

O/1009/25

TRADE MARKS ACT 1994

IN THE MATTER OF A JOINT HEARING HELD IN RELATION TO

APPLICATION NO. 4142184

TO REGISTER THE TRADE MARK:



IN CLASSES 30 & 43

IN THE NAME OF BY SUSHI TIGERS LTD

AND

THE LATE FILING OF FORM TM8 AND COUNTERSTATEMENT FILED IN
DEFENCE OF AN OPPOSITION THERETO UNDER NO. 453686

BY IRO SUSHI LONDON LIMITED

Background and pleadings

1. On 30 December 2024, Sushi Tigers Ltd (“the applicant”) applied to register the trade mark as shown on the front page of this decision. It was accepted and published on 17 January 2025 in respect of the following goods and services:

Class 30: Sushi; Ramen [Japanese noodle-based dish]; Chinese stuffed dumplings (gyoza, cooked); Udon noodles; Soba noodles; Rice-based snack food.

Class 43: Sushi restaurant services; Ramen restaurant services; Japanese restaurant services.

2. On 21 January 2025, Iro Sushi London Limited (“the opponent”) filed a Form TM7A (“Notice of threatened opposition”), the effect of which was to extend the opposition period until 17 April 2025.

3. On 17 April 2025, Briffa Legal Limited filed a Form TM7 (“Notice of opposition and statement of grounds”) on behalf of the opponent. The opposition was brought under sections 5(2)(b) and 3(6) of the Trade Marks Act 1994 (“the Act”) and was directed against all the goods and services in the application.

4. On 24 April 2025, the Tribunal served the TM7 on the applicant, by post and email. The pertinent paragraphs of the official serving letter are as follows:

“Please find enclosed a copy of the notice of opposition - Form TM7 - filed against your application.

[...]

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

[...]

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 Intellectual Property Office is an operating name of the Patent Office a further seven months. A 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 24 June 2025.

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)

5. The applicant did not respond to the Tribunal’s serving letter, therefore on 3 July 2025, after the expiry of the statutory deadline, an official letter was issued to the applicant and copied to the opponent, stating that the Registry was minded to deem the application as abandoned as no defence had been filed within the prescribed period. The applicant was given a deadline of 17 July 2025 to file a Form TM8 and provide full written reasons for a late-filed defence.

6. The applicant filed a Form TM8 on 17 July 2025. This was accompanied by a witness statement from Asif Ali, the Director of Sushi Tigers Ltd, dated the same, setting out its reasons for missing the prescribed deadline. The pertinent paragraphs are as follows:

“3. Circumstances Leading to the Delay

Due to so many similar kinds of emails received from IPO and our administrative oversights, we encountered difficulties in preparing and submitting the necessary documents within the prescribed timeframe.

4. Actions Taken to Remedy the Situation

Upon realising the oversight, immediate action was taken to compile the required documents, including Form TM8 and the counterstatement. We have now completed these documents, and they are prepared for submission.

5. Request for Discretion

We humbly request the registrar's consideration under Rule 18(2) of the Trade Marks Rules 2008 to permit the late filing of the defence documents. We believe this extension would not unfairly prejudice the opposing party and would align with the principles of fairness and justice."

7. On 15 August 2025, the parties were informed that it was the preliminary view of the registrar that the applicant's Form TM8 and counterstatement could not be admitted into the proceedings. In the same official letter, the parties were given until 29 August 2025 to request a hearing if they wished to challenge the preliminary view.

8. Subsequently, on 1 September 2025, Mr Ali wrote to the Tribunal to request a hearing on this matter. A hearing date was set for 9 October 2025.

