

O-060-04

TRADE MARKS ACT 1994

**IN THE MATTER OF AN INTERLOCUTORY HEARING IN RELATION TO
APPLICATION NOs 2210119 & 2210129 IN THE NAME OF
TELSTRA CORPORATION LIMITED**

AND

**OPPOSITIONS THERETO (NOs 90485 & 90609 - CONSOLIDATED CASES) BY
TETRA LAVAL HOLDINGS & FINANCE S.A.**

BACKGROUND

1. An Interlocutory Hearing was scheduled to take place before me on 11 December 2003 in relation to the consolidated opposition proceedings detailed on the first page of this decision. The hearing was appointed to determine the applicant's request for an extension of time to file evidence under Rule 13(9) of the Trade Mark Rules 2000. In advance of the hearing the applicant indicated that they would not be attending the hearing, they did however file written submissions (dated 9 December 2003) in lieu of attendance. On 8 December 2003 the opponent filed a letter indicating that they would be attending the hearing, their skeleton argument was also filed under cover of that letter. However, on the morning of the hearing they filed a further letter stating that they would no longer be attending and asked that their skeleton argument be treated as their written submissions in lieu of attendance.

2. On 15 December 2003 I wrote to both parties advising them that having considered all the papers before me I had decided to refuse the applicant's request for an extension of time. On 9 January 2004 the applicant filed a form TM5 requesting a written statement of the grounds for my decision.

3. It is not necessary to detail the early history of these proceedings; any relevant information will be included later in the decision. It is sufficient to say that following the filing of the oppositions, the applicant's defence, and the opponent's evidence in support of the oppositions, the applicant was set a three month period (under Rule 13(9)) ending on 7 October 2003 to file any evidence in support of their applications. On 7 October 2003 the applicant filed a witness statement of Mr Julius Stobbs (one of the applicant's trade mark attorneys) together with two exhibits. The applicant's covering letter also indicated that this was not the totality of their evidence, an extension of time of 3 months in which to file additional evidence was therefore requested. The reasons for the extension of time, as given in the applicant's letter of 7 October 2003, were:

"The applicant has not yet been able to conclude its evidence, and is considering obtaining statements from its own phonetics experts to counter the evidence filed on behalf of the opponent in this matter. It has not been possible to find, contact and discuss potential evidence with such an individual within the timescale set.

In addition, the attorney who normally has the handling of these matters is currently absent from the office due to the fact that his wife is having his second child. This has necessarily led to some delay in obtaining and finalising evidence in reply on this matter. We confirm that progress has been made towards the finalisation of evidence, as is shown in the witness statement filed herewith, and we respectfully request an extension of time until 7 January 2003 within which to file further evidence."

4. The Trade Mark Registry's preliminary view was to allow the extension of time sought, this was communicated to the parties on 6 November 2003. The opponent, however, objected to the granting of additional time and requested a hearing on the matter; their main arguments against the granting of the extension were contained in their letter of 6 November 2003, they were in summary:

- The reasons given were inadequate and incomplete. To still be considering whether statements should be obtained at the end of the period allowed for filing evidence did not justify an extension. No indication was provided on when they started making

enquiries to identify a suitable witness or what steps, if any, were taken to deal with these issues.

- The absence of the attorney did little to explain what had been done during the period of time in which evidence could have been prepared.
- The evidence filed by the due date was just a single page from the Trade Mark Attorney's own office which would have taken little time to prepare and could have done little to prevent progress being made with other aspects of the case.

Applicant's written submissions

5. In their written submissions the applicant gives a brief history of the proceedings. They observe that the opponent also filed partial evidence at the end of their initial three month period together with a request for an extension of time and that they had not objected to this request. They mention this point again later in their submissions and say that it would only be fair to also grant an extension to the applicant in similar circumstances.

6. The applicant then refers to the decision of Mr Simon Thorley QC (sitting as the Appointed Person) in *Siddiqui's application* (BL 0/481/00). They feel that they have met the criteria laid down by Mr Thorley QC in this decision i.e. that they have clearly shown what they have done, what they want to do and why it is that they have not been able to do it. The applicant also states that evidence from phonetics experts (as has been filed by the opponent) is not filed on a regular occurrence and that one of the decisions that needed to be made by the applicant was whether the opponent's evidence carried any relevant weight and consequently whether there was any benefit, need or requirement to put in their own evidence to counter it.

Opponent's written submissions

7. The opponent begins their submissions by referring to the Trade Marks Registry's most recent Practice Direction in relation to extensions of time, to the decision of Mr Geoffrey Hobbs QC (sitting as the Appointed Person) in *Liquid Force* [1999] RPC 429, and to the *Siddiqui* case referred to above. They state that the position set out in these documents requires that an extension of time should not be granted without good reason.

