

TRADE MARKS ACT 1994

**IN THE MATTER OF AN INTERLOCUTORY HEARING
IN RELATION TO A REQUEST BY TAM INTERNATIONAL
CONSULTANTS LIMITED (THE APPLICANTS) FOR AN EXTENSION OF
TIME IN WHICH TO FILE EVIDENCE IN SUPPORT OF
APPLICATION No 2137892 IN OPPOSITION PROCEEDINGS
(OPPOSITION No 49310)**

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5 **IN THE MATTER OF an Interlocutory Hearing**
in relation to a request by Tam International
Consultants Limited (the Applicants) for an extension of
time in which to file evidence in support of
Application No 2137892 in Opposition Proceedings
(Opposition No 49310)

10 Following an Interlocutory Hearing on 6 April 2000 I granted the applicants a final extension
of time to the date of the hearing to allow evidence, which had been filed on 4 April 2000, into
the proceedings. I am now asked by the opponents for my written grounds of decision.

15 **BACKGROUND**

20 Tam International Consultants Limited applied on 4 July 1997 to register the following trade
mark:



30 for the following specifications:

35 Class 1: Chemicals for use in industry; unprocessed artificial resins; unprocessed
plastics; adhesives used in industry; sealants; concrete repair materials;
polyurethanes; chemical products for use as sealants; coatings
consisting of epoxy resins; adhesive compositions with a base of epoxy
resins for use in industry; all the aforesaid goods for use in the
construction industry.

40 Class 2: Paints; raw natural resins; waterproof coatings; sealants; polyurethane
coatings; polyurethane finishes; surface coatings consisting of epoxy
type resin systems; epoxy coatings; epoxy resin coatings; epoxy
primers; surface coatings consisting of epoxy type binder resin systems;
epoxy resins for building repair and surface coating; polyurethane
injection resins for building repair and surface coating; all the aforesaid
goods for use in the construction industry.

45 Class 17: Packing, stopping and insulating material.

Class 19: Cement; cement based coatings; cement based materials; surface treatment preparations, coatings, surfacings and slurries all for applying to surfaces; cement based waterproof coatings.

5 Class 37: Construction and repair of buildings; rental of construction and repair equipment.

10 The application is numbered 2137892 and was published for opposition purposes on 23 September 1998, in Trade Marks Journal No. 6244. Notice of opposition was subsequently filed by Tam International Ltd on 23 December 1998. Opposition was also filed by another party. The applicants amended the specifications as follows:

CLASSES 1, 2, 17 had the following text added to each specification -

15 "; none relating to the ceramics industry."

CLASS 37 has been amended to read -

20 "Construction and repair of buildings; rental of construction and repair equipment; none being provided to the ceramics industry."

This amendment led to the other party withdrawing their opposition and no further mention need be made of that opposition. However, the opponents named above remained.

25 The applicants filed a counterstatement on 11 February 1999 and the Registry set a due date of 16 May 1999 for the opponents to file their evidence under Rule 13(4). The opponents duly filed evidence on 13 May 1999 but requested an extension of time of 3 months under Rule 62(1) in which to file additional evidence beyond that already filed. This further time was
30 duly granted. The evidence was completed by the filing of this additional evidence on 16 August 1999. The applicants were set a due date of 16 November 1999.

The first extension of time request

35 On 11 November 1999 the applicants filed a request for a further three months, that is to say until 16 February 2000. The reasons given were as follows:

40 "Further time is required to complete the preparation of our evidence in support of the Application. Also we have recently heard that the parties have been in direct contact in order to reach a settlement, although we have not received final confirmation of this from our solicitor principals. Finally, we note that the other side obtained a three month extension of time for filing their evidence without any objection from us. In all the circumstances we trust the extension will be allowed."

45 The Registry responded on 23 November 1999 saying that the extension request had been granted subject to no objection being received from the other side. The Registry's letter also

warned that "no further extension of this period will be granted unless you can support the request with detailed and compelling reasons in writing."

The second extension of time request

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On 16 February 2000 the applicants filed a further request for an additional three months until 16 May 2000, giving their reasons as follows:

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"We are now able to confirm that negotiations between the parties are at an advanced stage, and indeed a settlement has been agreed in principle. However, a further meeting to finalise the details of the settlement has had to be postponed, because the individuals concerned have been travelling extensively in the Near and Far East. It is our understanding that the Attorneys for the Opponents would, if necessary, be willing to support this extension request. Although this is the second extension request, we trust that it will be granted, particularly in the light of the new regime which now provides for a six month cooling-off period to cover a situation where active negotiations are being pursued, as here."

