

**o-0785-24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF A JOINT HEARING HELD IN RELATION TO  
INTERNATIONAL DESIGNATION NO. WO0000001718893**

**TO REGISTER THE TRADE MARK:**

**Sidekick Mixers**

**IN THE NAME OF SIDEKICK MIXERS PTY LTD**

**AND**

**OPPOSITION THERETO UNDER NO. 442608 BY  
POWER BRANDS INTL LTD**

## BACKGROUND

1. On 17 February 2023, Sidekick Mixers Pty Ltd (“the IR holder”) sought to protect the above registration in the United Kingdom in respect of the following goods in class 32:

*Aerated mineral waters; alcohol-free beverages; alcohol-free drinks; preparations for making carbonated water; ginger beer; aerated beverages (non-alcoholic); aerated drinks (non-alcoholic); carbonated non-alcoholic drinks; non-alcoholic carbonated drinks; ginger beer (non-alcoholic); non-alcoholic beverages; tonic water (non-medicated beverages).*

The holder’s request was published for opposition purposes on 2 June 2023.

2. On 19 July 2023, Lawrie IP Limited filed a Form TM7A (Notice of threatened opposition) on behalf of Power Brands Intl Ltd, the effect of which was to extend the two month opposition period prescribed in Rule 17(2) of The Trade Marks Rules 2008 (“the Rules”) by a further month. The IR holder was advised that a Form TM7A had been filed in an official letter of the same date.

3. On 18 August 2023, the application was opposed in full by Power Brands Intl Ltd (“the opponent”) under sections 5(1)/5(2)(a)/5(2)(b)<sup>1</sup> and 5(3) of the Trade Marks Act 1994 (“the Act”) by virtue of filing Form TM7 (“Notice of opposition”). The opponent relies upon two trade marks, one a UK trade mark and the other a comparable mark<sup>2</sup>, both for the mark “SIDEKICK”.

4. On 29 August 2023, the Tribunal served the Form TM7 upon the IR holder. The official serving letter contained the following:

“If you wish to continue with your international registration, you need to file a notice of defence and counterstatement by completing Form TM8 - please note the important deadline below.

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<sup>1</sup> The opponent selected all of the above in its Notice of opposition

<sup>2</sup> On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs.

...

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.

...

**IMPORTANT DEADLINE: A completed Form TM8 (or Form TM9c) MUST be received on or before 30 October 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 international registration will be treated as abandoned.**”

5. On 30 October 2023, a Form TM9c was filed by Bailey Walsh & Co LLP on behalf of the IR holder. As a result, the parties entered into a cooling off period which was set to expire on 29 May 2024. The parties were notified in an official letter dated 2 November 2023 which included the following wording:

“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 29 May 2024.

If no such request is made, the TM8 and counter-statement should be filed on or before 29 May 2024 or the international registration 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.”

6. On 5 June 2024, Bailey Walsh & Co LLP filed a Form TM8 alongside the witness statement of Mr Philip Stephenson, partner and registered trade mark attorney. Mr Stephenson’s statement was dated 5 June 2024, with the relevant parts reading as follows:

“1. Following a request to enter into the cooling off period filed on 30 October 2023, pursuant to Rule 18(4) of the Trade Mark Rules 2008 the deadline by which to extend the cooling off period or file the TM8 and counterstatement was set as 29 May 2024.

2. This date of the 29 May 2024 was entered into our case management system for action to be taken before this deadline and without prejudice correspondence was entered into with the Opponent’s representatives.

3. Following a without prejudice telephone call with the opponent’s representatives on the 7 May 2024, I entered a date of 7 June 2024 into our file management system to follow up with the Opponent’s representatives in one month following the call, however I mistakenly replaced the 29 May 2024 with the date of the 7 June 2024.

4. On reviewing my upcoming deadlines, I have today discovered my error and filed the required TM8 and counterstatement.”

7. On 2 July 2024, the Tribunal acknowledged receipt of the Form TM8 and witness statement and wrote to the IR holder as follows (copied to the opponent):

“I can confirm that the contents of the witness statement have been examined and it is the preliminary view of the Registry that there are sufficient mitigating circumstances outlined to allow the registry to exercise its discretion under Rule 18(2) and allow the late TM8 into these proceedings.

If either party disagrees with the above preliminary view a hearing must be requested on or before 16 July 2024. ...”

8. On 12 July 2024 the opponent requested a hearing.

9. A hearing was appointed for 6 August 2024 and the parties were notified by way of official letters dated 19 July 2024. Both parties filed skeleton arguments prior to the hearing.

## **The joint hearing**

### **Representation**

10. A joint hearing took place before me, via telephone, on 6 August 2024. At the hearing, Ms Sarah Dacre of Lawrie IP represented the opponent and Mr Philip Stephenson of Bailey Walsh & Co LLP represented the IR holder.

