

TRADE MARKS ACT 1994

**In the matter of an Interlocutory Hearing
in relation to a request by Climate Master Inc
(the Opponents) for an extension of time within
which to file evidence in support of Opposition
N° 49931 against Application N° 2018635 in the name
Climate Master Limited**

TRADE MARKS ACT 1994

**IN THE MATTER OF an Interlocutory Hearing
in relation to a request by Climate Master Inc
for an extension of time within which to file
evidence in support of Opposition N° 49931
against Application N° 2018635 in the name of
Climatemaster Limited**

Following an Interlocutory Hearing on 3 March 2000, I:

- a) allowed the opponents to file on the day of the hearing, a statutory declaration of Steven J Golsen and exhibits thereto
- b) granted the opponents a final extension of time of fourteen days from the date of the hearing to file further evidence in support of the opposition

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I am now asked, by the applicants for registration, for my written grounds of decision by way of Form TM5 filed on 31 March 2000.

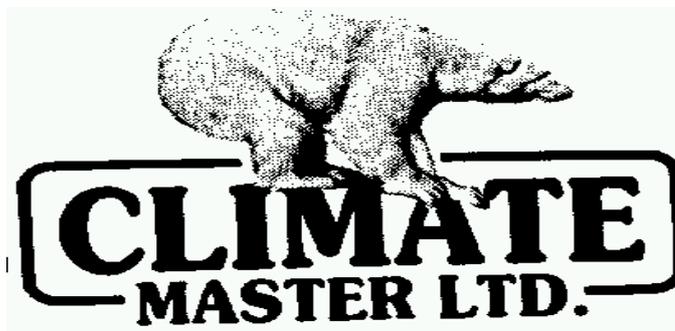
Background

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The background facts are as follows:

Climatemaster Limited have applied under application No. 2018635 to register the mark:

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in Class 11 for the following specification:

Class 11: Air conditioning apparatus, heat pumps, de-humidifiers and refrigerated units.

5 The application was published for opposition purposes on 31 March 1999 in Trade Marks Journal 6270, on the basis of Honest Concurrent Use with Registration No. 1514734 (6048, 6716). On 29 June 1999, Climate Master Inc, filed opposition in accordance with Section 38(2) of the Trade Marks Act 1994. The applicants filed a Form TM8 and counter-statement on 5 October 1999.

10 On 6 October 1999, the Registrar sent to the opponents a copy of the Form TM8 and counter-statement and invited the opponents to file evidence in support of their opposition within three months of the date of the official letter i.e. by 6 January 2000. On 6 January 2000, the opponents requested an extension of time of three months, i.e. to 6 April 2000, to file evidence in support of their opposition. The reasons given were:

15 “Whilst the opposition is based upon the existence of an earlier UK Registration and the evidence will largely follow that which was involved in an earlier opposition which was filed by the applicants against the opponent’s mark, the applicant has additional evidence relating to the use of its mark which it wishes to submit and it is taking some time to compile the necessary details. As a
20 consequence and given the recent holiday period the opponent requires an extension of time to enable it to complete the evidence in this matter and we trust that in those circumstances the extension may be granted.”

25 By way of a letter dated 12 January 2000, the Trade Marks Registry advised both parties of the preliminary decision to grant the extension of time sought and, in line with Trade Marks Registry practice, set a period of 14 days from the date of the letter for either party to provide either written arguments or to request a hearing on the grant of the extension of time.

30 Under cover of a letter dated 25 January 2000 from their Trade Mark Attorneys, Bailey Walsh, attached to which was a letter dated 24 January 2000 from the applicants themselves, the applicants requested a hearing in this matter. A copy of the letter dated 24 January 2000 is attached to this decision at Annex 1.

35 That completes my review of the background. At the Interlocutory Hearing held on 3 March 2000 held via a telephone conference link, Mr Peter Banks of Climatemaster Limited represented the applicants for registration and Mr Graham Farrington of Ladas & Parry represented the opponents, in person.

40 At the outset of the hearing and for the benefit of both parties, I explained the format of the hearing and the order of submissions.

