

O-0975-25

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION

NO. UK00004023806

BY EDWARD IKEMEFUNA OBI

TO REGISTER

Igbo Community Aberdeen

IN CLASS 41

AND

THE OPPOSITION THERETO

UNDER NO. OP000448269

BY ONYEKA EKEKWE

BACKGROUND AND PLEADINGS

1. On 8 March 2024, Edward Ikemefuna Obi (“the applicant”) applied to register the trade mark shown on the cover page of this decision.
2. The application was published for opposition purposes on 22 March 2024 for services in Class 41.
3. On 24 June 2024, Onyeka Ekekwe (“the opponent”), a litigant in person, filed a Form TM7, opposing the applicant’s mark on the basis of sections 3(1)(a), 3(1)(b), 3(1)(c), 3(1)(d) and 3(6) of the Trade Marks Act 1994 (“the Act”).
4. The Form TM7 was served on the applicant by email on 30 September 2024 and I copy an extract from the Tribunal’s covering letter below.

“If you wish to continue with your application, you need to file a notice of defence and counterstatement by completing Form TM8 - please note the important deadline below. You will find a blank Form TM8 on the IPO website, together with brief guidance on what happens after it is filed:

<https://www.gov.uk/government/publications/trade-mark-forms-and-fees>

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 02 December 2024.”

5. On 18 December 2024, the Tribunal wrote to the applicant by email and by post and I copy an extract below.

“The official letter dated 30th September 2024 invited the applicant to file a TM8 and counterstatement on or before 2nd December 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, **8th January 2025**. 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.”

6. On 8 January 2025, the Tribunal received an email from the applicant’s representatives, together with a witness statement which I reproduce below.

WITNESS STATEMENT

I, Stephen Dobson am a Director of The Trademark Helpline, the appointed representatives of Mr Edward Ikemefuna Obi, Chairman of the Igbo Community Group in Aberdeen. The Trademark Helpline has held this position since 28 June 2024 and has been managing this opposition process as well as two others which are relevant to this case – namely OP000448170 and OP600003348.

On 18 December 2024 my firm received the tribunal correspondence notifying that Rule 18(2) had been enacted due to failure to provide a form TM8 and counterstatement in defence of our client's trademark before the deadline of 02 December 2024. This was unexpected as I was of the understanding that we had filed these documents well within this deadline. However, on investigating this matter internally, it appears that the system we use to track our case work was incorrectly updated to show this had been done, when it in fact had not. This is despite the documents being prepared and signed on 28 November 2024.

It appears that there may have been human error by one of our team members which caused this discrepancy, but from our client's perspective, I believe it to be unfair and disproportionate to penalise him for our mishap, especially when this is one of three opposition cases for which our client is representing his community in its defence against a group of alleged bad faith actors. It is likely that the tribunal outcome of this case would be replicated or at least influenced by the others and therefore it should be allowed to part of the wider dispute resolution process.

I have attached the original documents with this filing for review.

I believe that the facts stated in this witness statement are true.

Signed



Name

Stephen Dobson

Dated

08/02/2025

7. I assume that the date at the end of the witness statement is an error, and the intention was to date it 8 January 2025.
8. The applicant's representatives also enclosed a Form TM8 dated 28 November 2024.
9. On 4 March 2025, the Tribunal wrote to the applicant by email as follows:

"I acknowledge receipt of the late TM8 and witness statement.

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. I draw your attention in particular to the appeal decisions in *Kix*: BL Number O/035/11 and *Mercury*: BL Number O/050/12, which provide further guidance on this type of issue. Those decisions can be found on the IPO website <https://www.ipo.gov.uk/t-challenge-decision-results.htm>

On review of your witness statement which explained why the TM8 was filed outside of the prescribed period, it has been found that the reasons provided do not constitute extenuating circumstances and therefore it is the Registry’s preliminary view to **refuse** the late TM8 and witness statement.

