

TRADE MARKS ACT 1994

IN THE MATTER OF A REQUEST BY EMAP CONSUMER MAGAZINES LTD (THE  
OPPONENTS) FOR AN EXTENSION OF TIME WITHIN WHICH TO FILE EVIDENCE  
IN OPPOSITION PROCEEDINGS (No 50104) IN RELATION TO APPLICATION  
NUMBER 2167183

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IN THE MATTER OF a request by Emap Consumer Magazines Ltd (the opponents) for an extension of time within which to file evidence in opposition proceedings (No 50104) in relation to application number 2167183.

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### **Background**

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On 20<sup>th</sup> May 1998 Mortons of Horncastle Ltd applied to register the trade mark OLD BIKE MART for a specification of goods which reads:

Class 16      Newspapers, relating to vintage motor cycles

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The application is numbered 2167183 and it was accepted and published. On 25<sup>th</sup> August 1999 Emap Consumer Magazines Ltd filed notice of opposition together with a statement of grounds. A counter-statement was filed on 1<sup>st</sup> December 1999, and by letter dated 8<sup>th</sup> December 1999 the Office invited the opponents to file their evidence by 8<sup>th</sup> March 2000, under rule 13(4) of the Trade Mark Rules 1994 (as amended).

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On 8<sup>th</sup> March 2000, Form TM9 requesting an extension was filed by the agents for the opponents. They wanted a further three months to file their evidence (taking them up to 8<sup>th</sup> June 2000) and said they had “commenced the collection and collation of evidence which is in various states of readiness”. This extension was allowed by official letter dated 28<sup>th</sup> March 2000, noting that any further request would need to be supported with detailed and

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compelling reasons and show progress with the preparation of evidence.

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On 8<sup>th</sup> June 2000, following a telephone conversation between Alice Luxmoore of the agents for the opponents and Alastair East of the registry, a fax was received from the agents requesting a further extension of one month taking them up to 8<sup>th</sup> July 2000. The fax said that the instructing principal solicitor, John Olsen, had unfortunately:

“been called urgently to the States on 6<sup>th</sup> June 2000. The file has been passed to Ms Luxmoore for review, but in the absence of Mr Olsen and despite her due and diligent efforts to ensure completion of this matter, this has not been possible in the time allowed.”

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Agents for the applicants opposed this request in a fax dated 12<sup>th</sup> June 2000 saying that they had approached the opponents on 26<sup>th</sup> October 1999 with a view to settlement of the matter on the basis of co-existence of both parties’ marks. No substantive response had been received from the agents for the opponents and a further letter of 5<sup>th</sup> April 2000 pointing out that the parties had met and apparently agreed a settlement had similarly illicited no response.

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In addition, there was also a formal problem with the request for an extension made on 8<sup>th</sup> June 2000, and that was that it had not been properly made on Form TM9 with fee. The registry noted this in a letter dated 26<sup>th</sup> June 2000 confirming a telephone call of 16<sup>th</sup> June 2000 between Mark Edwards of the registry and Alice Luxmoore. The letter advised that,  
5 following the phone call of 16<sup>th</sup> June, when the agents had been asked to file the correct form as a matter of urgency and to provide reasons for the late filing of the form, no form had been received, and accordingly the opposition was to be deemed withdrawn. Comments on this proposal were invited by 10<sup>th</sup> July 2000.

10 The agents for the opponents replied by fax dated 10<sup>th</sup> July saying that they had filed Form TM9 but that the original must have never been received by the Law Section. A copy of the original Form TM9 dated 16<sup>th</sup> June (the date of the phone call between Mark Edwards and Alice Luxmoore) was supplied. The agents also confirmed that the “submission of the TM9 in support of the extension of time was overlooked”. The reason for the extension of time  
15 given on the Form TM9 mirrored the reason given in the fax received on 8<sup>th</sup> June, namely:

“that the instructing solicitor, John Olsen has been called urgently to the States. In the absence of Mr Olsen, it has not been possible to ensure completion of this matter in the time allowed. “

20 The agents for the applicants continued to oppose the extension adding, in a letter dated 14<sup>th</sup> July, that the opponents had not presented detailed and compelling reasons showing progress with the preparation of evidence as requested in the official letter of 28<sup>th</sup> March 2000.

