

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2365874
BY IAN FLEMING PUBLICATIONS LIMITED
TO REGISTER A TRADE MARK IN CLASSES 9, 16, 25, 28, 38 & 41**

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER No. 93035
BY DANJAQ LLC**

**AND IN THE MATTER OF AN APPEAL
TO THE APPOINTED PERSON
AGAINST A DECISION OF MR C J BOWEN
DATED 1 DECEMBER 2005**

DECISION

Background

1. This is an appeal against a decision of Mr. C. J. Bowen, the Hearing Officer acting for the Registrar, dated 1 December 2005, allowing Danjaq LLC (“D”) an extension of time within which to file evidence in support of its opposition to an application by Ian Fleming Publications Limited (“IFPL”) to register the words YOUNG BOND for use as a trade mark in relation to goods and services in Classes 9, 16, 25, 28, 38 and 41. At the conclusion of the hearing before me, I indicated that the appeal would be dismissed for the reasons that I would give in my written decision. I set out those reasons below. I mention also matters arising during the processing of the appeal, which I decided to take as a preliminary issue, inter alia, to ensure a proper record in the transcript.
2. The relevant sequence of events is as follows:

15 June 2004	IFPL files application
17 September 2004	Application published
15 December 2004	D files notice of opposition under section 5(2)(b), 5(3) and 5(4)(a), Trade Marks Act 1994 (“TMA”)
15 March 2005	IFPL files counterstatement
7 April 2005	Registry issues preliminary indication under rule 13B(1) and 13B(2), Trade Marks Rules 2000, as amended (“TMR”)

6 May 2005	D files TM53 to continue (r. 13B(4)(a) TMR)
11 May 2005	Registry notifies D that it has until 11 August 2005 to file evidence in support of opposition (r. 13C(1)(a) TMR)
11 August 2005	D files written request for extension of time
24 August 2005	IFPL objects to extension request
25 August 2005	Registry issues preliminary view granting extension
7 September 2005	IFPL requests hearing
25 October 2005	Hearing by video conference. 3 months extension of time granted until 11 November 2005
11 November 2005	D files evidence in support of opposition
18 November 2005	IFPL files TM5 requesting statement of reasons
1 December 2005	Registrar's decision issued
28 December 2005	IFPL files notice of appeal to an Appointed Person under section 76 TMA

3. The grounds for appeal are twofold. They are, in summary:
- (i) The Hearing Officer erred in taking account reasons advanced orally for the first time at the hearing below. Those reasons constituted a new request for an extension of time. Since that request was: (a) not in writing; and (b) made after the expiration of the period allowed for filing evidence in support of the opposition, the request should have been considered under rule 68(5) TMR and not rule 68(1). The requirements of rule 68(5) are more onerous than those of rule 68(1). Under rule 68(1) the time or periods may be extended by the Registrar as he thinks fit and upon such terms as he may direct, whereas under rule 68(5) the Registrar may only grant an extension of time if he is satisfied with the explanation for the delay in requesting the extension and it appears to him just and equitable to do so. Alternatively, since the new request was never put in writing (and late), it was outside rule 68(5) also¹.
 - (ii) In any event, the reasons put forward by IPFL were insufficient on the case law to support an extension of time.

¹ I did not understand Dr. James to pursue this alternative at the appeal hearing.

4. At the hearing of the appeal before me, IFPL was represented by Dr. Steven James, Messrs R. G. C. Jenkins & Co. Mr. Benet Brandreth of Counsel, instructed by Messrs. Boulton Watt Tennant, appeared on behalf of D. Mr. Brandreth reminded me that the appeal concerned an exercise of the Registrar's discretion with which this tribunal should only interfere if satisfied that the Hearing Officer acted unreasonably (*A. J. and M. A. Levy's Trade Mark* [1999] RPC 291) or was plainly wrong (*Siddiqui's Application*, BL O/481/00).

