

O-1131-24

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION

NO. UK00004006552

BY

ROBIN JOHANNES
PARVIAINEN SAXERUD

TO REGISTER

RST

AS A TRADE MARK

IN CLASS 36

AND OPPOSITION THERETO

UNDER NO. OP000448397

BY UKROED LIMITED

BACKGROUND AND PLEADINGS

1. On 25 January 2024, Robin Johannes Parviainen Saxerud (“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 5 April 2024 for the following services:

Class 36 Trade finance services; Financial trading of cryptocurrency; Financial exchange of crypto assets; Electronic transfer of cryptocurrency; Currency trading; Currency dealing; Virtual currency exchange; Currency trading and exchange services; Digital currency wallet; cryptocurrency services; provision of information in the fields of finance, cryptocurrency, digital currency, virtual currency, crypto-tokens, non-fungible tokens, non-fungible assets and crypto-collectibles; provision of information, advice and consultancy services relating to all of the above services.

3. Having previously filed a Form TM7A, notice of threatened opposition, on 17 May 2024, UKROED Limited (“the opponent”) opposed the application, its Form TM7 being received on 2 July 2024. The opposition is based on sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”).
4. The Form TM7 was served on the applicant by post and by email on 12 July 2024 and I copy an extract from the Registry’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/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.

...

IMPORTANT DEADLINE: A completed Form TM8 (or Form TM9c) MUST be received on or before 12 September 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.”

5. On 20 September 2024, the Registry wrote to the applicant as follows:

“The official letter dated 12 July 2024 invited the applicant to file a TM8 and counterstatement on or before 12 September 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, **21 October 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.”

6. Two minutes before the expiry of the deadline for requesting a hearing, at 23:58 on 21 October 2024, the applicant’s representative wrote to the Registry by email including a document headed “Witness Statement”, albeit it was not in the correct format to be regarded as a properly constituted witness statement. The pertinent part of the document is extracted below.

“1) GCS Europe Ltd. as a representative of the applicant hereby states that the correspondence was received at the address of our office with delay (on 21 October 2024) and after the date specified in the UK IPO’s letter for submission of Form TM8.

2) In view of the above, the Applicant hereby request the UK IPO to schedule a hearing for consideration of the case.”

7. The rest of the document (paragraphs 3 to 7) consisted of the applicant’s “statement on the filed opposition”. While this may have been the applicant’s attempt to supply its defence and counterstatement, it was not properly filed, there being no Form TM8 provided.

THE HEARING

8. A joint hearing took place before me, via Microsoft Teams as an audio call, on Thursday 7 November 2024.

9. Alice Andonyan, from GCS Europe Ltd, attended as the representative of the applicant. She did not file any skeleton arguments.
10. Martin Delafaille, from Sonder & Clay, attended as the representative of the opponent. He filed skeleton arguments prior to the hearing.
11. I asked Ms Andonyan to explain the circumstances of the relevant correspondence being subject to “delay” as per paragraph 1 of her “witness statement”.
12. Ms Andonyan said that the email that the Registry sent was not received and that there was a delay in the hard copy letter reaching the right person who was capable of providing a response. This was an internal organisational issue and was unintentional.
13. I asked Ms Andonyan to confirm that the correspondence she was referring to was the Registry’s letter of 12 July which served the Form TM7 and she said that it was.
14. I said that the letter in question was sent by post and by email.
15. Ms Andoyan again said that the letter of 12 July was subject to a delay.
16. I asked Ms Andoyan to say on what date her company – as the representatives of the applicant – came into possession of the letter.
17. Ms Andoyan said that she would need to check into this.
18. I said that it was not satisfactory to simply say that the letter was subject to a delay. I needed to know how long the letter was delayed for and what the reason was for that. I had nothing on file to say that there was a problem in terms of the email correspondence or hard copy correspondence.
19. It was not satisfactory to come before me to say that the matter would need to be looked into further. There was an original deadline of 12 September that was not met. The deadline for requesting a hearing was only met by two minutes. In filing the “witness statement”, no Form TM8 was forthcoming.