25 On 18<sup>th</sup> July 2000, the registry wrote to the opponents saying that the extension of one month requested on Form TM9 was refused as the reasons put forward were not compelling enough to justify the granting of an extension. A period of 14 days was allowed in which to present written arguments against the decision or to request a hearing. By fax dated 1<sup>st</sup> August 2000 the opponents asked to be heard.

30 On reviewing the papers prior to the hearing, the registry wrote on 17<sup>th</sup> August 2000 to the opponents noting a preliminary point which was that the Form TM9 should have been filed on 8<sup>th</sup> June but was filed on 16<sup>th</sup> June. In accordance with rule 68(5) of the Trade Mark Rules 2000 (which had, by then, superceded the Trade Mark Rules 1994 as amended) the period for requesting extension can only be extended at the registrar’s discretion, provided there is an  
35 explanation for the delay in requesting the extension and it appears to the registrar that it is just and equitable to do so. It was the preliminary view of the Office that the reason given for the delay, namely that Form TM9 was ‘overlooked’ was inadequate. It was also pointed out that even if the registrar was persuaded to accept that the requirements of rule 68(5) had been met *and* that the extension of one month from 8<sup>th</sup> June to 8<sup>th</sup> July should be allowed, there  
40 remained the fact that no evidence had yet been filed. Additional substantive reasons were therefore required to persuade the registrar that an extension should be granted for any period after the 8<sup>th</sup> July up to the point evidence was to be filed.

45 The hearing took place on 25<sup>th</sup> August 2000; Mr Mark Engelman of Counsel represented the opponents and Mr Jeremy Goddin represented the applicants. On the preliminary point at the

hearing, I accepted the Form TM9 into the proceedings, thereby overruling the registry's objection, but refused the extension requested. I am now asked to give my reasons.

## DECISION

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### The preliminary issue

10 The Form TM9 and fee was filed on 16<sup>th</sup> June 2000 and it should have been filed on 8<sup>th</sup> June 2000. Could it be admitted into the proceedings? Instead of addressing me on the requirements of rule 68(5) of the Trade Mark Rules 2000 ('the rules'), on which the registry had based its formal objection to the late filed Form TM9, Mr Engelman relied on three main arguments: the wording of rule 68(1) of the rules, registry practice in relation to that rule, and the notion of 'legitimate expectation'.

15 He said that a request had been made in writing on 8<sup>th</sup> June 2000, before expiry of the relevant period, and thus it had complied with rule 68(4). That it was not made on Form TM9 with fee within the period was excusable given the terms of rule 68(1) which reads:

20 *"Alteration of time limits (Form TM9)*

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."

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Mr Engelman said that it is established practice before the registrar that she was content, deriving authority from the words 'as she thinks fit' in rule 68(1), to regard the absence of Form TM9 as a matter of form which does not prevent consideration of the substantive reasons given for an extension (cf *Genius Trade Mark* [1999] RPC 741).

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If an extension is allowed on the basis of submissions at a hearing for example, then the registrar may direct that matters are subsequently regularised by the filing of Form TM9 and the paying of the requisite fee. Registry practice therefore treats the filing of Form TM9 and paying of a fee as a matter of procedure and form; it would be wrong to deny a person an extension purely on the basis that they had not communicated the request in the correct manner, particularly where a person had made their request in writing within the relevant period.

