

O/0538/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3802353

IN THE NAME OF KITSLIMY BEAUDELAB LTD

**TO REGISTER THE FOLLOWING TRADE
MARK:**

**BeauLab⁺
Beau Lab⁺
de Lab⁺**

IN CLASS 5

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 436759**

BY ROGER AOUN

Background and pleadings

1. On 23 June 2022, KITSLIMY BeauDeLab LTD ('the applicant') applied to register the trade mark as shown on the front page of this decision. It was accepted and published on 8 July 2022 in respect of the following goods:

Class 5: Nutritional supplements; Preparations of vitamins; multivitamin preparations; vitamin and mineral preparations; dietary supplements; vitamin preparations; vitamin A preparations; vitamin B preparations; vitamin C preparations; mixed vitamin preparations; vitamin D preparations; dietary supplements; Herbal dietary supplements for persons special dietary requirements; dietary supplements in powder form; dietary supplements consisting of vitamins; vitamin supplements; vitamin and mineral supplements; mineral supplements; vitamin tablets.

2. On 8 September 2022, Laytons LLP filed a Form TM7A (Notice of threatened opposition) on behalf of Roger Aoun ("the opponent"), the effect of which was to extend the opposition period until 10 October 2022.

3. On 7 October 2022, Laytons LLP filed a Form TM7 (Notice of opposition and statement of grounds) on behalf of the opponent. The opposition was brought under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act") and was directed against all the goods in the application.

4. On 12 October 2022, the Tribunal served the TM7 on the applicant, by post and by email to the recorded representative of the applicant, Bonamark Limited ("Bonamark"). In accordance with Rules 18(1) and 18(3) of the Trade Marks Rules 2008 ("the Rules"), the applicant was informed that it had two months from the date of the letter in which to file its Form TM8 and counterstatement. The applicant was also informed that, in the alternative, if both parties agreed to enter into a cooling off period, then a Form TM9C should be filed. The date for the filing of Form TM8 or TM9C was given as 12 December 2022. In addition, the consequences of failing to file a Form TM8 or TM9C were outlined. The pertinent paragraphs of the letter are as follows:

“Please find enclosed a copy of the notice of opposition - Form TM7 - filed against your application.

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 [...]

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 December 2022.

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. The applicant filed a TM8 two days after the deadline on 14 December 2022. This was accompanied by a covering email stating, “Please be informed that due to a technical error the email message containing the form was not sent on December 12, 2022. We apologize for the error and for the inconvenience caused. We hope that the submission will be accepted.”

6. As the applicant did not file their TM8 by the deadline, the Tribunal sent an official letter dated 16 January 2023, by post and email, advising the parties of its preliminary view to deem the application abandoned. Either party, if it disagreed with the preliminary view, was to provide full written reasons and request a hearing by 30 January 2023.

The request was to be accompanied by a witness statement containing reasons for the late filing of the TM8.

7. On 24 January 2023, a witness statement was filed by Vladimir Isaev, the director of Bonamark explaining that there was a technical error on their mail server. The main body of the witness statement is reproduced in full below:

- “1. The TM8 form was timely prepared by us and scheduled to be sent to the Intellectual Property Office on December 12, 2022.
2. Due to a technical error on our mail server, the email containing the TM8 form was not sent.
3. Once we discovered that the email was not sent automatically, we immediately sent the TM8 form manually. The form was sent by me on December 14, 2022.”

8. On 10 March 2023, the parties were informed that it was the preliminary view of the registrar that the applicant’s Form TM8 and counterstatement should be admitted into the proceedings. In the same official letter, the parties were given until 24 March 2023 to request a hearing if they wished to challenge the preliminary view.

9. Subsequently, on 23 March 2023, Laytons LLP wrote to the Tribunal to request a hearing on this matter.

THE HEARING

10. The hearing took place before me, by conference call on 27 April 2023. The opponent was represented by Nigel Parnell of Laytons LLP whereas the applicant did not attend. Mr Parnell provided skeleton arguments prior to the hearing, into which the applicant’s representatives were copied. The applicant’s representatives did not provide any submissions in lieu of attendance.

11. The opponent’s skeleton arguments consisted of six pages and included: a timeline of events in the proceedings; submissions in relation to the missing of the TM8 deadline; reference to and application of the relevant statutory guidance; and a

request for a security for costs in the event of the Registry admitting the late filed TM8 into the proceedings.

12. At the hearing Mr Parnell noted the applicant's absence stating that the onus is on the party seeking to have the late TM8 admitted into the proceedings and that the applicant is not present to provide their reasons. He submitted that this should be a reason in itself to not allow the late filed TM8.

