

O-193-16

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION FOR CANCELLATION
UNDER NO 500864 BY KEVIN ALAN BRZOZOWSKI
OF REGISTRATION NO 3053122
IN THE NAME OF ZILLION ENTERPRISE

Background

1. These cancellation proceedings were launched on 1 June 2015 when Kevin Alan Brzozowski (“the applicant”) filed a Form TM26i seeking invalidation of registration No 3053122 on grounds based on sections 3(1)(b)(c) and (d) of the Trade Marks Act 1994 (“the Act”). For reasons that I do not need to address, the form was subject to amendments before it was eventually served on the registered proprietor. The proceedings were joined on 26 September when Zillion Enterprises (“the registered proprietor”) filed a notice of defence and counterstatement on Form TM8. Again, for reasons I do not need to address, the Form TM8 was subject to amendments. By way of a letter dated 2 December, the registrar served the amended Form TM8 on the applicant and allowed him a period expiring on 2 February 2016, to file evidence in support of his request for cancellation.

2. No evidence was filed within the period allowed, however, by way of a Form TM9R received on 8 February 2016, the applicant requested a retrospective extension of time to enable him to file such evidence. Having considered the request and, by way of a letter dated 12 February, the parties were advised of the registrar’s preliminary view which was to grant the request and extend the period for filing evidence to 23 February. The parties were also advised that if either disagreed with that preliminary view, they should request to be heard within fourteen days (i.e. on or before 26 February).

3. By way of an email dated 26 February, the registered proprietor indicated its disagreement and requested to be heard. In the meantime, the applicant filed evidence in the form of a witness statement and 5 accompanying exhibits. For completeness, I record that the evidence was filed in a short period straddling midnight which led to two of the exhibits being filed on 23 February with the remaining exhibits and the witness statement itself being filed on 24 February.

4. Matters came before me at a Case Management Conference (“CMC”) held by telephone on 5 April 2016. In attendance were Mr Brzozowski himself and Ms Tham of the registered proprietor. Each confirmed they had no previous experience of such matters. Having considered their respective submissions, I refused the applicant’s request for a retrospective extension of time. As a consequence, the evidence filed by him was not admitted which, in turn, led to a finding that the application for cancellation fails. This decision sets out my reasons in full.

Decision

5. As indicated above, having been served with notice of the application for cancellation, the registered proprietor filed a Form TM8 seeking to defend the registration. Rule 42 of the Trade Marks Rules 2008 (as amended) sets out the next stage of proceedings and states:

“42.—(1) Where the proprietor has filed Form TM8, the registrar shall send notice to the applicant inviting the applicant to file evidence in support of the grounds on which the application is made and any submissions and send a copy to all the other parties.

(2) The registrar shall specify the periods within which evidence and submissions may be filed by the parties.”

6. In accordance with the above rule, and by way of a letter dated 2 December 2015, the parties were advised that the applicant was allowed until close of play on 2 February 2016 to file evidence in support of his application for cancellation. No such evidence was filed within the period allowed, however, by way of a Form TM9R received on 8 February 2016, he requested a retrospective extension of time to enable him to file such evidence.

7. There is no dispute that the period for filing evidence is a period which may be extended or that the applicant filed the requisite form (albeit after the initial period had expired) and paid the appropriate fee.

8. There is no automatic “right” to an extension of time for filing evidence. Rather, it is a matter of discretion which will be exercised in exceptional cases taking into account all relevant factors. In considering the request for an extension of time, I bear in mind the comments made in *Siddiqui’s Application* BL O/481/00) where the Appointed Person stated:

“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. However, in the normal case it is by showing what he has done and what he wants to do and why he has not done it that the Registrar can be satisfied that granting an indulgence is in accordance with the overriding objective and that the delay is not being used so as to allow the system to be abused.”

Where the request is made after the original period has expired, the applicant must also satisfactorily explain the delay in making the request.

9. In the appropriate section of the Form TM9R, the applicant gave the following reasons in support of his request for an extension of time:

“My grand father was admitted into hospital with pneumonia mid january 2016. I have been totally pre-occupied with attending to him every day as we are very close.

Although I have evidence for submissions, I feel that a 2-3 week extension would allow me to fully collect any further evidence for submission. I also did not foresee his admission into hospital else would have completed all evidence sooner.”

10. At the hearing, the applicant submitted that his request for an extension of time had already been granted on the basis of the above reasons, suggesting that there was nothing further to be determined. As I explained to him, the registrar’s letter of 12 February had informed the parties that the decision to grant the extension was a preliminary one and would be subject to review should either party disagree with it.

Whilst its letter had given no specific reasons for its stance, the registered proprietor *had* disagreed with the preliminary view and therefore the matter came before me afresh for determination.

11. For her part, Ms Tham submitted that the extension of time was not justified. She stated the applicant had already been allowed a period of two months to file his evidence and that the reasons he had given in support of the extension were baseless. Referring to the evidence filed, she submitted that it consisted of a short witness statement signed on 23 February with exhibits consisting primarily of a few screen shots which would not have taken much time or effort to prepare and did not go to support the applicant's objections.