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Pursuing the theme of procedural fairness, Mr Engelman also relied on the notion of 'legitimate expectation' as expounded in *R.v Devon County Council, ex parte Baker and another* [1995] 1 All ER 73. In this respect, I understood Mr Engelman to argue that a clear and unambiguous statement of intent had been given by the opponents to the effect that they

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wanted an extension for a month and that they had provided written reasons for the extension. The official letter of 26<sup>th</sup> June 2000, which confirmed the phone call of 16<sup>th</sup> June, gave rise to a legitimate expectation that if they complied with the formal requirements as to the Form TM9 as a matter of urgency then, in the exercise of procedural fairness, the registrar would go on to consider the substantive grounds for the extension, the formal matter being satisfied.

In giving my decision at the hearing however, I turned my attention back to rule 68(5) and addressed the official letter of 17<sup>th</sup> August 2000. Rule 68(5) reads:

“ (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 to be just and equitable to do so “.

I overruled the preliminary view of the registry taken in the letter of 17<sup>th</sup> August that an unacceptable reason had been given as regards the delay in filing Form TM9. I accepted the explanation for the delay in filing Form TM9 which had originally been given by the agents in their letter of 10<sup>th</sup> July 2000, namely that it had been ‘overlooked’. As regards the second limb of the test in rule 68(5), I accepted that it was just and equitable to extend the period for filing the request for extension as the applicant’s had not drawn my attention to any prejudice suffered as a result. Indeed, they would have found it hard to point to any prejudice as the written request for an extension had been filed in time and copied to them at the same time, thereby putting them on notice that an extension had been sought.

Whether one derives authority from rule 68(1) or from rule 68(5) depends on whether one treats the application for an extension as being late or not. Rule 68(4) requires that a request to extend a period must be made before expiry of that period. In relying on rule 68(5) I took a strict view that it was a late request. In case I am wrong in relying on rule 68(5) to derive authority to correct the formal defect to admit the Form TM9 into proceedings, I am nevertheless persuaded that, in these circumstances and based on registry practice, reliance on rule 68(1) could be placed to remedy the irregularity. Because I have found that formal remedy lies within the rules themselves, I do not have to consider the notion of ‘legitimate expectation’ as it may or may not apply to these circumstances.

However, the fact that I found that the requirements of rule 68(5) had been met still left me with the decision as to whether I should allow the extension of one month from 8<sup>th</sup> June to 8<sup>th</sup> July. At one point, I understood Mr Engelman to say that since I had found that I could remedy the formal defect then there was no further issue with the registrar. Plainly that is wrong; the official letter of 17<sup>th</sup> August, which I had overruled on the preliminary point, did not displace the substantive objection to the reasons given for extension expressed in the official letter of 18<sup>th</sup> July 2000.

### **The extension of time**

The discretionary authority to grant an extension in connection with the filing of the opponent’s evidence in chief lies in rule 68(1) which I have already quoted.

At the hearing Mr Engelman had nothing further to add, clarify, or expand upon in respect of the reason given for the extension; namely Mr Olsen's absence on a business trip to the States. Indeed, he said that it was his duty not to mislead the tribunal in this matter. Instead, Mr Engelman took me to a number of authorities on the question of extension of time.

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Mr Engelman took me to R v Registrar of Trade Marks ex parte S.A.W Company S.A [1996] RPC 507 ('SAW') and he said that in this case there had been clear evidence of inactivity (during the (then) 6 month statutory period for filing evidence) on the part of the applicants for an extension, and this formed the basis of the refusal to allow the extension. The same evidence of inactivity was not available in the present case.

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He also took me to Re: Trade Mark Opposition by Ride Snowboard Co (unreported), a decision of the registrar which later went on appeal to the appointed person and was then reported as Liquid Force Trade Mark [1999] RPC 429('Liquid Force'). In this case Mr Engelman noted that the hearing officer was persuaded to allow an second extension of three months in which to file opponent's evidence.

