

**IN THE MATTER OF APPLICATION NO. 2273578
IN THE NAME OF BURHANI TRADING COMPANY
AND IN THE MATTER OF OPPOSITION NO.80377
BY BASIC TRADEMARK S.A**

TRADE MARKS ACT 1994

IN THE MATTER OF application no. 2273578
In the name of Burhani Trading Company
5 **AND IN THE MATTER of opposition no. 80377**
by Basic Trademark S.A

BACKGROUND

10 On 19 June 2001 Burhani Trading Company applied to register the following trade mark in Class 25:



15 in respect of the following goods:

20 **Class 25** - Jogging suits, casual wear.

The application was accepted, and published for opposition purposes on 15 August 2001.

25 On 15 November 2001, Basic Trademark S.A, filed a notice of opposition along with a statement of grounds in support of the opposition. There then followed an exchange of correspondence between the opponent and the Registrar which resulted in the filing of an amended statement of case on 20 December 2001. The Form TM7 and amended statement was served on the applicant on 15 January 2002 and the deadline for the applicant to file a Form TM8 and counter-statement was set at 15 April 2002.

30 A Form TM8 and counter-statement was filed by the applicant. Although the form was dated 12 April 2002 it was not received at the registry until 16 April 2002. The applicant was subsequently informed that as the 3 month period allowed for the filing of the Form TM8 and counter-statement had expired on 15 April 2002, the applicant's Form TM8 and counter-statement had been received outside the allowed period. It could not be accepted and
35 therefore the application would shortly be deemed withdrawn.

40 In further correspondence, the applicant submitted that they had posted the Form TM8 and counter-statement by first class mail on 12 April 2002 so that it would have been received within the period allowed. The applicant asked for it to be admitted into the proceedings. The registry responded and informed the applicant that the period for filing a Form TM8 and counter-statement was a non-extendible period and the Registrar has no discretion to extend

this period and admit the Form TM8 and counter-statement and reiterating that the application would be deemed abandoned.

5 On the 31 July 2002, the applicant filed a Form TM5 requesting the Registrar give a statement of grounds of the decision. This I now do.

DECISION

10 The opponent's Form TM7 and amended statement of grounds had been correctly served upon the applicant on 15 January 2002. The applicant was invited to file a Form TM8 and counter-statement if he wished to defend his application. The period for filing the Form TM8 and counter-statement is governed by rule 13(3) of the Trade Marks Rules 2000 which states:

15 *“Rule 13.-(3) Subject to paragraphs (4) and (5) below, within three months of the date on which a copy of the notice and statement is sent by the registrar to the applicant, the applicant may file a counterstatement, in conjunction with notice of the same on Form TM8; where such a notice and counterstatement are filed within the prescribed period, the registrar shall send a copy of the Form TM8 and the counter-statement to the person opposing the application.”*

20 The three month period set under rule 13(3) is subject to the provisions of rules 13(4) and 13(5) which state:

25 *“Rule 13.-(4) - Subject to paragraph (5), at any time before the expiry of the period prescribed in paragraph (3) above for filing of Form TM8 by the applicant the registrar may, on request, grant an extension of three months to that period where such a request is filed on Form TM9c and with the agreement of both the applicant and the opposing party (the “cooling off period”); the registrar may, on request, extend the cooling off period for a further three months where such a request is filed*
30 *on a Form TM9c and with the agreement of both the applicant and the opposing party.*

35 *Rule 13.-(5) - With one month after the expiry of the cooling off period the applicant may file a counterstatement, in conjunction with notice of the same on Form TM8; where such a notice and counterstatement are filed within that one month period, the registrar shall send a copy of the Form TM8 and the counter-statement to the person opposing the application. by the filing of a Form TM9c to enter into a cooling off period may the three month period for filing the Form TM8 and counter-statement be*
40 *extended.”*

No request was received from either party to enter a cooling off period and therefore the provisions of rules 13(4) and (5) do not apply in this case. The period for the filing of the Form TM8 and counter-statement was therefore 15 April 2002 as set out in rule 13(3).

45 Under the Trade Marks Rules 2000, provision is made for the alteration of time periods. These are set out in rule 68 which states:

50 *“Rule 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 a 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.”