Preliminary issue

5. Before turning to my reasons for dismissing the appeal, I make mention of steps I took at the start of the hearing to avoid any appearance of bias (see, *Peter Smith v. Kvaerner Cementation Foundations Ltd* [2006] EWCA Civ 242 and the authorities cited therein). I explained:
 - (a) On 8 May 2006, the Treasury Solicitor wrote to the parties' representatives informing them of circumstances affecting each of the Appointed Persons. Details were provided in each case. The parties were asked to liaise with one another with a view to determining whether they could agree upon the particular Appointed Person(s) they would and the particular Appointed Person(s) they would not willingly accept as their tribunal for the purposes of the appeal.
 - (b) Subsequently, the Treasury Solicitor received a telephone call from Messrs. Boulton Watt Tennant asking what would happen if the parties could not agree. The Treasury Solicitor stated the option of the Appointed Person referring the appeal to the High Court. In a further telephone call, Messrs. Boulton Watt Tennant informed the Treasury Solicitor that they were instructed not to contact Messrs. R. G. C. Jenkins until it had been established what would happen if the parties could not agree on an Appointed Person to hear the appeal.
 - (c) The Appointed Persons considered that this cut across the request for the parties to liaise with one another and that in the circumstances the appeal should be listed for hearing before me.
 - (d) On 9 June 2006, the Treasury Solicitor wrote to the parties informing them that I would hear the appeal on Monday 24 July 2006 at 2.30 pm, i.e., over one month's notice of the appointment of the appeal hearing before me was given.
 - (e) On 17 July 2006, Messrs. Boulton Watt Tennant requested an adjournment. In an email to the Treasury Solicitor dated 19 July 2006, Messrs. Boulton Watt Tennant said this was because: "... we [have] not had a chance to consider the potential conflict that Ruth Annand would have in this matter, and also the client is unhappy about the procedural irregularity in relation to the appointment of this Hearing (namely that we were asked to discuss the appointment of the specific Appointed

Person with Jenkins, and were then told we need not do this before we had a chance to actually discuss it”.

- (f) I informed the parties that I was not prepared to grant an adjournment at that stage but would hear any submissions on the two matters mentioned in Messrs. Boulton Wade Tennant’s email of 19 July 2006 as a preliminary to the hearing of the appeal on 24 July 2006.
 - (g) On 21 July 2006, Messrs. Boulton Wade Tennant sent an email to the Treasury Solicitor (copy to Messrs R. G. C. Jenkins) stating: “Now that we have had a chance to review the possible conflict of Ruth Annand the Opponent does not have any issue at all with the fact that she will be hearing this case”. Further, although D wished to place on record its dissatisfaction with the procedural handling of the hearing (as in (e) above): “the Opponent no longer wishes to take issue specifically with this and there is no need to address it at the Hearing on Monday”. Messrs. Boulton Wade Tennant confirmed the latter in a further email to the Treasury Solicitor on the same day.
6. Having recounted the events leading up to the hearing, I restated my own circumstances and the option of a referral to the High Court. I also mentioned the possibility of awaiting the appointment of a fourth Appointed Person now that the application process had started, but regarded that as a distant option. I informed the parties of their right to object to my hearing of the appeal and the steps that would follow. I explained that if the parties consented to my hearing the appeal their rights to object would be lost. I indicated that I would rise to allow the parties time to reflect before making an election. Both sides indicated that this was unnecessary and that they consented to my hearing of the appeal.

The appeal

7. Rule 68 of the TMR provides in so far as relevant:

“**68.** – (1) The time or periods-

(a) prescribed by these Rules ...

subject to paragraph (2) below, may, at the written request of the person or party concerned, or on the initiative of the registrar, be extended by the registrar as she thinks fit and upon such terms as she may direct.

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

(a) is sought in respect of a time or periods prescribed by rules 13 to 13C ... 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 ...

[...]

(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 her discretion, extend the period or time if she is satisfied with the explanation for the delay in requesting the extension and it appears to her just and equitable to do so.”

8. As noted by the Hearing Officer (para. 14), D’s request for additional time, dated 11 August 2005, complied with the above requirements, i.e., it was: (a) submitted on form TM9; (b) accompanied by the relevant fee; (c) filed before the relevant period expired; (d) copied to IFPL; and (e) in respect of a period capable of being extended.
9. The reasons given for an extension of time of three months were:

“Our instructing principal in the USA has been involved in legal proceedings over the past four months and furthermore, the opponent has been occupied with preparations for the filming of a new “BOND” film.

Unfortunately, it has not yet been possible to finalise the evidence that is required to establish the reputation of Danjaq, LLC in relation to their “BOND” trade marks. Evidence gathering is ongoing at present, as is the near completion of the draft Witness Statement.

In addition, we understood from our instructing principal, that settlement negotiations were ongoing between the respective parties counsel in the United States and that a suspension of these proceedings would be in order (as for all other corresponding oppositions between the same parties). However the applicant’s UK attorneys have informed us today that they do not believe the subject proceedings to be a part of the current negotiations. Further time is therefore required to establish whether or not this is in fact the case.”

