

TRADE MARKS ACT 1994

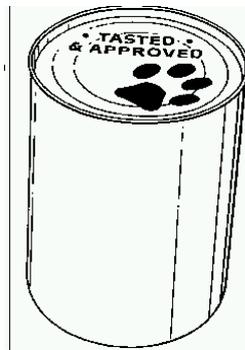
**IN THE MATTER OF A REQUEST BY
FRISKIES PETCARE (UK) LIMITED (THE APPLICANTS)
FOR AN EXTENSION OF TIME WITHIN WHICH
TO FILE EVIDENCE IN OPPOSITION PROCEEDINGS (No 49328)
IN RELATION TO APPLICATION NUMBER 2158449**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF a request by
Friskies Petcare (UK) Limited (the applicants)
for an extension of time within which
to file evidence in opposition proceedings (Number 49328)
in relation to application number 2158449**

10 **Background**

On 17 February 1998 Dalgety Spillers Foods Limited applied to register the trade mark



for a specification of goods which reads:

30 **Class 31** Foodstuffs for animals.

35 The application is numbered 2158449 and it was accepted and published. On 23 December 1998, Mars UK Limited filed notice of opposition. Following a change of name and address, the applicant was recorded as Friskies Petcare (UK) Limited. The applicants filed a counter-statement on 1 April 1999 and the Office set a due date of 14 July 1999 for the opponents to file evidence under rule 13(4) of the Trade Mark Rules 1994 (as amended).

The opponents' evidence was filed on 14 July 1999 and in accordance with rule 13(6) the due date for the applicants to file evidence in support of their application became 14 October 1999.

40 On 5 October 1999 the applicants filed a request for an extension of time. 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. The reasons for the request were set out in the applicants' letter of 4 October and read as follows:

45 "An extension of time is requested for three months from 14 October 1999 to 14 January 2000 in respect of the above application in order to deal with outstanding matters. The reasons for this request are as follows:

The applicant has reviewed the opponent's evidence and is now attempting to get the necessary figures and other documentation from the relevant personnel.

5 This extension is requested to enable us to collate the information and prepare the required Statutory Declaration."

10 The Official letter of 11 October 1999 indicated that the applicants' request was granted. Thus, the due date for the applicants to file evidence became 14 January 2000. A period of 14 days was given for the opponents to request a hearing in the matter. No request for a hearing was made.

15 On 10 January 2000 the applicants filed a further request for an extension of three months in which to file evidence. The reasons for the request were set out in a letter dated 10 January 2000. This read:

20 "We request an extension of time for three months from 14 January 2000 to 14 April 2000.

25 Further to our letter of 4 October 1999, we confirm that we have received the necessary figures, together with other supporting documentation, including brochures and leaflets. Accordingly, a draft Statutory Declaration has been prepared but unfortunately on checking the figures supplied some inconsistencies were noted and we have therefore asked for clarification of these discrepancies. We also understand that there is some further advertising literature available in support of our application but this has yet to be received in our offices.

30 This further extension of three months is requested to allow the figures to be checked and if necessary amended and the additional documentation to be received and exhibited with the Statutory Declaration.

35 We confirm that a copy of this letter together with the accompanying Form TM9, has been sent to the agent for the opponent."

40 Subsequently on 14 January 2000 the Office wrote to the parties informing them that the applicants' request had been granted. The due date for the applicants to file evidence became 14 April 2000. A period of 14 days was given for the opponents to request a hearing. No request was made, however, in a letter dated 28 January 2000 the opponents noted that this was the applicants' second request for an extension of time and that a draft Statutory Declaration had been prepared. It concluded:

45 "Therefore, while we are prepared not to object to the current extension request, we consider that the current extension should provide time for the remaining information to be inserted into the Declaration. It is our client's intention to vigorously oppose any further extension request on this matter."

On 14 April 2000 the applicants filed evidence in the form of a Statutory Declaration by Mr Peter Farrand. In addition to the evidence they also filed a third request for an extension of time of three months. The reasons given on the accompanying letter dated 13 April were as follows:

"I file herewith the Statutory Declaration of Peter Farrand together with four exhibits. This

declaration forms part of the Applicant's evidence in support of the application.

5 The applicant is considering the possibility of submitting further evidence in the form of a public survey and evidence in the form of statement from members of the public taking part in this survey. As the registrar will be aware, organising such a project is a lengthy procedure. In this regard, I request a further extension of time, for a period of three months, to allow this work to be completed and I enclose form TM9.

