

O/0813/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003937371

IN THE NAME OF SUPREME NUTRA LABS LTD

FOR THE FOLLOWING TRADE MARK:



IN CLASSES 5 AND 35

AND

THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT

IN DEFENCE OF AN OPPOSITION

UNDER NO. 600003157

BY NUVIALAB LIMITED

## BACKGROUND

1. On 22 July 2023, supreme nutra labs ltd ('the Applicant') applied for the trade mark no. 3937371 in the UK. Registration is sought for goods and services in classes 5 and 35. The full specification is annexed to this decision.
2. On 29 November 2023, NuviaLab Limited ('the Opponent') opposed the application by way of filing a notice of opposition and statement of case under the Fast Track procedure ("Form TM7F"). The opposition is based on section 5(2)(a) and (b) 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 UK00918244620,<sup>1</sup> for both grounds:



3. On 5 January 2024, the Registry wrote to the Opponent stating that the Form TM7F filed was inadmissible due to a number of defects; including the fact that evidence of use of the earlier mark, which had been registered for less than 5 years, had been filed.<sup>2</sup> The letter was copied to the Applicant.
4. On 16 January 2024, the Opponent filed an amended Form TM7F which, despite the previously identified defects having been remedied, was deemed inadmissible because the representation of the earlier mark did not match the stylised mark as registered. The official letter of 18 January 2023 informing the Opponent of this defect was copied to the Applicant.
5. On 23 January 2024, an admissible Form TM7F was filed by the Opponent.

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<sup>1</sup> This is a comparable mark pursuant to Article 54 of the Withdrawal Agreement, based on an EUTM which was registered prior to the withdrawal of the UK from the European Union.

<sup>2</sup> Evidence of use is not permitted in fast track proceedings unless the earlier mark has been registered for at least five years.

6. On 29 January 2024, the Registry wrote to the Applicant by email and physical post, using the email and postal addresses provided, in the following terms:

'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 2 April 2024**

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)

7. No Form TM8 was filed by the Applicant on or before 2 April 2024.
8. On 14 May 2024, the Registry wrote to the Applicant, by email and regular post, in the following terms:

'The official letter dated 29 January 2024 invited the applicant to file a TM8 and counterstatement on or before 02 April 2024.

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, **28 May 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)

9. On 17 May 2024, a Form TM8 was filed by the Applicant.

10. On 31 May 2024, the Registry wrote to the Applicant, by email and regular post, in the following terms:

‘I can confirm receipt of the late TM8 filed on 17 May 2024. Please note that as outlined in the official letter dated 14 May 2024 the late TM8 must be accompanied by a signed witness statement outlining the reasons why the TM8 was not filed within the prescribed two-month period.

A period of 7 days, that is on or before **7 June 2024** is granted in which to provide a signed witness statement outlining the full reasons why the TM8 was not filed within the prescribed period.’ (original emphasis)

11. On 5 June 2024, the Applicant wrote to the Registry in the following terms (which have been reproduced verbatim):

‘Dear IPO

I am writing this letter as a witness statement conveying my sincere apologies in the filing the late TM8 for my trademark UK00003937371 Active Keto I was away overseas to Saudi Arabia and upon returning was very sick and unwell for a number of weeks whereas i was unable to work.

Sincerely,  
Shabana Amin'

12. On 2 July 2024, the Registry wrote to the Applicant, by email and regular post, in the following terms:

'I can confirm receipt of the witness statement for the late TM8 dated 5 June 2024.

After careful consideration of the contents of the papers you have provided, it is the preliminary view of the Registrar that the reasons given are not sufficient to exercise his limited discretion and admit a late filed Form TM8 into these proceedings. **Therefore, the Registrar's preliminary view is that this application is to be treated as abandoned.**

If you disagree with the preliminary view you must provide full written reasons and request a hearing on, or before, **16 July 2024**. The request must be accompanied by a signed witness statement. If no response is received within the time allowed, the preliminary view will automatically become final immediately after that date and the application will be confirmed as deemed abandoned.

Before requesting a hearing to challenge a preliminary view, you should bear in mind the following points:

The deadline for filing a counter-statement on Form TM8 is not a flexible time limit (see Trade Mark Rule 77(6) and Schedule 1 to those rules);

The legal constraints on the exercise of discretion by the Registrar in these circumstances; and

That in the event that the hearing officer upholds the preliminary view, there may be costs implications arising from the hearing against the party who requested the hearing.’ (original emphasis)

13. On 14 July 2024, the Applicant wrote to the Registry by email requesting that the Application not be abandoned, attaching a copy of its previously filed ‘witness letter’ of 5 June 2024.
14. On 17 July 2024, the Registry wrote to the Applicant to request confirmation of whether it wished to have a hearing, setting a deadline of 24 July 2024 to respond.
15. On 18 July, the Applicant confirmed that it wished to have a hearing, which was duly arranged for 8 August 2024.
16. On 7 August 2024, it was noted that the Applicant’s letter of 5 July 2024 did not fulfil the requirements for a Witness Statement and the Registry wrote to the Applicant in the following terms:

‘As outlined in the official letter dated 24 July 2024 the above proceedings are set for a hearing tomorrow, as the applicant opposed the preliminary view to reject the late filed TM8.