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On 21 February 2000 the registry wrote to the applicants granting this further period subject to any objections being received and further said

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"If either party disagrees with this decision they should provide full written arguments against the decision and request a hearing under Rule 48(1) on or before 6 March 2000."

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In a letter dated 6 March 2000 from Mr P R Muir of Fry, Heath & Spence, their Trade Mark Attorneys, the opponents requested a hearing in this matter and set out their objection, in summary, as follows:

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S They had not objected to the first extension but noted that the applicants had still filed no evidence when the extension expired on 16 February 1999 (I assume they meant 16 February 2000) and considered that the further three months given by the first extension should have been sufficient for them to have "completed" their evidence. Reference was made to the S.A.W. Company SA case 1996 RPC 507 where Jacob J stated at page 508, line 30 that "six months is a very generous period for the filing of evidence" and added at lines 35 to 37, the Registrar said as follows "after consultation with the professional bodies it was thought six months was an adequate time in most instances". It was noted that Jacob J accepted that there may be circumstances to justify a further extension but only in cases where the Registrar is satisfied that the circumstances are such to justify the extension.

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S In the present case, it was argued, the applicants' request does not explain why they have been unable to "complete" their evidence and that it was not such that it required extensive research or investigations in order for the applicants to find any relevant evidence.

S They also say that six months should have been more than sufficient to file evidence if, as the applicants claimed in their counterstatement the opposition was "frivolous and

vexatious". They also say that the applicants do not now rely on any claim that they are completing their evidence but say that they "are now able to confirm that negotiations between the parties are at an advanced stage and indeed a settlement has been agreed in principle."

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S With regard to negotiations they say that there was "one informal meeting between the respective principals, without any advisors and that no agreement was reached even "in principle". They further say that since the meeting "the applicants have made no attempt to re-open negotiations or to propose any settlement agreement."

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They conclude by saying:

"Accordingly, the reasons given by the applicants' agents for requesting the present extension appear to be based on a misunderstanding of the actual position regarding the purported negotiations between the parties, and the expectations of an early settlement."

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On 21 March 2000 the Registrar wrote to both sides to appoint an Interlocutory Hearing on 6 April 2000.

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Also on 21 March 2000, Mr Armitage of Withers and Rogers, the applicants' Trade Mark Attorneys, wrote to the Registrar in response to the letter of 6 March 2000 from the opponents' Trade Mark Attorneys, setting out the following points:

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S He said they were astounded by the objections as they had been led to believe by the other side that a serious effort at resolving the matter amicably was under way.

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S He said that Mr Antoni Partyka, Managing Director of the applicants' company, had discussions with Mr Tom Robbins of the opponents on or around Christmas 1999 in which "Tom Robbins informed Antoni Partyka that there was no conflict as far as he was concerned and that he had spoken to his solicitor with a view to settling on terms which would have been acceptable to the applicants." He went on to say that Mr Partyka asked Mr Tom Robbins to have a meeting at which an agreement to this end could be finalised but that as Mr Robbins was about to travel to Turkey it was left that he would contact Mr Partyka on his return.

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S He also said that Mr Martin Robbins (for the applicants and son of the opponent) met Mr Tom Robbins at Wembley in 1999 and again in Singapore on 24 January 2000.

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S He also referred to a letter (copied to the Registrar) dated 16 November 1999 from the opponents' solicitors, Morgan Cole which stated "of course we would be agreeable to any extension of time that you may be wishing to obtain from the Registry."

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S He says, therefore, that Fry, Heath & Spence are not correct when saying that "the only negotiations between the parties was one informal meeting between the respective principals" and that "the applicants have made no attempt to re-open negotiations or to propose any settlement agreement." In these circumstances, he said, they and their clients were led to believe that a "cooling-off" stage had arisen in which the interests of both

parties would be best served by obtaining extensions of time pending the finalisation of the settlement.

5 S He went on to say that given the stance now adopted by the opponents it was unlikely that an amicable settlement would be reached and that they would press ahead with finalising the evidence which it would be possible to file "within the next few weeks."

10 S He submitted that attending a hearing would be an unnecessary burden and expense for both parties and invited the opponents to withdraw their objections.

