conducted at 17:29 does not mean that is when the email containing the Form TM7 was sent. Evidence demonstrating the email was sent but caught in the outbox would have been beneficial in this instance but given the failure of the IT system to log such information, I have no clear evidence to indicate when the email was actually sent. Further, there

was no evidence to corroborate the claim that the opponent's IT system had failed, nor that it had failed at the material time, or that failure continued beyond the deadline.

22. In considering whether any unfairness or prejudice is caused to the opponent, I note that the opportunity has been afforded, by way of this hearing, to the opponent (who at all material times has been professionally represented) to rectify the situation by providing cogent arguments for the Registry to validate its late filing on its Form TM7. I considered that if there is any inconsistency in complying with the overriding objective, it is more likely to be found on the part of the opponent, who failed to file the Form TM7 on time.

23. I must also take into consideration the fairness of subjecting the IR holder to opposition proceedings, and more importantly, based upon an action filed outside of the strict three-month opposition window (taking into account the filing of the Form TM7a) when the applicant could have reasonably expected oppositions or notices of threatened opposition to have been filed.

24. In reaching a decision, I have taken all the above matters into account, including the overriding objective (which is to ensure fairness to both parties) to deal with this case expeditiously and justly. I have found no single reason or combination of reasons sufficient to enable me to admit the Form TM7 into these proceedings.

25. In all the circumstances I find that the opponent has failed to show any compelling reason to justify its deviation from the rules and consider that the strict adherence to the procedural requirement outweighs the opponent's interest in having the matter determined via opposition proceedings.

OUTCOME

26. After careful consideration of the parties' oral and written submissions and in light of the various case law cited above, my decision is not to exercise the discretion in favour of the opponent. Subject to appeal, I uphold the Registry's preliminary view that the Form TM7 is not to be admitted as a formal opposition against the application. Therefore, the application will proceed to registration.

COSTS

27. As my decision terminates the proceedings, I must consider the matter of costs. The IR Holder has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. However, as the IR holder did not attend the hearing and the opposition was not filed, there are no costs to be awarded.

Dated this 12th day of August 2024

A Klass

For the Registrar

Annex

Class 9: Downloadable computer software development tools; downloadable computer software for developing, creating, testing, and/or extending the functionality of distributed applications; downloadable computer software for developing, creating, testing, and/or extending the functionality of distributed applications on a blockchain network; downloadable computer software for use as an application programming interface (API) for extending the functionality of a blockchain-based distributed computing platform; downloadable computer software in the nature of electronic data files featuring software development tools for enabling users to electronically create, exchange, store, send, receive, and transmit digital information and digital asset on the blockchain; downloadable e-wallets.

Class 42: Providing on-line non-downloadable computer software for developing, creating, testing, and/or extending the functionality of distributed applications; providing on-line non-downloadable computer software for developing, building, and operating consumer blockchain applications and for enabling users to electronically access a blockchain-based distributed computing platform; computer services, namely, providing on-line non-downloadable computer software platforms for accessing, developing, building, and operating distributed computing platforms and applications; internet security consultancy; data security consultancy; computer software design; updating of computer software; maintenance of computer software; installation of computer software; monitoring of computer systems by remote access; software as a service [SaaS]; platform as a service [PaaS].