9. Prior to the hearing, the applicant filed skeleton arguments. The opponent's representatives wrote to the Tribunal prior to the hearing to confirm that they would not be attending, and provided the following statement:

"Notwithstanding our and our client's non-attendance at the hearing, we submit on behalf of our client that we agree with the Registry's view that the TM8 and counterstatement filed late by the applicant should not be admitted into the proceedings. The applicant was given sufficient time to file a TM8 and in any event could have applied for an extension of time. The consequences of filing a late TM8 are clear and ultimately, the applicant's reasons whether filed to

date or to be submitted at the upcoming hearing, are not valid reasons to overcome the Registry's preliminary view.”

THE HEARING

10. The hearing took place before me, by conference call, on 9 October 2025. Only Mr Ali, the director of the applicant's company, was in attendance.

11. At the hearing, I gave a summary of the timetable of the proceedings up to this point, which has also been summarised above. I also informed Mr Ali that I had received his skeleton arguments and had read all of the documents relevant to the case before me.

12. Mr Ali cited *HILIFE*,¹ submitting that this case was comparable to the present case and that, in the cited case, the Registry approved the appeal and allowed the late filings.

13. Mr Ali further submitted that the applicant received multiple near identical communications from the Registry for the three separate proceedings, and that the applicant was unable to manage this “flood of paperwork”. As a result, a notice of defence for one of their other trade mark applications was mistakenly filed. Mr Ali submits that this was an honest mix up under pressure and that as soon as the error was identified, the correct TM8 was filed. On this point, I note that Mr Ali has filed two other applications that have both been opposed by the opponent, namely opposition number 453806 and 454074. Both oppositions are still at the pleadings stage.

14. I then asked Mr Ali why the late TM8 was not filed until the deadline of 17 July 2025, despite the letter informing the applicant that their application would be deemed abandoned being issued on 3 July 2025. Mr Ali responded that the applicant contacted solicitors, who told the applicant that the time period was very short and that the three linked proceedings were confusing, so they would need more time to prepare the case. Mr Ali said that as a result, he had to act on behalf of the applicant himself rather than appoint professional representation.

¹ BL O/498/21

15. Mr Ali further submitted that the opponent is “deliberately hurting” the applicant by opposing all of its trade marks and filing a lot of documents at one time to confuse the applicant.

16. 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. In making my decision, I have reviewed all of the papers on file, the applicant’s skeleton argument, which I take into account.

DECISION

17. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by Rule 18 of the Rules. The relevant parts read as follows:

“18. – (1) The applicant shall, within the relevant period, file a Form TM8, which shall include a counter-statement.

(2) Where the applicant fails to file a 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.”

18. 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.”

19. It was not disputed that the late filing of the applicant's TM8 in this instance was because of an irregularity, default, omission or other error on the part of, *inter alia*, the Registrar. 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).

20. 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")² and *Mark James Holland v Mercury Wealth Management Limited* ("Mercury")³ i.e. I must be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the applicant's favour.

21. In *Music Choice Ltd's Trade Mark* [2005] RPC 18 ("*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

22. The circumstances as to why the deadline was missed are summarised above. The stipulated deadline for the filing of the applicant's Form TM8 and counterstatement was 24 June 2025. The form was filed by the applicant on 17 July 2025. Therefore, the deadline was missed by three weeks.

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

23. The opposition is brought under section 5(2)(b) and section 3(6) of the Act. Whilst it is not for the present hearing to determine the merits of the case, there is nothing to suggest that the opposition is without merit.

² BL/O/035/11

³ BL/O/050/12

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

24. If the applicant is allowed to defend the opposition, the proceedings may be consolidated with the aforementioned related oppositions 453806 and 454074. The proceedings will continue with the parties given an opportunity to file evidence and the matter will be determined on its merits.

25. If, however, the defence is not admitted into the proceedings, the application will be deemed abandoned, and the applicant will lose their filing date of 30 December 2024. It will remain open to the applicant to re-file their application, which may, in turn, be opposed again by the opponent.

Any prejudice caused to the opponent by the delay

26. The opponent did not submit any comments regarding prejudice caused. In its skeleton arguments, the applicant submitted that the prejudice caused to the opponent due to the delay is minimal. I do not consider that any significant prejudice has been caused to the opponent by the delay.