10. By letter dated 24 August 2005, IFPL confirmed to the Registry their understanding that there were no ongoing settlement negotiations between the parties concerning the application in suit.
11. The Hearing Officer’s decision records that D’s skeleton argument contained further information relating to the extension request (para. 9):

“... at the time of the request it had not been possible to complete the evidence gathering process, nor the draft witness statement, because

firstly, the evidence required to support the claim to reputation is extensive (spanning some 43 years), and secondly, because the opponent was not in a position to finalise the evidence in a format suitable for submission to the Registrar. In addition, D states that there are a large number of opposition and cancellation proceedings ongoing in the United Kingdom and abroad which require the submission of evidence of the trade marks JAMES BOND and 007. And, due to the massive amount of evidence relating to these trade marks resulting from the success of the JAMES BOND series of films, it has been impossible to complete the evidence collection within the first time limit set;

... there are negotiations ongoing between the parties and ... there are a large number of Agreements already in existence between the parties spanning some 40 or more years, all of which relate to the JAMES BOND registered and unregistered trade marks. It was ... D's assumption that the application in suit was also part of the current negotiations, although they add that it has not affected D's efforts in-so-far as the collection and compilation of their evidence was concerned."

12. Finally, the Hearing Officer's letter to the parties, dated 26 October 2005, made clear that he took into account two further factors at the hearing:

"Having considered the parties' skeleton arguments and the submissions at the hearing, my decision was to confirm the Preliminary View ... However, I did so on the basis of the additional information you provided at the hearing (to which Dr. James did not object), and given your assurance that the totality of the Opponent's evidence-in-chief would be filed by 11 November 2005 ...".

13. The Hearing Officer expanded on those factors at paragraph 17 of his decision:

"At the hearing, and having confirmed that the evidence was being prepared diligently during the relevant period, Mr. Stobbs explained that the additional time was needed because of: (i) the size and nature of D (Mr. Stobbs explaining that D "*were not MGM*" but were a company established to exploit the rights in, inter alia, the JAMES BOND character), (ii) the extent of the evidence available (given use over forty years) [I note this reason was foreshadowed in the skeleton argument], (iii) that the marks had not been used by only one proprietor during that time, and (iv) that there were nineteen separate licensees to consider. He said that three witness statements were to be provided; one from D's Chief Executive Officer, one from an independent third party (over whom they had no control), and one in relation to the licensing programme. Mr. Stobbs added that despite the misunderstanding as to whether or not these proceedings formed part of ongoing settlement negotiations between the parties, the preparation of the evidence continued regardless. Finally, Mr. Stobbs indicated

that he was in a position to file some evidence on the day of the hearing, and the remainder in draft form. He confirmed that all of the evidence would be provided by the expiry of the contested extension of time request.”

14. The Hearing Officer directed himself as to the applicable legal principles by reference to *Siddiqui’s Application*, BL O/481/00. The parties agree that he was correct to do so. In *Siddiqui*, Mr. Simon Thorley QC sitting as the Appointed Person said:

“Accordingly, it must be incumbent on the application for the extension to show that the facts do merit it. 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.”

Earlier in *Siddiqui*, Mr. Thorley had agreed with the conclusion of Mr. Geoffrey Hobbs QC sitting as the Appointed Person in *LIQUID FORCE Trade Mark* [1999] RPC 429 at 438 to the effect that the absence of good reason for failure to comply with a time limit is not always in itself sufficient to justify refusal of an extension of time. The true position being that it is for the party in default to satisfy the tribunal that, despite his default, the discretion to extend time should nevertheless be exercised in his favour, for which purpose he could rely on any relevant circumstances (see also *Tottenham Hotspur PLC’s Application*, BL O/527/01).

15. Although the Hearing Officer expressed himself satisfied on the first and second *Siddiqui* criteria from the original request² that was not the case for the third criterion (para. 20):

“While D may have been involved in evidence gathering and the preparation of a draft witness statement during the relevant period, there were, in my view, no justifiable reasons provided in the original request as to why the evidence could not have been produced in the prescribed period ...”.

However overall an extension of time was justified on the additional reasons given at the hearing (para. 23):

“At the hearing, Dr. James raised no objections to the additional information relied upon by Mr. Stobbs to justify the granting of the additional time. In my view, this additional information i.e. the size

² And an assurance from Mr. Stobbs at the hearing that evidence gathering was underway.

and nature of D, the extent and length of use on which D wished to rely, that use had not been by only one proprietor, the number of licensees involved, and that D intended to file a witness statement from an independent third party (over which they had no control) were, when taken together, sufficient to justify the exercise of the Registrar's discretion in D's favour."

