

o/1150/24

TRADE MARKS ACT 1994

**IN THE MATTER OF THE UK DESIGNATION
OF INTERNATIONAL REGISTRATION
NO. 1728008
IN THE NAME OF MONOS TRAVEL LTD.
FOR THE TRADE MARK:**

MONOS

IN CLASSES 18 & 35

AND

**THE LATE FILING OF FORM TM8 AND
COUNTERSTATEMENT
FILED IN DEFENCE OF THAT DESIGNATION
IN OPPOSITION THERETO
UNDER NO. 444311
BY MONO CREATORS INC.**


Background

1. Monos Travel Ltd. (“**the holder**”) is the holder of the International Registration (“**IR**”) in respect of the mark shown on the front page of this decision. Protection in the UK was requested on 28 November 2022. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 25 August 2023 in respect of the following goods and services:

Class 18: Traveling trunks; valises; suitcases with wheels; wheels for suitcases; wheel housings for suitcases and bags; holdalls; bags, namely, airline bags, all-purpose bags, casual bags, cross body bags, messenger bags, shoulder bags and waist bags; roller bags; suitcase handles; telescopic handles for cases; briefbags; toiletry bags, not fitted; travelling sets; rucksacks; hipsacks; shoe bags for travel; gym bags; garment bags for travel; handbags; leather, unworked or semi-worked; wallets; business card cases; luggage tags; labels of leather; bags of leather, for packaging; fitted protective covers for luggage; toiletry bags sold empty; backpacks, duffel bags.

Class 35: Advertising agency services; retail services and wholesale services and online retail services relating to luggage, traveling trunks, valises, suitcases with wheels, wheels for suitcases, wheel housings for suitcases and bags, holdalls, bags, namely, airline bags, all-purpose bags, casual bags, cross body bags, messenger bags, shoulder bags, waist bags and roller bags, suitcase handles, telescopic handles for cases, briefbags, toiletry bags, not fitted, travelling sets, rucksacks, hipsacks, shoe bags for travel, gym bags, garment bags for travel, handbags, leather, unworked or semi-worked, wallets, business card cases, luggage tags, labels of leather, bags of leather, for packaging, toiletry bags sold empty, backpacks, and duffel bags.

2. On 27 November 2023, MONO Creators Inc. (“**the opponent**”) filed an opposition based on Section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”)¹. The opponent relies upon the following mark:

| | |
|--|--|
| Trade Mark No. | UK00916316051 ² |
| Trade Mark |  |
| Goods & Services for which the mark is registered | Classes 9, 15, 18 & 35 |
| Filing date | 2 February 2017 |
| Date of entry in register | 19 September 2017 |

3. The opposition is directed against all goods in Class 18 and some services in Class 35 as follows:

Class 35: retail services and wholesale services and online retail services relating to luggage, traveling trunks, valises, suitcases with wheels, wheels for suitcases, wheel housings for suitcases and bags, holdalls, bags, namely, airline bags, all-purpose bags, casual bags, cross body bags, messenger bags, shoulder bags, waist bags and roller bags, suitcase handles, telescopic handles for cases, briefbags, toiletry bags, not fitted, travelling sets, rucksacks, hipsacks, shoe bags for travel, gym bags, garment bags for travel, handbags, leather, unworked or semi-worked, wallets, business card cases, luggage tags, labels of leather, bags of leather, for packaging, toiletry bags sold empty, backpacks, and duffel bags.

¹ The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

² Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM. As a result, the opponent’s earlier EUTM was automatically converted into a comparable UK trade mark. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

4. On 28 November 2023, the Registry served the TM7 on the holder. The deadline for the holder to file a completed Form TM8 or Form TM9c was set at 29 January 2024 which was communicated by the Registry in the serving letter. The pertinent paragraphs of the letter are as follows:

“[...] 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 29 January 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 international registration will be treated as abandoned. [...]” (original emphasis)

5. On 26 January 2024 the parties filed a Form TM9c. On 9 February 2024, the Registry wrote to the parties stating that:

“I refer to the TM9c dated 26 January 2024 indicating that the parties wish to enter into a cooling off period.

