

O-325-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3096855
BY LOOT FINANCIAL SERVICES LTD**

TO REGISTER THE TRADE MARK:

LOOT

IN CLASSES 9, 20 AND 36

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 404544 BY DOWNDANIEL INVESTMENT HOLDINGS LIMITED**

BACKGROUND

1. Application number 3096855 is for the trade mark **Loot**. It stands in the name of Loot Financial Services Ltd (“the applicant”), has a filing date of 1 March 2015 and was published in the *Trade Marks Journal* on 20 March 2015.

2. Following the filing of a Notice of Threatened Opposition on form TM7a, the parties were notified that the period for filing opposition would expire on 20 June 2015. On 19 June 2015, Downdaniel Investment Holdings Limited (“the opponent”) filed a form TM7 Notice of Opposition. The opposition was based on grounds under sections 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and was directed against all of the goods and services in the application.

3. The Tribunal raised a number of queries with the opponent regarding its Notice of Opposition. These matters having been resolved, on 1 December 2015 the Tribunal served the Notice of Opposition on the applicant by email (its stated preference) and the applicant was advised that it had until 1 February 2016 to file either a form TM8 or TM9c. The letter contained the following paragraph:

“If you choose not to file a TM8, or a TM9c to continue with your application, you should be aware that your application 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”.

4. A form TM8 was received on 10 February 2016. On 26 February 2016, the Tribunal wrote to the applicant and advised it that the form TM8 had been filed late. It informed the applicant that, if it wished the Registrar to consider the form TM8, it should provide a witness statement explaining the reasons for the late filing of the form. It indicated that the Registrar would then consider the request for discretion.

5. On 9 March 2016, a witness statement was received from the Founder and Chief Executive of Loot Financial Services Ltd, Oliver Purdue. The reasons given for the failure to meet the deadline were:

“2. I sent the TM8 form expecting it to arrive on time and it seems to have been delayed in the post, it should have arrived a week earlier than it did. I would therefore appreciate it still being considered”.

6. The Tribunal considered the reasons provided by Mr Purdue but did not issue a preliminary view at that stage. Instead, in a letter dated 24 March 2016, it stated:

“You are asked to resubmit a Witness Statement confirming the date the form was posted and how it was sent, i.e. 1st Class Delivery or Special Delivery Guaranteed, on or before **7 April 2016**”.

7. A further witness statement was filed by Mr Purdue on 4 April 2016. It repeated the content of his first witness statement and provided no other information about the circumstances of the filing of the form TM8. It did not address the questions raised by the Tribunal about the method or date of posting.

8. The Tribunal considered the reasons provided by Mr Purdue and in a letter dated 12 April 2016, it stated:

“It is the view of the Registry that the applicant has not provided extenuating circumstances sufficient on their own to allow the Registrar to exercise discretion so the Preliminary view of the Registry is to refuse to allow the late TM8”.

9. The applicant was allowed until 26 April 2016 to challenge this preliminary view by requesting a hearing. On 25 April 2016 it requested a hearing. A hearing was appointed and took place before me on 17 May 2016. The applicant was represented by Mr Purdue; the opponent was represented by Chris Pearson of Counsel. Both parties filed skeleton arguments in advance of the hearing.

The statutory provisions

10. For the purposes of this decision, it is not necessary for me to set out all of the statutory provisions governing the conduct of opposition proceedings before the Tribunal. Suffice to say that the period allowed to an applicant to file a Form TM8 by Rule 18(1) is a non-extendable period governed by Schedule 1 to the Rules. Notwithstanding the above, the registrar may find that a late-filed Form TM8 can be considered validly filed if he is satisfied it is appropriate to do so. This discretion is provided by Rule 18(2) which reads as follows:

“18(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”.

11. In addition, Rule 76 provides for discretion in the event that a communication service (such as the postal system) fails. It reads:

“76.—(1) The registrar shall extend any time limit in these Rules where the registrar is satisfied that the failure to do something under these Rules was wholly or mainly attributed to a delay in, or failure of, a communication service.

(2) Any extension under paragraph (1) shall be—

(a) made after giving the parties such notice; and

(b) subject to such conditions,
as the registrar may direct.

(3) In this rule “communication service” means a service by which documents may be sent and delivered and includes post, facsimile, email and courier”.

The discretion under Rule 18(2)

12. In approaching the discretion provided by the use of the words “unless the registrar directs otherwise” in Rule 18(2), the Tribunal takes 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). The Tribunal must be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the applicant's favour.

The submissions at the hearing

13. As both parties attended the hearing, there is, in my view, no need to record the competing submissions in great detail. Mr Purdue accepted that there is no dispute that the form TM7 was correctly served. He expanded on his skeleton argument, stating that the form TM8 had been posted by first class mail "a few days" before the deadline. He did not send the TM8 by recorded or special delivery and did not obtain proof of posting. When questioned, Mr Purdue said that he had posted the form on the same day that he completed it. That was, he said, on 27 January 2016. The TM8 is dated 29 January 2016. Mr Purdue explained this by saying he must have made a mistake when dating the form.

14. Mr Purdue also claimed to have sent a copy of the form TM8 by email on the same date on which he posted the form, i.e. 27 January 2016. He stated that this was sent to tribunalsection@ipo.gov.uk. However, during the hearing he was not able to find the confirmation of such an email in his records.

15. In addition, Mr Purdue stated that he had telephoned the tribunal section to confirm whether the form TM8 had been received. He indicated that it is his practice to file duplicate copies and to telephone when filing important documents at the Registry. He said that he spoke to the caseworker responsible for the case but that she did not confirm whether the form had been received: she stated only that it can take a few days for correspondence to be linked to the file. Mr Purdue was unable to explain why he did not fully set out these events in either of the witness statements he filed.