On 4 April 2000, Mr Armitage of Withers and Rogers again wrote to the Registrar enclosing a copy of an e-mail dated 24 September 1999, from Mr Thomas Robbins (for the opponents) to his son Mr Martin Robbins (for the applicants). Apart from personal pleasantries he said:

15 "Martin, business is business. Isn't it about time to think how much it is costing us both in solicitor's fees?..... Give it some thought as the only winners are the solicitors. According to my solicitors, this case could drag on for 1-2 years. By then all the damage has been done and cannot be retrieved. Besides that the whole industry knows and it is bad business practice. I am sure that we can come to some agreement that
20 would be beneficial to both of us."

Mr Armitage stated that "This is further clear evidence that the opponents have been holding themselves as desiring to settle this matter amicably." He again said that a hearing to decide the issue was a waste of time and money for all concerned and again invited the opponents to
25 withdraw the objection. He also said that they would be filing their evidence "in the very near future."

On 4 April 2000 a letter was also received from Mr Muir of Fry, Heath & Spence with a copy of a Statutory Declaration from Mr Tom Robbins which it was asked should be put to the
30 Hearing Officer.

The Statutory Declaration disputes the events set out in the letter from Mr Armitage of 21 March 2000. He says, in summary:

35 S He had only one discussion with Mr Partyka, a telephone conversation at or around the end of November 1999 in which other matters were discussed and that there were no meaningful negotiations for a settlement "during what was a rather brief telephone conversation."

40 S He confirmed that he met his son (Martin Robbins) "by chance, at the Wembley Exhibition in October 1999 and did then discuss with him the terms of a possible settlement, but no further meeting or negotiations occurred until I met with Martin again on 24 January 2000 in Singapore." Other matters were discussed but he says "following this meeting on 24
45 January 2000 I have had no further negotiations with the Applicants at all, and the Applicants have made no attempt to re-open negotiations with my Company".

S With regard to the letter from the opponents' solicitors of 16 November 1999, which says that they would agree to an extension Mr Tom Robbins says that:

5 "this was as long ago as in November 1999 which following the meeting with my son, Martin, at the Wembley Exhibition it was thought that our earlier discussions had indicated that an amicable settlement was possible.

10 Because the Applicants have not attempted to re-open negotiations since 24 January 2000, it must surely be assumed that it was they who no longer wished to reach an amicable settlement and accordingly it is denied as stated in Withers & Rogers letter, at the last paragraph, that the Opponents have "apparently suddenly" adopted a different stance in this matter."

15 That completes my review of the background. At the Interlocutory Hearing held on 6 April 2000, Mr M A Armitage of Withers & Rogers represented the applicants and Mr P R Muir of Fry Heath & Spence represented the opponents.

20 Mr Armitage's case for the extension of time was largely based on the disputed sequence of events leading up to the current extension of time request and that they understood negotiations were continuing. It was, he said, only the response from the opponents to the disputed extension of time request, set out in their letter of 6 March 2000, which alerted them to the fact they were not going to settle. He noted the comments in the S.A.W. Company S.A case referred to in the opponents letter of 6 March 2000 but argued that the circumstances set out in LIQUID FORCE, 1999 RPC 429, were more relevant.

25 Mr Muir's case for refusing the extension of time was largely based on disputing the sequence of events leading up to the request and that no serious negotiations had taken place for some time, at least since the meeting with the opponents' son (the applicant) which took place on 24 January 2000. He said that the matter was not complex and could see no reason for requesting time beyond the "generous" six months already taken. He contended that the case was straightforward and that negotiations were no excuse for holding back on the preparation of evidence.

35 Decision

At the time of the Interlocutory Hearing, the Registrar's power for extending time periods was provided for in Rule 62 of the Trade Mark Rules 1994 (as amended), which reads:

40 62.-(1) The time or periods -

- (a) prescribed by these Rules, other than 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, be extended by the Registrar as he thinks fit and on such terms as he may direct.