Upon review of the file, it has been noted that the document filed by the applicant, which was accepted on the 2 July 2024 as a witness statement, does not comply with the criteria of a witness statement. Please note that a witness statement must contain a signed statement of truth.

Guidance of how to complete a witness statement can be found using the below link to the Registry’s website

[Filing evidence about an application or in tribunal proceedings - GOV.UK](https://www.gov.uk/government/guidance/filing-evidence-about-an-application-or-in-tribunal-proceedings)  
([www.gov.uk](https://www.gov.uk))

**Please provide the reasons for the late filing of the TM8, as contained within the document filed on 5 June 2024, within an official witness statement in line with the above guidance before the hearing due to take place tomorrow, 8 August 2024.'** (original emphasis)

## **THE HEARING**

17. On 8 August 2024, I was ready to conduct the joint hearing at the appointed time of 10:30, by telephone conference. Only the Opponent attended. Ms Agnieszka Wagemann-Smolanska, of adv Małgorzata Krzyżowska, appeared for the Opponent. Attempts were made to contact Ms Shabana Amin, representing the Applicant as a litigant-in-person, by telephone and email, but to no avail. I waited until 10:40 before proceeding with the hearing in the Applicant's absence.

18. Ms Wagemann-Smolanska's skeleton argument focused almost entirely on the substantive claim rather than the matter of the late filing of the Form TM8. I explained that the instant hearing was concerned only with the matter of the late-filed Form TM8 and invited her to make an oral submission focusing on that specific matter. The essence of Ms Wagemann-Smolanska's submission was simply that the relevant correspondence from the Registry had been properly served on the Applicant and that the prescribed deadline had been communicated clearly to them. She argued that the scant information provided by way of reasons for the lateness in filing the Form TM8 was insufficient to justify allowing it to be considered.

19. After the hearing, the Registry emailed the Applicant in the following terms:

'Due to the Applicants non-attendance at the 10:30 hearing this morning, and our unsuccessful attempts to contact her by telephone.

The Hearing Officer will decide the matter of whether or not to allow the Late Form TM8 to proceed to be examined, on the papers.'

## DECISION

20. 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.

(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."

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 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."

22. Although, strictly speaking, the Registry's initial oversight regarding the Applicant's reasons not being filed in the correct format amounts to a procedural irregularity, this irregularity has no bearing on the specific matter of the *late-filing* of the Form

TM8. Such irregularity is not, therefore, caught by Rule 77(5). 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).

23. 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.

24. 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;

25. As noted above, the stipulated deadline for filing the Form TM8 was 2 April 2024. The Form TM8 was filed on 17 May 2024. The deadline was therefore missed by some 45 days.

26. The explanation provided by Ms Amin, on behalf of the Applicant, is that she had an illness after returning from Saudi Arabia which made her unwell and unable to work for several weeks. No other information was provided.

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

27. The opposition is based upon sections 5(2)(a) and (b) of the Act and is directed against the entire specification applied for. Whilst it is not for the present hearing

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.

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

28. 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.

29. 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 22 July 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

30. No specific prejudice was highlighted to me, but I recognise that it is often the case in litigation that delays result in ongoing costs and continuing legal uncertainty.

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

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

**Conclusions**

32. 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 may 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.

33. I have considered the submissions of both parties. It is my view that the reasons provided by the Applicant for the late-filing of the Form TM8 do not amount to 'exceptional circumstances' or 'compelling reasons' to justify the exercise of my discretion in the Applicant's favour. The Form TM8 was not filed until 45 days after the prescribed deadline. It is my view that, based on the information provided to me by the Applicant, and in the absence of any details as to the particular date when Ms Amin was taken ill, the duration of the illness or explanation of how the illness prevented the Applicant company from observing the prescribed deadline, the Applicant has failed to demonstrate exceptional circumstances or provide compelling reasons.

### **Outcome**

34. In the light of the foregoing, it is my view that that it would be inappropriate for me to exercise the discretion available under Rule 18(2) in favour of the Applicant. Subject to any successful appeal, the preliminary view to refuse to admit the late filed TM8 and counterstatement is confirmed and the Application will be deemed undefended.

### **Costs**

35. Given that my decision terminates proceedings, I must consider the matter of costs. The Opponent has been the successful party and is entitled to a contribution to its costs based on the published scale at TPN 1/2023, calculated as follows:

Official fee for filing Form TM7	£200
Preparing the Statement of Case	£300
Preparing for and attending the hearing of the matter of the late filing of a defence	£200
<b>Total</b>	<b>£700</b>

I have awarded a sum in respect of preparation for and attendance at the hearing below the minimum threshold because the Opponent's skeleton argument was, in large part, irrelevant, and there was no particular complexity to the issue at stake.

