

**O/0877/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF A JOINT HEARING HELD IN RELATION  
TO UK TRADE MARK NUMBER. 3958083  
REGISTERED IN THE NAME OF FOX SOCCER ACADEMY IN  
RESPECT OF THE FOLLOWING TRADE MARK:**

**Fox Soccer Academy**

**IN CLASS 41**

**AND**

**AN APPLICATION FOR A DECLARATION OF  
INVALIDITY UNDER NUMBER 507306  
BY MICHAEL APPIAH-KUSI**

## **Background and pleadings**

1. Trade mark number UK00003958083 for the mark shown on the cover page of this decision stands registered in the name of Fox Soccer Academy (“the proprietor”). It has a filing date of 19 September 2023 and a registration date of 15 December 2023. The contested mark is registered for services in class 41.

2. On 30 April 2024, Michael Appiah-Kusi (“the applicant”) applied to have the registration declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”). In pursuit of the invalidation, the applicant relies on sections 5(2)(b), 5(3) and 5(4)(a) of the Act.

3. On 7 May 2024, the Tribunal served the declaration of invalidity (being filed under Form TM26(l)) on the proprietor, by post (via Royal Mail’s “Signed for” service) and by email. The postal and email addresses used in the letter were those given by the proprietor in its application for the trade mark. The pertinent paragraphs of the letter are as follows:

“Rule 41(6) 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.

**IMPORTANT DEADLINE: A completed Form TM8 MUST be received on or before 08 July 2024.**

In accordance with rule 41(6) if the TM8 and counter-statement are not filed within this period, (a period which cannot be extended), the registration of the mark shall, unless the registrar otherwise directs, be declared invalid in whole or part. **It is important to understand that if the deadline date is missed, then in almost all circumstances, the registration will be treated as invalid in whole or part.**”

4. The result of the letter from the Tribunal was that the deadline for the proprietor to file its counterstatement stood at 8 July 2024.

5. On 1 July 2024, Mathys & Squire LLP filed a Form TM33 appointing themselves as the representatives for the proprietor. On 10 July 2024, the Tribunal wrote to both parties to confirm that Mathys & Squire LLP had been appointed as new representatives for the proprietor. In the same letters, the Tribunal also notified the parties that the proprietor's deadline to file a Form TM8 and counterstatement had been missed.

6. As the proprietor did not file their TM8 by the deadline, the Tribunal sent an official letter dated 17 July 2024, advising both parties of its preliminary view to declare the registration invalid. Either party, if it disagreed with the preliminary view, was to provide full written reasons and request a hearing by 31 July 2024.

7. On 23 July 2024, Mathys & Squire LLP filed a Form TM8 and counterstatement along with two witness statements. The first witness statement is in the name of Gary Johnston, a Partner at Mathys & Squire LLP together with exhibits 1-3. The second witness statement is in the name of Gillian Shaw, an IP Support Specialist at Mathys & Squire LLP together with exhibit 1. The following reasons were submitted for the late filing of the defence:

- The proprietor was always intent on defending these proceedings and instructed Mathys & Squire LLP accordingly.
- Mr Johnston requested an electronic file for the case to be created on 25 June 2024.
- On 26 June 2024, Ms Shaw sent a copy of the completed Form TM8 to Mr Johnston requesting him to check the form. Mr Johnston confirmed that the TM8 was acceptable on 27 June 2024.
- On 1 July 2024, Ms Shaw emailed Ms Wycherley, a paralegal at the firm, requesting her to appoint Mathys & Squire LLP as the representatives for the proprietor and stating that she would then file the TM8. In that email, Ms Shaw also stated that the deadline to file the TM8 was 8 July 2024.

- On 1 July 2024 at 10pm, Ms Shaw received a call informing her that her mother's health was deteriorating and that she should attend. Ms Shaw's mother passed away on Friday 5 July 2024 and Ms Shaw did not return to the office until Friday 12 July 2024.
- Ms Shaw claims that due to her distressed state, she failed to pass the request to file the Form TM8 to one of her colleagues.