8. Reference is made to the criteria set out by Mr Thorley QC in *Siddiqui's Application*. The opponent does not consider that the criteria has been met. In terms of what the applicant has done, they observe that whilst the witness statement of Mr Stobbs has been filed, the circumstances surrounding evidence from a phonetics expert is less than clear. They say that because the applicant is merely "considering obtaining a statement from its own phonetics expert" it is not clear what the applicant has actually done; they say that nothing may have been done at all. In terms of what the applicant wants to do, the opponent again considers this to be less than clear. They feel that because the applicant is "considering" obtaining a witness statement from its own phonetics expert, this does not clearly indicate what the applicant wants to do.

9. The opponent then turns to consider "why the applicant has not been able to do it". They say that the applicant's claim that it has not been possible to find, contact and discuss potential evidence within the timescale set is irrelevant because the applicant is still considering whether to file such evidence. They also observe that no reasons have been

advanced as to why it has not been possible to carry out these steps. They point out that the evidence from the opponent's phonetics expert was obtained in a time period of only 6 days. The opponent also says that the applicant's attorney's absence from the office should have been anticipated and should not have delayed progress being made.

10. The opponent then addresses whether the facts put forward merit the extension. The opponent does not feel that they do. They do not consider that the applicant has acted with the required level of diligence during the period allowed so far and further that there is nothing to suggest that this is an exceptional case. The only other point the opponent mentions is in response to the applicant's suggestion that because the opponent was granted an extension in similar circumstances then it is only fair to grant the applicant one. The opponent disagrees with this as they feel that the circumstances of their request were quite different from that of the applicant.

DECISION

11. The discretionary power to extend time periods is provided for in Rule 68 of the Trade Mark Rules 2000, the relevant parts of which read:

“68. - (1) The time or periods-

(a) prescribed by these Rules, other than the times or periods prescribed by the rules mentioned in paragraph (3) below, or

(b) specified by the registrar for doing any act or taking any proceedings,

subject to paragraph (2) below, may, at the written request of the person or party concerned, or on the initiative of the registrar, be extended by the registrar as she thinks fit and upon such terms as she may direct.

(2) Where a request for the extension of a time or periods prescribed by these Rules-

(a) is sought in respect of a time or periods prescribed by rules 13, 18, 23, 25, 31, 32, 33 or 34, the party seeking the extension shall send a copy of the request to each person party to the proceedings;

(b) is filed after the application has been published under rule 12 above the request shall be on Form TM9 and shall in any other case be on that form if the registrar so directs.

(3) The rules excepted from paragraph (1) above are rule 10(6) (failure to file address for service), rule 11 (deficiencies in application), rule 13(1) (time for filing opposition), rules 13(3) and 13(5) (time for filing counter-statement), rule 13(4) (cooling off period) save as provided for in that rule, rule 23(4) (time for filing opposition), rule 25(3) (time for filing opposition), rule 29 (delayed renewal), rule 30 (restoration of registration), rule 31(2) (time for filing counter-statement), rule 32(2) (time for filing counter-statement), rule

33(2) (time for filing counter-statement), and rule 47 (time for filing opposition).

(4) Subject to paragraph (5) below, a request for extension under paragraph (1) above shall be made before the time or period in question has expired.

(5) Where the request for extension is made after the time or period has expired, the registrar may, at her discretion, extend the period or time if she is satisfied with the explanation for the delay in requesting the extension and it appears to her to be just and equitable to do so.”

12. Both parties have referred me to the decision of Mr Simon Thorley QC in *Siddiqui's Application*; the opponent has also referred me to Mr Hobbs' decision in *Liquid Force*. In *Siddiqui's Application*, Mr Simon Thorley QC said:

“Accordingly, it must be incumbent on the applicant for the extension to show that the facts merit it. In a normal case this will require the applicant to show clearly what he has done, what he wants to do and why it is that he has not been able to do it. This does not mean that in an appropriate case where he fails to show that he has acted diligently but that special circumstances exist an extension cannot be granted.”

13. Whilst laying down the above criteria, Mr Thorley QC affirmed the line taken in *Liquid Force* where Mr Hobbs QC cited from and applied the decisions in *Finnegan v. Parkside Health Authority (1998) 1WLR 411* and *Mortgage Corporation Limited v. Shandoe (1996) TLR 751* in reaching his conclusions that:

“the absence of good reason for failure to comply with a time limit was not always and in itself sufficient to justify refusal of an extension of time; the true position being that it is for the party in default to satisfy the court that despite his default the discretion to extend time should nevertheless be exercised in his favour, for which he could rely on any relevant circumstances.”

