

O-592-22

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO 3706083**

**IN THE NAME OF
CODIKOAT LTD**

TO REGISTER

CODIKOAT

**AS A TRADE MARK
IN CLASSES 1, 5, 9, 10 & 11**

**AND
THE LATE FORM TM8 AND COUNTERSTATEMENT
FILED IN DEFENCE OF THAT APPLICATION**

IN OPPOSITION PROCEEDINGS (UNDER NO. OP000429468)

**BY
BASF SE**

Background

1. On 3 October 2021, Codikoat Ltd (“the Applicant”) applied to register the mark CODIKOAT for goods in classes 1, 5, 9, 10 & 11, as set out in the Annex to this decision. The application was published for opposition purposes on 22 October 2021.
2. On 21 December 2021, BASF SE (“the Opponent”) opposed the Application pursuant to section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against the Applicant’s goods in class 1 only.
3. On 7 January 2022, the Tribunal served the Form TM7 on the Applicant by post and email at the respective addresses on record. This letter advised the Applicant amongst other things 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...

IMPORTANT DEADLINE: A completed Form TM8 (or Form TM9c) MUST be received on or before 7th March 2022 (emphasis in original).

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** (emphasis in original).

4. On 15 March 2022, the deadline for filing the TM8 having passed, and with no indication of one being filed, the Tribunal again wrote to the Applicant in the following terms:

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, **29th March 2022**. 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 (emphasis in original).

If no response is received the registry will proceed to deem the application abandoned in respect of all goods in class 1 and the application will proceed to registration for the remaining goods and services.

5. By email dated 16 March 2022 the Applicant replied to the Tribunal, stating:

I had caught COVID when the email was sent on 7th Jan and hence was unable to check my emails as regularly as normal times and simply missed the email. Since I have a crowded in-box, it was very easy for this to happen.

I was not expecting official emails which contain notifications concerning legal proceedings to be sent via email therefore it is possible that the email could be missed due to lack of expectation on receiving legally bearing notifications.

No material prejudice or advantage to either party if application is reinstated.

In addition, reinstating the application would result in cost and time saving for both parties and UKIPO. Rejecting application to reinstate would cause more

time and cost with the need to refile the same mark in Class 1. BASF would then need to file another opposition.

6. Following the Tribunal's letter of 21 March 2022, outlining the procedure to request a hearing, the Applicant filed a Witness Statement in the name of Mohammah Javad Mohseni, dated 22 March 2022. This statement replicates the reasons given in the Applicant's earlier email.

7. A Form TM8 was filed by the Applicant on 6 April 2022, in compliance with the Tribunal's guidance in a letter dated 24 March 2022.

Hearing

8. A remote hearing took place before me on 29 June 2022. The Applicant was represented by Mr Raj Sharma, a Director at the Applicant Company; the Opponent was represented by Mr Chris McLeod of Elkington and Fife. Both parties filed skeleton arguments in advance of the hearing.

9. At the hearing Mr Sharma focussed on the electronic service of the Tribunal's letter of 7 January 2022. He explained that said service was effected upon an email address in the name of Mr Mohseni, who had sole access to that email. Further, that on 4 January 2022 Mr Mohseni contracted Covid-19.¹ Mr Sharma explained that this period had been particularly traumatic for Mr Mohseni, as his wife required hospitalisation due to the critical symptoms she had suffered after also contracting Covid-19 at the material time.

10. When Mr Mohseni felt well enough, some weeks later, he looked at only a few emails in his crowded inbox. Mr Mohseni, in Mr Sharma's submissions, "thought to himself that if there was anything that important, then an email will be resent". The Applicant also submitted that he had never received any correspondence of this type

¹ The Applicant provided an image of a positive (self-tested) Lateral Flow Test dated 4th January [year not indicated]. There also was nothing to connect Mr Mohseni to this test result. However, this evidence was not challenged: Mr McLeod accepted that Mr Mohseni had contracted Covid and must have had a traumatic time.

from the Tribunal; though he conceded that he had received email correspondence from the Registry in relation to other registrations.

11. In response to the argument that Mr Mohseni had contracted the virus three days before the relevant notification was issued and would have still had ample opportunity to meet the deadline after he had recovered, Mr Sharma submitted that he still would not have met the deadline, as he had missed the email.

12. A further submission of Mr Sharma's, both in his skeleton argument and at the hearing, is that "reinstating the application would result in cost and time saving for both parties and UKIPO. Rejecting our application to reinstate would cause more time and cost with the need to refile the same mark in Class 1. BASF would then need to file another opposition."