If you disagree with the preliminary view you must provide full written reasons and request a hearing on, or before, **18 March 2025**. If no response is received within the time allowed, the preliminary view will automatically become final immediately after that date and the trademark will be struck out.”

10. On 31 March 2025, not having received any response from the applicant to its letter of 4 March 2025, the Tribunal wrote to the applicant as follows:

“I refer to the official letter dated 04 March 2025. As no response has been received the preliminary view is confirmed and I can now confirm that the above application has now been withdrawn.”

11. ‘On 31 March 2025, following receipt of the official letter of the same date, the applicant telephoned the Tribunal claiming that they had not received a copy of the official letter, sent by email on 4 March 2024. However, an

investigation by the IPO's IT department showed that an email was sent to the email address held on file for the applicant's representatives on 4 March 2025 and so the Tribunal wrote to the applicant again on 7 April 2025 confirming its view that the application was considered to be withdrawn.

12. The applicant's representatives wrote to the Tribunal by email on 14 April 2025 as follows:

“Whilst we accept that the IPO system shows the email of 04 March 2025 being sent and delivered at 11:05, a check on our side shows no email received containing the opposition number OP000448269 (please see attached screenshots). We did receive numerous other emails from the address no-reply@ipo.gov.uk on that day so it is unclear why this is has happened.”

13. The applicant asked to be heard on the substantive question of the Tribunal's preliminary view, that the application was considered to be withdrawn.

14. It was decided to convene a procedural hearing.

THE HEARING

15. A procedural hearing took place before me, via Microsoft Teams as an audio call, on Thursday 18 September 2025.

16. Alex Pugh, from The Trademark Helpline, appeared on behalf of the applicant having filed skeleton arguments prior to the hearing.

17. The opponent, Onyeka Ekekwe, attended as a litigant in person. His skeleton arguments were filed a day late, but I accepted them.

18. I took Mr Pugh's observations on whether the email of 4 March 2025 was received, and also on the substantive question of the Tribunal's preliminary view, that the application was considered to be withdrawn.
19. On the email in question, Mr Pugh said the email could have been "moved by one of my team in error", but from his point of view and that of the rest of his team, they were not aware of the email or deadline. One major factor which potentially led to confusion on the part of the applicant's representatives was that there have been several oppositions from "several different people deemed to be on the same side" which has "muddied the waters". Mr Pugh did not want the applicant to suffer as a result.
20. On the substantive question of the Form TM8 having been filed late, Mr Pugh had been running the argument that the applicant's form should be reinstated because the appropriate paperwork was never served on the applicant. However, at this point in the proceedings, I asked for Mr Pugh's comments in respect of Mr Dobson's witness statement of what I took to be 8 January 2025. Mr Pugh did not appear to be familiar with Mr Dobson's witness statement, Mr Dobson being the previous person who was managing this case. Mr Pugh was not able to confirm what the reason for late filing was. However, the error could have occurred due to the number of oppositions in play.
21. For his part, Dr Ekekwe said that he had received correspondence from the Tribunal by email in a timely fashion. There was no reason to suppose that the applicant did not also receive such correspondence. The applicant had failed to comply with clear deadlines. His submission of a Form TM8, albeit late filed, showed that the applicant was in receipt of the Tribunal's correspondence. The IPO's letter of 4 March 2025 detailed the Tribunal's preliminary view that the reasons for late filing were not sufficient, and the applicant had until 18 March 2025 to request a hearing. This view was subsequently confirmed on 31 March 2025, no response to the Tribunal's letter having been received. Dr Ekekwe did not think it likely that the

particular email of 4 March 2025 was not received by the applicant given that the applicant had received other correspondence from the Tribunal.

22. Dr Ekeke did not consider it appropriate that a hearing had been convened: proceedings should have concluded on 31 March 2025 with confirmation that the application had been withdrawn.