- 5 (2) Where a request for the extension of time or periods prescribed by these Rules-
 - 10 (a) is sought in respect of a time or periods prescribed by rules 13, 18, 23 or 25, the party seeking the extension shall send a copy of the request to each person party to the proceedings;
 - 15 (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.
 - 20 (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 13(2) (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), and rule 41 (time for filing opposition).
 - 25 (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.
 - 30 (5) Where the request for extension is made after the time or period has expired, the Registrar may, at his discretion, extend the period or time if he is satisfied with the explanation for the delay in requesting the extension and it appears to him to be just and equitable to do so.
 - 35 (6)
 - 40 (7)

I considered that the extension of time request filed on 16 February 2000 satisfied the provisions of Rule 62 outlined above, in that the extension was sought to extend the period set down in Rule 13(6) which is not a period excepted by Rule 62(3). The request was copied to the opponents as set down by Rule 62(2)(a), made on Form TM9 as set out in Rule 62(2)(b) within the parameters of Rule 62(4) and the appropriate fee paid.

From the above it is clear that different interpretations of the events leading up to the extension of time request at issue have been presented.

Taking the best view I can of the information provided by each side and the arguments presented, it seems to me that negotiations had, indeed, been taking place and the expectation of resolving the matter amicably existed at least until the meeting on 24 January 2000. When the Registrar provisionally granted the extension of time request of 16 February 2000 she was not aware of any evidence to suggest that negotiations had broken down. The subsequent information provided by each side presents rather different interpretations of events after

24 January 2000 and the extent to which negotiations were at an end. There was, therefore, uncertainty at a period only a few weeks prior to the expiry of the extension of time (16 February 2000).

5 Turning to the formal correspondence between the two sides I note the statement in the opponents' solicitors' letter of 16 November 1999 that they would be "agreeable to any extension of time request." I noted Mr Muir's comment, made at the hearing, that this should not be interpreted as open-ended, but no evidence has been presented to the Registrar that, prior to making the next extension request, the offer was ever formally rescinded or that the opponents' position had changed.
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Furthermore, I note in Mr Thomas Robbins' declaration of 4 April 2000 he says that "Because the Applicants have not attempted to re-open negotiations since 24 January 2000....." which indicates to me that there may have been room for further talks. Even if I am wrong in this, I do not consider that a period from 24 January to the filing of evidence on 4 April 2000 is an exceptional period of time in which to finalise evidence and I am satisfied that it was done with due diligence, especially if I am correct in assuming that a period of uncertainty, as to the breakdown of negotiations, followed the meeting on 24 January 2000.
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20 Taking account of the following passage of G Hobbs QC sitting as the Appointed Person in *Liquid Force [1999]* RPC at page 438 lines 32 through to 38:

25 "In the interest of legal certainty it is plainly desirable that valid applications for registration should succeed and valid objections to registration should be upheld without undue delay. The time limits applicable to opposition proceedings under the 1994 Act and the 1994 Rules were formulated with that consideration in mind. The Registrar endeavours to ensure that prescribed time limits are observed, subject to his power to grant fair and reasonable extensions of time in appropriate cases".

30 I considered that from the submissions put before me an extension of time to allow the evidence filed prior to the hearing into the proceedings was, to use Mr Hobbs' words, "fair and reasonable".

35 In coming to this conclusion I also bear in mind G Hobbs QC's further comments in the *Liquid Force* decision, at page 440, lines 29 to 35, when referring to the possibility of settlement:-

40 "That could not relieve the opponent of its obligation to file evidence in support of its opposition under Rule 13(3), but it does provide some support for the view that the opponent's delay in filing its evidence was related to the approach to negotiations adopted on behalf of the applicant. That, to my mind, adds weight to the principal hearing officer's preference for allowing the proceedings to continue to a main hearing where the issue at the heart of the action can be decided with the benefit of evidence."

45 In order for the Registrar to reach a decision on the substantive issues, I considered the Registrar should have the evidence filed by Mr Armitage immediately prior to the hearing

before her when taking a decision. I was not satisfied that any further time for filing evidence was justified. (Mr Armitage indicated he may wish to file additional evidence, but I rejected this at the hearing.)

5 My decision therefore was to grant the applicants, a final extension of time to 6 April 2000 (the date of the hearing) to admit the applicants' evidence into the proceedings. I refused to allow any further extension of time.

10 In view of my decision in respect of the extension of time, a period for the opponents to file evidence in accordance with Rule 13(7) of the Trade Mark Rules 1994 (as amended), was set at 4 July 2000, ie. 3 months from the date of filing the applicants' evidence.

I gave no order as to any award of costs at this stage of the proceedings.

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Dated this 16 day of June 2000

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**R A JONES
For the Registrar
The Comptroller General**