

**TRADE MARKS ACT 1994**

**IN THE MATTER OF A REQUEST BY  
DR . M.H.Z. KHAN ACTING AS A NOMINEE OF THE MUSLIM PARLIAMENT  
OF GREAT BRITAIN  
FOR AN EXTENSION OF TIME WITHIN WHICH  
TO FILE EVIDENCE IN OPPOSITION PROCEEDINGS (No 50126)  
IN RELATION TO APPLICATION NUMBER 2189191  
IN THE NAME OF DR GHAYASUDDIN SIDDIQUI**

## TRADE MARKS ACT 1994

IN THE MATTER OF a request by

5 Dr. M.H.Z. Khan acting as a nominee of The Muslim Parliament of Great Britain  
for an extension of time within which  
to file evidence in opposition proceedings (Number 50126)  
in relation to application number 2189191  
in the name of Dr. Ghayasuddin Siddiqui

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### BACKGROUND

On 17 February 1999 Dr. Ghayasuddin Siddiqui applied to register the following trade mark

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for a specification of goods and services which reads:

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**Class 9** Photographic, cinematographic, teaching apparatus and instruments, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, data processing equipment and computers.

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**Class 16** Paper, cardboard and goods made from cardboard; printed matter, bookbinding material, photographs, stationery, instructional and teaching material, plastic material for packaging; printers' type; printing blocks; carrier bags, envelopes, advertising materials.

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**Class 38** Telecommunications; audio-visual communication using the Internet, radio or television or other forms of audio-visual communication or transmission of messages, information or communication, including video conferencing and satellite communications.

**Class 41** Education and provision of training, relating to religious matters; provision of

concerts and live entertainment.

**Class 42** Provision of hostel and temporary accommodation; medical, hygienic and beauty care services; veterinary and agricultural services; legal services; scientific and industrial research; computer programming; web page design; leasing of access time to a computer database.

The application is numbered 2189191 and was accepted and advertised for opposition purposes on 2 June 1999 . On 1 September 1999 Dr. M.H.Z Khan acting as a nominee of The Muslim Parliament of Great Britain filed notice of opposition. The grounds of opposition, as set out in the accompanying statement of grounds, were based on Sections 3(3)(b), 3(6) and Section 5(4)(a) of the Trade Marks Act 1994.

The applicant's filed a counter-statement on 2 December 1999 and the Office set a due date of 3 March 2000 for the opponent's to file evidence under rule 13(4) of the Trade Mark Rules 1994 (as amended).

On 3 March 2000 the opponent's filed a request for an extension time to file this evidence. The request was made on Form TM9 together with the appropriate fee, under the provisions of rule 62(1). The request was for an extension of three months and was copied to the applicant. The reasons given in support of the request were as follows:

“The opponent is experiencing difficulty in obtaining evidence in support of the grounds of opposition under Section 5(4) of the Act. The reason that the opponent is experiencing difficulty is that the applicant, being a former leader of The Muslim Parliament of Great Britain is in possession of documentation relevant to the opponent's case under this Section and is not willing to release this information to the opponent. Accordingly, the opponent is having to explore other routes by which this evidence can be obtained and this is necessarily taking some time. Accordingly, the Registrar is asked to exercise his discretion and allow the opponent a further period of three months in which to file their evidence in this matter. In deciding whether to exercise his discretion, the Registrar is asked to bear in mind that both the applicant and the opponent are alleging that they are the rightful authorised nominee of The Muslim Parliament of Great Britain and as a result of this dispute which is being pursued elsewhere, evidence of the activities of The Muslim Parliament of Great Britain is not easily accessible. The opponent trusts that the Registrar will oblige him in this request.”

The Official letter of 10 March 2000 indicated that the opponent's request for an extension of time was granted subject to any objections being received. Thus, the due date for the opponent's to file evidence became 30 June 2000. A period of 14 days was given for either party to provide full written arguments against the decision or to request a hearing under Rule 48(1).

On 23 March 2000 the applicant's filed a letter submitting that the opponent's request be refused for the following reasons:

“The opponent states in support of his application for an extension of time that he is

5 experiencing difficulty in obtaining evidence to support the grounds of opposition under  
Section 5(4) of the Act. The opponent states that the applicant is in possession of  
documentation relevant to the opponent's case but is not willing to release this  
information to the opponent. This is not the case. The applicant has not received any  
requests for information from the opponent since August 1999 (requests made at that  
time were for financial information of a confidential nature). No request of any kind has  
been made since that date. The applicant therefore invites the opponent to disclose  
details of all such requests, together with evidence to show that his requests were  
refused."

