

**TRADE MARKS ACT 1994**

IN THE MATTER OF an interlocutory hearing  
in relation to application No 2360358  
in the name of Philip-Maitland Kraft  
and opposition No. 92917 thereto  
by Maytag International, Inc.

**Background**

1. Application No. 2360358 is for the trade mark MAGIC HOME CHEF and was applied for on 6 April 2004. It stands in the name of Philip Maitland-Kraft. Following publication of the application in the Trade Marks Journal, notice of opposition was filed against the application on 1 November 2004 by Maytag International, Inc. The proceedings followed the usual course with the filing of a Form TM8 and counter-statement and then evidence. Following the filing of evidence by the applicant, the opponent was allowed until 23 April 2006 to file any evidence on which it wished to rely, which was strictly in reply to the applicant's evidence, under the provisions of rule 13C(5) of the Trade Marks Rules 2000 (as amended).
2. On 24 April 2006, the opponent filed a Form TM9 and fee, asking for an extension of time of three months until 23 July 2006. The accompanying letter gave the following reasons for the request:

“We are in the process of discussing the information and evidence required. As you will appreciate, obtaining and collating this information takes a significant amount of time, since generally the information needs to be obtained from a number of different departments within the company. As you are aware, the opponent is a US based company which complicates the situation as the overall responsibility for UK trade marks lies with the in-house Counsel in the US, and there is no person based in the UK with responsibility for trade marks.

The situation is further complicated by the fact that the company is currently in the midst of commercial negotiations relating to numerous takeover bids. The commercial situation the company is faced with is of course affecting their entire business, including the trade mark portfolio. It also means that the in-house Counsel, who is solely responsible for the entire UK trade mark portfolio, is currently under abnormal working pressures. There has therefore been a delay in the matter, which simply could not have been helped or

anticipated. Therefore, we will clearly need more time to obtain the information and formalise the evidence before it can be formally filed with the Registry.

Therefore, whilst every effort has been made to obtain the evidence requested as quickly as possible we will require further time to enable the clients to finalise the collection of the information and materials.

We can assure you that we are making every effort to progress the completion of the evidence in support of the opposition.

We hope that in the light of [the] position outlined above and the unusual changes that our client is subject to at the moment you will consider granting the extension of time.”

3. On 27 April 2006, a letter was issued advising the parties of the registrar’s preliminary view. This was that the request should be granted (until 23 July 2006) and allowed a period of fourteen days for either party to provide full written arguments against the preliminary view or to request to be heard under rule 54(1). The applicant responded by email on 3 May 2006, requesting an interlocutory hearing.
4. Arrangements were made for the appointment of the hearing. By way of an email dated 13 June 2006, the opponent’s representatives, Marks & Clerk, said that they were not going to attend the hearing, but that they would make written submissions in lieu of attendance. The applicant consented to the hearing being conducted over the telephone. The opponent sent written submissions on 28 June 2006.
5. The hearing began, as scheduled, by telephone, on Friday 30 June 2006. Mr Maitland-Kraft, the applicant, was in attendance only and represented himself. It became apparent to me in the opening minutes of the hearing that Mr Maitland-Kraft had not seen a copy of the opponent’s written submissions. Upon checking the documents in my possession, there was no indication that they had been copied to the applicant and my conclusion was, therefore, that they had not been sent to the applicant. In the circumstances, I adjourned the hearing and made arrangements for him to receive a copy of the submissions, for the opponent’s representative to be informed and for the hearing to be reconvened.
6. The reconvened hearing took place before me by telephone, with Mr Maitland-Kraft in attendance only, as before. I did not give my decision at the end of the hearing but instead gave it in writing later that day. My decision was to reverse the preliminary view and refuse the request for an extension of time. My letter said the following:

“I write to confirm my decision following the interlocutory hearing which took place before me earlier today, by telephone. You, as the applicant, represented yourself. The opponent did not attend, but its representatives, Marks & Clerk, instead asked that written submissions be taken into account in lieu of attendance. The hearing was to consider the Registrar’s preliminary view to

grant the opponent's request for a three-month extension of time in which to file evidence-in-reply.

I have reviewed all relevant written and oral submissions and my decision is to reverse the preliminary view. Having regard to the guidance in the *Siddiqui* case, it does not appear to me that the reasons given in the opponent's request of 24 April 2006 are sufficient. Although the opponent gave reasons as to why no evidence was yet ready by 23 April 2006, it did not say what had been done thus far and, importantly, what it was that it wanted to do, in relation to the evidence-in-chief, that could not be achieved in the three months already allowed.