8. In correspondence dated 2 August 2024, sent by email, the Tribunal issued a preliminary view refusing to admit the late filed TM8 into the proceedings. The parties were given until 16 August 2024 to request a hearing if they disagreed. The proprietor subsequently requested a hearing on 7 August 2024.

9. A hearing was appointed for 28 August 2024 and the parties were notified by way of official letters dated 12 August 2024. Both parties filed skeleton arguments prior to the hearing.

## **THE HEARING**

10. The hearing took place before me on 28 August 2024, by telephone conference. The cancellation applicant was represented by Mr Jamie Watt of Harper Macleod LLP and the proprietor was represented by Mr Gary Johnston of Mathys & Squire LLP

11. Whilst they have been carefully considered, I will not reproduce the entirety of the submissions that were made but will highlight those which are pertinent.

12. At the hearing, Mr Johnston began by outlining that the discretion afforded to the Registrar was enshrined in Rule 41(6). Next, Mr Johnston cited the factors in *Music Choice Ltd's Trade Mark*<sup>1</sup> ("*Music Choice*") as useful guidance on the exercise of this discretion.

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<sup>1</sup> [2005] RPC 18

13. Mr Johnston confirmed that he approved the TM8 and counterstatement on 27 June 2024 by email to his secretary who in turn asked for the TM33 to be filed (as outlined previously, this was filed on 1 July 2024). He added that on 1 July 2024, Ms Shaw's mother, who was receiving palliative care at the time, became increasingly ill and passed away several days later. Ms Shaw did not return to the office until 12 July 2024. Mr Johnston accepted that the missed deadline was due to human error. He explained that he had worked with Ms Shaw for 11 years and that due to her conscientious and committed nature, he had harboured no doubt when he gave the "go ahead" for the TM8 and counterstatement to be filed that it would be filed on time. Whilst Mr Johnston conceded that the deadline was missed due to human error, he suggested that the reasoning given for the missed deadline constituted 'extenuating circumstances' or 'compelling reasons' as to why the Tribunal should exercise discretion to admit the late filed Form TM8 and defence and not treat the registration as invalid.

14. As to the extent of the delay, Mr Johnston stated that the TM8 and counterstatement were filed six days from the Tribunal's notification letter of 17 July 2024, resulting in a total delay of just over two weeks. Mr Johnston submitted that he did not believe this to be in any way a huge delay, nor did he believe that anyone would be prejudiced by a two-week delay.

15. Mr Johnston further stated that if the late filed TM8 was refused, this would lead to further actions by way of opposition proceedings and revocation proceedings as the proprietor would refile their mark and potentially apply to revoke the applicant's three earlier registrations that are relied upon in these proceedings.

16. Mr Johnston also commented on the applicant's skeleton arguments with regards to the filing of a TM9R stating that he did not consider the filing of a TM9R to be necessary but would be happy to do so if required. I confirmed that the discretion afforded to me is outlined in Rule 41(6) and that the filing of a TM9R would not be necessary.

17. I then turned to Mr Watt for his submissions on behalf of the applicant. At the hearing and in the skeleton arguments provided, Mr Watt directed me to several

decisions concerning the failure to meet deadlines. It was submitted that the allowance of a late submission should not automatically succeed on the basis that the refusal would lead to commencement of another action on the same subject matter. In response to Mr Johnston's remarks about potential revocation proceedings, Mr Watt explained that the parties had been interacting with each other for 18 months and that Mr Johnston would therefore be aware of the applicant's prior use of its three marks relied upon in these proceedings.

18. Mr Watt also commented on the witness statement of Ms Shaw, noting that the Form TM33 was filed on 1 July 2024, at which point, the Form TM8 had already been drafted. He stated that it was unclear as to why the TM8 was not filed at the same time as the TM33. He further added that it was clear that there were two other individuals (Mr Johnston and Ms Wycherley) who were aware of both Ms Shaw's absence and the TM8 deadline. As a result, Mr Watt submitted that the reason that the TM8 and counterstatement were filed late was because of the agents forgetting to file on time and not having appropriate systems in place to identify that failure. Mr Watt submitted that the reasons provided by the proprietor did not meet the standard of exceptionality required in the present proceedings.

