

TRADE MARKS ACT 1994

**IN THE MATTER OF OPPOSITION NO. 46677
BY POMACO LIMITED
TO AN APPLICATION FOR REGISTRATION
BY REED INTERNATIONAL BOOKS LIMITED**

AND

**THE APPLICANTS REQUEST FOR THE SUSPENSION OF
PROCEEDINGS
PENDING THE OUTCOME OF ASSOCIATED REVOCATION/ INVALIDITY
PROCEEDINGS**

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20 On 5 March 1998, Summerville and Rushton, on behalf of Reed International Books Limited, the applicant for registration, filed a Form TM9, requesting that these opposition proceedings be suspended pending resolution of a newly filed application for invalidation and/or revocation of registration, No. 1372819, standing in the name of the opponents, Pomaco Limited or, alternatively, seeking an extension of time to file evidence in these proceedings.

25 Mr M A Hill, Managing Director of Pomaco Limited, trading as Sittingbourne Print, the opponents, in a letter dated 6 March 1998, objected to the request and the matter came to be heard before me on 28 May 1998.

30 Mr Michael Edenborough, of Counsel, represented Reed International Books Limited and Mr M A Hill, represented Pomaco Limited. After considering the submissions by both parties I refused to suspend the opposition proceedings pending the outcome of the related revocation/invalidation proceedings, but I allowed the applicant for registration an extension of time up until 28 May 1998 - the date of the Hearing - in which to file their evidence in support of the application for registration. I am now asked to set out the grounds of my decision.

BACKGROUND

40 The application for registration by Reed International Books Limited in respect of the trade mark MINERVA, in Class 16, was published in the Trade Marks Journal on 12 March 1997. Pomaco Limited filed Form TM7, Notice of Opposition on 11 April 1997 and Form TM8, Counterstatement, was filed by Summerville & Rushton on behalf of Reed International Books Limited on 22 July 1997. Subsequently, the opponents filed evidence in support of the opposition. This consisted of two Statutory Declarations by Mr M A Hill, together with exhibits. The applicants were informed by the Trade Marks Registry that any evidence they wished to provide in support of the application should be filed by 24 January 1998 in accordance with Rule 13(5) of the Trade Mark Rules 1994.

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5 On 15 January 1998, Summerville & Rushton on behalf of the applicants, filed a Form TM9 seeking an extension of time of three months in which to file their evidence under the provisions of Rule 62 of the Trade Marks Rules 1994 which state:

10 **62.-(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

15 (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, be extended by the registrar as he thinks fit and upon such terms as he may direct.

20 The reasons given were that the evidence to be presented by the applicant dates back ten years and they required further time to contact witnesses who had worked for Reed International Books Limited but had subsequently left. In accordance with the Trade Marks Registry's practice the opponents were asked for their views and on 22 January 1998 Mr M A Hill in a letter to the Trade Marks Registry objected strongly to the granting of an extension of time because the opponents considered that the application and its outcome, and any delay in determining matters, had important ramifications for his company's business, and its workforce. Having considered the request, and the written submissions by both parties, the Trade Marks Registry decided to grant an extension of time, but only until 6 March 1998.

30 On 9 March 1998, Summerville & Rushton, on behalf of Reed International Books Limited, filed a further Form TM9, requesting the suspension of these proceedings pending the outcome of revocation/invalidation proceedings Reed International Books Ltd had commenced before the before the Trade Marks Registry in respect of the registration of the trade mark Minerva, no. 1372819, covering goods in Class 16, and standing in the name of the opponents, Pomaco Ltd. As an alternative, an extension of time until 24 July 1998 was sought in which to file their evidence. Both of these requests were the subject of objections by Pomaco and Reed International Books Ltd sought the hearing.

40 At the Hearing, Mr Edenborough stated that the opposition to his client's application for registration by Pomaco Ltd was based upon the provisions of Section 5 of the Act through Pomaco Ltd's claim to an earlier right based upon registration No. 1372819. Reed International Books Ltd had now filed an application to revoke or invalidate that registration and it would be unjust and unfair, in his view, to proceed with the opposition until such time as the opponents' rights in the trade mark on which the opposition was based had been determined. Thus his clients sought the suspension of the opposition proceedings pending the outcome of the associated proceedings which might, in the event, determine the outcome of these proceedings. As an alternative, Mr Edenborough argued that his client should have an extension of time in which to file their evidence under the provisions of Rule 13(6) of the Trade Mark Rules 1994. This was because the application had proceeded to advertisement

5 under the provisions of Section 7, on the basis of honest concurrent use. In order that the
evidence filed at the ex parte stage could be supplemented there was a need to file evidence
derived from information provided by individuals who had been employed by the applicants
at the appropriate time. In addition, as a result of restructuring of the company on more than
10 one occasion, there was a need to refer back to archive material. In all of the circumstances
he considered that an extension of time was justified. In making these submissions, Mr
Edenborough stated that his clients were ready to file their evidence that day.