10 I confirm that a copy.....”

15 On 26 April the Office wrote to both parties informing them that the applicants' request for an extension of time had been granted and that the due date for them to file evidence was now 14 July 2000. A period of 14 days was given for the opponents to provide written argument against the decision and to request a hearing under rule 48(1).

The opponents filed a letter dated 10 May 2000 objecting to the grant of the extension of time and requesting a hearing in the matter if the Registrar was minded to grant the applicants' request.

20 A review of the applicants' request was undertaken by the case work officer who issued a letter dated 17 May 2000 maintaining the decision to grant the applicants' request for an extension of time. As the opponents had already requested a hearing in their letter of 10 May the case was forwarded for the appointment of an interlocutory hearing.

25 **The Hearing**

30 The interlocutory hearing took place on 15 June 2000. The applicants were represented by Ms Rachel Delamere of Nestle UK Limited, the opponents were represented by Ms Claire Hutchinson of Grant Spencer Caisley & Porteous. At the hearing I refused the applicants' request for an extension of time. Following the issue of my decision, the applicants filed Form TM5 requesting a statement of the grounds of my decision.

Statement of Grounds

35 At the time of the request, the power of the Registrar in relation to the alteration of time limits was set out in rule 62 of the Trade Mark Rules 1994 (as amended), the relevant parts of which provide as follows:

40 “62(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

45 (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 upon such terms as he may direct”.

The applicants' request was copied to the opponents in accordance with rule 62(2)(a) and the period for which the extension was sought was not one of the periods excluded by rule 62(3). The

request was made on the appropriate Form TM9 together with the appropriate fee.

5 In her opening submissions Ms Delamere took me through the history of the case. She explained that the opponents had been able to file their evidence within the initial three month period as their evidence consisted of material that had been filed on a related opposition. The applicants' evidence for the application in suit was not the same as that filed in the other proceedings and so the applicants had required an initial extension of time within which to prepare evidence. Concerning the initial request for an extension Ms Delamere explained that the delays that had occurred in the filing of the applicants' evidence had been due, in part, to staffing difficulties at Nestle UK Limited. A member of staff had left in June 1999 and had been replaced by a temporary employee. That member of staff had not been up to speed. There had also been delays caused by correspondence between the applicants and external solicitors concerning the scope of the application in suit and whether the application could proceed.

15 Ms Delamere said that the second request for an extension of time had been required to resolve problems with the sales figures. The applicants' business had been acquired and the different methods of keeping accounts had caused problems for Nestle UK Ltd's accounts department. This had been resolved and the evidence of Mr Farrand filed within the extended period.

20 The applicants were now seeking a third request for an extension of time. The request had been made when the applicants were considering whether a survey should be undertaken. Since making the request, a pilot survey had now been carried out and solicitors had been instructed to undertake a full survey in the week beginning 26 June. Ms Delamere explained that no mention had been made of the survey in previous requests because it was uncertain whether the scope of the application required clarification and so they did not want to incur the cost and expense of a survey unless necessary. Ms Delamere confirmed that if the survey was carried out in the week commencing 26 June the results would not be ready for submission as evidence within the three month period requested. If the extension of time to the 14 July 2000 was allowed the applicants would require a further extension of time in order to analyse the data obtained from the survey and compile it into a form suitable for submission in evidence.

35 Ms Hutchinson commented on the history put forward by the applicants and submitted that three changes of agent responsible for a case was not uncommon and was in the "nature of the business". She noted that this was the third request for an extension of time. The first request had indicated that evidence was being prepared. The second had said that the evidence was ready to be filed but minor clarification was being sought of certain figures. No mention had been made that the applicants were considering a public survey. The applicants third request had been filed after they had already received nine months within which to file their evidence. Their request had consisted of one sentence stating that they were *considering* a public survey. The applicants, in her view, had not been diligent in preparing their evidence and the extension of time should be refused.

45 Ms Hutchinson referred me to the decision in *SAW* [1996] RPC 507 where Mr Justice Jacob indicated that the onus lies on he who seeks an extension and to the passage where he stated that six months is a very generous period for the filing of evidence. Ms Hutchinson also referred me to the decision of Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person in *Liquid Force Trade Mark* [1999] RPC 429. In addition, I referred to the decision of Mr Matthew Clarke Q.C. sitting as the Appointed Person in *A.J. and M.A. Levy's Trade Mark* [1999] RPC 291.