16. For the opponent, Mr Pearson drew my attention to the authorities referred to in his skeleton argument, principally *Mercury*. He argued that the evidence provided by the applicant is insufficient to justify the exercise of the Registrar's discretion. He pointed to what he characterised as "significant problems" in the applicant's case, such as the discrepancy between the stated posting date and the date on the form TM8, the absence of a file note to evidence any conversations between the tribunal section and the applicant, and the absence of proof of posting or confirmation of the email Mr Purdue claims to have sent. Mr Pearson submitted that nothing in Mr Purdue's submissions altered the fact that no detailed reasons have been provided for the failure to meet the deadline and that it is not open to me to exercise the Registrar's discretion in the absence of evidence in support of the applicant's case.

After the hearing

17. Given the nature of Mr Purdue's submissions at the hearing and their potential importance for the decision I must make, I wrote to the applicant on 18 May 2016 in the following terms:

"In your skeleton argument and at the hearing you made a number of statements in relation to the filing of the form TM8. In particular, you

indicated that you had posted the form TM8 by first class post on 27 January 2016 (although the form is dated 29 January 2016) but that you had neither sent it by recorded nor special delivery, nor obtained proof of posting. You also stated that you had sent a copy of the TM8 by email to tribunalsection@ipo.gov.uk in advance of the deadline, although you were not able during the hearing to find the confirmation amongst your emails.

In light of this, you are allowed **fourteen days from the date of this letter, i.e. until 1 June 2016**, to provide a statutory declaration explaining the full chronology of events surrounding how you filed the form TM8. You will need to set out in detail your account of how the form TM8 was posted and when it was posted. You should also explain any discrepancies, such as that noted above. Any additional documentary evidence (for example, confirmation of your email to the tribunal section or the results of any enquiries made of the Royal Mail) which you consider supports your case should be provided as exhibits to your statutory declaration.

Statutory declarations must be made in a particular format and must be sworn before an authorised person. Further information regarding statutory declarations can be found in the Tribunal Practice Manual, which can be accessed at https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/513918/Manual-of-trade-marks-practice.pdf. The relevant section is 4.8.3.3 (p. 428).

The statutory declaration **must be copied to the opponent, who is then allowed a further fourteen days from the date of receipt** to file any submissions it may have. When all of the documentation is to hand, I will issue a decision explaining whether the late-filed TM8 should or should not be admitted into the proceedings”.

18. No statutory declaration and no request for additional time has been received. Accordingly, I make my decision based on the papers on file, taking into account the submissions of the parties at the hearing.

DECISION

19. In reaching a conclusion, I bear in mind that the applicant has filed a witness statement in which Mr Purdue states that he posted the form TM8 expecting it to arrive on time. However, the applicant has manifestly failed to respond adequately to the Tribunal’s request for more information, in particular as regards the date and manner of posting of the form TM8. This is despite the applicant being invited to provide evidence to that effect on two occasions. I note that the applicant has stated in its letter of 25 April 2016 and at the hearing that the form TM8 was emailed to the Tribunal before the deadline. There is no record of that email on the official file and Mr Purdue has not provided any evidence of his having sent it, again despite being offered the chance to do so. I also note that Mr Purdue did not mention this email in his witness statements of 1 March or 1 April 2016. Taking into account all of the above, I am not satisfied that the failure to file the form TM8 was attributable wholly

or mainly to a delay in, or a failure of, a communication service, as provided for by Rule 76.

20. As for the general discretion available under Rule 18(2), it will be clear from the guidance referred to above that only exceptional circumstances will persuade me to exercise my discretion. It seems to me that there are no such circumstances in this case. The applicant has provided the briefest explanation of its failure to meet the deadline and has declined to solemnise in evidence its unsupported assertions regarding the posting date and method. Given the discrepancies in the applicant's case, compounded by the fact that it was offered but did not avail itself of the opportunity to explain, I am not prepared to accept the unsubstantiated statements of the applicant. In deciding thus, I am aware that the application will be deemed abandoned and the applicant will therefore suffer prejudice. However, this does not outweigh, in my view, the failure of the applicant to provide any compelling reason to justify the late-filing of the form TM8.

21. Having considered the competing written and oral submissions and the decisions in *Kickz* and *Mercury*, my decision is not to exercise the discretion available in the applicant's favour. The consequence of that decision is that, subject to any successful appeal, the application will be treated as abandoned.

COSTS

22. As my decision concludes the proceedings, I must also consider the matter of costs. At the hearing, the applicant requested that any costs award be made on the usual Registry scale. The opponent requested costs off the scale on the basis that it was unreasonable for the applicant to request a hearing when there was no evidence on which the Registry could exercise its discretion.

23. I am not persuaded that an award off the scale is appropriate. The applicant was entitled to challenge the preliminary view and did so. The fact that it has lost does not make its behaviour unreasonable. Having said that, the application has been deemed abandoned and the opponent is therefore entitled to an award of costs in its favour. Awards of costs are dealt with in Tribunal Practice Notice ("TPN") 4 of 2007. Bearing the guidance in that TPN in mind but noting that the opponent was not professionally represented apart from at the hearing, I make the award on the following basis:

Official fees	£200
Filing the Notice of Opposition	£100
Considering the counterstatement	£50
Preparing for and attending the hearing	£300
Total:	£650

24. I order Loot Financial Services Ltd to pay Downdaniel Investment Holdings Limited the sum of **£650**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11th day of July 2016

**Heather Harrison
For the Registrar
The Comptroller-General**