Mr Hill on behalf of Pomaco Ltd submitted that neither the suspension of proceedings or the
extension of time should be granted. He considered that the applicants had not complied with
15 requests by the Trade Marks Registry to provide comments or seek a Hearing within the
fourteen days set out in the Registry's letter informing them that the request for suspension or
an extension of time had been refused. The application for registration was being pursued in
the full knowledge of his company's existing registration and the applicant, a large company,
was now using the threat of revocation/invalidation proceedings against his company in order
20 to intimidate them. Mr Hill went on to submit that his company's position was being
endangered because a third party was now using the trade mark MINERVA in respect of the
same or similar goods for which his company's trade mark was registered, but Kent County
Council Trading Standards Officers were reluctant to take action against the counterfeiter
because of the proceedings before the Registrar. Thus it would be unfair and unjust for the
25 proceedings to be suspended or for the applicant to be given even more time to file evidence
than the prescribed and extended period already allowed and thus prolonging the proceedings
even further.

30 DECISION

In relation to the request for suspension of the opposition proceedings I took note of Mr
Edenborough's submission that the outcome of the revocation/invalidation proceedings in
relation to registration No. 1372819 might be material insofar as the opposition proceedings
were concerned. Because, of course, if the opponents' registration was declared invalid or
35 revoked then they would have no earlier right on which to base the opposition. However, I
note that Section 46(6) of the Act states:

40 **46.-(6)** Where the registration of a trade mark is revoked to any extent, the rights of
the proprietor shall be deemed to have ceased to that extent as from-

- 45 (a) the date of the application for revocation, or
- (b) if the registrar or court is satisfied that the grounds for revocation
existed at an earlier date, that date.

Therefore, the application for revocation if successful, could result in the rights of Pomaco
Ltd being deemed to have ceased with effect from the date of the application for revocation
which in this case the date post dates the material date in the opposition proceedings (ie. the
date of application for registration). Thus, the application to revoke would not necessarily
50 determine the matter. If the application for invalidity is successful then, under the provisions

5 of Section 47(6) of the Act, the registration shall be deemed never to have been made. In all
of the circumstances I do not consider that the application to revoke/declare invalid Pomaco's
registration would, with any certainty at this stage, determine the outcome of this opposition.
In my view, therefore, it was not in the interests of either party to suspend these proceedings.
The applicants' request for suspension of proceedings was therefore refused.

10 Insofar as the request for an extension of time was concerned I first of all stated that it was
not fatal to any request for an extension of time (or indeed in relation to any other procedural
matter) for a party not to respond to the Trade Marks Registry within fourteen days of a letter.
Rule 62 (5) of the Trade Marks Rules states:-

15 **62.-(5)** Where the request for extension is made after the time or period has expired,
the registrar may, at his discretion, extend the period or time if he is satisfied with the
explanation for the delay in requesting the extension and it appears to him to be just
20 and equitable to do so.

This allows the Trade Marks Registry to consider and accept requests for an extension of time
after the time or period has expired and the Registrar, at his discretion, may go on to refuse or
25 grant the request.

In this case I had a request, filed late, from the applicants for registration to extend the time to
file evidence. The late filing of the request lay in the hands of the applicants' Trade Mark
Agents, Sommerville & Rushton. It has never been the Trade Marks Registry's practice to
30 disadvantage a party to proceedings where their Agents have made an error in filing a form
which is not otherwise debarred from being considered e.g. by virtue of the fact that the time
for filing the form was unextendable. I saw no reason to do so in this case, I went on
therefore to consider the substantive request.

35 The evidence the applicants wished to file (on the date of the hearing) was the culmination of
efforts made during the proceeding months to extract information from archives and elicit
information from employees who had previously worked for the applicants. Thus there had
therefore been continuous efforts by the applicants and their Agents, since the opposition had
40 been filed, to defend the application. Having full regard to the decision of Mr Justice Jacob
in the S.A.W. case 1996 RPC 507, I considered in all of the circumstances that the request for
an extension of time was justified.

In reaching this decision I took note of the submissions by Mr Hill, in particular that his
company was being disadvantaged by delays to these proceedings because of his inability to
45 persuade the Trading Standards Authorities to take action against counterfeiters.
Nevertheless, it seemed to me that the Reed International Book Ltd had been taking action
diligently to compile evidence which was now available and therefore its admission to the
proceedings was both fair and reasonable. It was therefore admitted into the proceedings.
The remaining stages are now largely in the hands of the opponent. If they wish to file

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5 evidence in reply, they have three months from the date of the hearing and the admittance of Reed International Books Ltd's evidence to do so.

10 Insofar as the revocation/invalidation proceedings are concerned, Mr Edenborough stated that Reed International Books Limited, as the applicant for revocation/invalidation, would soon have their evidence available to support of the application. Thus it was likely that both the opposition proceedings and the revocation/invalidation proceedings could complete their evidence stages and could be ready to be heard (if a hearing was sought by either party) by the end of the year. I stated that the Trade Marks Registry would aim for the completion of both of these proceedings in that timescale and would expect the parties to do so also.

15 In this decision I have considered all the material available to me and all of the submissions made.

20 **Dated this 27th day of August 1998**

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M KNIGHT
For the Registrar
The Comptroller General

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