

O/0976/24

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK REGISTRATION NO's. 3669735, 915305352 AND 904023041
IN THE NAME OF ADVANCE MAGAZINE PUBLISHERS INC.
FOR THE FOLLOWING MARKS:

VOGUE

IN CLASS 35

VOGUE LIVING

IN CLASSES 11, 20, 24 AND 27

AND

VOGUE

IN CLASSES 14, 16, 18, 24, 26, 28, 35, 38, 39, 40, 42, 44 AND 45

AND

THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT
FILED IN DEFENCE OF REGISTRATIONS FOR INVALIDATION AND
REVOCAION PROCEEDINGS UNDER NO's. 506256, 506258 and 506259
BY WREN KITCHENS LIMITED

Background

1. Advance Magazine Publishers Inc. (“the proprietor”) is the registered proprietor of the following UK trade marks:

VOGUE

under UK trade mark registration number 3669735;¹ filed on 31 October 2003; registered on 21 January 2022 for services in class 35 (“the proprietor’s first mark”),

VOGUE LIVING

under UK trade mark registration number 915305352;² filed on 5 April 2016; registered on 26 September 2016 for goods in classes 11, 20, 24 and 27 (“the proprietor’s second mark”) and,

VOGUE

under UK trade mark registration number 904023041,³ filed on 2 September 2004 and registered on 12 November 2017 for goods and services in classes 14, 16, 18, 24, 26, 28, 35, 38, 39, 40, 42, 44 and 45 (“the proprietor’s third mark”).

Collectively known as “the contested marks”.

¹ On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 59 of the Withdrawal Agreement between the UK and EU, applications for EUTMs made before the end of the transition period that had received a filing date can form the basis of a UK application with the same filing date as the corresponding EUTM, provided they were filed within 9 months of the end of the transition period. The proprietor’s EUTM number 3529336 was filed at the EUIPO on 31 October 2003, whereas its UK application was filed on 16 July 2021. Accordingly, the UK application was given the same filing date as its EUTM.

² Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM. As a result of the proprietor’s EUTM number 15305352 being protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark now recorded on the UK trade mark register has the same legal status as if it had been applied for and registered under UK law, and retains its original international registration date as its filing date.”

³ The same applies as above with the comparable trade mark created from the EUTM number 4023041.

2. On 3 July 2023, Wren Kitchens Limited (“the applicant”) made an application to invalidate the proprietor’s first mark pursuant to section 3(6) of the Trade Marks Act 1994 (“the Act”). This was directed against all the services of the proprietor’s first mark.

3. On the same date, the applicant also made applications to revoke the proprietor’s second and third marks in accordance with sections 46(1)(a) and 46(1)(b) of the Act. This was directed against goods in classes 20, 24 and 27 of the proprietor’s second mark, and for the proprietor’s third mark goods in class 24 and “retail services; mail order services” in class 35.

4. In relation to the application for invalidation, the Registry served the Form TM26(I) on the proprietor by email on 5 July 2023. In accordance with rule 41(6) of the Trade Mark Rules 2008 (“the Rules”), the proprietor was informed that it had two months from the date of the official letter in which to file its Form TM8 and counterstatement. The relevant paragraphs of the letter are as follows:

“Please find enclosed a copy of a TM26(I), application for invalidity, filed against your registration.

If you wish to continue with your registration, 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/trade-mark-forms-and-fees>

*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 05 September 2023

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. Intellectual Property Office is an operating name of the Patent Office
www.gov.uk/ipo

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.

[...]"

(Original emphasis)

5. With regard to the applications for revocation of the proprietor's second and third marks, the Registry served the Forms TM26(N) on the proprietor on the same date as the letter regarding invalidation. In a virtually identical letter, in accordance with rule 38(3) of the Rules, the proprietor was informed that it had two months from the date of the official letter in which to file its Form TM8(N) and counterstatement in the respective revocations. The pertinent paragraphs of the letter are as follows:

"Please find enclosed a copy of a TM26(N) filed against your registration.

If you wish to continue with your registration, you need to file a notice of defence and counterstatement by completing Form TM8(N) - please note the important deadline below. You will find a blank Form TM8(N) 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/trade-markforms-and-fees>

*Rule 38(3) of the Trade Marks Rules 2008 require that you must file your notice of defence and counterstatement (Form TM8(N)) within **two months** from the date of this letter.*

IMPORTANT DEADLINE: A completed Form TM8(N) MUST be received on or before 05 September 2023.