The consequence of my decision is that the time requested until 23 July 2006 is not allowed and that therefore the time period allowed under rule 13C (5) has expired, with no evidence-in-reply having been filed. I direct that the evidence rounds are complete and that the case is ready for a decision to be made on the substantive ground (section 5(2)(b)). The Registry will contact the parties in due course regarding arrangements for that stage of the process."

7. The opponent filed a Form TM5 requesting a statement of reasons for the decision. This I now give.

#### **Written submissions**

8. The opponent supplied written submissions in lieu of attendance. There were no skeleton arguments. The opponent submitted that:
  - (i) there had been difficulties obtaining and collating the evidence because the opponent was involved in a number of takeover bids and a consequent new in-house legal department was giving instructions, needing time to become familiar with the case;
  - (ii) it had provided "strong and compelling reasons" for the granting of the extension, citing *AG and M.A. Levys trade mark* [1999] RPC 292;
  - (iii) it had complied with *Siddiqui's Application* (BLO-481-00) by clearly showing what it wanted to do and why it had not been possible to achieve that in the circumstances;
  - (iv) it had not challenged the applicant's earlier extension of time request;
  - (v) the applicant had failed to copy documents to the opponents on a number of occasions, causing the opposition to be complicated by the resetting of dates. It would be inequitable for the Registrar not to grant the requested extension in view of the leniency already shown to the applicant.

## Decision

9. Alteration of time limits are provided for by rule 68 of the Trade Marks Rules 2000 (as amended). This states:

“68.- (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

(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, 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, 18, 23, 25, 31, 31A, 32, 32A, 33, 33A or 34, 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.

(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 13A(1) (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), rule 31(3) (time for filing counterstatement and evidence of use or reasons for non-use), rule 32(3) (time for filing counterstatement), rule 33(6) (time for filing counterstatement), and rule 47 (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).....

(6).....

(7).....”

10. The opponent’s request was in respect of an extension to the period for filing evidence and was therefore not proscribed by rule 68(3). The request was made on the correct form (Form TM9), was made on Monday 24 April 2006 (the statutory

period for filing evidence had expired the preceding day, an excluded business day) and was accompanied by the requisite fee. It is unclear from the request itself whether it was copied to the applicant, but a letter from the applicant dated 26 April 2006, which begins with the sentence “ I have received notice from Marks and Clark of their request for a further delay in this matter” strongly suggests that it was copied as is required by rule 68(2)(a).

11. The Registrar has issued a number of practice directions on extensions of time in inter partes proceedings. The first of these, which came into force in January 1999, stated that:

“Full reasons in support of the request must be provided and, in the case of requests filed after the time or period has expired, full reasons also to explain the delay in making the request must be provided. It is likely that the reasons for the request will need to be filed on a separate sheet attached to the Form TM9. The extension will not be granted if the request has not been copied to the other party(ies) to the proceedings or in the absence of detailed reasons.”

12. A subsequent practice direction on the subject of extensions of time in inter partes proceedings quoted Geoffrey Hobbs QC, sitting as the Appointed Person (under sections 76 and 77 of the Trade Marks Act 1994) in the case of *Liquid Force* [1999] RPC 429:

“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 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 the prescribed time limits are observed, subject to his power to grant fair and reasonable extensions of time in appropriate cases.”

13. Although the relevant rules in that case were the Trade Marks Rules 1994, I believe Mr Hobbs’ comments remain equally relevant under the Trade Marks Rules 2000 (as amended), currently in force. The practice direction goes on to quote from the case of *Dr Ghayasuddin Siddiqui v Dr M H A Khan as a nominee of the Muslim Parliament of Great Britain* SRIS O/481/00. In that case, Simon Thorley QC, acting as the Appointed Person said:

“1. It must always be borne in mind that any application for an extension of time is seeking an indulgence from the tribunal. The Act and the rules lay down a comprehensive code for the conduct of opposition. The code presumes for a normal case and provides for it.

2. There is a public interest which clearly underlies the rules that oppositions and applications should not be allowed unreasonably to drag on.

3. In all cases the registry must have regard to the overriding objective which is to ensure fairness to both parties. Thus, it can grant an extension when the facts of the case merit it.

4. 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.

Jacob J made it clear in the SAW case that any perception that the registrar would grant extensions liberally was wrong and I take this opportunity to repeat that. In principle matters should be disposed of within the time limits set out in the rules and it is an exceptional case rather than the normal case where extensions will be granted.”

14. The opponent was allowed a statutory period of three months under rule 13C(5) to file evidence in reply to the applicant’s evidence. This period expired on 23 April 2006 and the opponent’s extension request asked for a period of three months until 23 July 2006 in which to file its evidence in reply. It had not filed any evidence within the statutory period already permitted.