13. I was referred to the applicant's witness statement, and paragraph 2 in which the applicant stated, "Due to a technical error on our mail server, the email containing the TM8 form was not sent." Mr Parnell submitted that the reason put forward was very brief and it does not necessarily explain why the Form TM8 was not sent for two days, and that the applicant would have been aware of any mail server issues fairly quickly. He went on to say that if the applicant was aware of its deadline and the technical error with their mail servers, they could have attempted to submit the form using other methods such as a courier, a web mail service or by creating a web hotspot from a phone.

14. Mr Parnell also pointed out that the applicant's claim that they submitted the form "manually" on 14 December 2022 was unclear and seemed to suggest that the applicant was still experiencing server issues at that time but was still able to find an alternative method to submit the Form TM8. Mr Parnell claimed that this begged the question as to why the form was not submitted using an alternative method on 12 December 2022. In response, I confirmed that the Registry received the TM8 via email from the applicant's representative's recorded email address.

15. At the conclusion of the hearing, I reserved my decision to give me an opportunity to properly reflect on the submissions put forward by the opponent and all the circumstances of the case.

DECISION

16. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by Rule 18 of 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.”

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 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.”

18. There is no suggestion that there has been any irregularity on the part of the Tribunal and so I need not consider the provisions of Rule 77(5) further.

19. I must also consider whether there has been a failure in communication. Rule 76 of the Rules relates to delays in communication services and states:

“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 services” means a service by which documents may be sent and delivered and includes post, facsimile, email and courier.”

20. I note that in the witness statement of Mr. Isaev, he states that the TM8 was not sent due to a technical error on their mail server. In *Praesidiad NV v Tescon Sicherheitssysteme Schweiz GMBH (“Tescon”)*, BL O/240/20, Mr Geoffrey Hobbs Q.C. as the appointed person stated at paragraph 33 that:

“This is the point at which the Proprietor’s request for relief under rule 41(6) ran into difficulty. The general tenor of the representations made on its behalf was that its attorneys had taken reasonable and proper steps to ensure that the required Form TM8 and Counterstatement were filed before expiry of the specified deadline, but were inadvertently deflected from doing so until after the deadline had expired. However, the Registrar was presented with assertions rather than evidence and materials of sufficient clarity and precision to substantiate that or any proposition to the like effect. In the end, as emphasised in the Respondent’s Notice, the Hearing Officer was left with no satisfactory explanation for the default which had occurred.”

21. Although *Tescon* concerned an application for invalidity, the same assessment is relevant to the late filing of a TM8 and counterstatement in opposition proceedings. In this case, the applicant was not present at the hearing to further elaborate on the technical error, it is therefore unclear as to what the exact nature of the technical error was. Further, it is unclear how long the problem persisted, how widespread the issue was and when the applicant first became aware of the issue. As such, I do not consider that there is sufficient information for me to be satisfied that the deadline was missed due to a delay in, or failure of, a communication service.

22. Consequently, the only basis on which the applicant may be allowed to defend the opposition proceedings is if I exercise in its favour the discretion afforded to me by the use of the words “unless the registrar otherwise directs” in Rule 18(2).

23. In approaching the exercise of discretion in these circumstances, I consider the decisions of the Appointed Person in *Kickz AG v Wicked Vision Limited (“Kickz”)*¹ and *Mark James Holland v Mercury Wealth Management Limited (“Mercury”)*² i.e. I must be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the applicant’s favour.

24. In *Music Choice Ltd’s Trade Mark (“Music Choice”)*³, 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;

25. As noted above, the stipulated deadline for the filing of the applicant’s Form TM8 and counterstatement was 12 December 2022. This was filed by the applicant’s

¹ BL/O/035/11

² BL/O/050/12

³ [2005] RPC 18

representatives on 14 December 2022. Therefore, the deadline was missed by two days. The applicant's explanation as to why this deadline was missed was due to a technical error on their mail server. In the witness statement of Mr Isaev, he states that the TM8 form was timely prepared and scheduled to be sent to the Tribunal on 12 December 2022. Due to a technical error on their mail server, the email containing the form was not sent. Once it was discovered that the email was not sent automatically, it was immediately sent manually on 14 December 2022. I note that the Tribunal received the form TM8 via email from the recorded email address of the applicant's representatives.

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

26. Under section 5(2)(b) of the Act, the opponent claims that the applied for mark is similar to the opponent's earlier '418, '538 and '459 marks and has been applied for in relation to identical and/or similar goods.