36. I therefore order supreme nutra labs ltd to pay to NuviaLab Limited the sum of £700 as a contribution to its costs. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

**Dated this 27<sup>th</sup> day of August 2024**

**N. R. MORRIS**  
**For the Registrar**

## Annexe 1

The full specification of goods and services for the applied-for mark UK00003937371 is:

Class 5:

*Vitamin supplements; Dietary supplements; Nutritional supplements; Probiotic supplements; Herbal supplements; Homeopathic supplements; Chlorella dietary supplements; Flaxseed dietary supplements; Calcium supplements; Anti-oxidant supplements; Colostrum supplements; Protein supplements; Dietary supplements consisting of vitamins; Prebiotic supplements; Lecithin dietary supplements; Food supplements; Mineral dietary supplements; Zinc dietary supplements; Mineral nutritional supplements; Propolis dietary supplements; Acai powder dietary supplements; Liquid dietary supplements; Dietary and nutritional supplements; Nutraceuticals for use as a dietary supplement; Vitamin supplements for animals; Protein dietary supplements; Vitamin and mineral supplements; Linseed dietary supplements; Liquid nutritional supplements; Liquid vitamin supplements; Casein dietary supplements; Yeast dietary supplements; Enzyme dietary supplements; Dietary supplements for animals; Dietary supplements for pets; Anti-oxidant food supplements; Dietary food supplements; Alginate dietary supplements; Albumin dietary supplements; Liquid herbal supplements; Flaxseed oil dietary supplements; Wheat dietary supplements; Vitamin and mineral supplements for pets; Dietary supplements for infants; Dietary supplements for humans; Pollen dietary supplements; Glucose dietary supplements; Protein powder dietary supplements; Vitamin and mineral food supplements; Dietary supplements in powder form; Mineral dietary supplements for animals; Nutritional supplements for veterinary use; Dietary supplements with a cosmetic effect; Medicated food supplements; Whey protein dietary supplements; Mineral dietary supplements for humans; Dietary supplements for medical use; Food supplements for sportsmen; Nutritional supplements consisting primarily of magnesium; Protein supplements for animals; Soy protein dietary supplements; Vitamin supplement patches; Health-aid foods supplements containing ginseng; Dietary supplements consisting primarily of magnesium; Soy isoflavone dietary supplements; Vitamin preparations in the nature of food supplements; Dietary supplement drinks; Health food supplements*

*made principally of vitamins; Dietary supplements and dietetic preparations; Linseed oil dietary supplements; Nutritional supplements consisting of fungal extracts; Folic acid dietary supplements; Nutritional supplements consisting primarily of calcium; Brewer's yeast dietary supplements; Dietary supplements consisting primarily of calcium; Calcium tablets as a food supplement; Dietary supplements for controlling cholesterol; Nutritional supplements consisting primarily of zinc; Nutritional supplements for livestock feed; Herbal dietary supplements for persons special dietary requirements; Nutritional supplements consisting primarily of iron; Food supplements for veterinary use; Dietary supplements and dietetic preparations containing CBD oil; Food supplements for dietetic use; Dietary supplements consisting primarily of iron; Nutritional supplement energy bars; Medicated supplements for animal feedstuffs; Dietary food supplements used for modified fasting; Multivitamins; Dietary supplement drink mixes; Dietary supplements promoting fitness and endurance; Mineral supplements for feeding livestock; Ganoderma lucidum spore powder dietary supplements; Feed supplements for veterinary use; Medicated supplements for foodstuffs for animals; Activated charcoal dietary supplements; Health food supplements made principally of minerals; Food supplements for medical purposes; Zinc supplement lozenges; Food supplements in liquid form; Food supplements for non-medical purposes; Fitness and endurance supplements; Natural dietary supplements for treating claustrophobia; Protein supplement shakes; Wheat germ dietary supplements; Vitamin supplements for use in renal dialysis; Dietary supplements for pets in the nature of a powdered drink mix; Ground flaxseed fiber for use as a dietary supplement; Royal jelly dietary supplements; Pine pollen dietary supplements; Antibiotic food supplements for animals; Diet capsules; Health food supplements for persons with special dietary requirements; Nutritional supplement meal replacement bars for boosting energy; Food supplements consisting of amino acids; Dietary supplements for humans not for medical purposes; Powdered nutritional supplement drink mix; Dietary supplements for human beings; Fodder supplements for veterinary purposes; Vitamins and vitamin preparations; Dietary pet supplements in the form of pet treats; Preparations for supplementing the body with essential vitamins and microelements; Health-aid foods supplement containing red ginseng; Capsules for*

*medicines; Multi-vitamin preparations; Powdered nutritional supplement energy drink mix; Food supplements consisting of trace elements; Powdered fruit-flavored dietary supplement drink mix; Nutritional supplements made of starch adapted for medical use; Preparations of vitamins; Antioxidant pills; Delivery agents in the form of coatings for tablets that facilitate the delivery of nutritional supplements; Dietary supplemental drinks; Multivitamin preparations; Vitamin tablets; Anti-oxidants obtained from herbal sources.*

**Class 35:**

*Wholesale services in relation to dietary supplements; Retail services in relation to dietary supplements.*