

O-115-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN INTERLOCUTORY HEARING  
HELD IN RELATION TO APPLICATION NO. 2320344  
IN THE NAME OF WHITBY FUDGE  
AND  
OPPOSITION NO. 91813 THERETO BY  
DENNIS HARLAND AND SUSAN HARLAND**

## **TRADE MARKS ACT 1994**

### **IN THE MATTER OF an interlocutory hearing held in relation to application No. 2320344 in the name of Whitby Fudge and opposition No. 91813 thereto by Dennis Harland and Susan Harland**

#### **Background**

1. Trade Mark No. 2320344 was filed on 11 January 2003 and stands in the name of Whitby Fudge. The application was published for opposition purposes on 11 April 2003.
2. On 10 July 2003 Carin Burchell Trade Marks Services, who subsequently underwent a change of name to Branded!, acting as agent for Dennis Harland and Susan Harland, filed notice of opposition against the application. The notice was served on the applicant following some initial difficulties with the postal services which I do not need to explain for the purposes of this decision. The applicant then appointed an agent, Harrison Goddard Foote, and the opposition then followed the usual course with the applicant filing a defence and the opponent filing its evidence. The registrar then allowed the applicant until 18 January 2005 to file its evidence.
3. On 13 January 2005 the applicant filed a Form TM9 seeking an extension of the period for filing evidence. The request was considered by the registry but refused in a letter dated 20 January 2005 as it was considered there were insufficient reasons given to justify its grant.
4. By way of a letter dated 26 January 2005, the applicant provided further information effectively asking the registrar to reconsider the preliminary view. The registrar did so and notified the parties in a letter dated 7 February 2005 of its revised preliminary view that the extension should be granted.
5. The opponent then wrote to the registry by a letter dated 14 February 2005, objecting to the preliminary view to grant the extension, indicating that neither the Form TM9 nor the applicant's letter of 26 January 2005 had been copied to the opponent, as required by rule 68(2) and the registrar's published practice.
6. The registry then issued a letter dated 23 February 2005 indicating that a procedural irregularity appeared to have occurred. The letter went on to withdraw the preliminary view, stating that as the form had not been copied, the request for an extension would not be considered.
7. The applicant requested to be heard.

#### **The hearing**

8. An interlocutory hearing took place before me on 7 April 2005. Mr Lumber represented the applicant, Ms Burchill represented the opponent.

9. Having considered the skeleton arguments filed and the submissions made by both parties I gave my decision. I allowed the applicant until close of play that day to copy both the Form TM9 and its letter of 26 January to the opponent and to confirm to the registrar that this had been done. Subject to this being done, I indicated that the extension of time request would then be considered by the registrar in accordance with usual practice.

10. On 14 April 2005 Branded! filed a Form TM5 requesting a written statement of the grounds of my decision. These I now give.

### **Skeleton arguments**

#### **Applicant's skeleton argument**

11. The applicant provided a skeleton argument by way of a letter dated 1 April 2005. The letter essentially explained that the failure to copy the request for an extension was due to an error on behalf of one of the staff employed within the applicant's attorney's office. The failure to copy had not been identified as the employee's supervising officers were out of the office at the time the request was prepared and sent out.

12. The applicant submitted that there was no bad faith associated with failing to copy the documentation. It was further submitted that it would not be in the public interest for evidence relating to a trade mark opposition to be refused as the result of an error by an agent.

#### **Opponent's skeleton argument**

13. After setting out the background to the case, the opponent raised a preliminary issue on the purpose of the hearing. I will return to this in due course.

14. The opponent indicated that it did not dispute that it was possible to obtain an extension of time for filing evidence but argued that the applicant had failed to comply with the legislative requirement that any such request be copied to the opponent.

15. The opponent referred to the registrar's practice directions on extensions of time in inter partes actions and submitted that the registrar had been correct to refuse to consider the request for an extension of time.

### **Decision**

#### **Preliminary issue**

16. Ms Burchill submitted that the only purpose of the hearing was:

“for the Applicant to provide arguments as to the reason why the decision of the Registrar detailed in the letter of 23 February 2005 should be reversed and should not be used to enable the Applicant to have an opportunity “to provide

**further arguments** in support of his request for an extension of time”([Ms Burchill’s] emphasis added.)”

17. Ms Burchill went on to submit:

“allowing the attorneys for the Applicant “to provide **further arguments** in support of his request for an extension of time” would go against the overriding objective of fairness to both parties....”

18. The purpose of the hearing was set out in the registrar’s letter advising of the appointment of the hearing. The letter indicated that the hearing was arranged “to discuss the preliminary view of the Registrar issued on 23<sup>rd</sup> February 2005 concerning the refusal to consider the extension requested by the applicants. The Hearing Officer will make a decision in respect of the above and the consequences thereof.” The purpose of the hearing being clearly set out in this letter to the parties, I therefore proceeded on this basis.