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

27. As previously stated, the applicant has drawn to my attention two corresponding oppositions, 453806 and 454074. However, this application does not affect these other two oppositions as they are not dependent on the outcome of these opposition proceedings.

Conclusions

28. 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, and the applicant will lose their filing date in respect of all the goods and services in the application (since the opposition is directed against the application in full). I further recognise that it may be that the applicant will simply re-file their application and that this may, once again, be opposed by the opponent resulting in opposition proceedings arising at some point

in the future. However, as the loss of priority 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 TM8, these are not factors that, in my view, are particularly compelling.

29. Whilst Mr Ali has cited *HILIFE*, a case in which discretion was exercised, I note that the decision in question relates to cancellation proceedings in which the late-filed defence was a result of human error on the part of the applicant's representatives. I consider the circumstances of this cited case do not appear to be on all fours with the present proceedings.

30. As regards the related oppositions, I 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*⁴ 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]):

“I readily accept that human error is not necessarily inconsistent with the existence of extenuating circumstances or compelling reasons for permitting invalidity proceedings to be defended in the exercise of the discretion conferred by rule 41(6) [...] It is nonetheless clear that the test to be applied cannot be taken to permit or require all human errors to be treated as excusable for the purposes of rule 41(6). There must, in other words, be a fact specific evaluation for the purpose of determining whether the particular error in question should or should not be treated as excusable in the circumstances of the case at hand.”

31. Whilst *Praesidiad NV* concerned an application for invalidity, the same assessment is relevant to the late filing of a Form TM8 and counterstatement in opposition proceedings. Mr Hobbs acknowledged that human errors can constitute extenuating

⁴ BL O/193/19

circumstances or compelling reasons sufficient for the exercise of discretion, where the specific facts of the case merit it.

32. I acknowledge the circumstances that caused the late-filed TM8 in the present proceedings and I am of the view that if the applicant had been conscientious in their filing of the TM8 forms, the issue of the notice of defence being filed for the wrong trade mark would have been identified before the deadline.

33. Mr Ali also stated that he considered that the opponent was “deliberately hurting” the applicant by opposing all of its trade marks and filing many documents at one time to confuse the applicant. I do not consider that the question of the opponent deliberately hurting the applicant is relevant to the present decision. I do recognise that, as a litigant in person, the applicant may have been overwhelmed by receiving oppositions for their three trade marks at one time. However, as the owner of said trade marks, it is the applicant’s responsibility to defend them when necessary and, overall, I do not consider that the applicant would have missed the deadline for filing the defence if due care and attention had been paid. I also note that each of the Registry’s letters clearly states the application number and opposition number at the top of the letter, which make it clear to which trade mark they refer. Additionally, the letters also include a contact number so it would have been open to the applicant to call the Registry to ask for clarification if they were confused or overwhelmed.

34. In my view, this amounts to a failure to exercise the “minimal degree of vigilance” required to meet the deadline as set out by Mr Hobbs in *Kickz*. Therefore, while it is possible for human error to amount, in some cases, to extenuating circumstances for exercising discretion, given the facts, I do not find that to be the case here.

35. Taking all of the above into account 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 18(2).

CONCLUSION

36. The Registry’s preliminary view is upheld and the late-filed TM8 is not admitted into the proceedings. The applicant will be treated as not defending the opposition.

The application is deemed abandoned in respect of all of the goods and services applied for.

COSTS

37. As my decision terminates the proceedings, I must consider the matter of costs. The opponent 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 TM7: £100

Preparing a statement: £250

Total: £350

38. I therefore order Sushi Tigers Ltd to pay the sum of £350 to Iro Sushi London Limited. The above sum should be paid within twenty-one days of the expiring of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 30th day of October 2025

K HARBACH

For the Registrar