

O/0456/24

TRADE MARKS ACT 1994

IN THE MATTER OF A CASE MANAGEMENT CONFERENCE
HELD IN RELATION TO
APPLICATION NO. UK00003668612
BY
LINDSAY HOOPES

TO REGISTER THE FOLLOWING MARK:

NAPÑAC

IN CLASS 33

AND THE OPPOSITION THERETO
UNDER NO. OP000428632
BY
BUREAU NATIONAL
INTERPROFESSIONNEL DU COGNAC

BACKGROUND

1. On 12 January 2024, a decision was issued to both parties in respect of case number OP000428632 (“the Cognac case”) with a reference number of BL O/0020/24.

2. The overall conclusion of the decision was as follows:

“107. The opposition is successful under Section 3(4A) of the Act. The applicant’s mark will be refused.”

3. The decision of 12 January 2024 was accompanied by a covering letter, an extract from which I copy below:

“A decision in the above matter is enclosed. Under the provisions of the Trade Marks Act 1994, you may appeal against this decision to either the “Appointed Person” or to “the court”. The Trade Marks Act defines the Appointed Person as a person appointed by the Lord Chancellor to hear and decide appeals. Section 75 of the Act defines “the court” in England and Wales and Northern Ireland, as the High Court and in Scotland, as the Court of Session.

An Appeal to the Appointed Person will need to be made on a form TM55P, which incorporates the Statement of Grounds, and must be accompanied by the fee of £250.

Any appeal to the Appointed Person or to the High Court in England and Wales must be filed on or before **Friday the 9th of February 2024**. To extend this period for appeals to the Appointed Person, detailed and compelling reasons must be submitted to the Registrar, on a TM9 with a fee of £100.”

...

If no appeal is lodged within the prescribed time periods or if the Trade Marks Registry is not informed of such, then the decision will be implemented.”

4. On 9 February 2024, the day of the deadline for filing an appeal, Lindsay Hoopes (“the applicant”) filed a Form TM9 requesting an extension of time. Her stated reasons for doing so were set out in response to Question 7 as follows:

“The decision of the Hearing Officer in OP000428632 made it very clear that oppositions OP000428632 and OP000428633 [“the Napa Valley case”] are, albeit not consolidated, very closely connected (see para. 3 in decision 0/0020/24). The Hearing Officer has not yet issued a decision in the parallel proceedings OP000428633 irrespective of the fact that the issues in both oppositions are closely related.

The Applicant is not in a position to fully consider an appeal in OP000428632 before a decision in OP000428633 has been handed down. It would be fair and equitable to extend the deadline to appeal the decision in OP000428632 until a decision in OP000428633 has been issued. The Applicant would be unreasonably disadvantaged to either accept the decision in OP000428632 or to file a notice of appeal before being put in a position to take the outstanding decision in OP000428633 into consideration.

We therefore respectfully request an extension of the deadline to appeal decision 0/0020/24 in OP000428632. We ask that the extension is granted until 2 weeks from the date of notification of the decision in OP000428633 to the Applicant.”

5. On 14 February 2024, the Appointed Person Secretariat responded to the request for an extension of time as follows:

“The Form TM9 filed on **09 February 2024** by the Applicant, requested a **projected 2 week extension of time to file an Appeal, effective from the date of notification of the decision on a related case, which is yet to be issued.**

The Registry’s preliminary view is that the extension of time request be refused.

In making this view, the Registry has taken into consideration the reasons provided in support of the request, whilst also noting the direction given in Tribunal Practice Notice (2/2011) in respect of extension of time requests.

If either party disagrees with the preliminary view, they should request a hearing within 14 days from the date of this letter; that is, on or before **Wednesday 28 February 2024.**”

6. On 19 February 2024, Bureau National Interprofessionnel du Cognac (“the opponent”) wrote in to say that it agreed with the Registry’s preliminary view and that it would not be requesting a hearing.
7. On 28 February 2024, the applicant wrote in requesting a hearing.