DECISION

23. I will first deal with the question of whether the Tribunal acted correctly in initially concluding proceedings by letter on 31 March 2025, no response to its letter of 4 March 2025 having been received.

24. Paragraph 6.2 of the Tribunal section of the *Manual of trade marks practice* states that “The Tribunal’s preliminary view will become final unless a party objects to it”.

25. An investigation by the IPO’s IT department found that *an* email was sent to the correct email address and successfully received at 11:05 on the relevant date. In the absence of a further IT investigation definitively establishing that this was *the* email in question, it is likely that the email at issue was received by the applicant’s representatives on the date in question. Having looked at the file, the letter in question is shown as being sent by email on the relevant date and given that the applicant’s representatives have stated that other emails about other cases were safely received by the applicant’s representatives from the Tribunal on the same date, it seems highly unlikely that this particular email was not received.

26. Mr Pugh has conceded that the email could have been moved by one of his team in error and it is far more likely that the email was received and misfiled than that it was never received.

27. On balance, I find that the Tribunal correctly concluded proceedings on 31 March 2025 due to no response having been received to its official letter of 4

March 2025, its preliminary view being confirmed, and so the application is considered withdrawn at that point. The related case OP000448170 is therefore also concluded due to the application UK00004023806 being withdrawn and an opposition case, OP600003348, falls away

28. If I am wrong in making the above findings, I will also consider the substantive question of whether the Tribunal was correct when it said on 4 March 2025:

“On review of your witness statement which explained why the TM8 was filed outside of the prescribed period, it has been found that the reasons provided do not constitute extenuating circumstances and therefore it is the Registry’s preliminary view to **refuse** the late TM8 and witness statement.”

29. The filing of a Form TM8 in opposition proceedings is governed by rule 18 of the Trade Mark 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 is the period of two months beginning immediately after the notification date.

(4) This paragraph applies where—

(a) the applicant and the person opposing the registration agree to an extension of time for the filing of Form TM8;

(b) within the period of two months beginning immediately after the notification date, either party files Form TM9c requesting an extension of time for the filing of Form TM8; and

(c) during the period beginning on the date Form TM9c was filed and ending nine months after the notification date, no notice to continue on Form TM9t is filed by the person opposing the registration and no request for a further extension of time for the filing of Form TM8 is filed on Form TM9e,

and where this paragraph applies the relevant period is the period of nine months beginning immediately after the notification date.”

30. 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.”

31. There is no suggestion in this case that there has been any irregularity on the part of the Tribunal. Consequently, the only basis on which the applicant may be allowed to defend the opposition 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 18(2).

32. Sitting as the Appointed Person in *Kickz*, Mr Geoffrey Hobbs KC held that the discretion conferred by Rule 18(2) can be exercised only if there are “extenuating circumstances”. And sitting as the Appointed Person in *Mark James Holland and Mercury Wealth Management Limited* (BL-O-050-12) (“*Mercury*”) Ms Amanda Michaels KC held that there must be “compelling reasons” to justify the Registrar exercising that discretion. In considering relevant factors, Ms Michaels referred to the criteria established in *Music Choice Ltd’s Trade Mark* [2006] R.P.C. 13 (“*Music Choice*”), which provides guidance applicable by analogy when exercising the discretion under rule 18(2). The factors are as follows:

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

33. Looking at Mr Dobson’s witness statement of what I take to be 8 January 2025, he states that the failure to meet the deadline for filing the Form TM8 was “unexpected as I was of the understanding that we had filed these documents well within this deadline. However, on investigating this matter internally, it appears that the system we use to track our case work was incorrectly updated to show this had been done, when it in fact had not. This is despite the documents being prepared and signed on 28 November 2024.”

34. The Form TM8 being filed late on 8 January 2025, the deadline having been 2 December 2024 means that the deadline was missed by 37 days.

The nature of the opponent’s allegations in its statement of grounds

35. The opposition was brought under sections 3(1)(a), 3(1)(b), 3(1)(c), 3(1)(d) and 3(6) of the Act. There is nothing to suggest that the opposition was without merit.

