

O-070-19

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO 3310884
IN THE NAME OF BILLIONS LONDON LTD
TO REGISTER



AS A TRADE MARK IN CLASS 25
AND
THE LATE FORM TM8 AND COUNTERSTATEMENT
FILED IN DEFENCE OF THAT APPLICATION
IN OPPOSITION PROCEEDINGS (UNDER NO. 413714)
LAUNCHED BY
BILLIONAIRE TRADEMARKS B.V.

Background

1. On 15 May 2018, Billions London LTD ('the applicant') applied to register the mark set out on the title page in class 25 for *clothing, footwear, headgear*.
2. The application was published on 15 June 2018. A notice of opposition, the form TM7, was filed on 12 September 2018 by Billionaire B.V. ('the opponent') based on section 5(2)(b) of the Trade Marks Act 1994 ('the Act') relying on two earlier trade marks, one a UK mark and the other an EU mark.
3. The form TM7 was served on the applicant on 18 September 2018 setting a deadline of 19 November 2018 for the filing of a defence via the form TM8 and counterstatement. No defence was received by the deadline date. Following further enquiries by the Tribunal, the applicant stated that a physical form TM8 was submitted to the IPO by post along with another TM8 for opposition no. 413754 and sent a copy of the Royal Mail receipt for the package dated 7 November 2018. On investigation it transpired that the IPO had received a TM8 for opposition no. 413574, but not for the present case. An emailed copy of the TM8 for the present case was received by the Tribunal on 22 November 2018.
4. The Tribunal gave a preliminary view dated 27 December 2018 to the applicant that the late TM8 could not be admitted to the proceedings. Subsequently the applicant requested a hearing.

Hearing

5. A hearing took place before on 31st January 2019. Messrs Jordan Townsend and Joseph Aluko appeared on behalf of their company Billions London Ltd. The opponent did not attend.
6. Mr Townsend set out the circumstances surrounding the filing of the form TM8. He had emailed the TM8 for this case to his partner Mr Aluko on 1 November 2018 (and has provided a screenshot of the email) for despatch to the IPO. This action was completed to the best of the applicants' knowledge and it was not understood why only one TM8 for opposition no. 413754 was received by the IPO.

The Rules regarding late filing

7. With regard to the late filing of a form TM8, I must refer to Rule 18 of the Trade Marks Rules 2008 which states:

“(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.” (my emphasis)

8. 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 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.”

9. As there has been no error on the part of the registrar or the office, rule 77(5) is not relevant. In *Kickz*¹, Mr Hobbs QC sitting as the Appointed Person held that the discretion conferred by rule 18(2) is a narrow one and can be exercised only if there are “extenuating circumstances”. In *Mercury*², Ms Amanda Michaels, also sitting as the Appointed Person, in considering the factors the Registrar should take into

¹ O-035-11

² O/050/12

account in exercising the discretion under rule 18(2), held that there must be “compelling reasons”. She also referred to the criteria established in *Music Choice*³, which provides guidance, applicable by analogy, when exercising the discretion under rule 18(2). Such factors (adapted for an opposition case) are:

- (1) The circumstances relating to the missing of the deadline including reasons why it was missed and the extent to which it was missed;
- (2) The nature of the opponent’s allegations in its statement of grounds;
- (3) The consequences of treating the applicant as opposing or not opposing the opposition;
- (4) Any prejudice caused to the opponent by the delay;
- (5) Any other relevant considerations, such as the existence of related proceedings between the same parties.

Decision

10. Insofar as the first *Music Choice* factor is concerned, I note that the deadline was missed by 3 days and I must bear in mind the circumstances which led to the delay in filing the defence. Messrs Townsend and Aluko believe they did everything they could to ensure the form TM8 was sent to the IPO on time and there is no apparent reason as to why the IPO did not receive it.

11. In terms of the second *Music Choice* factor, the grounds of opposition are based on section 5(2)(b) of the Act, as the opponent alleges the marks are confusingly similar to two of its UK and EU trade marks.

12. Turning to the third *Music Choice* factor, the consequences for the applicants if discretion is not exercised in their favour are serious as this trade mark application would be deemed abandoned for want of a defence. By contrast, if discretion is exercised in their favour, then they would have the opportunity to defend the trade mark and a decision would be made on the merits of the case. Mr Townsend stated that if the TM8 was not admitted in to these proceedings, then they would need to

³ *Music Choice Ltd Trade Mark* [2006] RPC 13

consider all their options, one of which could be to refile this application. This would presumably lead to the likely consequence that the opponent would again oppose the mark which in turn would lead to delay and more expense for all parties.

13. In terms of the fourth *Music Choice* factor, the opponent has not commented on any prejudice caused by the delay.

14. As regards the fifth *Music Choice* factor, there are concurrent opposition proceedings, namely opposition case no. 413754, between the same parties.

15. Having addressed each of the relevant factors in *Music Choice*, I must now decide whether there are sufficient extenuating circumstances to enable me to exercise my discretion. After careful consideration, my decision is that the necessary compelling reasons have been made out, noting, in particular, the related proceedings between the parties, the absence of any prejudice caused by the short delay, and that if the TM8 were not admitted there would be detriment in terms of cost and greater delay to all parties. **The late filed form TM8 and counterstatement is admitted into proceedings.**

Costs

16. In the circumstances, I do not consider an award of costs to be appropriate.

Dated this 4th day of February 2018

**June Ralph
For the Registrar,
the Comptroller-General**