10 "In addition the applicant is unaware of the "dispute which is being pursued elsewhere"  
referred to by the opponent. The applicant therefore invites the opponent to provide  
details of this "dispute which is being pursued elsewhere". Accordingly, the Registrar is  
asked to refuse the opponent's request for an extension of time in which to file the  
evidence in this matter and also requests a hearing under rule 48(1) ".

15 The official letter of 31 March 2000 indicated that the comments in the applicants letter dated  
23 March 2000 had been noted however the Trade Marks Registry was minded to maintain the  
initial decision to grant the extension until 30 June 2000. As requested an interlocutory hearing  
was arranged.

## 20 **THE HEARING**

25 The interlocutory hearing took place before me on 26 April 2000. The applicant was represented  
by Mr M Foreman, of Rouse & Co. The opponent did not attend the hearing, and chose not to  
be represented, although shortly before the hearing I did receive written submissions from their  
Trade Mark Attorney Mr Hill of Wilson Gunn M'Caw.

## 30 **OPPONENT'S SUBMISSIONS (WRITTEN)**

The principle points emerging from Mr Hill's submissions were as follows:

35 - The opponent admits that no requests to the applicant for information have been made  
since August 1999.

40 -They state that because the requests to the applicant for information were declined,  
alternative routes have been utilised in an attempt to gather this information including  
dealing with the Charities Commission in an attempt to force the applicant to disclose  
financial and other information relating to The Muslim Parliament of Great Britain.

- The opponent has also been seeking access to the financial information of The Muslim  
Parliament of Great Britain through the courts.

45 -The reference made in the extension of time request to "disputes being pursued  
elsewhere" relates to the opponent's dealings with the Charities Commission mentioned  
above.

-The applicant has issued a writ against the opponent to prevent him from carrying out legitimate activities under the name The Muslim Parliament of Great Britain and the issuance of the writ has been mentioned in correspondence passing between the opponent and the applicant's legal advisors but the writ has never been served.

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## APPLICANT'S SUBMISSIONS

The principle points arising from Mr Foreman's submissions were as follows:

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-Wilson Gunn McCaw were advised on 15/11/99 that the applicant would not withdraw this application and therefore they should have been compiling evidence from that date.

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-From the grounds of opposition that have been pleaded Mr Foreman failed to see why evidence from the applicant would assist the opponent. Any evidence should come from the opponent.

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-The opponent has not contacted the applicant since August 1999 to request information of any nature. This date pre-dates the date the opposition was filed.

-Mr Foreman provided a brief history of the background to this case, explaining that an early resolution was required.

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-With regard to the writ that is referred to in the opponent's submissions, Mr Foreman stated that this was out of time.

Having considered the submissions from both sides, I decided that the extension of time requested by the opponents was not justified and I therefore refused it at the hearing. I wrote to both parties by way of confirmation of this on 26 April 2000.

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Following the issue of my decision, the opponent's filed a form TM5 requesting a statement of the grounds of my decision.

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### Grounds of 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:

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62 (1) The time or periods -

- i. prescribed by these Rules, other than times or periods prescribed by the Rules mentioned in paragraph (3) below, or
- ii. specified by the registrar for doing any act or taking any proceedings,

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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.

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

- (1) 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;
- (2) 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 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).

(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 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.

(6) .....

(7) .....

I considered that the extension of time request filed on 3 March 2000 satisfied the procedural provisions of Rule 62 outlined above, in that the extension was sought to extend the period set down in Rule 13(4) 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.

First of all, I do not consider this is a case where an excessive amount of time has been taken by a party. It can be seen from my summary of the background to the case, that from the time the notice of opposition was filed by the opponent's (ie 1 September 1999) to the date on which the request for the extension was made (ie 3 March 2000) six months had elapsed. Indeed, the time in which the opponent can reasonably have been expected to begin the compilation of evidence in support of his case was only 2 December 1999, the date on which the applicant filed his counter statement to join the proceedings (see the comments of Geoffrey Hobbs QC in *Liquid Force* (1999) RPC 429 at 440). In effect the opponent had allowed no more than the statutory period of 3 months laid down in Rule 13(4) to elapse before requesting the extension of time. This is not excessive.