[...]

Rule 38(6) of the Trade Marks Rules 2008 states that “Where the proprietor fails to file a Form TM8(N) within the period specified in paragraph (3) the registration of the mark shall, unless the registrar directs otherwise, be revoked.” It is important to understand that if the deadline date is missed, then in almost all circumstances, the registration will be treated as revoked in whole or part.” (Original emphasis)

6. However, the proprietor did not file either a Form TM8 or a Form TM8(N) by the prescribed deadline of 5 September 2023 in respect to any of the proceedings, and so, on 13 September 2023, the Registry wrote to the proprietor again in relation to all three proceedings. The Registry stated:

“The registry is minded to treat the proprietor as not opposing the application for revocation and revoke the registration 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, **27 September 2023**. 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 issue an undefended decision on the issue of failure to comply with the Rules governing the filing of a defence.”

7. Following this, on 26 September 2023, the proprietor filed a Form TM8 in respect of the invalidation proceedings, a Form TM8(N) for each of the respective revocation proceedings, and a witness statement of Eric Gisolfi, who identified himself as the Vice President and Associate General Counsel of Advance Publications Inc.

8. The witness statement set out the reasons for missing the TM8/TM8(N) deadline in the respective proceedings, the pertinent paragraphs stated as follows:

[...]

7. In late 2021 we began transferring responsibility for the administration and maintenance of Advance's UK and European trademark portfolio to the firm Stobbs. That included the Contested Registrations. Stobbs was entered as the address for service for those registrations in April 2022. We retained Beck Greener for on-going pending matters and we continued to do so in relation to some enforcement and other contentious matters.

8. One of the matters that Beck Greener had initiated and continued to handle for us was an opposition to an application by Wren Kitchens Limited to register the mark VOGUE under No. 3568766 ("the Opposition"). The opposed application had been filed prior to the UK leaving the EU. The opposition was filed in July 2021 under number OP000424957 and was based on a number of earlier rights including a number of EU registrations for marks containing the word VOGUE.

9. It obviously was the Opposition which caused Wren Kitchens to commence the Cancellations, and the Opposition, at Wren Kitchen's request, was subsequently suspended.

10. On 19 July 2023 I was informed by Stobbs that the Cancellations against the Contested Registrations had been filed and had been served on them by the UK IPO. Stobbs confirmed that the deadline for filing defences against the cancellations was 05 September 2023.

11. On 19 July 2023 I informed Beck Greener of the action taken by Wren Kitchens knowing that it was likely to be in response to the Oppositions being handled by Beck Greener. In subsequent correspondence with Beck Greener on 26 July, we discussed potential terms Advance might offer to Wren Kitchens to settle the Opposition, and the Cancellations. Such potential terms for settlement have continued to be discussed internally by me and the relevant business units, though a conclusion has not been reached.

12. *In the meantime, I had mistakenly believed that I had instructed Beck Greener on 19 July 2023 to take over the handling of and to prepare and file defences to the Cancellations. I therefore wrote to Stobbs on 25 July 2023 informing them that Beck Greener would be handling the defences to the Cancellations, and that Stobbs was to take no further action.*

13. *On 13 September 2023 Stobbs informed me of the tribunal's letters of the same date stating that no defences had been filed in the Cancellation proceedings and setting a deadline of 27 September to challenge the provisional decisions set out in those letters. I then realised on reviewing the matters with Beck Greener that contrary to my intentions and earlier belief, I had not in fact instructed Beck Greener to take over the handling of the defences to the Cancellations. I immediately asked them to do so.*

14. *I confirm, as explained above, that our failure to file defences to the Cancellations was inadvertent and that it had always been our intention to defend to the fullest reasonable extent, the Contested Registrations against the Cancellations.”*

9. Having considered the reasons set out in the witness statement above, on 30 October 2023, the Registry informed the parties that its preliminary view was that the proprietor's Form TM8 and counterstatement should not be admitted into proceedings. The parties were advised that, if they disagreed with the preliminary view, a hearing should be requested on, or before, 13 November 2023. The relevant paragraphs of that letter are as follows:

“Thank you for your letter dated 26 September 2023 in which you submitted a late filed Form TM8 and counterstatement together with a witness statement of Eric Gisolfi.