THE CASE MANAGEMENT CONFERENCE

8. The Case Management Conference (“the CMC”) took place before me, as an audio call via Microsoft Teams, on 18 March 2024.
9. The applicant was represented by Florian Traub of Pinsent Masons LLP who did not file skeleton arguments.

10. The opponent was represented by Denise McFarland of Counsel, instructed by Michael Anderson of Lee Bolton Monier-Williams LLP, who filed comprehensive skeleton arguments.

WHAT WAS DISCUSSED

11. Mr Traub:

- said that while the two cases under discussion featured different opponents, they shared the same legal team and both oppositions claimed that NAPAÑAC evoked both the protected geographic indication Cognac and the protected designation of origin for Napa Valley. The arguments remained consistent leading to overlapping issues in both proceedings.
- accepted that a decision as to whether to consolidate the two cases had already been taken and said that he was not going to dwell too much on that point.
- noted that a preliminary view to refuse the request for an extension of time had been issued, citing Tribunal Practice Notice (TPN) 2 of 2011, albeit more specific reasons for the refusal were not provided. This caused the applicant to request a hearing.
- summarised TPN 2 of 2011 to the effect that disputes are to be dealt with in an efficient, fair and cost-effective manner and that extensions of time should be granted only in exceptional circumstances.
- argued that it would be fair and equitable to extend the deadline for filing the appeal due to the two cases under discussion being closely related. The applicant could only fully consider filing an appeal and formulating the grounds of appeal in the Cognac case once she had had full sight of the parallel Napa Valley case. Although the cases were not consolidated, the oppositions rested on the same grounds

and so the applicant was faced with a dilemma as to whether to accept the decision in the Cognac case (not being able to have sight of potentially beneficial points coming to light in the Napa Valley decision) or be “forced” to file an appeal to protect her rights. It would be fair and reasonable to allow the applicant to consider her position once both decisions in the related oppositions had been handed down.

- argued that an extension would be more efficient than requiring the applicant to apply to amend the grounds of appeal at a later date. It would also be proportionate given the complexity of the linked cases.
- did not consider that the opponent would be disadvantaged by the applicant being granted an extension.
- concluded by accepting that extensions should only be given in exceptional circumstances but argued that the unusual situation of awaiting a decision in a closely related case was an exceptional circumstance. Therefore, the granting of an extension would be reasonable and proportionate.

12. The points made by Ms McFarland were as follows:

- A decision on whether to consolidate the two cases under discussion had been made and the consolidation decision was not challenged by either party at the time. Therefore, neither party could now ask for the two cases be treated as if they had been consolidated.
- The facts of the two cases were different.
- No draft grounds of appeal had been submitted by the applicant.
- No details as to the linkage between the two cases had been submitted.

- Existing guidance and case law said that the burden is on the applicant to demonstrate that she is facing exceptional circumstances. The applicant then needs to show that the reasons for her request were detailed and compelling. The applicant's reasons were not sufficiently detailed.
- Even if the reasons were considered to be sufficiently detailed, simply wanting to see what the Napa Valley decision said could never amount to a compelling reason.
- There is an expectation and requirement that appeals will be dealt with promptly. The *Westar* case by reference to the *Whiteline* case said that appeals should be dealt with timeously. Were the extension of time to be granted, it would be contrary to the case law.
- Given that the facts of the two cases were different and featured different opponents that had no commercial relationship, the claim that the cases were linked was hypothetical.
- With regard to the argument that the applicant may later be faced with the prospect of seeking to amend its grounds of appeal, there was nothing unusual about this and it was always open to an applicant to do this.
- The argument that allowing the extension would be proportionate to the complexity of the circumstances was not made out in the absence of draft grounds of appeal.
- The opponent would suffer the prejudice of having an entirely open-ended extension of time being granted, albeit bounded by the point at which a decision in the other case was handed down.
- It would also be contrary to public policy to allow an extension on this basis because it would have the effect of allowing any appellant

awaiting what it considered to be a relevant third-party decision to seek such an extension.

- The preliminary view that the request for an extension of time to file an appeal should be rejected must be upheld.