16. Dr. James argued that the Hearing Officer was wrong to take into account those additional reasons for the purposes of applying rule 68(1). Dr. James relied on the following observations by Mr. Geoffrey Hobbs QC sitting as the Appointed Person in *Style Holdings PLC's Application*, BL O/464/01:

"By not simply confining the hearing to the question whether the reasons put forward in writing on 2nd March 2000 were adequate as a basis for the exercise of discretion in the opponent's favour, the hearing officer effectively allowed the opponent to renew its request orally on 1st June 2000 (one day less than three months after the expiry of the extension of time granted in December 1999) and to do so on the basis of facts and matters which had not previously been brought to the attention of the Registrar or the applicant.

Since the point does not appear to have been raised before the hearing officer, I propose to leave on one side the question whether the reasons put forward on 2nd March 2000 were so perfunctory that significant expansion or clarification of them must inevitably have amounted to the making of a substantive request after the expiry of the previously granted extension of time.

I take the view that if it was appropriate to allow the opponent to expand and clarify the written reasons for its request, it was no less appropriate to require it to reduce the intended expansion and clarification to a true and accurate statement in writing.

I think it is regrettable that the Registrar did not insist that if the opponent intended to offer an amplified explanation with regard to the preparation of the evidence and the reasons for the delay in filing it, it should do so in writing in advance of the hearing so that the request for an extension of time could be fully and effectively considered against the background of a properly stated case."

Nevertheless, Mr. Hobbs was not prepared to interfere with the Hearing Officer's decision to grant an extension.

17. The Hearing Officer makes clear in his decision that he was alive to the observations of Mr. Hobbs in *Style Holdings* (para. 21). Moreover, he was conversant with the subsequent clarification of those observations by Mr. Hobbs sitting as the Appointed Person in *Ministry of Sound Recordings Limited's Application*, BL O/136/03:

“I think that in this part of his decision the hearing officer may have been reading more into my observations in **Style Holdings PLC’s Application** than I intended to be the case. As I have already indicated, the concerns I had in mind when giving my decision in **Style Holdings PLC’s Application** were that applicants should not proceed to a hearing without having previously foreshadowed in writing the reasons for their request for an extension of time and that an application which is not actually based on reasons intimated in a Form TM9 filed before expiry of the relevant time limit is liable to be regarded as an application under rule 68(5) for an extension out of time.

The remedy for those concerns is to insist upon the filing of a succinct but complete statement of case in support of an application for an extension of time and treat reliance on other substantive reasons as a notional request for amendment of the statement of case rather than impose artificial limitations on the scope of the exercise of discretion under rule 68 at any ensuing hearing ...”.

In other words, although it is highly desirable that all reasons sought to be relied on in support of an extension of time should be committed to writing in advance of a hearing, that does not preclude the Hearing Officer from taking into account other reasons put forward orally at the hearing when deciding whether to exercise discretion under rule 68.

18. Dr. James accepts that he raised no objections at the time to the additional reasons relied upon by D. In my judgment the Hearing Officer was neither unreasonable nor plainly wrong in granting D an extension of time of three months within which to file evidence in support of the opposition. The first ground of appeal fails.
19. The second ground of appeal is that the additional reasons did not justify the grant of an extension of time. But this complaint is predicated on the nature of the evidence that was actually filed by D on 11 November 2005, i.e., after the extension of time was granted. IFPL do not allege any misrepresentation on the part of D at the hearing below. Nevertheless, D’s evidence as actually filed does not live up to expectations engendered at the hearing for reasons that are not in the materials before me. Be that as it may, the Hearing Officer cannot be said to have fallen into error in that regard. The second ground of appeal also fails.

Conclusion

20. In the result the appeal has not succeeded. Dr. James sought to argue that D was not entitled to any costs because D should have included their additional reasons in the original request. Mr. Brandreth accepts that this may have constituted good reason for the Hearing Officer making no order as to costs below, but the same is not true of the appeal. I agree with Mr. Brandreth. I will order that IFPL pay to D the sum of £600 towards D's costs of this appeal.

Professor Ruth Annand, 8 September 2006

Dr. Steven James, Messrs. R. G. C. Jenkins & Co., appeared on behalf of Ian Fleming Publications Limited

Mr. Benet Brandreth, instructed by Messrs. Boulton Watt Tennant, appeared as counsel on behalf of Danjaq LLC