

TRADE MARKS ACT 1994

IN THE MATTER OF A REQUEST
BY VFM CHILDREN'S ENTERTAINMENT LIMITED
FOR AN EXTENSION OF TIME
WITHIN WHICH TO FILE EVIDENCE
IN REPLY IN REVOCATION AND
INVALIDATION PROCEEDINGS (NO. 10921)

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At an interlocutory hearing on 7 December 2000 I gave a decision which was confirmed by letter the following day. Confirmation of the decision was given in the following words:

“After hearing the submissions I gave the following decision; that I would overturn the preliminary decision and refuse the request for the extension of time. This case is now ready to be decided and will be processed after the period for appeal has expired. If either party wishes to appeal this decision they have until 8 January 2001 to file a TM5 requesting a written statement of grounds of decision”

The applicant has requested a statement of the reasons for my decision, as provided by rule 62(2) of the Trade Marks Rules 2000.

Background

On 18 June 1999 VFM Children's Entertainment Limited (the applicant) filed a Form TM26 and Statement of Grounds making an application to revoke, on grounds other than non-use, and /or declare invalid trade mark registration No 1521388, standing in the name of Tabak Marketing Limited.

The registered proprietor filed their defence, by way of a Form TM8 and Counterstatement, on 21 July 1999. This was sent to applicant under cover of a letter dated 4 August 1999 and the period for him to file evidence in chief commenced.

On 2 November 1999 the applicant requested an extension of the period to file evidence of three months, which was provisionally granted. The registered proprietor subsequently requested to be heard in the matter and that hearing took place before the Registrar on 20 January 2000. The result of the hearing was that the extension of time was granted until 20 January 2000 and evidence was accepted into the proceedings on that date. The period for the registered proprietor to file evidence in support of his case was set.

On 6 April 2000 the registered proprietor requested an extension of time for filing evidence of two months. This was initially refused as the request contained no confirmation that it had been copied to the applicant as is required. Following confirmation received by letter dated 18 April 2000 that the request had been copied as required, the earlier refusal was overturned and the request was granted. On 19 June 2000 the registered proprietor's evidence was filed and the period for the applicant to file evidence strictly in reply commenced.

On 19 September 2000 the applicant requested an extension of time for filing evidence in

reply of three months stating:-

“We request an extension of time of three months ending 19th December 2000 to gather trade evidence. We anticipate that the extension for the term requested should be sufficient for such purposes and that no further extensions of time will be requested”.

The registered proprietors wrote to the registrar arguing that the reasons given were insufficient to allow the grant of the requested extension of time. They also argued that trade evidence should properly be filed as part of the evidence in chief rather than evidence in reply. After considering the request and supporting reasons, and the counterarguments of the registered proprietor, the request was provisionally refused by the registrar.

Following this refusal, the applicant sent a letter dated 9 November 2000, providing additional argument for the grant of the extension of time. In this letter they stated:-

“We apologise if our previous correspondence did not provide sufficient clarity with regard to the progress already made. However, we can confirm that at the time we already possessed magazine articles showing the generic use of the Mark complained of together with the results of generic word searched and a preliminary draft of the Evidence in Response.

Since requesting the extension of time we have had the opportunity to improve the evidence and are still in the process of obtaining further trade evidence which we believe will enable the registrar to make a conclusive decision in this matter.

Furthermore, we remind the registrar that an extension of time was granted to the other side as requested in their correspondence of the 20 April 2000. It would therefore appear appropriate of the applicants for Invalidation be treated in the same way and allowed to submit their evidence in response by 19 December 2000 as originally anticipated.

Again, we apologise if our previous correspondence was not sufficiently explicit in providing detail of information already obtained at that time and anticipate that the registrar will show an equal measure of patience to the Applicants for invalidity as she has already shown to the Registered Proprietors”.

Following receipt of this letter the request was reconsidered. The provisional decision to refuse the request was overturned and the extension was granted until 19 December 2000. The registered proprietor then filed a further letter objecting to the granting of the extension of time and sought to be heard.

The interlocutory hearing took place before me on 7 December 2000 with Mr Bernard of fJ Cleveland representing the registered proprietor and Mr Buehrlen of Sanderson & Co representing the applicant.

Submission

Mr Bernard took me through the early history of this dispute. This was broadly agreed between the parties although there was some disagreement about the involvement of trading standards officers. Nothing turns on this point as far as the consideration of the extension of time is concerned.

Mr Bernard said that the registered proprietor had always maintained that they would object to any request for additional time by the applicant. He cited the practice brought in with the Woolf reforms which encourage quicker processing of actions and early resolution of disputes. He confirmed that the registered proprietor had objected to an earlier extension request when the applicant was due to file evidence in chief. He referred to letters written at that time. He accepted that an extension had been granted to his client but argued that they had filed substantially more evidence than the applicant.

Mr Bernard addressed the applicant's written arguments for this requested extension of time and put forward the view that what was proposed to be filed, trade evidence, was not appropriate as evidence in reply. Such evidence should have been filed as part of the applicant's evidence in chief, he said. He argued that the applicant had no evidence ready to file and that the earlier decision to refuse the extension had been too casually overturned.

In reply, Mr Buehrlen argued that there should be equity between the parties as regards extensions of time. The registered proprietor had been granted a period for filing their evidence in support and therefore the applicant should be granted a period for filing their evidence in response.

He stated that he had an unsigned statutory declaration prepared, with sixteen exhibits. The witness was out of the country at that time and would not return for several days. He went on to argue that the applicant should have the right to file evidence in response, that the evidence he wished to file was in response to a substantial body of evidence filed by the registered proprietor and that the applicant had filed trade evidence as part of its evidence in chief. He argued that if the registered proprietor wanted an speedy resolution to these proceedings than they could agree to an early date for the main hearing.

Decision

Under the Trade Marks Act and associated rules each request for an extension of time is considered as a separate entity and on its own merits. There is no provision for an extension of time to be granted to one party to the proceedings just because one has previously been granted to the other party. I therefore considered the extension of time request before me on the basis of the information supplied.

I should say at this point that despite the arguments put forward I am unable to comment on whether the evidence the applicant may seek to file is evidence strictly in reply for the simple reason that I have not seen any evidence upon which I can properly make such a decision. I have been asked to consider a request for an extension of time to file evidence in reply. The onus is on the filer to ensure that if such a request were granted, any evidence filed would comply with the requirement that it be evidence "strictly in reply".

In the event I refused the request for an extension of time. I did so on the basis that despite the applicant already having had a period of three months for filing his evidence, no such evidence had been filed. The hearing did not take place until near the end of the requested period and yet, from the information I was given at that hearing, still no evidence had been finalised. Furthermore, I could not be sure when any evidence identified by the applicant might be ready to be filed.

Dated this 30th day of May 2001

G J Attfield
Hearing Officer
For the Registrar
The Comptroller General