13. By way of reply, Mr Traub said:

- It would not be contrary to public policy to grant an extension because the applicant's request merited being granted due to the exceptional circumstances that applied and so the extension would be consistent with the guidance set out in TPN 2 of 2011.
- It was the opponent that originally applied to consolidate the proceedings.
- While the cases were not consolidated, the other case was not simply an unconnected third-party case and so existing policy would not be at risk. This was borne out by the Hearing Officer's comments at paragraph 5 in the Cognac case where she accepted that both cases are based primarily on the same arguments and that there is a degree of overlap in the pleadings and the submissions.
- The lack of draft grounds of appeal being submitted was because the applicant's position was that she needed to have sight of the decision in the Napa Valley case in order to formulate the grounds of appeal in the Cognac case. It would put the applicant in a disadvantageous position to be required to file draft grounds without having sight of the other case. The Cognac case and the Napa Valley case were absolutely linked and required treatment together.
- There was no prejudice to the opponent in being asked to wait a little bit longer. The extension of time was indefinite, but it was outside the control of either party as to when the Tribunal handed down the second decision and this should not go against the applicant.

- It would be entirely justifiable and reasonable to grant the extension to allow the applicant to make an informed decision without incurring any expenses that would arise were she forced to file an appeal at this point.

14. Ms McFarland asked for, and was granted, permission to comment on one particular point which she considered to be new information put forward by the applicant – Mr Traub’s comments in respect of paragraph 5 of the Cognac decision.

15. Ms McFarland took me to paragraph 8 of her skeleton arguments where paragraph 4 of the Cognac decision is quoted because she argued that it sets the context for the decision. Ms McFarland said that at paragraph 4, the Hearing Officer said that the two cases were individual, separate matters, and no joint opposition had been brought. Ms McFarland argued that the Cognac decision stood on its own and nothing else was relevant to formulating the grounds for any appeal.

DECISION

Statutory provisions and guidance

16. Rule 62 of the Trade Mark Rules 2008 provides the Registrar with their general powers in relation to the management of proceedings. In particular that:

“(1) Except where the Act or these Rules otherwise provide, the registrar may give such directions as to the management of any proceedings as the registrar thinks fit, and in particular may—

(a) require a document, information or evidence to be filed within such period as the registrar may specify.”

17. In addition, Rule 77 provides:

“(1) Subject to paragraphs (4) and (5), the registrar may, at the request of the person or party concerned or at the registrar’s own initiative extend a time or period prescribed by these Rules or a time or period specified by the registrar for doing any act and any extension under this paragraph shall be made subject to such conditions as the registrar may direct.

(2) A request for extension under this rule may be made before or after the time or period in question has expired and shall be made—

(a) where the application for registration has not been published and the request for an extension is made before the time or period in question has expired, in writing; and

(b) in any other case, on Form TM9.”

18.I also note what is set out in the Manual of trade marks practice:

7.3.1 Extension of the period for filing an appeal to the Appointed Person

The period for filing an appeal may be extended, by the filing of a TM9 which must be accompanied by a fee. However, parties should note that strong and compelling reasons are required to support such a request (*Whiteline Windows Ltd v Brugmann Frisoplast GmbH* O/299/00).

Each request for an extension of time will be considered on its own merits.”

Analysis

19. I note and do not dissent from the opponent's observations at paragraph 19 of its skeleton arguments. The paragraph includes a reasonable summary of the relevant case law (albeit the opponent has added its own emphases):

"19. In reaching the Preliminary Decision (now challenged by the App) we observe that:

- (a) The IPO are acting in accordance with the guidelines and practical considerations set out in the rules and regulations prevailing in the IPO and also current case law. Hereunder we note that under the Practice Direction there is a clear statement that in deciding whether to grant an extension of time for filing an appeal to the appointed person, the registrar will consider the comments of the appointed person in ***Whiteline Windows Limited v Brugmann Frisoplast GmbH (BL 0/299/00)***:

*"Whilst I accept that the registry has power under ... the current Trademarks Rules 2000, Rule 68, to extend the time of 28 days provided for an appeal, this is a matter which must be approached with the greatest caution so as to ensure that the exercise of discretion does not undermine the purpose underlying the statutory provision. Appeals create uncertainty and it is in the interest of everyone that appeals are disposed of timeously. Extensions of time in which to enter notices of appeal are therefore not to be encouraged. [...] I should not like it to be **thought that extensions of time for serving appeal documents will be granted lightly.**" [Emphasis added]*

- (b) The IPO are following prevailing case law guidance and hereunder (by way of example) we refer to the ***Westar Decision***

of Mr Allan James in Case No: **0/608/19** (a copy of which Authority will be served with this Skeleton for ease of reference).