This does not however, provide a general right to extend all time periods. There are exceptions. These are set out in rule 68(3) which states:

“**Rule 68.-(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), 13(3) & 13(5) (time for filing counter-statement), rule 13(4) (cooling off) save as provided for in that rule, rule 23(4) (time for filing an opposition) rule 25(3) (time for filing opposition), rule 29 (delayed renewal), rule 30 (restoration of registration), rule 31(2) (time for filing counter-statement), rule 32(2) (time for filing counter-statement), rule 33(2) (time for filing counter-statement), and rule 47 ((time for filing an opposition).”

Rule 68(3) therefore makes it clear that the time of filing a counter-statement cannot be extended. The Form TM8 and counter-statement should therefore have been filed on or before 15 April 2002. The meaning of ‘filed’ is defined in rule 2(3) which states:

“**Rule 2.-(3)** - In these rules references to the filing of any application, notice or other document, unless the contrary intention appears, are to be construed as references to its being delivered to the registrar at the office.”

The Trade Mark Rules 2000 make provision for time periods which expire on a day when the office is not open for business. This is provided for under rule 67(4) which states:

“**Rule 67.-(4)** - in this rule “excluded day” means a day which is not a business day of the office

Where time periods expire on an excluded day, the time period is extended to the next day on which the office is open for business. The period for filing a Form TM8 and counter-statement in this case expired 15 April 2002. This being a Monday was a day the office was open for business. It was not therefore an excluded day.

The applicant’s Form TM8 and counter-statement should have been received by the Registrar on or before Monday 15 April 2002; this date is not a deadline for the posting of such documents.

In a letter dated 25 April 2002 the applicant stated that the Form TM8 and counter-statement had been sent by first class post on Friday 12 April 2002. A copy of the envelope is attached at annex A. Although the envelope in which the documents were sent to the office does have a first class stamp as the applicants suggest, a further inspection of the envelope shows, however that the envelope was franked by the Bradford West Yorkshire sorting office sometime after noon on 15 April 2002. It also bears a Patent Office receipt stamp showing the envelope was received in Newport on 16 April 2002. This evidence clearly shows that the

TM8 and counter-statement had been sent on 15 April 2002 and was received by the registry on 16 April 2002.

Whilst there is no general provision in the Trade Mark Act or associated Rules for a document to be deemed to have been received on a date other than the actual date of receipt, the rules do contain the provision to allow the acceptance of late delivered mail in circumstances where there is a failure or undue delay in the postal system. These are set out in rule 67 which states:

“Rule 67.-(1)Where, on any day, there is-

(a) a general interruption or subsequent dislocation in the postal services of the United Kingdom, or

(b) an event or circumstances causing an interruption in the normal operation of the Office,

the registrar may certify the day as being one on which there is an “interruption” and, where any period of time specified in the Act or these Rules for the giving, making or filing of any notice, application or other document expires on a day so certified the period shall be extended to the first day next following (not being an excluded day) which is not certified.

Rule 67.-(2) -

Rule 67.-(3) - If in any particular case the registrar is satisfied that the failure to give, make or file any notice, application or other document within any period of time specified in the Act or these Rules for such giving, making or filing was wholly or mainly attributable to a failure or undue delay in the postal services in the United Kingdom, the registrar may, if she thinks fit, extend the period so that it ends on the day of the receipt by the addressee of the notice, application or other document (or if the day of such receipt is an excluded day, on the first following day which is not an excluded day), upon such notice to the parties and upon such terms as she may direct.”

There is no evidence before me that there was any failure or any undue delay in the postal services. Even if I accept the applicant’s argument that, despite the franking date of 15 April 2002, the letter was actually posted on 12 April 2002 there is no evidence before me to explain the three day difference. I am therefore unable to accept that there had been an undue delay in the postal system and whilst I do not understand the Post Office to guarantee next working day delivery for mail sent by first class post, the evidence before me shows the envelope containing the documents to have been sent 15 April 2002 and received by the Registrar 16 April 2002.

In the event the applicant’s Form TM8 and counter-statement was received outside the period allowed. I therefore go on to consider the consequences of this late filing. The relevant rule is rule 13(6) which states:

“Rule 13.-(6) - Where a notice and Counterstatement are not filed by the applicant within the period prescribed by paragraph 2(2), he shall be deemed to have withdrawn his application for registration.”

The Registrar has no discretion in the matter. As the Form TM8 and counter-statement was not filed within the time period allowed the Register must deem the application to be withdrawn.

The application will be deemed withdrawn in accordance with rule 13(6) of the Trade Marks Rules 2000, the Form TM8 and counter-statement not having been filed within the period allowed for doing so.

5 **Dated this 1st day of November 2002.**

A J Rees

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**Acting for the Registrar
The Comptroller General**