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Mr Engelman submitted that in both SAW and Liquid Force the total length of time sought by the opponent (by 'sought' I mean allowed by statute, and additionally by way of discretionary extension) in which to file their evidence was comparable in quantum terms with the present case. In SAW six months was the statutory period and the opponents sought an extension beyond that. In Liquid Force three months was the statutory period, which had been extended once by three months and was sought to be extended by a further three months, the second extension being opposed by the applicants. In the present case the statutory period was three months, one extension of three months had been given and a further extension of just one month, forming the subject of the hearing, had been requested.

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It has to be noted of course that by the time the hearing took place, the one month period sought had expired without any evidence being filed, and therefore the opponents would have had to seek a further extension giving reasons if they wished to file evidence.

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At the hearing the opponents produced a draft witness statement and said that it comprised the totality of their evidence, but it had to be formalised and a number of exhibits were also required. An additional period of one month from the date of the hearing was required for completion. This would have taken us to 25<sup>th</sup> September 2000, making the total period for filing evidence over nine months.

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I would mention in passing, in relation to the 5 page draft witness statement handed up to me, that I find it hard to accept that such a document could possibly take nine months to prepare. It is not, on the face of it, evidence that would have required a substantial amount of research or preparation time. Nevertheless, the submissions made by Mr Engelman and the precedents he cited need addressing in full.

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Firstly, in relation to the SAW case and the question of whether there is evidence of inactivity by which the extension may be disallowed. I have difficulty with this submission and in my view the onus cannot be shifted in such a way; the opponents seek the indulgence of an

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extension, and it is they who must provide the detailed and compelling reasons for such an indulgence. In the absence of a full and complete history of the progress of the evidence, it is my view that an inference as to inactivity can be drawn; it must be for the defaulter to dispel such an inference. In *A. J and M. A Levy's Trade Mark* [1998] RPC 291, the appointed person said at page 292 line 12:

*It seems to me that when an extension of three months has been granted it is incumbent upon the party to whom it is 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 applicant 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 applicant must live with the consequences of that.*

Is the fact that Mr Olsen, the instructing principal solicitor, had been called away to the States on 6<sup>th</sup> June when the evidence was due on the 8<sup>th</sup> June a 'strong and compelling reason' which leaves matters on an unequivocal and certain basis? This, after all, is the opponent's best and only case. I do not think it meets the test in Levy's application. As Mr Goddin for the applicant's said, there is no knowledge as to when Mr Olsen returned and what he did when he returned. Crucially, the reason tells the registrar nothing of the evidence itself; its state of preparedness, and the precise steps taken within the first extension period by the opponents to ensure its completion. Not only does the reason lack detail however, it is also far from compelling since it asks the registrar to accept that the completion of the opponent's evidence is entirely dependent upon Mr Olsen's presence in the United Kingdom. I am unable to accept this; a largish firm of agents or solicitors ought to be in a position to substitute someone else to take matters forward.

Secondly, I am unable to accept Mr Engelman's submission that one should look at the overall length of time sought to file evidence in the *Liquid Force* and the *SAW* case, and by comparison, this case is by no means out of the ordinary. This sort of strict comparison is always going to be problematic, given that each and every case on extension of time will hinge on its own unique features. If a party is unable to file their evidence within the statutory period then, whether it is a first extension of one day or a tenth extension of six months, they must make their case to the registrar and: based on that case, the views of the other side and higher authority, the registrar will (or will not) exercise her discretion.

Thirdly, and this point was only briefly alluded to by Mr Engelman without being fully developed, even if a party seeking an extension could not provide good reasons for the extension, it was nevertheless possible that discretion could be exercised. In *Liquid Force*, applying the court's discretionary principles, the appointed person said at page 438 line 21:

*..the absence of good reason for failure to comply with a time limit was not always and 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 court that despite his default, the discretion should nevertheless be exercised in his favour, for which purpose he could rely on any*

*relevant circumstance.*

5 However, at the hearing Mr Engelman did not rely on any specific ‘relevant circumstance’. It was for him to do so, but in any event I cannot accept that the effect of Liquid Force is that all those who lack strong and compelling reasons (or have given inadequate reasons) for an extension can nevertheless successfully fall back on any relevant circumstance. Such a conclusion would seriously weaken, if not entirely deprive, the registrar of her discretionary powers, and effective management of proceedings would be in jeopardy.