Opponents’ Submissions

45 Mr Farrington opened the hearing by commenting on some of the points raised in the applicants’ letter dated 24 January 2000 (Annex 1). Mr Farrington stated that the applicants filed their TM8 and counter-statement on the last day of the period allowed by Rule 13(2) for filing said documents. In his opinion, if the applicants were eager to bring the proceedings to a

swift conclusion, then they themselves would have filed their TM8 and counter-statement much earlier.

5 He went onto state that the opponents were not in a position to file evidence by the end of the three month period prescribed by Rule 13(4), due to the fact that the opponents were still collating evidence of use of their mark and also because the period fell over the Christmas/Millennium holiday period. He stated that some of the evidence would be the same as evidence filed in earlier proceedings between the parties but because the current proceedings were several years later the opponents were also collating evidence for the intervening period.

10 He further stated that the collation of evidence was further complicated by the fact that the opponents had used different distributors in the United Kingdom in the early/mid 1990s and obtaining the necessary information from the previous distributors was proving difficult. The opponents had therefore filed Form TM9, seeking an extension of three months to the period for filing evidence in support of their opposition. In response to one of his submissions I explained to Mr Farrington that the decision to grant the extension of time in the official letter dated 12 January 2000 was a preliminary decision, and as such the question of whether the Registrar's discretion to grant an extension of time to the opponents should be rescinded accordingly was to be decided at the hearing in accordance with the Registrar's practice notice in relation to Extension of Time Requests in Inter Partes Proceedings published in the Trade Marks Journal No:6257.

20 Mr Farrington referred once again to the applicant's letter of 24 January 2000 (Annex 1) by putting forward comments in relation to the aforesaid letter. He began by saying that he did not consider Mr Banks' letter to be relevant to the extension of time request.

25 In response to the applicants' written comments (in the second paragraph) relating to the copying of the Form TM9, Mr Farrington stated that the extension of time request was filed at the Trade Marks Registry, by hand, on 6 January 2000 and on that date a copy was mailed to the applicant's representatives. The opponents therefore had met with the requirements of Rule 62(2)(a) and there had been no prejudice to the applicants.

30 This was the opponents' first extension of time request which, Mr Farrington stated, he did not consider was excessive. He re-iterated that some of the evidence the opponents were trying to collate was not held by its current distributor but by the previous distributor, whom the opponents have no hold over. Some evidence was to hand but not yet ready to file, although it would be within a month.

40 **Applicants' submissions**

Mr Banks opened his submissions by questioning the validity of the Form TM9 filed by the opponents on 6 January 2000. He submitted that the Form filed by the opponents was incomplete in that the last box on the form had not been completed by the opponents.

45 The last box on the Form TM9 which was at issue, states:

“State number of sheets attached to this form”

5 On the form filed by the opponents, this box had not been completed. Attached to the form, however, was a two page letter from Ladas & Parry (the opponents’ representatives) in which they put forward the reasons to support the extension of time request. Mr Banks submitted that the form should not be considered as it was incomplete. He went onto draw my attention to the fact that a similar box had also not been completed on the Form TM7 filed by the opponents on 29 June 1999 which commenced these proceedings.

10 Having heard these submissions from Mr Banks, I drew his attention to the fact that his representatives had also failed to complete this box on the Form TM8 they had filed on his behalf on 5 October 1999. Having said that I went onto state that there was no statutory requirement for this box to be completed on any of the Official Forms stated. It was there purely for administrative convenience in order that the Trade Marks Registry could ensure that all attachments had been received.

15 Mr Banks then put forward comments in relation to the extension of time sought, reiterating the points put forward in his letter dated 24 January 2000 (Annex 1). He stated that the dispute between the parties was a long ongoing saga which had already lasted in excess of five years. He stated that the opponents were seeking an extension of “only three months” but again re-iterated the fact that this had been hanging over his head for over five years. In respect of the opponents’ submission that the period for filing evidence fell over the Christmas period, Mr Banks stated that this was irrelevant given that the opponents were well aware of when Christmas fell and as such should have acted accordingly.