19. Further, it was submitted that the careful consideration of time limits is part of the basic duties of representatives<sup>2</sup> and an administrative error in meeting a deadline cannot be regarded as an exceptional or unpredictable event.<sup>3</sup>

20. At the conclusion of the hearing, I reserved my decision to give me an opportunity to properly reflect on the submissions put forward by the parties and all the circumstances of the case.

## **DECISION**

21. The filing of a TM8 in invalidity proceedings is governed by Rule 41 of the Trade Marks Rules 2008 ("the Rules"). The relevant parts read as follows:

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<sup>2</sup> *GIBBS Case R 748/2017-2* paragraph 43

<sup>3</sup> *KANSI Case R 265/2012-1*

“41. (6) 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.”

22. The combined effect of Rules 77(1), 77(5) and Schedule 1 of the Rules means that the time limit in Rule 41, 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.”

23. There is no suggestion that there has been any irregularity on the part of the Tribunal and so I need not consider the provisions of Rule 77(5) further.

24. Rule 76 of the Rules relates to delays in communication services and states:

“76. (1) The registrar shall extend any time limit in these Rules where the registrar is satisfied that the failure to do something under these Rules was wholly or mainly attributed to a delay in, or failure of, a communication service.

(2) Any extension under paragraph (1) shall be –

(a) made after giving the parties such notice; and

(b) subject to such conditions, as the registrar may direct.

(3) In this rule “communication services” means a service by which documents may be sent and delivered and includes post, facsimile, email and courier.”

25. I do not consider that there has been a failure in communication and so I need not consider the provisions of Rule 76 further.

26. Consequently, the only basis on which the proprietor may be allowed to defend the invalidity proceedings is if I exercise in its favour the discretion afforded to me by the use of the words “unless the registrar otherwise directs” in Rule 41(6).

27. In approaching the exercise of discretion in these circumstances, I consider the decisions of the Appointed Person in *Kickz AG v Wicked Vision Limited (“Kickz”)*<sup>4</sup> and *Mark James Holland v Mercury Wealth Management Limited (“Mercury”)*<sup>5</sup> i.e. I must be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the proprietor’s favour.

28. In *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;**

29. The circumstances as to why the deadline was missed are summarised above. The stipulated deadline for the filing of the proprietor’s Form TM8 and

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<sup>4</sup> BL/O/035/11

<sup>5</sup> BL/O/050/12

counterstatement was 8 July 2024. However, the Form TM8 and counterstatement was filed on 23 July 2024. Therefore, the deadline was missed by fifteen days.

**The nature of the applicant's allegations in its statement of grounds:**

30. The application for a declaration of invalidity is brought under sections 5(2)(b), 5(3) and 5(4)(a) of the Act. Whilst it is not for the present hearing to determine the merits of the case, there is nothing to suggest that there is not an arguable case to be determined.

**The consequences of treating the proprietor as defending or not defending the application for invalidation:**

31. If the proprietor is permitted to defend the application, the proceedings will continue, with the parties given an opportunity to file evidence and the matters will be determined on their merits. However, if the proprietor is not allowed to defend the application, the registration in its entirety will be declared invalid. Though it will remain open to the proprietor to re-file its application, which may, in turn, be opposed by the cancellation applicant.

32. Whilst I acknowledge Mr Johnston's comments regarding the potential filing of revocation actions against the applicant's earlier rights, a revocation action can be filed at any time after a mark has been registered for more than five years. Therefore, I do not consider that any revocation proceedings filed against the applicant's registrations would be a direct consequence of treating the proprietor as not defending the application for invalidation.

**Any prejudice caused to the applicant by the delay:**

33. In its skeleton arguments submitted on behalf of the applicant, Mr Watt submits that allowing the late Form TM8 and counterstatement would cause prejudice to the applicant on the basis that it increases the challenged rights from a single right to two rights, doubling its workload. In response, Mr Johnston submitted that he did not see

any prejudice to the applicant save for the costs of the hearing to discuss the late TM8 however, 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;

34. The parties have drawn my attention to related proceedings, namely cancellation number 507305 in which the proprietor has already filed a defence. In those cancellation proceedings, the applicant in these proceedings has sought to invalidate the proprietor's figurative registration, being that numbered 3987955. In the Tribunal's letters dated 27 June 2024, the parties were notified that cancellations 507305 and 507306 would be consolidated pending the filing of a defence in these proceedings. If the late filed TM8 in these proceedings is permitted, cancellations 507305 and 507306 will be consolidated. If not, this will have no impact on cancellation 507305 and those proceedings would continue.