27. Under section 5(3) of the Act, the opponent claims that its earlier '211 mark has a reputation for all of its goods and services in classes 3 and 44. Use of the applied for mark, according to the opponent, would take unfair advantage of, or be detrimental to, the distinctive character or the repute of its '211 mark.

28. As for its claim under section 5(4)(a), the opponent relies upon its alleged earlier right in the sign BEAUTYLAB. The opponent claims to have used the sign throughout the UK since 2003 in relation to '*cosmetics; skincare preparations; hair care preparations; tanning preparations; sunscreen; after sun preparations and substances; creams for the skin and body; perfumes; non-medicated toilet preparations; toiletries; essential oils; deodorants; antiperspirants; fragrancings preparations for personal use; health and beauty salons; provision of health and beauty treatments*'; establishing a significant goodwill. As such, it is argued that use of the contested mark would result in a misrepresentation as to the origin of the goods and services and as a result, the opponent will likely suffer damages.

29. Whilst it is not for the present hearing to determine the merits of the case, there is nothing to suggest that the opposition is without merit.

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

30. 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.

31. If, however, the applicant is not allowed to defend its mark, the application will be deemed abandoned, and the applicant will lose their filing date of 23 June 2022. It will remain open to the applicant to re-file their application, which may, in turn, be opposed again by the opponent.

Any prejudice caused to the opponent by the delay;

32. The opponent has submitted that there will be prejudice to the opponent if the late TM8 is admitted into the proceedings as they will need to spend time and costs on the opposition to which they may not be able to recover from the applicant if the opposition is successful.

33. The opponent also contends that the applicant is a company with no or negligible assets and has provided the following information from Companies House records: -

- (a) The Applicant was incorporated on 30 November 2021 and has not filed a confirmation statement (due by 13 December 2022) or accounts;
- (b) The Applicant has no bona fide registered office – the default address of Companies House is recorded;
- (c) The share capital of the company is £1 (100 shares of £0.01); and
- (d) The sole director and shareholder is indicated as being a Chinese national resident in China.

34. Consequently, the opponent believes it is unlikely that they would, having regard to Sections 68(2) and 76(5) be able to take further action to recover any costs by the registrar (and in any appeal).

35. The applicant has made no comment on this subject.

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

36. There do not appear to be any other relevant considerations.

Conclusions

37. In reaching my decision, as noted above, I recognise that if the discretion is not exercised in the applicant's favour, the opposition will succeed, and the applicant will lose their filing date in respect of all the goods in the application (since the opposition is directed against the application in full). I further recognise that it may be that the applicant will simply re-file their application and that this may, once again, be opposed by the opponent resulting in opposition proceedings arising at some point in the future. However, as the loss of priority and 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 TM8, these are not factors that, in my view, are particularly compelling.

38. At the hearing, Mr Parnell maintained that there were no compelling reasons or extenuating circumstances which would justify the application of the registrar's discretion and requested that the preliminary view of the registrar to admit the TM8 and counterstatement into the proceedings be overturned, and the application be deemed abandoned.

39. As previously stated, the applicant did not attend the hearing. Therefore, I have only the witness statement from Mr Isaev dated 24 January 2023 to consider in its defence. The applicant's witness statement itself does not provide much detail as to

the nature of the email server error and how long the issue persisted. Further, there was no evidence to corroborate the claim that the applicant's email server had failed, nor that it had failed at the material time, or that failure continued beyond the deadline.

40. Having carefully considered all the submissions made by Mr Parnell, taken note of the comments of Mr Isaev in his witness statement, and having regard to the factors set out in the case law in *Kickz*, *Mercury* and *Music Choice*, I see no compelling reason or extenuating circumstance which would justify the use of the registrar's discretion provided under Rule 18(2).

CONCLUSION

41. The late-filed TM8 is not admitted into the proceedings and the applicant will be treated as not defending the opposition. The application is deemed abandoned in respect of all the goods applied for.

42. As the late TM8 will not be admitted into the proceedings, I do not find it necessary to consider the opponent's request for a security of costs from the applicant any further.

COSTS

43. 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. I assess these as follows:

Official fee for filing the form TM7:	£200
Preparing the statement of case and considering the counterstatement:	£200
Preparing skeleton arguments and attending the hearing:	£500

Total:

£900

44. I therefore order KITSLIMY BeauDeLab LTD to pay the sum of £900 to Roger Aoun. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 9th day of June 2023

Catrin Williams

For the Registrar