

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN INTERLOCUTORY HEARING IN RELATION  
TO A REQUEST BY BABCO INTERNATIONAL LIMITED (THE APPLICANTS)  
FOR AN EXTENSION OF TIME IN WHICH TO FILE EVIDENCE IN SUPPORT OF  
APPLICATION No 2188911 IN OPPOSITION PROCEEDINGS  
UNDER OPPOSITION No 49926**

## **TRADE MARKS ACT 1994**

### **IN THE MATTER OF An Interlocutory Hearing in relation to a request by Babco International Limited (the applicants) for an extension of time in which to file evidence in support of application No 2188911 in opposition proceedings under Opposition No 49926**

1. Following an Interlocutory Hearing held on 22 February 2001 I granted the applicants a final extension of time to 20 February 2001, to allow evidence which had been filed on that date into the proceedings. I am now asked by the opponents for my written grounds of decision.

#### **BACKGROUND**

2. Babco International Limited applied on 16 February 1999 to register the trade mark POIROT in Class 33 for a specification of "Alcoholic beverages (except beers)".

3. The application is numbered 2188911 and was published for opposition purposes on 31 March 1999. Notice of opposition was subsequently filed by Agatha Christie Ltd on 29 June 1999. The applicants filed a counterstatement on 21 September 1999 and the Registry set a due date of 24 December 1999 for the opponents to file evidence under Rule 13(4) of the Trade Mark Rules 1994 (as amended).

4. The opponents requested and were granted an extension of time to 24 March 2000 in which to file their evidence. Part of the evidence was filed on 26 January 2000 and was completed by filing further evidence on 23 March 2000. The applicants were set a due date of 23 June 2000 to file their evidence under Rule 13(6).

#### **The first extension of time request**

5. On 19 June 2000 the applicants filed a request for a further 3 months, that is to say to 23 September 2000. The reasons given were as follows:

"The evidence filed in support of the Opposition is under active consideration. Final instructions are awaited to prepare a response to the very same. The Registrar's forbearance in the matter is requested, bearing in mind that our instructing Agents are based in Holland, who in turn have to seek the Applicant's instructions, before any information is transmitted to us."

6. The Registry responded on 20 June 2000 refusing the extension of time as they had not confirmed the form had been copied to the other party.

7. The applicants' agents wrote on 27 June 2000 apologising for the oversight and confirming they had now copied the form to the opponents' agents. On 7 July 2000 the Registry wrote to the applicants' agents to say that the extension of time had been granted, subject to any comments from the other party. The letter also said that "no further extension of this period will be granted unless you can support the request with detailed and compelling reasons in writing". No comments were received from the opponents and the decision was confirmed.

### **The second extension of time request**

8. On 19 September 2000 the applicants filed a further request for an additional three months, that is to say to 23 December 2000, giving their reasons as follows:

"The evidence filed in support of the Opposition has now been considered and a draft Affidavit has been prepared in response to the same. A copy of the draft Affidavit is attached. Approval of the draft is currently awaited, before the same can be formalised for submission to the Registrar.

Once again the Registrar's forbearance on the matter is requested, bearing in mind that our instructing Agents are based in Holland, who in turn have to seek the Applicant's instructions, before any information is transmitted to us."

9. On 2 October 2000 the Registry again wrote to the applicants' agents to point out that there was no indication that the extension of time request had been copied to the other party and that the request, therefore, "cannot be considered at this stage". On 5 October 2000 the applicants' agents wrote to the Registrar to confirm that the Form TM9 (and enclosures) had been copied to the other party. On 18 October the Registry wrote to the applicants' agents saying the extension of time had been granted subject to any objections being filed and again saying that should any further request be received it should provide detailed and compelling reasons. No objections were received from the opponents.

### **The third extension of time request**

10. On 18 December 2000 the applicants filed a further extension of time request for a further three months, ie to 23 March 2001. The reasons given were:

"The evidence filed in support of the Opposition has been considered and a final draft Affidavit in response to the same has been prepared and approval of the same is currently awaited. On approval of the same we shall pursue formalisation as soon as possible.