## **Conclusions**

35. Trade mark appeal authorities have established that it is only in cases where there are 'extenuating circumstances', or 'compelling reasons' that the Registrar is able to exercise his discretion to admit into proceedings a Form TM8 filed outside the stipulated period.

36. In reaching my decision, I keep in mind the factors outlined above and in particular, I recognise that if discretion is not exercised in the proprietor's favour, the proprietor will be treated as not opposing the application and registration of the mark shall be declared invalid. I recognise that this is a serious consequence. I further recognise that it may be that the proprietor will simply re-file an application for its mark and that this may be opposed by the applicant in proceedings arising at some time in the future. However, as the invalidation of the registration and possibility of further proceedings on much the same basis is often the consequence of a failure to comply

with the non-extensible deadline to file a Form TM8, these are not factors that, in my view, are particularly compelling.

37. I also recognise that the existence of related proceedings is an insufficient basis for the Tribunal to exercise its discretion in the absence of extenuating circumstances or compelling reasons. This position can be found in *Praesidiad NV*<sup>6</sup>, where the applicant faced losing an IR designation in the UK with the consequence that it would not be able to challenge the validity of another mark. The Hearing Officer in that case found that the severity of these consequences counted for less than the inadequacy of the explanation for non-compliance put forward [§39]. This decision was upheld by Mr Hobbs QC (as he then was) who stated (at [§44]):

“The structure of the rule as I have described it in paragraph [4] above points to the importance of the disciplinary dimension. As I have said, the procedural jurisprudence applicable to rule 41(6) confirms that the time limit it prescribes is designed to be strictly enforced. Many decisions can be found to support that proposition.”<sup>7</sup>

38. In the official letter dated 7 May 2024, the Tribunal made it very clear that failure to file a Form TM8 by the deadline would result in the registration being treated as invalid in accordance with Rule 41(6) of the Trade Marks Rules 2008. I bear in mind that the proprietor was represented one week prior to the TM8 deadline and that by their own admissions, the applicant’s representatives were fully aware of the deadline but due to human error, compounded by a family bereavement, as previously discussed, this deadline was missed.

39. Whilst I am sympathetic to the circumstances surrounding Ms Shaw’s absence, it is clear that at least two other individuals at the representative’s firm were aware of the TM8 deadline. I acknowledge Mr Johnston’s assertions that he had no doubt that Ms Shaw would have filed the TM8 on time, however this could have been followed up by implementing internal checks or by contacting the Tribunal to confirm whether

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<sup>6</sup> BL O/193/19

<sup>7</sup> BL O/240/20

a TM8 had been filed by Ms Shaw prior to her absence. I acknowledge that, while it was its representatives who fell into error, it is the proprietor who will suffer the consequences (which are serious, as it will lose its registration). That is not a decisive point, however, as that is always the case where a TM8 is filed late by a representative and the registrar makes a decision against the mark owner.

40. Having carefully considered all the submissions made by both parties, and having regard to the factors set out in the case law in *Kickz*, *Mercury* and *Music Choice*, I see no compelling reason or extenuating circumstance which would justify the use of the registrar's discretion provided under Rule 41(6).

### **Outcome**

41. My decision is not to exercise the discretion available under Rule 41(6) in favour of the proprietor. Subject to appeal, the registration UK00003958083 will be declared invalid.

### **COSTS**

42. As my decision terminates the proceedings, I must consider the matter of costs. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. I assess these as follows:

Official fee for filing the form TM26(l):	£200
Preparing the statement of case:	£300
Preparing skeleton arguments and attending the hearing:	£500
<b>Total:</b>	<b>£1000</b>

43. I therefore order Fox Soccer Academy to pay the sum of £1000 to Michael Appiah-Kusi. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 10<sup>th</sup> day of September 2024**

**Catrin Williams**  
**For the Registrar**