- (c) We particularly refer to and rely on the following paragraphs of Mr James' said decision in Westar; [5] which noted that a Form TM 55P and Grounds of Appeal were also served in support of the extension of time (which in our submission is the most normal course of events, though not followed here by this App), [10] which cited from the decision of Mr Simon Thorley QC as he then was, in *Muslim Parliament of Great Britain*, in which he said (sitting as an Appointed Person) that any application for an extension of time must be seen as **"seeking an indulgence from the tribunal"** since an otherwise "comprehensive code" is laid down. He also cited in support the public policy considerations and the "overriding objective", and [12] which cited from *White Line Windows* and emphasises that extensions of time in which to file **an appeal** make it "particularly important" that good reasons are provided. "*Appeals create uncertainty and it is in the interests of everyone that appeals are disposed of timeously. Extensions of time in which to enter notice of appeal are therefore not to be encouraged.*" [Emphasis added]"

20. Furthermore, this is an unusual case, in that the applicant asked for an extension of time that was contingent upon the issuing of a decision in a separate case. As such, the request for an extension was not for a fixed period and it introduced a greater degree of uncertainty than would be the case for a standard extension of time request.

21. Over and above the negative policy implications of allowing a party an extension of time pending the outcome of a separate decision, I am also mindful of *Siddiqui's Application*,¹ whereby the Appointed Person said that it

¹ BL O-481-00

was incumbent on the party requesting the extension to put forward facts which merited the extension. The Appointed Person said:

“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.”

22. I note that no fallback TM55P and statement of grounds of appeal were submitted at the CMC, nor was there any indication given that such documents could be swiftly prepared and filed were the applicant's request as framed to be rejected. Indeed, the applicant maintained her position that she could not formulate the grounds for appeal in this case without having had sight of the Napa Valley decision.
23. While I would not go so far as to say that the applicant was attempting to abuse the system, she did seem to be seeking to lodge an appeal in circumstances that she considered would be the most advantageous from her own point of view.
24. The reasons for seeking an extension of time should be strong and compelling. The applicant argued that she faced a dilemma as to whether to decide to file an appeal in the Cognac case without the benefit of potentially helpful arguments coming to light in the Napa Valley decision. She was being “forced” into a choice of not filing an appeal or having to file one to protect her rights.

25. I am not persuaded by the above argument. The applicant faced a dilemma that confronts many prospective appellants who are aware of cases that are in train and which could shed light on their own cases. These prospective appellants are not afforded the luxury of waiting for such cases to come to fruition.

26. A decision regarding the request for consolidation of the two cases under discussion had already been made and consequently any appeal in the case before me had to be made on a standalone basis.

27. While I note that a decision in the Napa Valley case (OP000428633) has now been handed down, that does alter the fact that there was nothing to prevent the applicant from filing a timely appeal in the case before me. I therefore reject the applicant's request for an extension of time.

CONCLUSION

28. I have rejected the applicant's request for an extension of time. Consequently, no appeal has been lodged within the prescribed time period and the decision in case BL O/0020/24 will be implemented.

COSTS

29. The costs award set out in case BL O/0020/24 stands.

30. I must now consider whether any costs should be awarded as a result of this hearing needing to be convened. The opponent seeks on scale costs in this respect.

31. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice 2 of 2016.

32. I award costs as follows:

Preparing for and attending the CMC: £500

Total: £500

33. I order Lindsay Hoopes to pay Bureau National Interprofessionnel du Cognac £500. This sum should be paid within twenty-one days of the expiry of the appeal period for this extension of time request decision or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 20th day of May 2024

John Williams

For the Registrar