14. Taking the case law in the round, I consider that I must firstly look to the criteria laid down in *Siddiqui's Application* and decide, based on it, whether the facts in this case warrant the grant of additional time. However, if the applicant fails on this, I am not prevented from granting the extension if there are any special or relevant circumstances that I consider sufficient to justify the extension. In other words, I have a broad discretion to grant an extension but only when I feel that the facts before me warrant it.

15. Accordingly, I turn to consider the facts before me and apply them to the criteria laid down in *Siddiqui's Application*. I firstly look at what the applicant has done prior to their request for an extension of time. I agree with the opponent that all I can take into account is that the witness statement of Mr Stobbs has been compiled and filed. With regard to the preparation of evidence from a phonetics expert, the applicant has said that they have been unable to find, contact and discuss potential evidence with an appropriate individual. However, they do not say what steps, if any, they have taken. The applicant, in their own words, have been “considering” obtaining statements, therefore, the only step that I can realistically infer that has taken place is that some thought has been given to obtaining evidence from a phonetics expert.

16. In terms of what the applicant wants to do, again this is not particularly clear. It appears that a positive decision by the applicant to pursue evidence from a phonetics expert has yet to be reached. No indication has been given that evidence from a phonetics expert will be forthcoming. The applicant states that they have been “unable to find, contact and discuss potential evidence with an appropriate individual” so it could be inferred, although it is far from clear, that if a decision to pursue such evidence is reached then these are the steps that will be taken.

17. I next consider the reasons put forward as to why the applicant has been unable to do what they wanted to do. I feel that little reason has been put forward here. In their initial request they simply say that they have been unable to do what they want to do in the time provided. Then also refer to fact that the applicant’s attorney was currently (presumably at the time the TM9 was filed) absent from work due to paternity leave. In their written submissions they also state that the filing of evidence from a phonetics expert is not a regular occurrence and therefore decisions had to be made as to the weight that could be attached to the opponent’s evidence and whether it required the applicant to counter it. However, there is nothing to suggest that this decision making process would require a lengthy amount of time to be conducted.

18. Having assessed the information put forward against the criteria laid down in *Siddiqui’s Application*, I must decide whether the facts warrant the granting of the extension. Some work towards the completion of the applicant’s evidence has clearly taken place but I do not consider that the evidence filed so far to be particularly voluminous. The evidence would not, in my opinion, have been difficult to locate or have taken a significant amount of time to produce (the evidence consists of a list of the applicant’s world wide registrations together with copy correspondence from an opposition they were party to before the Office for Harmonisation in the Internal Market). Filing this evidence would not have been so onerous a task to have delayed or prevented the pursuit of evidence from a phonetics expert. The only other work that appears to have taken place is the act of considering whether to file evidence from a phonetics expert.

19. There is little information before me to explain why the steps they intend to take could not have been carried out in the three month period already provided to the applicant for filing their evidence. The only explanations put forward, in addition to the statement that the time was not sufficient, was that evidence from phonetics evidence is not common and decisions had to be made as to whether such evidence should be countered. I do not consider that such a decision making process would have been so time consuming to have had any great effect on the capacity of the opponent to compile their evidence.

20. The applicant also refers to the fact that one of their Trade Mark Attorneys was absent from work due to paternity leave. No information is given as to when this paternity leave commenced or the impact it was having on the applicant’s efforts to compile their evidence. Having said that, even if such information had been provided, there is nothing to say that another attorney in the firm could not have taken on the responsibility of compiling such evidence. This is particularly the case when one bears in mind that periods of paternity leave are capable of anticipation and plans to deal with the attorney’s work could have been set down well in advance of his absence.

21. Taking all these factors into account I consider that there is no justification to allow the request for the extension of time sought. Neither do I consider there to be any special circumstances in this case that may have persuaded me to allow the request. The only other factor that I have yet to specifically address is the fact that the opponent was granted an extension of time also after having filed partial evidence and the applicant's claim that it would only be fair to also allow their request. I see little merit in this argument. Whilst the Registrar must ensure that he acts in an equitable manner, an extension of time can only be considered against the reasons put forward in relation to each request for the exercise of discretion. The reasons put forward in this case are perfunctory and lack the required detail such that I see no justification for the grant of the extension of time.

Conclusion

22. The extension of time requested by the applicant stands as refused. However, given that some evidence was filed by the applicant within the original timescale, a three month period was given to the opponent to file evidence strictly in reply.

Dated this 8th Day of March 2004

**Oliver Morris
For the Registrar
The Comptroller-General**