13. When asked to address the matter in relation to service effected by post, Mr Sharma affirmed that the Applicant had never received the postal correspondence. Mr McLeod pointed out that the Applicant had, on 8 February 2022, made an application to change its registered office address. This, he submitted, is an indication that the "Applicant was able to conduct other formal business during the period when Mr Mohseni was most ill with Covid". Mr Sharma explained that said application was done by another director of the Applicant's and not by Mr Mohseni.

14. In reply to Mr Sharma's submissions, Mr McLeod reiterated his written submissions, that:

- i. The applicant would have still had ample time after recovering from COVID to read its emails and file the form, which is a relatively simple task, even for an unrepresented party.
- ii. Mr Mohseni should have made arrangements at his company to ensure that emails were being monitored. As Annex 1 confirms, the Companies House website shows two other directors of the applicant company, who could have assisted and taken responsibility for the emails.

- iii. The Applicant's reasons for missing the deadline are also not compelling reasons for the registrar to admit the late-filed Form TM8.
- iv. The Opponent will suffer prejudice should the discretion be exercised in the Applicant's favour, given that the applicant took approximately one month from the initial deadline of 7 March 2022 to file the Form TM8 and because the opponent has also already incurred further costs in relation to the opposition proceedings because of this failure to meet the deadline.
- v. The applicant is also the proprietor of UK trade mark registrations nos. 3555675 (filed on 13 November 2020), 3635526 (filed on 30 April 2021) and UK trade mark application no. 3797396 (filed on 9 June 2022) in addition to the application under opposition, all of which are shown in Annex 2. It is clear that the applicant would therefore have previously received correspondence from the UKIPO by email and would be aware that the UKIPO usually corresponds by email.
- vi. The applicant's COVID-related reasons are not unique to its business, especially when the applicant has two further directors, who could have assisted.

15. At the conclusion of the hearing I reserved my decision to allow myself the opportunity to reflect upon the oral submissions made by the respective parties.

Decision

16. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by Rule 18 of the Trade Marks Rules 2008 ("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 (my emphasis).

(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”.

17. 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.”

18. There has been no suggestion that the late filing of the Applicant’s TM8 in this instance was due to 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).

19. 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 must be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the Applicant’s favour.

20. 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

21. The Registry's letter of 7 January 2022 notified the Applicant 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...

"IMPORTANT DEADLINE: A completed Form TM8 (or Form TM9c) MUST be received on or before 7th March 2022" (emphasis in original).

22. This letter also explained the consequences of a failure to file the TM8 on time. The Applicant's TM8 was filed on 6 April 2022, approximately one month late. The reasons given in Mr Mohseni's witness statement (and at the hearing) are that:

2. I had caught COVID when the email was sent on 7th Jan and hence was unable to check my emails as regularly as normal times and simply missed the email. Since I have a crowded in-box, it was very easy for this to happen.

3. I was not expecting official emails which contain notifications concerning legal proceedings to be sent via email therefore it is possible that the email could be missed due to lack of expectation on receiving legally bearing notifications.

23. When explanation was sought on service of the relevant notification effected by post, Mr Sharma did not clarify whether service was defective or whether the Applicant had

failed to notify the Registry of a change of address; he simply stated that the letter had not been received.

24. In *RARE*, BL O/767/21, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, considered the validity of generalised references to disruptions caused by the COVID-19 pandemic as evidence of extenuating circumstances or compelling reasons for missing a non-extendable deadline. He emphasised that “[a] fact specific evaluation is necessary for the purposes of the required determination” and explained that:

“20. It was incumbent on the Proprietor to establish the existence of extenuating circumstances or special reasons for not having filed its Form TM8 by 26 October 2020. That could not be done simply by pointing to the fact that the pandemic had created a working environment in which it was to a greater or lesser degree more difficult for people and businesses to function effectively by comparison with the way they were able to function before. It was necessary for the Proprietor to go further and explain the impact of the pandemic on its own particular situation relative to the circumstances of the present case....

23. In short, the Hearing Officer ought to have focused on the “specific impact of the pandemic on the Proprietor’s business operations” without endeavouring to treat ‘real world’ difficulties inflicted on the Proprietor by the pandemic as immaterial by characterising them as instances or examples of “general difficulties which all businesses have been faced with”.

25. Whilst I have some sympathy for Mr Mohseni, I find that the specific impact of his contracting Covid has not been sufficiently particularised to allow me to assess its relevance in relation to business operations. There is no information as to when he recovered; the severity of his symptoms; whether he was able to work, or communicate with his office; and there is no information on the workings of the business, in particular the management of its trade marks portfolio.

26. Similarly, submissions relating to Mr Mohseni’s traumatic experience, including his wife’s near-death experience, is also generalised in nature; thus preventing me from

making an informed decision as to whether the degree of disruption suffered in those circumstances provide a sufficient basis for granting relief from the disciplinary consequences of Rule 18(2).