The consequences of treating the applicant as defending or not defending the opposition

36. If the applicant was allowed to defend the opposition, the proceedings would continue, and the matter would be determined on its merits.
37. If, however, the applicant was not allowed to defend the opposition, its application would be deemed withdrawn, and the applicant would lose its filing date of 8 March 2024. It is possible to re-file an application, but I am told by Mr Pugh that other parties have since filed applications for identical or similar marks whose filing dates would pre-date that of the applicant's new application.
38. The opposition that the applicant is mounting against the mark UK00004030016, reliant upon UK00004023806, under case reference no OP600003348, would also fall away.
39. If the applicant was treated as not defending the opposition, its representatives argue that he would suffer through no fault of his own, his representatives having made an error.

Any prejudice caused to the opponent by the delay

40. The opponent has not commented on this point.

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

41. The applicant's mark, UK00004023806, is also subject to an opposition under case reference no OP000448170. Further, as previously stated, the applicant in the case before me is opposing the identical mark IGBO COMMUNITY ABERDEEN, UK00004030016, in case reference no OP600003348, relying upon UK00004023806.

42. Having addressed each of the relevant factors as proposed in *Music Choice*, I need to decide whether the applicant's witness statement and any subsequent comments at the hearing revealed extenuating circumstances or compelling reasons that would enable me to exercise my discretion to allow the proceedings to continue.
43. After carefully considering the expected detriment to the applicant in the event that discretion was not exercised in its favour, I find that the loss of a filing date is often the consequence of a failure to comply with the non-extensible deadline for filing a Form TM8 as indeed is the consequent falling away of an opposition reliant upon an applied for mark. This factor is not, therefore, particularly compelling.
44. Having taken all of the relevant factors into account, I am not satisfied that the reasons why the Form TM8 and counterstatement were filed late are particularly compelling, nor do they constitute extenuating circumstances sufficient to permit the Registrar to exercise its discretion under rule 18(2).
45. The applicant's representatives have highlighted the fact that they are acting for the applicant in more than one case. However, I do not think that this should have prevented the applicant's representatives from responding to the Tribunal's correspondence in a timely manner and filing defences on time.
46. The applicant, in the form of its representatives, could be said to have been the "the author of its own misfortune".¹ While I acknowledge that human error can occur, I find this is hardly a compelling reason, especially as the applicant's representatives should have been well aware of the opposition process and the strict statutory two month deadline to file a Form TM8 in order to defend an application. Furthermore, the deadline in question was clearly stipulated in the Tribunal's letter as were the consequences of not submitting the Form TM8 by this deadline. Moreover, I have not been

¹ *Kickz AG and Wicked Vision Limited* (BL- O-035-11), paragraph 15.

supplied with any evidence as to there being a robust system of checks in place to prevent errors from occurring. Accordingly, while the applicant will suffer the consequences of his representatives' error, I find no single reason or combination of reasons sufficient to constitute extenuating circumstances or compelling reasons to enable me to exercise my limited discretion under rule 18(2) and admit the late filed Form TM8 and counterstatement into these proceedings.

CONCLUSION

47. The preliminary view is upheld and the late-filed Form TM8 is not to be admitted into the proceedings. Subject to an appeal, the application UK00004023806 is treated as abandoned. Further, the related case OP000448170 is concluded and the opposition case OP600003348 falls away.

COSTS

48. Given that the outcome of this decision has terminated the proceedings, the opponent is entitled to a contribution towards his costs. However, as Dr Ekekwe is not professionally represented, as outlined in Tribunal Practice Notice ("TPN") 1/2023, before I can assess these costs, I invite Dr Ekekwe to submit a Tribunal Cost Pro Forma giving details of the costs he has incurred. I therefore defer my decision on costs pending the submission of the pro forma.

Dated this 20th day of October 2025

John Williams
For the Registrar