In accordance with Rule 18(4) of the Trade Marks Rules 2008, this period will expire on **28 August 2024**.

The Registrar, may on request, extend the cooling off period for a further nine months where such request is filed on TM9e and with the agreement of both parties. Please note that the TM9e should be received on or before **28 August 2024**.

If no such request is made, the TM8 and counter-statement should be filed on or before **28 August 2024**. [sic] or the international registration shall, unless the Registrar otherwise directs, be treated as abandoned in whole or part, in accordance with Rule 18(2) of the Trade Marks Rules 2008.

If the opponent wishes at any time to terminate the cooling off period they should submit a TM9t. The holder can terminate the cooling off period at any time by filing the TM8 and counterstatement. [...]"

6. In addition, the Registry made a reference to the Form TM33 filed on 22 January 2024 recording the change in the representation of the applicant.
7. The holder's Form TM8 was not received by the deadline of 28 August 2024.
8. On 6 September 2024, the Registry wrote to the holder stating:

"The official letter dated 09 February 2024 invited you to file a form TM8 and counter-statement on or before 28 August 2024. As the Form TM8 and counterstatement has not been received, the provisional refusal has been upheld in accordance with article 10B(1) of the Trade Marks (International Registration) (Amendment) Order 2004.

The international registration will proceed to protection for the following specification:

Class 35

Advertising agency services.

If you disagree with the preliminary view you **must** provide full written reasons and request a hearing on, or before, **20 September 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.

If no response is received the registry will proceed to notify the International Bureau that the provisional refusal has been upheld.”

9. On 20 September 2024, the holder requested a hearing and submitted the late TM8 form along with a witness statement dated 20 September 2024. The witness statement was signed by Ms Ruth Hoy of DLA Piper UK LLP, the holder’s representative in these proceedings, outlining the reasons for the delayed filing of Form TM8 by its original deadline as follows:

“[...]

6 The 28 August 2024 deadline had not been docketed in our systems, and we were unaware of it.

7 In the usual course of events, the process for docketing the deadline for filing the TM8 would be as follows:

7.1 the paralegal team would wait to receive a letter from the UKIPO confirming the cooling off had been accepted by the Registry prior to docketing the deadline in our systems for the filing of the TM8 (or the extension of cooling off as appropriate);

7.2 the letter confirming the deadline from the Registry would come into our trade mark inbox (TrademarksLondon TrademarksLondon@dlapiper.com) [sic] which is monitored daily by paralegals, who deal with the correspondence as and when it is received;

7.3 the paralegals docket the deadline in our CPi trade marks database and forward a copy of the letter to relevant fee earners working on the matter; and

7.4 at the same time, the paralegals also save a copy of the registry's letter into the client/matter space in our iManage document management system to be stored with all other matter relevant documents.

8 In this case, it is apparent that the deadline was never docketed. My initial thought was that the letter from the Registry dated 9 February 2024 confirming that the cooling off period was to last until 28 August 2024 (the "**Letter**") had never been received. On receipt of the registry's letter dated 6 September 2024, I asked for certain investigations to be carried out to see what happened.

9 We checked and there is no copy of the Letter in either our trade mark inbox or the client/matter space for the Opposition. We also checked the inboxes of the fee earners responsible for the matter and none of them were able to find any email attaching a copy of the Letter. This appeared to be consistent with the Letter never having been received.

10 I also asked our IT team to conduct a deeper review of the IT systems. Jakub Wierzbicki, a Junior Operations Engineer in our IT team conducted certain checks. His checks were inconclusive due to the age of the email dated 9 February 2024 as DLA Piper only stores information about emails for 30 days.

11 However, he was able to confirm that the email from the UKIPO dated 9 February 2024 arrived into our systems. What he is unable to say is whether the email arrived into a junk folder, or whether it was quarantined by our IT systems and never released. The message trace has shown nothing, so he also cannot see whether it was read, opened or dealt with in any way.