15. The opponent’s reasons were contained in the letter attached to the Form TM9 and I have reproduced the contents of that letter in paragraph 2 and have summarised their written submissions in paragraph 8 of this decision. As far as the opponent’s written submissions (iv) and (v) are concerned, the fact that it had not challenged the applicant’s earlier extension of time request has no bearing on the merits of their own request. It is well established that each request must be considered individually. It is also of no relevance to this request whether or not any so-called “leniency” had been shown to the applicant. The remainder of their submissions I will deal with below. For the applicant’s part, he argued at the hearing that the opponent’s lack of action showed that there was no substance to their action and that it had had a substantial amount of time already.

16. This request was not for the filing of evidence-in-chief; it was for the filing of evidence-in-reply. Rule 13C(5) states that such evidence “shall be confined to matters strictly in reply to the applicant’s evidence.” It is pertinent therefore to consider, alongside the weighing of their reasons for failing to file evidence-in-reply within the statutory period of three months, what that evidence was that the opponent wanted to reply to. Was it voluminous or complicated, for example?

17. The opposition is directed at the whole of the applicant’s specification: “kitchen utensils for pressing and moulding food into rectangular blocks” in Class 21 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. The applicant’s evidence consists of a witness statement and two exhibits. The substantive content of the witness statement runs to a total of twelve lines and is reproduced verbatim below:

“Para 1. Maytag produce electrical home appliances and are a USA based Company. At the time of making the trade mark application there was not found any opposing mark and the mark was granted. Since becoming aware

of Maytag's opposition I can find no evidence of Maytag's mark being used in the UK and Maytag have declined to provide any evidence of its use or advertising of the named mark. Essentially it has been unused

Para 2. Exhibit 002 Provides a set of drawings detailing the fact that the device, a kitchen aid to making perfect sushi and other party snack is not an electrical product, but manual operated

Para.3 Exhibit 001. Is a copy of Grant of Patent for the Magic Home Chef demonstrating that it in no way infringes on any design or device marketed by Maytag .

Para 4. In summary Maytag have not actively used their mark in the UK and certainly the trademark examiner could find no reasonable objection to the mark at the time of granting it..

I believe the facts stated in this witness statement are true"

18. Exhibit 001 is a letter from the UK Patent Office, dated 18 October 2005, notifying the applicant of the grant of his patent, serial number GB2407292. It gives patent grant publication details and information about renewals. That is the entirety of its content. Exhibit 002 is a copy of five pages of drawings detailing the device and its application; perhaps (it is not stated) the patent application itself.

19. I consider, with respect to the applicant, that the evidence is not voluminous or complicated. Exhibit 001 can hold no surprises for the opponent's representatives, whose letter head states that they are "Patent and Trade Mark Attorneys". Investigation of the patent would not be difficult. However, I do not take the foregoing alone; I must view it alongside the opponent's reasons for asking for a further three months and apply the well-established jurisprudence which I refer to above and to which the opponent referred in its written submissions.

20. The opponent said that it had provided "strong and compelling reasons" and that it had complied with *Siddiqui's Application* in putting forward facts that merited the extension, showing clearly what the opponent wished to do and why it had not been possible to achieve it. I cannot agree. The opponent did give reasons as to why no evidence was ready by 23 April 2006, in that it was involved in commercial takeovers and that the in-house Counsel was under "unusual working pressures caused by due diligence actions". However, the opponent did not explain what it was that it wanted to do as a response to the applicant's evidence, the content of which I have outlined above. It also did not say what had been done so far. Even allowing for the difficulties in finalising any evidence-in-reply via Counsel in the three months which had already passed, I would have expected that the opponent's representatives could have made some preparations with regard to replying to a standard patent grant letter and line drawings of the applicant's product. No indication was given to that effect either in the extension request or in the opponent's written submissions.

21. I took the view that this was a normal case and that the position of the applicant would be prejudiced, in suffering further delay in determining whether or not his trade mark would be registered, which was not justified by the reasons given by the opponent. In the light of the information before me, in the form of the extension request and the opponent's written submissions, I decided that to grant the indulgence

would not be in accordance with the overriding objective envisaged in the *Siddiqui* case. In short, I was not persuaded to grant the extension request.

22. I therefore reversed the registry's preliminary view to allow the extension of time, the effect of which was to bring the evidential part of the proceedings to a close.

23. I made no award of costs in respect of the interlocutory hearing.

Dated the 11th day of December 2006.

**Judi Pike**  
**For the Registrar**  
**The Comptroller-General**