10 The decision in Liquid Force needs to be looked at as a whole and in relation to its own unique circumstances. As the appointed person also noted in the case, there must be room for justice, and a defaulter guilty of abuse of process, or where a delay is inordinate, inexcusable and so seriously prejudicial to the opposite party must not be able to take refuge in ‘any relevant circumstance’. I am not suggesting that abuse or prejudicial delay are proven in this case; I  
15 am suggesting though that a party seeking to rely on ‘any relevant circumstance’ nevertheless faces a diligence test of the kind outlined in Levy’s application.

The defaulter in Liquid Force was tested, by the hearing officer if not the appointed person on appeal, as to his diligence in the preparation of his evidence which he made available in  
20 completed form at the hearing. Assurances were given in Liquid Force that the opponent’s agent had been pushing her client to get the evidence completed and that matters had been moving forward during the evidence period. In addition, and on the special circumstances of the case, the defaulter’s ‘inactivity’ in the completion of his evidence was in part at least due to a belief, based on the actions of the other side, that a negotiated settlement was a realistic  
25 prospect.

I would have to say that the defaulter in this case fell a long way short in accounting for the preparation and progress of their evidence, or that they had very good reasons such as ongoing negotiation, such as would persuade me that discretion should be exercised.  
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For all these reasons I found that the extension of time from 8<sup>th</sup> June to 8<sup>th</sup> July should be refused, and it follows that I do not need to consider any period after that

### **Costs**

35 Mr Goddin asked for costs in respect of the hearing and Mr Engelman opposed the request. In the event I declined to make an award in respect of the hearing.

40 It could be argued that the applicants were the ‘successful’ party at the hearing; the opponents were refused their request for an extension to file evidence. I think though it is more correct to view this particular result as the opponent’s failure not the applicant’s success. ‘Success’ in these discretionary cases where, as has been observed, a number of right answers may exist, is not a straightforward concept. The opponents, though they had prepared extensively for the hearing, ultimately failed to persuade the registrar to exercise her discretion.  
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Both the registrar and the applicants had objected to the reason for the extension and for the

5 same reason namely, that the reason given for the extension was not detailed and compelling. Whilst it could be argued that the applicant's agents were obliged to be at the hearing to protect their client's interests, I do not see in this particular case that the applicants offered anything more at the hearing than they had said in writing prior to the hearing, and nor did they take any other point than the registrar herself had taken.

10 There will of course be circumstances, particularly in the 'Woolf' era, where interlocutory hearing costs can be awarded in extension of time cases. Even a 'successful' party may find themselves penalised if it is felt that the hearing has been occasioned by a failure to give detailed and compelling reasons for an extension at the first available opportunity. In this particular case though, I was of the view that an award was not appropriate.

15 I must stress of course that this does not rule out any award at the conclusion of proceedings in relation to the overall contest or, for that matter, any other interlocutory matter that may arise.

**Conclusion**

20 Although I refused the opponent's request for an extension it does not necessarily mean that the proceedings are deemed withdrawn. Rule 13(8) permits the registrar to direct otherwise. The circumstances where the registrar may give such a direction are, for example, if the opposition, or part of the opposition, is based on section 5 grounds and an undertaking is given by the opponents to make submissions at the main hearing. The opponents drew my attention to the relevant Practice Direction, and have subsequently made such an application to continue within the 14 day period I allowed, and this will be dealt with outside the scope of this decision.

30 Dated this 5 day of October 2000

35 Edward S Smith  
Hearing Officer for the Registrar  
The Comptroller General