However, it can also be seen from my summary of the background to this case, that the reasons given by the opponent in the request for an extension of time filed on TM9 dated 3 March 2000 stated that “The opponent is experiencing difficulty in obtaining evidence in support of the grounds of opposition under Section 5(4) of the Act”. This is but one of the grounds of opposition pleaded. It is clearly a ground for which evidence to prove the case will need to be adduced. But the other grounds pleaded, Section 3(3)(b) and 3(6), are also grounds for which evidence will be required. It can also be seen from my summary of the hearing, that the written submissions from Mr Hill concentrated exclusively on the reasons given in support of the request given on the TM9 i.e. the steps taken in preparing the *compilation* of evidence to support the case under Section 5(4). There were no submissions regarding the steps taken to compile any evidence to support the Section 3(3)(b) and 3(6) grounds. In the circumstances, it seemed to me that the opponent’s submissions had some gaps in them which suggested that the exercise of any discretion should be measured accordingly.

In any case, merely using the period prescribed in Rule 13(4) to *prepare* or *compile* evidence does not seem to me to be proper utilisation of that period.

Rule 13(4) states that:

Within three months of the date upon which a copy of the counterstatement is sent by the registrar to the person opposing the registration, that person *may file such evidence by way of statutory declaration or affidavit as he may consider necessary to adduce in support of his opposition* and shall send a copy thereof to the applicant. (My emphasis)

The emphasis added above stresses the intention of the Rule to provide for the period that the opponent has to file any evidence he thinks necessary to support his case. The period is there for the filing of evidence not for e.g. its compilation or the formulation of a strategy for supporting the grounds of opposition.

In this present case I had no evidence or submissions to the effect that the opponent’s evidence was being compiled on two of the three pleaded grounds, and whether they were actually in a position to file it within the period sought. Although I do not dispute that the opponent had decided upon an initial route in which to support their grounds under Section 5(4), I was not persuaded that that route was sufficiently advanced to allow for the filing of the evidence within the period. There was no indication from the opponent’s written submissions that any evidence under any of the pleaded grounds was in a position to be filed, even in draft form.

In the A.J. and M.A. Levy’s Trade Mark application (1999) RPC 291 M G Clarke QC, sitting as the appointed person, supported the views of the Registrar’s hearing officer in that case when he stated that there was nothing to prevent a party from filing evidence with the registrar at any time prior to the hearing, which would have then indicated to the hearing officer that some steps had been taken in advance of the hearing to collate at least some of the evidence. Although the circumstances of that case were different in that the evidence was in order to be filed prior to the hearing, but had simply not been filed, the principle that available evidence should be filed within statutory periods is clear. In the interests of legal certainty it is plainly desirable that valid applications for registration should succeed and valid objections to registration should be upheld

without any due delay. The time limits applicable to opposition proceedings under the 1994 Act and the 1994 Rules were formulated with this consideration in mind. The Registrar endeavours to ensure that the prescribed time limits are observed, subject to his power to grant fair and reasonable extensions of time in appropriate cases.

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It seems to me that the opponent may have been relying on what is a common misconception that the registrar will grant a first extension of time request regardless of the surrounding circumstances. This was a matter commented on as not being the true situation in the S.A.W. (1996) RPC 507 at 510 and it remains the position today.

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The period of three months set out in Rule 13(4) is a period which must be considered to be a fair and reasonable period for the completion of the action in suit (ie the filing of such evidence as the opponent deems necessary to support his case), otherwise it would not have been prescribed as such. The provision to extend that period via Rule 62(1) is a discretionary one and one on which the onus is on the party making the request to convince the registrar of the legitimacy of that request.

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Whilst clearly the opponent had embarked upon a strategy to support the Section 5(4) claim that strategy fell upon some difficulties, not least of all the applicants unwillingness to release the requested information, prior to the filing of the opposition. Alternative avenues were explored by the opponent, but I am given scant information about the likelihood of the information being available via the Charity Commission, for example. I was also given no reason why, if the opponents believed that the applicant held documents which were material to these proceedings and could help determine the issues involved, a request was not made for disclosure. Overall it seems to me that this is a case which may have some unusual features, but the opponent's have not persuaded me that their actions and diligence in pursuing the evidence needed to support the grounds of opposition was likely to achieve any results, let alone in any particular timescale. The opponent's case for an extension of time in which to file their evidence is not made out and their request is refused.

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As such the opponent will be deemed to have withdrawn his opposition. This action will be stayed for a period of 28 days pending any appeal. In the event that no appeal is filed the decision will be implemented and the application allowed to proceed to registration.

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**Dated this 27 day of June 2000**

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**Lynda Adams  
Hearing Officer  
For the Registrar, the Comptroller-General**