The case has been given consideration and it is the Registrar's preliminary view that, although a form TM8 and counterstatement has now been submitted, it cannot be admitted into the proceedings as it was received outside of the prescribed non-extendable period.

Whilst the Registrar is very sympathetic to the applicant's circumstances, the reasons provided for failing to meet the deadline are not deemed sufficient, given the guidance provided by the published authorities, to allow the exercise of the Registrar's limited discretion in such matters. Such discretion can only be exercised where there exists either 'compelling reasons' or 'extenuation circumstances' to do so. In this instance it would appear the reason for the non-compliance is human error which is deemed insufficient reason to admit the late filed TM8. [sic]

You are referred to the following decisions of the Appointed Persons in this regard: Kickz AG and Wicked Vision Limited (BL-O-035/11) and Mark James Holland and Mercury Wealth Management Limited (BL-O-050/12).

[...]

As a consequence of the above, it is therefore considered that there are no grounds on which to allow the exercise of the Registrar's discretion in this case.

*In accordance with paragraph 10 of Tribunal Practice 2/2011, if either party disagrees with the preliminary view, they should provide full written reasons and request a hearing on, or before **13 November 2023**." (original emphasis)*

10. On 13 November 2023, the proprietor filed a notice of objection to the Registry's preliminary view regarding the late filing of the TM8/TM8(N) in the respective proceedings, and consequently, after several adjournments to enable the parties to try and reach a settlement, a hearing was set for 9 July 2024, to discuss the admissibility of the Forms TM8/TM8(N) and counterstatements.

The hearing

11. A hearing took place before me by video conference on 9 July 2024. At the hearing, Ms Byfield of Stobbs appeared for the proprietor; the applicant was not in attendance, however, Kenan Hamarsheh appeared as a silent observer. The proprietor filed a

skeleton argument in advance of the hearing, along with the appeal decision BL O/240/20 (TESCON), and previous decisions of Hearing Officers including one of my own, BL O/781/19 (FIREXO) and BL O/0366/23 (FEMME LUXE) on which it relied.

12. At the hearing, Ms Byfield relied on the proprietor's skeleton argument which was further enhanced through submissions. At the time of the deadline for filing the defences in the relevant proceedings it is asserted that the proprietor was in the early stages of transitioning its intellectual property work in the UK from Beck Greener to Stobbs. This was a process that was being completed in stages which increased the burden on Eric Gisolfi. At the hearing Ms Byfield confirmed the position of Eric Gisolfi as in-house counsel for the proprietor. It was highlighted that Mr Gisolfi for his part admits to his error, in genuinely, but mistakenly believing that he had instructed Beck Greener to file the defences in the respective proceedings against the contested marks and was quick to rectify his error. It was stressed that this situation has now changed with Stobbs acquiring full responsibility for the Proprietor's trade mark portfolio and contentious matters since February 2024. The importance of the trade marks for the proprietor and the significant consequences of not being permitted to defend the applications against the contested marks were pressed upon me. Furthermore, it was highlighted that the applicant did not challenge the proprietor's request for discretion to be exercised.

13. I have taken the proprietor's submissions, its skeleton argument and the cases on which it relies into consideration when making my decision which is set out below.

DECISION

14. The filing of a Form TM8 in invalidation proceedings against the proprietor's first mark is governed by Rule 41(6) of the Rules. The relevant parts read as follows:

“(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.”

15. Whilst the filing of the Form TM8(N) and counterstatement in revocation proceedings against the proprietor’s second and third marks is governed by rule 38 of the Rules. The applicable parts to these proceedings read as follows:

“38. -(3) The proprietor shall, within two months of the date on which he was sent a copy of Form TM26(N) by the registrar, file a Form TM8(N), which shall include a counter-statement.

(6) Where the proprietor fails to file a Form TM8(N) within the period specified in paragraph (3) the registration of the mark shall, unless the registrar directs otherwise, be revoked.”

16. The combined effect of rules 77(1), 77(5) and Schedule 1 of the Rules means that the time limit in rules 38 and 41(6), 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.