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

27. The Opponent's claim is based upon sections 5(2)(b) of the Act. I note that the proof of use provisions contained in section 6A of the Act are engaged in this case; however, the onus is on the Applicant to require proof of use and it has not done so. Therefore the Applicant has accepted the Opponent's statement that it has used its mark. Whilst it is not for the present hearing to determine the merits of the case, for the purpose of the criteria under consideration it is sufficient to note that there is an arguable case to be determined.

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

28. If the Applicant is allowed to defend the opposition, the proceedings will continue with the parties given an opportunity to file evidence and the matter will be determined on its merits.

29. If, however, the Applicant is not allowed to defend the opposition, its application will be deemed abandoned and it will lose its filing date of 3 October 2021, in relation to its class 1 goods only (the application will proceed to registration for the other classes: 5, 9, 10 and 11). Nevertheless, it will remain open to the Applicant to re-file its application, which may, in turn, be opposed again by the Opponent.

Any prejudice caused to the Opponent by the delay

30. Further to the Opponent's submissions on this point, I note the inevitable costs and additional time associated with delays of this type.

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

31. Neither party has drawn my attention to any other proceedings in which they are involved.

Considerations

32. Having addressed each of the relevant factors as proposed in *Music Choice*, I must now decide whether the Applicant's submissions disclose extenuating circumstances or compelling reasons to enable me to exercise the discretion to admit the late-filed TM8 and counterstatement.

33. After carefully considering the expected detriment to the Applicant in the event the discretion is not exercised in its favour, I find that the loss of priority 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 to file a Form TM8; therefore, these are not factors that, in my view, are particularly compelling.

34. Although I can sympathise with the Applicant's failure to file a TM8 on time, the reasons given are not sufficient under law to excuse it. If Mr Mohseni had contracted Covid in the initial stages of the pandemic (for example), I might have taken a different view. However, in view of the fact that he had fallen victim to the virus almost two years after the pandemic first started, I cannot reasonably find that this amounts to extenuating circumstances or compelling reasons. The Applicant has had sufficient time (in the intervening period) in which to devise contingency plans to respond to the disruptions/difficulties concomitant with Covid-19, and it is apparent that it has failed to do so.

35. In relation to the traumatic experience surrounding Mr Mohseni's wife's hospitalisation, no information has been offered regarding the date/s of the event, nor explanation as to how the unfortunate circumstances affected the Applicant's ability to file the TM8 within the stipulated time limit. In the absence of this information, I am not

satisfied that these considerations amount to extenuating circumstances or compelling reasons.

36. The Applicant's submission that Mr Mohseni was the only person with access to his email, that he missed the email due to the illness and his inbox being crowded, also do not constitute extenuating circumstances or compelling reasons for failing to comply with the non-extendable deadline. My view is particularly reinforced by the fact that Mr Mohseni did have access to his emails; he had elected to read some of them; at the material time there were other directors who could have assisted him; and the Applicant was not new to IPO proceedings.

37. The Applicant is also not assisted by the submission that Mr Mohseni considered that any email correspondence of importance will be (or should have been) resent. There is a clear warning in the email notification of 7 January 2022 (also served by post) of the need to comply with the deadline and the consequences for failing to do so. Furthermore, as pointed out by Ms Amanda Michaels, sitting as the Appointed Person in *Mark James Holland v Mercury Wealth Management Limited*, BL-O-050-12, "[t]here is no such general obligation upon the UKIPO to remind parties to proceedings, whether represented or not, of impending deadlines. In my view, this is not a compelling reason to grant the extension needed".

38. After having considered all of the Applicant's reasons for its failure to file a TM8 by the deadline set, I find no single reason or combinations of reasons sufficient to enable me to exercise my discretion to admit the late-filed TM8 into these proceedings.

Conclusion

38. The late Form TM8 and counterstatement is not to be admitted into the proceedings. Subject to appeal, the application is treated as abandoned in relation to its class 1 specification and it may proceed to registration for the goods that were not opposed, in classes: 5, 9, 10 and 11 (as set out in the Annex below).

Costs

39. 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 2/2016. Applying this TPN as a guide, I assess costs as follows:

Official fee for filing the Form TM7	£100
Preparing the statement of case	£200
Preparing for and attending the hearing, including filing skeleton arguments	£400
Total	£700

40. I order Codikoat Ltd to pay BASF SE 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 11th day of July 2022

Denzil Johnson
For the Registrar,
The Comptroller-General

Annex

Class 1: Antimicrobial preservatives for pharmaceuticals; Antimicrobial preservatives for cosmetics; Antimicrobial agents for use in manufacture; Chemicals having antimicrobial properties [other than medical or veterinary].