### **Hearing discussion**

11. At the hearing, Ms Dacre began by submitting that, particularly in light of the cooling off period enjoyed by the parties, the IR holder had been given considerable time to review the pleadings and prepare a counterstatement accordingly. Ms Dacre noted that the TM8 deadline is statutory and, whilst she acknowledged the discretion awarded to the registry by Rule 18 of the Trade Mark Rules (referred to above), she nonetheless maintained that such discretion is narrow and deemed the “human error” which occurred in the present proceedings insufficient to justify its exercise. To that end, Ms Dacre submitted that neither “extenuating circumstances” nor “compelling reasons” were present.

12. At the hearing, and in the skeleton arguments provided in advance of the hearing, Ms Dacre directed me to several decisions issued by the IPO<sup>3</sup> concerning late-filed

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<sup>3</sup> *Trinity Frozen Foods v Cross Spades Limited* (BL O/0368/24); *Tianjin Taidu Technology Development Co., Ltd. v Legend Brands, Inc* (BL O/0705/24); *Sandra Carol Horswill & Lucy Jane Horswill v Acti Group LLC* (BL O/0054/24); *Inform Nutrition Ireland Ltd. v Hypred* (BL O/888/21); *Guy Lochner v UK Pacific Trading Limited* (BL O/758/22); *Michael Pablo Sutton & Mark Kevin Pinnock v Lexavi Ltd* (BL O/0807/23); *Mohammad Shafi Nadem v RPP IP Ltd* (BL O/0230/24)

defences in which, she submits, administrative and docketing errors have been held insufficient to justify the admission of a defence filed outside of the prescribed period.

13. Commenting on Mr Stephenson's witness statement, Ms Dacre noted that it does not explain why it took so long to identify the error and that it exposes a lack of internal safeguarding measures and lack of vigilance on the other side's part. Ms Dacre suggested that a professional representative should have been fully aware of the appropriate deadline (and, it follows, the consequences of failing to meet it).

14. As for prejudice, Ms Dacre submitted that her client had been affected both by the delay caused by the late filed defence, the additional preparation for a hearing and the costs incurred as a result. She asked that the defence be rejected and costs awarded in the opponent's favour.

15. I then turned to Mr Stephenson for the submissions of the IR holder. For his part, Mr Stephenson acknowledged that the discretion available under Rule 18 was, indeed, narrow, and, for the most part, he agreed with the submissions of Ms Dacre with the exception of the recommended rejection of the late-filed defence. Mr Stephenson also cited *Praesidiad NV*<sup>4</sup> to the extent that it states 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) [...]]." Mr Stephenson directed me to a recent IPO decision (BL O/0687/24 "DM ORGANIC") in which a late-filed Form TM8 was admitted into the proceedings, but nonetheless he submitted that each case should be assessed on its own merit.

16. In reply to Ms Dacre's criticism of the representative's file management system, Mr Stephenson submitted that its system had in fact functioned well for many years and the failure to meet the deadline in the current proceedings was simply a 'one-time' error in an otherwise functioning system whereby he mistakenly overwrote an existing deadline. Mr Stephenson explained that the error was made whilst he was working from a laptop with a significantly smaller screen (than he is used to working from). He also advised that measures have since been implemented to reduce the likelihood of the

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<sup>4</sup> BL O/240/20

same mistake (or similar) occurring in the future. Mr Stephenson also noted that the original statutory deadline was successfully met (with the Form TM9c filed within the appropriate period).

17. As for the prejudice referred to by Ms Dacre, Mr Stephenson suggested that this was limited only to preparation for the hearing and drafting of skeleton arguments and acknowledged that any costs incurred by the delay could be dealt with on the closing of the proceedings. He also noted that the holder's defence was filed only seven days after the applicable deadline had expired.

18. Mr Stephenson submitted that his client would prefer to not have to refile its application (but implied that this would be the outcome should the existing application be deemed abandoned) as it would create a multiplicity of proceedings and effectively result in greater costs for all parties. He also submitted that it seemed "harsh" to punish the holder for a mistake made by its representative. Finally, in closing, Mr Stephenson maintained that the error was not indicative of a lack of vigilance or reasonable care but instead a "simple mistake" with "serious consequences".

19. In reply, Ms Dacre accepted Mr Stephenson's comments regarding 'human error' but upheld her position insofar as the other side had failed to present any compelling reasons or extenuating circumstances sufficient to justify the exercise of the registry's discretion, particularly as a professional representative should be expected to adhere to a simple deadline and the official letters make clear how important the deadline for filing a defence is.

## **DECISION**

### **Statutory provisions**

20. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by Rule 18 of 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 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.”

21. 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 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

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

22. There is no suggestion from either side that there has been a default, omission or error on the part of the office. Consequently, the only way the IR holder may be allowed to defend its trade mark application is if I exercise the discretion provided to me by the use of the words “unless the registrar otherwise directs” in Rule 18(2) in its favour.