17. There is no suggestion that there has been any irregularity on the part of the Tribunal. Consequently, the only basis on which the proprietor may be allowed to defend the respective applications for invalidation and revocation is if I exercise in its favour the discretion afforded to me by the use of the words “unless the registrar directs otherwise”, which applies equally to rules 38 and 41(6).

18. In approaching the exercise of discretion in these circumstances, I take into consideration the decisions of the Appointed Person in *Kickz AG v Wicked Vision Limited* (“*Kickz*”)⁴ and *Mark James Holland v Mercury Wealth Management Limited* (“*Mercury*”)⁵ i.e. I have to be satisfied that there are extenuating circumstances or compelling reasons which justify the exercise of the narrow discretion afforded to me in the proprietor’s favour.

19. In *Music Choice Ltd’s Trade Mark* (“*Music Choice*”),⁶ the High 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, addressing each factor below in turn, and referring to the proprietor’s submissions to the extent I consider necessary.

20. I pause here to confirm that the same circumstances apply to the late filing of the TM8 within the invalidation proceedings against the proprietor’s first mark and the late filing of the TM8(N)’s in the revocation proceedings against the proprietor’s second and third marks.

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

21. As outlined above, the deadline for filing the respective TM8/TM8(N)’s was 5 September 2023. The proprietor was in the process of transferring ownership for its legal matters from Beck Greener to Stobbs as described in the witness statement and submissions set out above. The proprietor accepts that Stobbs received the Registry’s letter dated 5 July 2023, and on 19 July 2023, Stobbs then informed the proprietor of the proceedings against its marks and the subsequent deadline. However, the proprietor admits to mistakenly believing that it had instructed Beck Greener to handle the filing of the defences in the relevant proceedings. This appears to be on the basis

⁴ BL/O/035/11

⁵ BL/O/050/12

⁶ [2005] RPC 18

that the proprietor informed Beck Greener of the invalidation and revocation proceedings filed against the contested marks, and the fact that Beck Greener was instructed to handle the related oppositions for which settlement negotiations involving the parties were taking place. As a result, the TM8 and TM8(N)'s were not filed until 21 days later, following the Registry's letter (set out above at paragraph 6) informing it of the missed deadline.

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

22. With regards to the invalidation proceedings the application against the proprietor's first mark is based upon allegations of bad faith under section 3(6) of the Act, *inter alia*, that the contested mark covers an exceptionally wide list of terms, and it is inconceivable that the proprietor had a bona fide intention to use the full breadth of the specification. Further that the re-filing of the contested mark is an attempt to artificially extend its protection in respect to class 35 services.

23. As for the revocation applications against the proprietor's second and third marks these are based upon allegations of non-use and are brought under sections 46(1)(a) and 46(1)(b) of the Act.

24. Whilst it is not for me to determine the merits of the cases at present, there is nothing to suggest that the applications are without merit, and the cases will require the filing of cogent evidence. Indeed, it is accepted within the proprietor's skeleton argument that the proprietor '*does not put forward the position that the Cancellation Actions have been improperly filed.*'⁷

The consequences of treating the proprietor as defending or not defending the applications for invalidation and revocation:

25. Should the defences be admitted into proceedings, the proprietor will be permitted to defend the applications, the proceedings will continue with the parties given an opportunity to file evidence and the matter will be determined on its merits.

⁷ Proprietor's skeleton argument, paragraph 25.

26. If, however, the defence is not admitted into proceedings, there would, clearly, be serious consequences for the proprietor as its relevant registrations will either be declared invalid in full or be partially revoked; though that is always the case where the Tribunal makes an adverse decision because of a failure to file a defence in time, and in that respect the consequences are no more severe than any other proprietor who fails to file its defence on time.

Any prejudice caused to the applicant by the delay:

27. Neither party has identified any prejudice caused to the applicant as a result of the delay by the proprietor to file its defence on time.

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

28. As referenced above, the parties were involved in earlier opposition proceedings. However, as clarified by the proprietor at the hearing, these proceedings do not involve reliance on the contested marks, but on their EU counterparts. Consequently, the outcome of those proceedings is not relevant to the outcome of this decision. Nevertheless, as the parties are currently involved in negotiations to reach a settlement in both the cancellation and opposition proceedings, it follows that the proprietor would have an interest in defending its marks, and it should have come as no surprise to the applicant that the proprietor intended to defend the applications filed against its marks.