Once again the Registrar's forbearance on this matter is requested, bearing in mind that our instructing Agents are based in Holland, who in turn have to seek the Applicant's instructions, before any information is transmitted to us."

11. On 21 December 2000 the Registry again responded by saying that the form had not been copied to the other party and that the request could not be considered. A due date of 28 December 2000 was given in which to comply.

12. The applicants' agents responded on 2 January 2001 by saying:

"First and foremost, we can confirm that we did in fact comply with Rule 68(2)(a) and (b) in that we did copy our extension request to the other side but for the avoidance of doubt, the said request has again been copied by way of a copy of this letter to the Opponent's Attorneys."

13. They also go on to say that the time set by the Registrar, given the holiday period and delays in the post meaning the Registrar's letter did not arrive until the day of the deadline, was "unsuitable" and an effective period of 24 hours to act was "inequitable". They also said that a copy of a draft Affidavit was copied to the Registrar (only) which was, they said, awaiting approval with their Associate Attorneys in the Netherlands and further said that it was quite detailed "to prove to the Registrar that the Applicant had not been sitting idly by but rather has put some considerable effort into drafting an appropriate Affidavit in reply ....."

14. The Registrar wrote to the opponents on 8 January 2001 refusing the extension of time request, advising that the draft Affidavit was not attached to their letter of 2 January 2001 and saying that the reasons given for the request are the same as those on the previous request and that no signs of progress were given.

15. On 3 January 2001 the opponents' agents wrote to say "It appears we did not receive a copy of the Applicant's Form TM9 of 15 December 2000 until today when we were copied the Applicant's letter to the Registry dated 2 January 2001. In the circumstances, we would like to request a Hearing in relation to the matter." (This was before the Registrar's letter of 8 January 2001, which refused the applicants' extension of time, was received by them.)

16. The applicants' agents then wrote on 19 January 2001 requesting an Interlocutory Hearing under Rule 54(1) in connection with the Registrar's preliminary view, to refuse their latest extension of time request.

17. The applicants' evidence was received on 20 February 2001.

18. That completes my review of the background. At an Interlocutory Hearing held on 22 February 2001, the applicants were represented by Mr G Johnston of William A Shepherd & Son, the opponents were not represented. However, Paisner & Co, who are the opponents' trade mark agents, provided written submissions, in their letter of 8 February 2001, in which they made the following points:

- proceedings have become unnecessarily protracted without valid justification
- given modern communications the fact that the applicants' instructing Agents are in Holland should not be a determining factor in the applicants' delay
- the applicants have now had over ten months to prepare its case

- the applicants have long been aware of the general nature of the opponents' complaint since the opposition follows similar proceedings in other countries and litigation in the USA
- the opponent has been cooperative to date regarding the applicants' extension of time requests, bearing in mind their non-compliance with Trade Mark Rule 68(2)(a) on three occasions
- the situation has now become unacceptable and the opponents' position prejudiced by the prolonged proceedings and increased costs incurred in addressing issues which have arisen purely due to procedural irregularities
- the Examiner's decision to refuse the extension of time should be upheld.

19. Mr Johnston argued at the Hearing and in his skeleton argument provided shortly beforehand that:

- the channels of communication have led to delay. They are taking instruction from MARKGRAAF BV, Attorneys in Benelux. They in turn take instructions from CENTRE SERVICES (C.I.) LIMITED, a Trust company set up in St Helier, Jersey who in turn take their instructions from the applicants
- the opponents took 9 months from filing their opposition to filing their evidence while the applicants have only taken a little longer (11 months)
- apart from the general difficulty of the lines of communication there were additional problems:
  - (a) opponents' evidence did not arrive with them until March 2000
  - (b) clearer copies of certain Exhibits were requested from the opponents' attorneys to assess the weight they should be given. These did not arrive until August 2000
  - (c) the complexity of dealing with similar issues in several jurisdictions and ensuring the appropriate evidence is filed in each case. (See comments from the opponents in their letter of 8 February 2001.)
  - (d) a change in the applicants' personnel requiring an amendment to the Affidavit
  - (e) a fax of an Affidavit was received on 8 January 2001 but was not properly completed and could not be submitted as evidence.