Class 5: Sanitising wipes; Hand-sanitising preparations; Disposable sanitising wipes; Compounds for sanitising eggs; Sanitisers for household use; Medicated and sanitising soaps and detergents; Disinfectants; Disinfectant dressings; Disinfecting handwash; Disinfectant swabs; Disinfectant soap; Urinary tract disinfectants; Sticks (Sulphur -) [disinfectants]; Contact lens disinfectants; Sulfur sticks [disinfectants]; Sulphur sticks [disinfectants]; Disinfectants and antiseptics; Disinfectants for medical instruments; Disinfectants for hygienic purposes; Disinfectants for sanitary purposes; Fumigating sticks as disinfectants; Disinfectants for sanitary use; Sulphur sticks as disinfectants; Disinfectants for chemical toilets; Disinfectants for household use; Disinfectants for veterinary use; Disinfectants for swimming pools; Disinfectants impregnated into tissues; Disinfectants for hygiene purposes; Disinfectants for contact lenses; Disinfectants for medical use; Washes (disinfectant -) [other than soap]; Solutions for disinfecting contact lenses; Disinfectants for dental apparatus and instruments; Disinfectants for medical apparatus and instruments; Cleaning cloths impregnated with disinfectant for hygiene purposes; Antimicrobial clay; Antimicrobial mouthwashes; Antimicrobial facewashes; Antimicrobials for dermatologic use; Antimicrobial preparations for inhibiting microbiological decomposition; Naturally derived antimicrobials for dermatological use.

Class 9: Ventilation suits.

Class 10: Medical ventilators; Patient ventilation instruments; Ventilator breathing apparatus for artificial respiration; Ventilator exhalation valves for artificial respiration; Compressor modules being parts of ventilators [medical]; Peep activators being parts of medical ventilators for maintaining pressure; Inadvertent peep reducers being parts of medical ventilators for maintaining pressure.

Class 11: Sanitisers; Sanitising apparatus; Urinal sanitiser units; Turbine ventilators [ventilation apparatus]; Aeolian ventilators; Electro ventilators; Ventilating fans; Ventilating units; Ventilating apparatus; Ventilation hoods; Ventilating installations; Ventilation apparatus; Suction ventilators; Ventilation terminals; Apparatus for ventilating; Ventilators for vehicles; Installations for ventilating; Ventilators for automobiles; Ventilating exhaust fans; Extractor units [ventilation]; Mobile ventilating apparatus; Fans for ventilating; Industrial ventilation

apparatus; Residential ventilating units; Compressed air ventilators; Oven ventilator hoods; Air impellers for ventilation; Ventilation installations for kitchens; Ventilating apparatus for vehicles; Ventilating hoods for laboratories; Dampers for ventilating installations; Solar powered ventilation apparatus; Hoods for ventilating apparatus; Air inductor apparatus [ventilation]; Ventilating hoods for steam; Ventilators for heat exchangers; Ventilation hoods for stoves; Air curtains for ventilation; Ventilating hoods for smoke; Electric fans for ventilation; Motorised fans for ventilation; Ventilation hoods for laboratories; Flues for ventilating apparatus; Electrically powered blowers for ventilation; Ventilating fans for industrial purposes; Ventilating fans for household use; Fire ventilators for exhausting gases; Fire ventilators for exhausting vapours; Fire ventilators for exhausting fumes; Fire ventilators for exhausting smoke; Extractors [ventilation or air conditioning]; Ventilating fans for industrial use; Ventilating fans for commercial use; Apparatus and installations for ventilating; Ventilating fans for use in vehicles; Electrically powered fans for ventilation purposes; Ventilation [air-conditioning] installations and apparatus; Ventilation [air-conditioning] installations for vehicles; HVAC systems (heating, ventilation and air conditioning); Heat sinks for use in ventilating apparatus; Ventilation grilles being parts of extractor fans; Electrically powered air blowers for ventilation purposes; Filters for use with apparatus for ventilating; Electrical fans being parts of household ventilation installations; Vehicle HVAC systems (heating, ventilation and air conditioning); Heating, ventilating, and air conditioning and purification equipment (ambient); Disinfection apparatus; Disinfectant apparatus; Disinfecting apparatus; Water disinfection apparatus; Disinfectant distributors for toilets; Disinfectant dispensers for washrooms; Disinfectant dispensers for toilets; Apparatus for disinfecting water; Disinfectant apparatus for banknotes; Disinfectant apparatus for banknote; Sterilization, disinfection and decontamination equipment; Disinfectant apparatus for medical purposes; Dish disinfectant apparatus for industrial purposes.