Considerations

29. In reaching my decision, I have carefully considered the seriousness of the resulting impact if discretion is not exercised in the proprietor's favour i.e., the contested marks will either be declared invalid or partially revoked. However, this is merely a consequence of the failure to comply with the non-extendable deadline to file a form TM8/TM8(N). Therefore, this factor is not, in my view, determinative in isolation.

30. I take account of the circumstances that caused the late filed defences. Whilst I accept that the relevant TM8/TM8(N)'s were filed late due to a human error, i.e. that the proprietor was under the mistaken belief that he had instructed one set of solicitors to file the defence rather than the solicitors that had received the initial letters from the Registrar, it is clear from Tescon BL O/240/20, that the existence of a human error on its own is not enough to find that there are compelling reasons or extenuating circumstances to exercise discretion. Not all errors should be treated as excusable. A fact specific evaluation of the nature of the human error must be undertaken. Further, in relation to the earlier decisions of the Tribunal referred to above, one being my own decision, I make two observations; firstly, they have different factual patterns that each have to be considered on their own merits, and secondly, I am not bound by previous decisions (even my own).

31. The proprietor accepts it was aware of the deadline of 5 September 2023 for it to file its relevant TM8 and TM8(N)'s but claims to have mistakenly believed that it had instructed Beck Greener to handle the filing of the defences in the relevant proceedings. Consequently, the respective TM8/TM8(N)'s were filed 21 days late, after the proprietor was notified by the Tribunal that no defences had been received. I note that other than referring to the fact that the proprietor had on 19 July 2023 informed Beck Greener of the action taken by Wren Kitchens in response to the oppositions being handled by Beck Greener, and the subsequent discussions regarding settlement negotiations on 26 July 2023,⁸ (a day after the proprietor confirmed with Stobbs that Beck Greener would be handling the matter) the proprietor has failed to precisely detail why it had mistakenly believed that it had gone on to instruct Beck Greener. The proprietor was informed of the deadline for filing the Forms TM8/TM8(N). The onus was on the proprietor to ensure that it had a robust process in place to guarantee that ownership of its legal matters was properly communicated. It is not uncommon that marks involved in current proceedings may become linked to future proceedings that involve the same parties, and it is incumbent on the proprietors of those marks to have a reliable system in place to confidently identify who will take legal ownership of each set of proceedings. Particularly in a scenario where legal work is in the process of being migrated from one law firm to another. This, I hold to be the

⁸ Witness statement of Eric Gisolfi, paragraph 11 (as set out above).

minimum degree of vigilance required in meeting a deadline. Indeed, given the migration of legal work and the multiple proceedings relating to VOGUE marks, the proprietor should have exercised more caution in checking that the TM8 had been filed. If this had been checked it may have alerted the proprietor to its error. Although I acknowledge that the parties have been involved in settlement negotiations for some time prior to the cancellation proceedings being launched and continuing up until the hearing before me, this does not negate the need for the proprietor to file the defences by the prescribed deadline. Furthermore, as the opposition relies on different earlier marks to the contested marks,⁹ there will be no impact on the outcome of my decision upon the opposition proceedings.

32. Taking all of the above into account, I am not satisfied that the discretion provided under rules 38(6) and 41(6) should be exercised in the proprietor's favour. For the reasons I have given above, I do not consider that the minimum degree of vigilance was exercised by the proprietor in meeting the defence deadline.

CONCLUSION

33. The consequence of the above finding is that the Registrar's preliminary view is upheld and the late filed forms TM8/TM8(N) and counterstatements will not be admitted into the proceedings. Subject to any appeal, the invalidation and revocation proceedings will be deemed as undefended and treated as abandoned.

COSTS

34. As my decision terminates the proceedings, I must consider the matter of costs. The applicant is entitled to a contribution towards its costs, based on the scale published in the TPN 2/2016. I therefore assess the costs as follows:

Official fee x 3:	£600
Preparing the statement of case x 3:	£600

⁹ Being their EU counterparts

Total:

£1,200

35. I therefore order Advance Magazine Publishers Inc to pay Wren Kitchens Limited the sum of £1,200. This 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 14th day of October 2024

Sarah Wallace

For the Registrar