12 Another paralegal in my team (Tunay Adem) was responsible for checking the trade mark inbox on 9 February 2024. She has no recollection of the Letter.

13 The results of my enquiries suggest that the Letter was never seen nor reviewed by any employee of this firm. I am unable to confirm the exact reason for this.

14 I respectfully request that the UKIPO shows leniency on the Applicant and permits the late filing of its Defence Documents, as the delay was not wilful or deliberate. [...]"

10. On 7 October 2024, the Registry issued its preliminary view stating the following:

"[...] 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. There appears to be no 'compelling reasons' or 'extenuating circumstances' that would permit the exercise of the Registrar's very limited discretion.

[...]

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 **21st October 2024**.

If no hearing is requested, the application **WO0000001728008** will be deemed withdrawn as no TM8 was filed within the prescribed deadline. [...]"

11. The holder filed written submissions on 21 October 2024 and requested a hearing. A hearing was scheduled for 12 November 2024 and the details were sent to the parties in an official letter from the Tribunal on 23 October

2024. The holder filed its skeleton argument on 8 November 2024. The opponent only filed written submissions in lieu of appearance at hearing requesting (in summary) that the Registry's preliminary view to be maintained. Only the holder attended the hearing.

Skeleton Arguments

12. The holder's skeleton argument reiterated the information from the previously submitted witness statement. With regard the facts relevant to exercise the Registrar's discretion conferred by Rule 18(2) Trade Mark Rules 2008, and with regard the legal test set in *Music Choice Ltd's Trade Mark* [2006] R.P.C. 13 ("*Music Choice*") the IR holder submits that:

- Although the mailbox having been monitored on the date in question, the letter was not seen by anyone at DLA Piper. Therefore, the 'error' appears to have been a technical 'IT' error, rather than a human error.
- There is an arguable case to be determined.
- Refusal to admit the defence will lead the holder to refile another designation or a national filing, resulting in unnecessary delay, additional costs to the parties, and prejudice to the holder as the earlier filing date will be lost.
- The opponent will not suffer any prejudice as a result of the delay.
- The parties are involved in multi-jurisdiction proceedings with attempts to seek a global settlement.

13. The skeleton argument provides a previous decision where the Registrar exercised its discretion and admitted the late filing. However, I note that I am not bound by previous decisions of fellow Hearing Officers and will evaluate this case solely based on its specific facts and merits.

The Hearing

14. The hearing took place before me, via telephone conference, on Tuesday, 12 November 2024. Ms Hoy represented the holder.
15. At the hearing, I explained that the purpose of the hearing was to consider whether the late filed defence should be admitted into the proceedings. I also highlighted that the TM8 deadline is a non-extensible time limit, pursuant to the relevant case law and Trade Mark Rules 2008 (“the Rules”). However, my discretion to allow the Form TM8 to proceed to be examined is a narrow one which can only be exercised where there are compelling reasons or extenuating circumstances.
16. I further confirmed that I had received the written submissions of the opponent and the skeleton argument from the holder, and that I had read all the documents relevant to the case before me.
17. I note that this was a fairly brief hearing, and since only the holder attended the hearing, I will briefly reassume the arguments and submissions.
18. Ms Hoy’s submissions were foreshadowed in her skeleton arguments. Ms Hoy started by referring to the legal test set out in *Music Choice*. First, she stressed that the deadline mentioned in the Registry’s letter dated 9 February 2024, which confirmed that the cooling off had been granted until the 28th of August, was never received by the paralegals or the solicitors working on the case. As a result, it was never seen, and the deadline was never docketed in their systems, including their document management system. She further explained that, according to their technical investigation, the Registry’s email was successfully delivered into their systems, but it remains unclear if it was automatically routed to a junk folder or what exactly happened to it. She reiterated that none of the individuals involved in the matter ever saw the said correspondence. In this regard, Ms Hoy stated that this situation was more a case of an IT error rather than a human mistake. She highlighted that this had never

happened before in her practice, and this is a fairly unique case and should be taken in to account by the Registry.

