

O-101-16

TRADE MARKS ACT 1994

IN THE MATTER OF A JOINT HEARING IN RELATION TO

APPLICATION NO 3104606

IN THE NAME OF TELUGU NRI FORUM CORPORATION

AND

NOTICE OF OPPOSITION THERETO BY TELUGU NRI FORUM

Background

1. Application No 3104606 stands in the name of Telugu NRI Forum Corporation, has a filing date of 18 April 2015 and was published in the *Trade Marks Journal* on 31 July 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 2 November 2015. On behalf of its client Telugu NRI Forum, KTS Legal filed a Form TM7 (notice of opposition) on 30 October 2015. Whilst this form was received within the period allowed, it was not accompanied by any fee nor was any fee received before the expiry of the period for filing opposition. The registrar wrote to the parties (sent by email on 9 November 2015) notifying them that he was minded to reject the opposition because no fee had been received and advising the putative opponent of its right to be heard in the matter. That same day, a fee was received from KTS Legal and they requested to be heard. In the event, two hearings took place, both by telephone. The initial hearing was held on 10 December 2015 ("the initial hearing") with a further hearing taking place on 24 February 2016 ("the later hearing"). At both, Mr Alluri represented the applicant and Mr Subramani, of KTL Legal, represented the putative opponent.

Decision

3. Section 38 of the Trade Marks Act 1994 provides for oppositions. The relevant part of the section reads:

"38 (1) When an application for registration has been accepted, the registrar shall cause the application to be published in the prescribed manner.

(2) Any person may, within the prescribed time from the date of the publication of the application, give notice to the registrar of opposition to the registration.

The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition."

4. Rules made under the Trade Marks Act 1994 make detailed provisions in relation to practice and procedure. The Rules in force, and applicable for the purposes of the issue before me, are The Trade Marks Rules 2008.

5. The relevant Rules for present purposes are as follows:

"4(1) The fees to be paid in respect of any application, registration or any other matter under the Act and these Rules shall be those (if any) prescribed in relation to such matter by rules under section 79 (fees).

(2) Any form required to be filed with the registrar in respect of any specified matter shall be subject to the payment of the fee (if any) prescribed in respect of that matter by those rules."

6. The Trade Mark (Fees) Rules 2008 state:

“1(2) These Rules shall be construed as one with the Trade Mark Rules (2008).”

7. Under the heading ‘Fees Payable’, Rule 2 states:

“...(2) In any case where a form specified in the Schedule as the corresponding form in relation to any matter is specified in the 2008 Rules, that form shall be accompanied by the fee specified in respect of that matter (unless the 2008 Rules otherwise provide).”

8. In TITAN¹ the hearing officer stated (albeit in respect of the Trade Mark Rules 2000):

“34. In summary I take the view that the Trade Marks Rules and the Trade Marks (Fees) Rules are to be read together; payment of the fee is an integral part of the process of filing an opposition; the word "accompanied" should be given its normal meaning; no separate time period (prescribed or specified) arises in relating to the opposition fee; the fact that no such separate provision is made is consistent with the intention behind the statutory provisions to provide certainty in opposition proceedings; it puts opponents and applicants on an equal footing (no extension of time being available to the latter for filing a counterstatement) and it is consistent also with the fact that where, as in the case of an application for a trade mark, payment may be made separately from the filing of the form, the Rules make express provision to this effect.”

9. At the initial hearing Mr Subramani submitted that he was in possession of a letter from his company’s bank confirming that the requisite fee was originally debited from their account on 30 October 2015. He submitted that there must have been a delay in the banking system that led to the fee not being received until 9 November. Having heard submissions from both parties I gave my decision and wrote to the parties the same day to confirm it. The letter stated:

“I allowed Mr Subramani until 31 December 2015 to file a statutory declaration to explain the delay in receipt of the fee said to have been sent on 30 October. Exhibited to that statutory declaration should be an original letter from the bank confirming the payment was made on 30 October along with a copy of a bank statement (redacted as necessary) to show the debit from the company’s account.

...If received, the evidence will be reviewed and rejection of the opposition reconsidered.”

10. On 29 December, the registrar received documentation from KTS Legal. It consisted of a statutory declaration by Kumar Subramani dated 24 December 2015, along with a copy of a letter from HSBC bank dated 27 November 2015 and a copy of a bank statement. These latter documents were not filed as exhibits to the witness statement as had been directed but were filed as stand-alone documents. Following receipt of these documents, a preliminary view was given that the evidence filed did

¹ BL O/460/01

not adequately support the claims made by the putative opponent and that the Notice of Opposition would be refused. This led to the later hearing.

11. In his statutory declaration, Mr Subramani stated that, as per his client's instructions, he had filed the notice of opposition on 30 October 2015 and that he had transferred the sum of £200 by electronic transfer the same day.

12. The HSBC letter does not appear to be an original as directed but is dated 27 November 2015 and indicates that a payment of £200 was debited on 30 October and paid to "IPO-CARDIFF BP". I understand that the BP refers to "Bill Payment". The bank statement appears to be a copy of a document downloaded from the internet. It has been heavily redacted but lists a payment of £200 on 30 October to IPO-Cardiff. Whilst a payment was received it was not received until 9 November and was recorded as being made by FP, which I understand to refer to a Faster Payment. Mr Subramani accepted that no evidence has been filed to explain how something paid by Bill Payment would be recorded as being received as a Faster Payment.