12. The applicant submitted that there was little he could add to the information set out on the Form TM9R. He stated that his grandfather's hospitalisation in mid-January 2016 had been unexpected. Mr Brzozowski submitted that the registered proprietor had not identified any good reason why the extension should not be allowed. I advised him that, whatever objections the registered proprietor might have, given that he is the person seeking the extension, the onus remains on him to satisfy the registrar that the discretion should be exercised in his favour (as per *Liquid Force* [1999] RPC 429).

13. In response to my questions, he accepted that the initial period allowed to him for filing evidence had begun on 2 December 2015 and expired on 2 February 2016 and that during this period, he had thought about what evidence to file but he gave no details of what, specifically, he had done to identify and gather evidence nor why he had not been able to complete it within the period allowed.

14. I note that in his reasons in support of his request, as set out above, the applicant had included a statement indicating that he had evidence to file. He did not give any details of what that evidence might have been nor did he file any such evidence at that time. Instead, he simply asked for a further "2-3 weeks [which would] allow [him] to fully collect **any further evidence** for submission" (my emphasis). The wording used suggests that he had not identified at that time what that further evidence might be but instead, was going to try to find something that he could file.

15. In my view, whilst he has stated that his grandfather's hospitalisation had pre-occupied him, these are not "strong or compelling" reasons (as per A J and MA Levy's Trade Mark [1999] RPC 292) which justify the grant of an extension of time. The hospitalisation is said to have taken place in mid-January, some six weeks after the two month period for filing evidence had begun. The applicant has failed to show what he had already done or what he still needed to do either when his grandfather was taken ill or at the end of the original period allowed to him and accordingly, he has failed to show that he acted diligently. His request for an extension of the period for filing evidence was filed retrospectively but he gave no explanation for this delay. He is clearly in default. This is not the end of the matter however because, as set out in *Liquid Force* (supra), an extension may still be granted if special circumstances are found to exist to warrant it.

16. I have no reason to doubt that, like many people would when finding themselves in the same position, the applicant would have been caused concern by the unexpected hospitalisation of his grandfather. I do not consider, however, that this is a special circumstance that allows me to grant the extension. There is nothing before me to suggest that he had made any real attempt to gather his evidence within the period originally allowed to him or indeed that he took any actions at all before his grandfather's illness. Neither is there anything before me to indicate how long the gentleman remained in hospital or whether and, if so how, it adversely affected the applicant's ability to carry on his business or day to day activities. Whilst it was filed after the expiry of the original period allowed to him and he gave no explanation for that delay, clearly, he was able to complete and submit a form seeking an extension of time on 8 February. That form indicated he had evidence available to file but he did not file any such evidence at that time. He did, however, file a brief witness statement and accompanying exhibits on 23/24 February and I go on to consider the effect of this.

17. I note that in *Liquid Force* (supra), Mr Hobbs Q.C. stated:

“...I consider that the natural reluctance of the registrar to refuse an extension of time for filing evidence which has belatedly come to hand cannot be elevated to the status of an invariable rule. In order to leave room for justice to be done I think it is necessary to recognise that a contested application for an extension of time to file evidence should not necessarily “follow the event” (i.e. succeed if the evidence is available at the hearing of the application and fail if it is not) and should not automatically succeed on the basis that refusal is liable to result in the commencement of another action between the same parties covering essentially the same subject matter. I nevertheless agree that these are important factors to be taken into account when deciding whether an extension of time should be granted or refused. In the present case the hearing officer took them into account without regarding them as determinative *per se*. I agree with that approach.”

Despite the fact that evidence has now been received, and notwithstanding that this may lead to the commencement of another action between the same parties covering essentially the same subject matter (a matter on which the applicant may wish to consider seeking professional advice), I was not persuaded, in the circumstances of this case as set out above, that the requested extension of time should be granted. The request was therefore refused. The consequence of this is that the evidence received on 23/24 February is deemed not to have been filed. Rule 43 (3) states:

“Where—

- (a) the application is based on an earlier trade mark of a kind falling within section 6(1)(c); or
- (b) the application or part of it is based on grounds other than those set out in section 5(1) or (2); or
- (c) the truth of a matter set out in the statement of use is either denied or not admitted by the proprietor,

the applicant shall file evidence supporting the application.

(4) Where the applicant files no evidence under paragraph (3), the applicant shall be deemed to have withdrawn the application to the extent that it is based on—

(a) the matters in paragraph (3)(a) or (b); or

(b) an earlier trade mark which has been registered and is the subject of the statement of use referred to in paragraph (3)(c).

(5) ...”

18. As per rule 43(3)(b), Mr Brzozowski’s application for cancellation is based on grounds other than those set out in section 5(1) or (2) of the Act. He has been deemed not to have filed evidence. That being the case, and in accordance with rule 43(4)(a), he is further deemed to have withdrawn his application for cancellation.

19. The application for cancellation having failed, the registered proprietor is entitled to an award of costs in its favour. Taking into account the fact that its involvement has been limited to the filing of the Form TM8 and dealing with matters that led to its attendance, by telephone, at the CMC, I make the award on the following basis:

Reviewing the applicant’s statement of case (TM26i) and filing its own (TM8) in reply:	£200
Preparation for and attending the CMC:	£50
Total:	£250

20. I order Kevin Alan Brzozowski to pay Zillion Enterprise the sum of £250. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of April 2016

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