19. Ms Hoy moved on to cover the other criteria in *Music Choice*, indicating the nature of the allegations, namely likelihood of confusion, the consequences of refusing the late TM8 form (i.e. refiling of another designation or national filing), the lack of prejudice caused by the delay to the opponent, while adding that there are other related proceedings in place between the same parties. She concluded by stating that if the Tribunal were to refuse the late TM8, there would be a detriment in terms of cost and greater delay to all parties. Thus, Ms Hoy requested the Registry to exercise its discretion in this matter.
20. Before concluding the hearing, I asked Ms Hoy to elaborate on how this issue is attributed to an IT error rather than a human error, particularly in light of the successful delivery of the Registry's email to their system's inbox. Ms Hoy explained that if the email was in the inbox, a person would have seen it. However, their IT staff could not confirm whether it had been quarantined or ended up in the junk folder, as they can only trace emails that are up to 30 days old; anything older gets automatically deleted if it went to either of those locations. When I asked whether anyone monitors the junk or quarantine folders, Ms Hoy replied that there is only an ad hoc review of those systems, rather than consistent monitoring.
21. At the hearing, I reserved my decision to give me an opportunity to properly reflect on the oral and written submissions put forward by the parties. In making my decision, I have reviewed all of the papers on file, the holder's skeleton argument, and both parties' submissions, which I take into account.

Decision

22. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by Rule 18 of the Rules, which provides as follows:

“(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 shall begin on the notification date and end two months after that date”. (Emphasis added)

23. 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 rules 77(5)(a) and (b) which provide that:

“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.”

24. It was not disputed that the late filing of the holder’s TM8 in this instance was not because of an irregularity, default, omission or other error on the part of, *inter alia*, the Registrar. Therefore, my consideration is restricted to the limb of the discretion contained in the words “unless the registrar otherwise directs” under Rule 18(2).

25. In approaching the exercise of discretion in these circumstances, I take into account the decisions of the Appointed Person in *Kickz AG v Wicked*

Vision Limited (BL O-035-11) and *Mark James Holland v Mercury Wealth Management Limited* (BL O-050-12), i.e. I have to be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the holder's favour.

26. In *Music Choice Ltd's Trade Mark* [2005] RPC 18, 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

27. The circumstances as to why the deadline was missed are summarised above. The stipulated deadline for the filing of the holder's Form TM8 and counterstatement was 28 August 2024. However, the Form TM8 and counterstatement, together with a witness statement providing reasons for not filing the defence, were filed by the holder on 20 September 2024. Therefore, the deadline was missed by 23 days.

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

28. The opposition is brought under Sections 5(2)(b) of the Act. There is nothing to suggest that the opposition is without merit.

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

29. If the holder is permitted to defend the opposition, 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 holder is not allowed to defend its designation, it will be treated as abandoned, and the

holder will lose its UK designation date of 28 November 2022 for the opposed goods and services. Nevertheless, it will remain open to the holder to re-file its designation, which may, in turn, be open to opposition.

Any prejudice caused to the opponent by the delay

30. The opponent has not identified any prejudice.

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

31. The holder has submitted that the parties are involved in similar proceedings regarding the same marks in other jurisdictions.