13. Mr Alluri sought to challenge the authenticity of the HSBC letter on the basis that the reference given on it (SCxxx) is indicative of it relating to a security charge rather than what would be considered a normal transaction through a bank account, however, whilst he made a number of submissions recounting telephone calls to the relevant bank, I have no evidence which would confirm this. He also seeks to challenge its authenticity on the basis that it contains a number of grammatical errors. I accept that it has these errors and would further comment that the presentation of the listing on the bank statement also appears to be in a slightly different format to the others appearing on it. Despite these apparent anomalies, however, I have no evidence that these documents have been falsified or are not authentic.

14. As indicated above, Mr Subramani submitted that the reason the fee was not received until 9 November, outside the period for filing the Notice of opposition, must have been down to some unexplained delay in the banking system. In his statutory declaration, he stated:

"I understand that the above sum was not received by the Intellectual property office until 09th November 2015 and I believe that it could be the problem associated with the banking system in getting the funds on time to the correct account."

15. Mr Subramani's witness statement did not give any explanation of why or how he had come to "understand" there to be a "problem associated with the banking system" nor did it explain what any such problem may have been. In skeleton arguments prepared for the later hearing, it was submitted that the payment was delayed "due to a banking technical error which the Opponent's solicitors were not aware" and further submitted that "Any banking error in getting the funds to the recipient on time, is outside their control" but there is no evidence that there was any error, whether technical or otherwise. Mr Subramani eventually accepted that there was no such evidence and asked to be given time to provide it, submitting that it would be "disproportionate and unfair not to allow the admittance of the opposition".

16. At the later hearing, I refused to admit the Notice of opposition. As I reminded Mr Subramani, at the initial hearing I allowed the putative opponent ample opportunity to file evidence to explain any delay but it had failed to do so whether by Mr Subramani's own evidence or in evidence from the bank or some other source. Whilst the Notice of opposition has not been accepted and the application will now proceed to registration, the putative opponent would still have the ability to seek its cancellation. Mr Subramani accepted this but submitted that this would cause unnecessary expense and delay. I do not consider there would be unnecessary expense and delay. Mr Subramani stated that any cancellation action would be brought on the same grounds as set out (very briefly) in the Form TM7 already submitted and, other than the minimal time required to complete the relevant form, I cannot see that there would be any additional expense (the filing of the cancellation form will attract a fee but the fee received on 9 November will be refunded). Whilst a cancellation action cannot be filed until the application has completed its registration process, it should not be a lengthy process. In any event, any delay there might be cannot be used to override the putative opponent's failure to comply with the requirements of the Rules.

17. Mr Subramani submitted that the failure was one that could be rectified under the provisions of Rule 74. This states:

"74.—(1) Subject to rule 77, the registrar may authorise the rectification of any irregularity in procedure (including the rectification of any document filed) connected with any proceeding or other matter before the registrar or the Office.

(2) Any rectification made under paragraph (1) shall be made—

- (a) after giving the parties such notice; and
- (b) subject to such conditions, as the registrar may direct."

Rule 77 states:

"77.—(1) Subject to paragraphs (4) and (5), the registrar may, at the request of the person or party concerned or at the registrar's own initiative extend a time or period prescribed by these Rules or a time or period specified by the registrar for doing any act and any extension under this paragraph shall be made subject to such conditions as the registrar may direct.

(2) A request for extension under this rule may be made before or after the time or period in question has expired and shall be made—

- (a) where the application for registration has not been published and the request for an extension relates to a time or period other than one specified under rule 13 and is made before the time or period in question has expired, in writing; and
- (b) in any other case, on Form TM9.

(3) Where an extension under paragraph (1) is requested in relation to proceedings before the registrar, the party seeking the extension shall send a copy of the request to every other person who is a party to the proceedings.

(4) The registrar shall extend a flexible time limit, except a time or period which applies in relation to proceedings before the registrar or the filing of an appeal to the Appointed Person under rule 71, where—

- (a) the request for extension is made before the end of the period of two months beginning with the date the relevant time or period expired; and
- (b) no previous request has been made under this paragraph.

(5) 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.

(6) In this rule—

“flexible time limit” means—

(a) a time or period prescribed by these Rules, except a time or period prescribed by the rules listed in Schedule 1, or

(b) a time or period specified by the registrar for doing any act or taking any proceedings; and “proceedings before the registrar” means any dispute between two or more parties relating to a matter before the registrar in connection with a trade mark.”

18. Mr Subramani referred me to an earlier opposition case O-237-09 where the registrar had allowed an opponent to amend his Form TM7 after the expiry of the opposition period and following the filing of a Form TM7A. That situation is not on all fours with the current one, where the issue is that a form has been filed which is not the subject of a flexible time limit (the relevant form being listed in Schedule 1) and which has not been accompanied by the requisite fee. And whilst it is clear from Rules 74 and 77 above, that the registrar has the power to rectify irregularities, as Rule 77(5)(a) makes clear, such irregularities must be attributable to a default, omission or other error by the registrar, the Office of the International Bureau. That is not the case here.

Summary

19. As per the Schedule set out in the Rules, a Form TM7 is a form which, under Rule 2 of the Trade Mark (Fees) Rules 2008, “shall be accompanied by the fee specified”. The Form TM7 received on 30 October 2015 was not accompanied by the fee as required and furthermore, that fee was not received until after the expiry of the period for filing opposition. Despite the putative opponent’s claim that the fee had

been paid in time but was delayed by an unidentified error in the banking system, no evidence of any such delay has been filed, even though it has been given the opportunity to file such evidence. In the circumstances, I refused to admit the Form TM7 and the application shall proceed to registration. The fee which was received on 9 November 2015 will be refunded.

20. Neither party having sought them, I made no order as to costs.

Dated this 25th day of February 2016

**Ann Corbett
For the Registrar
The Comptroller-General**