23. In approaching the exercise of such discretion, I take into account the decisions of the Appointed Person in *Kickz AG v Wicked Vision Limited*<sup>5</sup> (“*Kickz*”) and *Mark James Holland v Mercury Wealth Management Limited*<sup>6</sup> (“*Mercury*”) i.e. I have to be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the applicant’s favour.

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<sup>5</sup> BL O-035-11

<sup>6</sup> BL O-050-12

24. In *Music Choice Ltd's Trade Mark*<sup>7</sup> ("Music Choice") 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 parties' submissions to the extent that I consider it necessary to do so.

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

25. As explained by Mr Stephenson, following a call with the opponent's representative he mistakenly overwrote the deadline for filing a Form TM8 in his file management system (erroneously replacing 29 May 2024 with 7 June 2024). Once Mr Stephenson became aware of this error, he immediately filed a counterstatement and a witness statement explaining why the deadline was missed. This being on 5 June 2024, the Form TM8 and counterstatement were effectively filed seven days beyond the prescribed period.

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

26. As detailed above, the opposition is based upon sections 5(1)/5(2)(a)/5(2)(b) and 5(3) of the Act with the opponent relying upon two "SIDEKICK" trade marks. The opponent alleges that there is a likelihood of confusion between the parties' respective trade marks and that protection of the IR in the UK would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the relied upon marks.

**The consequences of treating the IR holder as defending or not defending the opposition;**

27. Should the defence be admitted into proceedings, the IR holder will be able to defend its application and the case will likely be decided on its merits. If the defence is refused, the opposition automatically succeeds and the application is deemed abandoned. Mr Stephenson suggested that the IR holder intends to re-file its application

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<sup>7</sup> [2005] RPC 18

should this be the outcome. Ms Dacre was not able to confirm whether the opponent would file an opposition in the same terms.

**Any prejudice caused to the opponent by the delay;**

28. Ms Dacre has submitted that the opponent faces prejudice both in terms of the time delay caused by the late filing, the preparation for a joint hearing and an increase in incurred costs. Mr Stephenson, in reply, identified that the delay had been only seven days and acknowledged that this could be remedied, if appropriate, by way of a cost order issued as part of the substantive decision.

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

29. Both sides agreed that there were no related proceedings between the parties.

**Conclusion**

30. When approaching my decision, I keep in mind the factors outlined above, and in particular I am mindful of the consequences the parties face whether the Form TM8 is or isn't admitted. I recognise that, if discretion is not exercised in favour of the IR holder, it will lose the filing date for its mark. On the basis of Mr Stephenson's submissions, it may also be the case that the IR holder simply re-files its application which may result in opposition proceedings being brought on the same terms as the present case. However, as such consequences are often applicable whereby a defence is filed outside of the prescribed period, they are not, in isolation, particularly compelling.

31. It is clear that the failure to meet the deadline for the filing of a defence came about as a result of an inputting error made by Mr Stephenson. I am empathetic to the circumstances at hand and I accept Mr Stephenson's submission insofar as he submits that human error is not *necessarily* inconsistent with finding sufficient justification for exercising the registrar's discretion. I am also satisfied that Mr Stephenson acted quickly upon identifying his error and that any prejudice to the opponent as a result was fairly minimal. That said, Mr Stephenson does not dispute that the statutory deadline of 29

May 2024 was clearly laid out in the official communications from the registry and that he was aware of the relevant date (having originally inputted the correct date into the file management system). His overwriting of this date further to a conversation between the parties is not necessarily indicative of a lack of vigilance but nonetheless Mr Stephenson is acting on behalf of the IR holder in a professional capacity and would have been wholly aware of the implications should the deadline not be met. To cite the example offered in *Praesidiad*, I do not consider the error here to be as simple as “an unnoticed keystroke error which caused the due date to be incorrectly entered.” The existing deadline was manually overwritten and a greater degree of thought, even retrospectively, could have allowed Mr Stephenson to rectify the error within the appropriate period. It was the responsibility of the holder’s representative to properly record the existing deadline and, additionally, to maintain the record appropriately and adhere as required. In these circumstances, whilst the failure to meet the deadline was a result of simple human error to which I am sympathetic, I do not find the reasons at hand to constitute exceptional circumstances such to allow the exercise of the registrar’s discretion which, as the parties have accepted, is narrow. My decision is therefore not to exercise the discretion available under Rule 18(2) in favour of the IR holder. Subject to appeal, the application will be deemed abandoned.

## **Costs**

32. As my decision terminates the proceedings, I must now consider the matter of costs. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 1 of 2023. Applying that TPN as a guide, I award costs to the opponent on the following basis:

Official fee:	£200
Preparing a notice of opposition:	£200
Reviewing the late-filed TM8 and witness statement and preparing for and attending the hearing:	£300

Total:

£700

33. I therefore order Sidekick Mixers Pty Ltd to pay Power Brands Intl Ltd the sum of **£700**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 15<sup>th</sup> day of August 2024**

**Laura Stephens**  
**For the Registrar**