The Registrar's Direction on Extensions of Time in inter parties proceedings, published in the Official Journal on 3 September 1997, indicates that when requesting an extension of time, "full and detailed reasons for the request" should be given. This was very much in line with the decision of Mr Justice Jacob in *SAW* where he stated "*The onus lies on he who seeks an extension.*"

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The applicants have been aware since the opposition proceedings were filed on 23 December 1998 that evidence in support of the application may have been required. Since 14 July 1999 when the opponents filed their evidence they have been aware of the nature and extent of the opponents' case. Yet despite this fact the two requests for extensions of time filed on 5 October 1999 and 10 January 2000 made no mention of the fact that the applicants were "considering" a public survey. To my mind the applicants second request made it clear that they were finalising their evidence and merely checking up on some details.

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By the time the matter came to be heard the applicants had received in excess of eleven months within which to file their evidence. Yet as Ms Delamere made clear at the hearing they were in no position to file their evidence at that time and indeed even if the request was granted they would require a further extension of time within which to complete and file their evidence.

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As Mr Clarke noted in *Levy*.

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"It seems to me that when an extension of three months has been granted it is incumbent upon the party to whom it has been granted to ensure that, if any other extension is to be sought, strong and compelling reasons for such an extension are put forward. When the matter is opposed and there has to be a hearing, it is, in my view, essential that the applicants makes the best case for a further extension at that hearing. If that is not done and matters are left on an equivocal or uncertain basis, then it seems to me that the applicants must live with the consequences of that."

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The decision in *Levy* concerned a second request for an extension of time. In the instant case, the applicants were seeking a third extension to the period for them to file evidence. In my view the fact that the applicants were considering a survey was not a strong or compelling reason for allowing an extension of time. The reasons put forward by the applicants for the delay in filing their evidence did not lead me to alter this view. Whilst I understand that there were difficulties and changes of staff I accepted Ms Hutchinson' comment that such changes and difficulties frequently occur in the course of proceedings. The applicants' representatives are a large organisation and difficulties within that organisation should not, in my view, prejudice the opponents. There is a duty on the applicants to ensure that the compilation and preparation of evidence proceeds diligently.

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In addition, I took note that the opponents in their letter of 28 January put the applicants on notice that they would object to any further request for an extension of time. Despite this warning that any further request would be opposed the first mention of any public survey evidence occurred in their letter accompanying the TM9 filed on 14 April 2000. In *Levy*, Mr Clarke confirmed the statement made by Mr Justice Jacob in *SAW* to the effect that "*Six months is a very generous period for the filing of evidence*". As stated above, the applicants have had in excess of eleven months and I was not satisfied that they had acted with due diligence in the preparation of evidence in this case.

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5 The fact that I did not accept the reasons put forward by the applicant for the delay is not the end
of the matter. The Appointed Person in *Liquid Force* found that the Registrar has a wide
discretion when considering requests for an extension of time analogous to that of the Court. In
examining the breadth of that discretion and in taking note of authorities from the Court of
Appeal, he noted that the absence of good reasons for failure to comply with a time limit was not
always and in itself sufficient to justify refusal of an extension of time. He found that the true
position was that it was for the party in default to satisfy the tribunal that despite his default, the
discretion to extend time should nevertheless be exercised, for which purpose he could rely on any
relevant circumstance. Therefore, it seems clear that when considering a request for an extension
10 of time the Registrar should take a number of factors into account.

In *Liquid Force* Mr Hobbs stated:

15 *“In the interest of legal certainty it is plainly desirable that valid applications for
registration should succeed and valid objections to registrations should be upheld
without undue delay. The time limits applicable to opposition proceedings....were
formulated with that in mind. The registrar endeavours to ensure that the prescribed time
periods are observed, subject to his power to grant fair and reasonable extension of time
in appropriate cases”.*

20 It was my view that the applicants had received ample opportunity to file their evidence but were
in no position to do so. The matters which they cited as mitigation were entirely within their own
control. I could find nothing that would lead me to the view that despite their default I should
nevertheless exercise my discretion and allow the extension of time. Therefore, in the light of the
above I refused the applicants’ request for an extension of time to file further evidence under rule
25 13(6) and I set the period for the opponents to file evidence in reply under the provisions of rule
13(10) of the Trade Marks Rules 2000.

30 I did not hear any submissions on costs, both parties being content for the matter of costs from
the interlocutory hearing to go forward for consideration at the conclusion of the proceedings.

Dated this 7 day of July 2000

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40 **S P Rowan
Hearing Officer
For the Registrar, the Comptroller-General**