20. Turning to Mr Delafaille, I asked him if there was anything further that he wished to say over and above his skeleton arguments. His skeleton arguments had flagged his client's concerns in respect of the status of the company representing the applicant, saying that the representative's address was not a proper address for service. Furthermore, the applicant's witness statement had not been correctly constituted. Ultimately, the applicant had not "properly explained why it has failed to respond to any correspondence."
21. Mr Delafaille said that the question of addresses for service had been a matter of concern to CITMA for some time and that the particulars of the applicant's address for service appeared to be an example of this.
22. Mr Delafaille had always been told that certain deadlines could never be missed, such as missing the deadline for filing of an opposition or missing the deadline for filing a defence and counterstatement. If you missed those deadlines, there would be no fallback. While the IPO had been rather more flexible about that in recent years, he could not see how the applicant in this situation could say there had been a mistake without really providing an adequate explanation as to what the mistake was.
23. I confirmed that the reason for not meeting such a deadline has to be one of extenuating circumstances and compelling reasons.
24. Turning back to Ms Andoyan, I said that I had listened carefully to the points that she had made. I had not found them sufficiently compelling to allow the proceedings to continue.
25. It was not satisfactory to say that she needed to make further enquiries. Today would have been the day on which to have supplemented the stated reasons for not filing on time with further evidence and/or submissions. Looking at the file, I could see nothing to say that the Registry's hard copy letter would not have been received in good time, nor indeed was there anything to indicate that there had been a problem with the applicant's email address.

26. The conclusion I had come to would have been the same had Ms Andoyan's witness statement been made in the correct format.

27. While noting the opponent's reservations about the validity of the applicant's address for service¹, the key question before me was, "Is the reason for seeking to file late acceptable?" and I did not consider it to be acceptable.

28. I upheld the Registry's preliminary view that the application should be deemed to be abandoned. This would be confirmed in the form of a full written decision.

DECISION

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

¹ Albeit that the address on file is a "c/o" address, it is nevertheless an address which satisfies the requirement of Rule 11(4) of the Trade Mark Rules 2008 in that it is in the United Kingdom

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. Sitting as the Appointed Person in *Kickz AG and Wicked Vision Limited* (BL-O-035-11) (“*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

32. The applicant's representative said that the email that the Registry sent was not received and that there was a delay in the relevant hard copy letter reaching the right person who was capable of providing a response. This was an internal organisational issue and was unintentional. She was unable to elaborate beyond that.

33. I did not consider the applicant's "statement on the filed opposition" at paragraphs 3 to 7 of its "witness statement" to be a properly constituted defence and counterstatement in that it was not submitted on a Form TM8 and therefore the applicant's Form TM8 remained outstanding at the time of the hearing.

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

34. The opposition was brought under sections 5(1) and 5(2)(a) of the Act. There was nothing to suggest that the opposition was without merit.

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

35. If the applicant was allowed to defend the opposition, the proceedings would continue, and the matter would be determined on its merits. If, however, the applicant was not allowed to defend the opposition, his application would be deemed abandoned and the applicant would lose his filing date of 25 January 2024. It might remain open to the applicant to re-file his application.

Any prejudice caused to the opponent by the delay

36. The opponent had not identified any prejudice caused to itself other than costs. The applicant made no comment on this subject.

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

37. There were no other relevant considerations.
38. Having addressed each of the relevant factors as proposed in *Music Choice*, I needed to decide whether the applicant's "witness statement" and 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.
39. After carefully considering the expected detriment to the applicant in the event that discretion was not exercised in his favour, I found that the loss of a filing date and the possibility of further proceedings on much the same basis is often the consequence of a failure to comply with the non-extensible deadline for filing a Form TM8. These factors were not, therefore, particularly compelling.
40. The applicant's representative said that the email that the Registry sent was not received and that there was a delay in the relevant hard copy letter reaching the right person who was capable of providing a response. This was an internal organisational issue and was unintentional. She was unable to elaborate beyond that.
41. This state of affairs did not constitute a sufficiently extenuating circumstance or compelling reason for not filing the form on time.
42. It was not satisfactory to come before me at the hearing and say that the matter would need to be checked into.

43. Having considered all of the applicant's reasons for his failure to file a Form TM8 by the deadline set, I found no single reason or combination of reasons sufficient to enable me to exercise my discretion and allow these proceedings to continue.

CONCLUSION

44. The Form TM8, which had yet to be submitted at the time of the hearing, would not now be admitted were it to be late filed. Subject to appeal, the application is treated as abandoned.

COSTS

45. As my decision terminates the proceedings, I must consider the matter of costs which the opponent requested at the end of its skeleton arguments.

46. I award the opponent costs in line with Tribunal Practice Notice 1/2023:

| | |
|--|-------------|
| Preparing a statement: | £250 |
| Official fee: | £100 |
| Preparing for and attending a hearing: | £350 |
| Total: | £700 |

47. I order Robin Johannes Parviainen Saxerud to pay UKROED Limited the sum of £700 as a contribution towards 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 27th day of November 2024

John Williams
For the Registrar