20 In respect of the opponents’ submissions regarding the difficulties they were experiencing in collating evidence from their previous distributors, Mr Banks said that he thought the opponents would have been able to collate this information from their own records. He submitted that in the United Kingdom, there is a requirement for companies to retain records for a set number of years. Mr Banks said, using his words “they [the opponents] know what they sell”. He considered the points put forward by the opponents to be a “red herring”.

25 In relation to the filing of the Form TM9, Mr Banks stated that the Form TM9 may have been filed within time at The Patent Office, but that a copy was not received by his agent on the same date, but had been received some time later. He argued that the form should have been sent to his agent on the same date as being filed at the Patent Office, and that this could have been met by sending the copy to his agent by facsimile. I noted his submissions, but advised Mr Banks that the requirement was to copy the Form TM9 and that this had been done. Whilst I acknowledged that his representatives may not have received their copy on the same date as the copy was filed at the Patent Office, I did not consider that there was significant difference between the time the original was filed at the Patent Office and when his representatives received their copy to cause any prejudice to the applicants.

45 **Opponents’ Submissions in Reply**

In reply Mr Farrington referred to paragraph 1 of Mr Bank’s letter at Annex 1 stating that he

did not know that application number 2018635, the subject of these opposition proceedings, was proceedings on the basis of Honest Concurrent Use, until the application was published. In reply to Mr Banks' comments that the information the opponents were seeking from their previous distributors should be available in their own records, Mr Farrington stated that this information was not in the opponents' records.

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In relation to the evidence to be filed by the opponents, Mr Farrington stated that the opponents' intentions were to file a single statutory declaration exhibiting the evidence filed in the earlier proceedings together with the up to date evidence they were seeking from their previous distributors. This was likely to be available in the very near future. Mr Farrington confirmed however, that the statutory declaration together with the earlier evidence to be exhibited, was ready for filing on the day of the hearing.

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Decision

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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:

62 (1) The time or periods -

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- 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,

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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.

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

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- (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;
- (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.

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(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).

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(4) Subject to paragraph (5) below, a request for extension under paragraph (1)

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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 6 January 2000 satisfied the 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 applicants 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.

In considering the request for the extension of time for the opponents to file evidence in accordance with Rule 13(4), I took account of the comments of Geoffrey Hobbs Q.C. sitting as the Appointed Person in *Liquid Force* [1999] RPC 438 at lines 36 to 38 which read:

“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”

I considered taking account of the submissions of both parties in the instant case, that using the Appointed Persons’ words from the above extract, a “fair and reasonable” extension of time was justified in these proceedings. However, I did not consider that the full extension of time, to 6 April 2000, sought by the opponents was justified. In reaching this conclusion I took account of the fact that the opponents were to use evidence filed in previous proceedings supplemented by additional evidence which would cover the intervening period between the respective actions. As such I considered that the opponents already had a head-start with regard to the collation of evidence in support of their opposition at the time the Registrar set the period for the filing of evidence in accordance with Rule 13(4). From the opponents’ submissions it appeared that they only had to collate and file the “additional evidence” during the statutory period. However, as was submitted by Mr Farrington, this was complicated due to a change in distributors which resulted in difficulties in obtaining some information for the opponents’ evidence, which necessitated the extension of time request being sought. In view of these facts I decided to grant an extension of time to allow the opponents to file their evidence.

My decision was therefore to admit into the proceedings the statutory declaration of Mr Steven J Golsen, which Mr Farrington had brought to the hearing with him. I further instructed Mr Farrington to send a copy of the statutory declaration by facsimile to Mr Banks’ representatives before the end of the day of the hearing. I also allowed a final period of two weeks from the date of the hearing, i.e. to Friday 17 March 2000, for the opponents to file the

remainder of their evidence in support of their opposition under Rule 13(4) of the Trade Marks Rules 1994 (as amended).

Neither party made any request for costs at the hearing before me.

5 Dated this 8th day of June 2000

10 J S PARKER

Acting for the Registrar
The Comptroller General

15 The annexe is only available as a paper copy

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