19. Alteration of time limits are provided for by rule 68 of the Trade Marks Rules 2000 (as amended). This states:

“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 13,13C, 18, 23, 25, 31, 31A, 32, 32A, 33, 33A 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), rule 13A(1) (time for filing counter-statement), 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(3) (time for filing counter-statement and evidence of use or reasons for non-use), rule 32(3) (time for filing counter-statement), rule 33(6) (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).....

(6).....

(7).....”

20. The applicant’s request for an extension was in respect of an extension to the period for filing evidence and thus was not excepted by rule 68(3). The request was made on Form TM9 as required by rule 68(2)(b). The request was made before the period for filing evidence had expired and therefore it complied with the requirements of rule 68(4). What the applicant failed to do was to copy the request to the opponent as is required by rule 68(2)(a).

21. The registrar has issued a number of practice directions on extensions of time in inter partes proceedings. The first of these is entitled:

“Inter partes actions before the Registrar: Extensions of time practice”

and includes the following paragraph:

“When filing a Form TM9 the requester must confirm that the form (and any attachment) has been copied to every other party to the proceedings in accordance with rule 68(2)(a) of the Trade Marks Rules 2000 (see also Registrar’s Direction in relation to Extensions of time). Full reasons in support of the request must be provided and, in the case of requests filed after the time or period has expired, full reasons also to explain the delay in making the request must be provided. It is likely that the reasons for the request will need to be filed on a separate sheet attached to the Form TM9. The extension will not be granted if the request has not been copied to the other party(ies) to the proceedings or in the absence of detailed reasons.”

22. The second practice direction reads as follows:

“Registrar’s Direction in relation to Extensions of time

The Registrar directs that, under the provision of Rule 3 of the Trade Marks Rules 2000 and Section 66 of the Trade Marks Act 1994, any request for an extension of time in inter partes proceedings before the Registrar must be copied to any other party to the proceedings. This Direction is also in accordance with Rule 68(2)(a) of the Trade Marks Rules 2000. Failure to comply with this Direction will result in the Registrar refusing to consider the extension of time request.”

23. It is unfortunate that the two practice directions differ in that the first indicates that non-copying of the request will result in a refusal to consider any request whilst the second indicates the request will not be granted. The difference may appear somewhat

semantic but my reading of the two directions in combination is that a request for an extension of time which has not been copied to any other party to the proceedings will not be considered and so cannot be granted.

24. The Form TM9 was reviewed when initially received by the registry but the request was refused because insufficient reasons had been given to allow it to be granted. The applicant filed further reasons by letter and, in accordance with usual practice, the request was reconsidered by the registry. A letter was then issued advising of the registrar's preliminary view that the extension should be granted.

25. At this point the opponent wrote to advise the registrar that it had not received a copy of either the Form TM9 nor the additional reasons. It appears the registry had failed to notice that the applicant had not provided confirmation that these documents had been copied to the opponent. Having received the opponent's letter, the registry withdrew the preliminary view and advised both parties that it was refusing to consider the request. Given the requirements of rule 68(2)(a), I believe that it was correct to do so.

26. I therefore went on to consider what the consequences of this decision should be. Whilst it might be considered best practice for a party seeking an extension of time to copy the request to any other party to the proceedings at the same time as making the request, neither rule 68(2)(a) nor the registrar's practice directions specify when the request should be copied nor do they impose a time limit within which this should be done.

27. I bear in mind the comments made by Pumfrey J in the *Friskies* case [2000] RPC 536 where he said:

“I have no doubt that the registrar has the power to regulate the procedure before her in such a way that she neither creates a substantial jurisdiction where none existed, nor exercises that power in a manner inconsistent with the express provisions conferring jurisdiction upon her.”

28. There was nothing before me to suggest that the failure to copy the relevant documents to the opponent was anything other than an unfortunate oversight by the applicant's trade mark attorneys. It seemed to me that the applicant should not suffer because of the attorney's failure and, whilst it was clearly unacceptable that the opponent had been unsighted on the request and the reasons for it, the matter should be dealt with in a way that was proportionate in all the circumstances of the case. I also bore in mind the overriding objective to provide as much certainty as the nature of the case allowed given that there remains a substantive dispute between the parties to resolve.

29. Bearing the comments of Pumfrey J in mind, I therefore allowed the applicant until close of play on the day of the hearing to copy the Form TM9 and letter dated 26 January 2005 to the opponent and to confirm to the registrar that this had been done. Subject to this being carried out satisfactorily, I indicated that the registrar would then consider the request for an extension of time in accordance with usual practice.

**Costs**

30. Neither party made any request for, or representations on an award of costs in respect of the hearing and so the matter was not one for me to decide. In case this decision should go before an appellant tribunal, however, I would confirm that the hearing took place by telephone and was brief, as were the skeleton arguments provided by both parties.

**Dated this 26<sup>th</sup> day of April 2005**

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