20. Mr Johnston then elaborated on the apparent omissions regarding the copying of correspondence. He said that while they had not indicated they had copied evidence to the opponents they had done so on all occasions except the first (15 June 2000) and he had

personally witnessed the Extension request of 15 December 2000 being sent. He commented that they had encountered occasional difficulties before with Royal Mail/Post Office services, in common with others, and was a failing in the system - although usually a rare one.

21. Mr Johnston also argued that the opponents are fully aware that the applicants will defend their mark as they are doing so in other jurisdictions. He pointed out that a draft Affidavit had been produced earlier and was a further indication of their intention to defend their mark and that if the evidence was rejected they would re-file and the process would have to start again.

## DECISION

22. The power vested in the Registrar to grant extensions to certain periods of time determined in the Trade Marks Rules is discretionary, the periods allowed for the filing of evidence are not excluded from this discretionary power. At the date the contested request was made the relevant parts of Rule 62 in the Trade Marks Rules 1994 (as amended) read:

"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  
(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.

(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, 18, 23, or 25, 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 13(2) (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), and rule 41 (time for filing opposition)."

23. The breadth of the discretion afforded the Registrar by this Rule was dealt with by the Appointed Person in the *Liquid Force Trade Mark* appeal, 1999 RPC 429, at pages 437 and 438, and allows that where any relevant circumstances are brought to her attention the Registrar can exercise this discretion. (This decision referred to the 1994 Rules which were not, then, amended but I consider his comments equally apply to the Rules as amended in 1998)

24. From the information and arguments submitted to me it seemed clear that this action is one of several taking place in various jurisdictions. While it can be argued that the issues should be known to each side it also seems to be the case that different actions, different timescales and different issues are likely to be involved in each case which will require careful handling by the respective parties. I noted that the opponents had taken 9 months from the filing of the TM7 to completion of their evidence and the applicants took 11 months to finalise their evidence in response. I consider the additional time needed by the applicants can be explained, at least in part, by the more difficult lines of communication and the need for Exhibits to be seen clearly, rather than eg faxed. Nevertheless, I bear in mind the comments made in the LIQUID FORCE case referred to earlier, at page 438, lines 32 through to 38:

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

25. I considered that from the submissions put before me an extension of time to allow the evidence filed prior to the hearing into the proceedings was, to use Mr Hobbs' words, "fair and reasonable". It was clear that the applicants intended to defend their mark and had filed a draft Affidavit with their extension of time request dated 19 September 2000. They have made numerous minor amendments and added to this in the final version filed prior to the hearing. Therefore, I am satisfied that the matter was under active consideration and being actively pursued by the applicants, notwithstanding the delays which have clearly occurred. I also considered that in order for the Registrar to reach a decision on the substantive issues, the Registrar should have this evidence before her when taking a decision.

26. I also bear in mind further comments made in the LIQUID FORCE decision, at page 439 lines 18 to 30:

"..... I consider that the natural reluctance of the registrar to refuse an extension of time for filing evidence which has belatedly come to hand cannot be elevated to the status of an invariable rule. In order to leave room for justice to be done I think it is necessary to recognise that a contested application for an extension of time to file evidence should not necessarily "follow the event" (ie succeed if the evidence is available at the hearing of the application and fail if it is not) and should not automatically succeed on the basis that refusal is liable to result in the commencement of another action between the same parties covering essentially the same subject matter. I nevertheless agree that these are important factors to be taken into account when deciding whether an extension of time should be granted or refused. In the present case the hearing officer took them into account without regarding them as determinative per se. I agree with that approach."

27. As in the above case I considered another action between the parties on the same issue was probable if the evidence was not admitted. With the evidence to hand the matter could now proceed to its final stage. However, I did not regard this as "determinative per se".

28. My decision, therefore, was to grant the applicants a final extension of time to 20 February 2001 (the date the evidence was filed) to admit the applicants' evidence into the proceedings.

29. In view of my decision in respect of the extension of time a period for the opponents to file evidence in accordance with Rule 13(10) of the Trade Marks Rules 2000 was set at 23 May 2001.

**Dated this 2<sup>nd</sup> day of May 2001**

**R A JONES  
For the Registrar  
the Comptroller-General**