Conclusions

32. In reaching my decision, I bear in mind that the deadline for filing a Form TM8 is a statutory one, with the holder having been made fully aware of the consequences of failing to comply by way of correspondence from the Registry. I recognise that if the discretion is not exercised in the holder's favour, the UK designation will be treated as abandoned and the holder will lose its filing date for its mark. I also recognise that it may well be that the holder's refiled designation may again be opposed by the opponent resulting in further opposition proceedings arising at some point in the future.
33. Considering the specific circumstances in this matter, the reason for missing the initial deadline for the filing of Form TM8 was due to a critical oversight, resulting in the failure to file the Form TM8 and counterstatement in time. I bear in mind that the holder was fully represented throughout these proceedings and that they entered into the cooling off period knowing that it will extend the period for filing the Form TM8 for a specified period of time, as per Registry's official letter dated 28 November 2023. At the hearing, Ms Hoy confirmed that the Registry's

email dated 9 February 2024 was successfully delivered into their email systems and asserted that the TM8 was not filed within the stipulated timeframe due to an 'IT error', without ascertaining whether the relevant communication from the Registry had been quarantined or redirected to the junk/spam folder. However, I must note that this issue resembles a human error, as the situation did not involve a technical failure as such but rather a failure to adequately monitor the email folders.

34. In *Praesidiad NV v Tescon Sicherheitssysteme Schweiz GMBH* ("Tescon"), BL O/240/20, Mr Geoffrey Hobbs QC (as he then was) as the Appointed Person stated at paragraph 32 that:

"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."

35. Although *Tescon* concerned an application for invalidity, the same assessment is relevant to the late filing of a Form TM8 and counterstatement in opposition proceedings. Moreover, while, ultimately, the decision not to admit the Form TM8 into proceedings was upheld in *Tescon*, Mr Hobbs acknowledged that human errors can constitute extenuating circumstances or compelling reasons sufficient for the exercise of discretion, where the specific facts of the case merit it.
36. Whilst I acknowledge human error can occur, I find this is hardly a compelling reason in this case, especially as the holder is professionally represented, and it does not appear that the "minimal degree of vigilance"³

³ See *Kickz AG v Wicked Vision Limited*, BL-O-035-11, in paragraph 15.

required has been exercised. There is no doubt that the Registry's emails had been effectively delivered, and it was the holder's responsibility to verify the security settings of its electronic inbox to ensure that it is configured to receive communication from the Registry without quarantining it or filtering it into 'junk mail'. Moreover, it is also incumbent upon the holder to periodically check its 'junk mail'. It is apparent from Ms Hoy's witness statement and submissions that she and her colleagues did not become aware of the deadline until after it was missed, this means that the 'junk mail' folder was left unmonitored for an extended period. I also note that the holder was well aware of the cooling off period, the opposition process and the strict statutory two month deadline to file a Form TM8, as explicitly stated in the Tribunal's letter dated 28 November 2023, along with the consequences for not submitting the Form TM8 by this deadline.

37. The filing of a Form TM8 is a relatively simple task, capable of being successfully carried out, irrespective of whether an applicant/holder is represented. Taking all of the above into account, I am not satisfied that the reasons why the Form TM8 and counterstatement were filed 23 days late are particularly compelling, nor do they constitute extenuating circumstances sufficient to permit the Registrar to exercise its discretion under rule 18(2). I therefore find that the holder was clearly "*the author of its own misfortune*".⁴

Outcome

38. The Registry's preliminary view is upheld. The late Form TM8 is not to be admitted into the proceedings. Consequently, as the opposition against the UK designation at hand is deemed as undefended, the IR will, subject to any appeal, be treated as abandoned.
39. For completeness, the IR will proceed to protection for the following services:

⁴ See *Kickz*, paragraph 15.

Class 35: Advertising agency services.

Costs

40. As my decision terminates the proceedings, I must consider the matter of costs. Awards of costs are set out in Tribunal Practice Notice (“TPN”) 1/2023. Using the guidance set out in the TPN, I award the opponent costs on the following basis:

| | |
|----------------------------------|-------------------------|
| Official opposition fee | £100 |
| Preparing a notice of opposition | £250 |
| Preparing submissions-in-lieu | £100⁵ |
| Total | £400 |

41. I order Monos Travel Ltd. to pay to MONO Creators Inc. the sum of £400. This sum is to be paid within two months of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of November 2024

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General

⁵ The amount is reduced to reflect the length of the submissions which were particularly brief.