

**0/608/19**

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATION 3232605 BY ACQUISITION 395215436 LIMITED**

**AND**

**OPPOSITION No. 409964 BY WESTAR INTERNATIONAL CORPORATION**

**AND**

**A REQUEST BY ACQUISITION 395215436 LIMITED**

**FOR A RETROSPECTIVE EXTENSION OF TIME TO APPEAL**

## Background and pleadings

1. On 5<sup>th</sup> August 2019 I issued a decision in consolidated proceedings between Westar International Corporation (“Westar”) and Acquisition 395215436 Limited (“Acquisition”) in which I decided that:

- (i) Acquisition’s application to invalidate Westar’s trade mark 3180687 succeeded in full, and
- (ii) Westar’s opposition to Acquisition’s application 3232605 also succeeded in full.

2. The letter to the parties covering my decision stated as follows:

*“Any appeal to the Appointed Person or to the High Court in England and Wales must be filed on or before **2 September 2019**. 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.”*

3. No appeal was filed by 2<sup>nd</sup> September.

4. On 11<sup>th</sup> September, a form TM9R was filed on behalf of Acquisition asking for a retrospective extension of time to file an appeal to the Appointed Person against the decision to refuse trade mark application 3232605. The reasons given were:

*“Due to the holiday season it was difficult obtaining instructions. Plus there were additional intervening events. A call was placed with the UKIPO on 04 September 2019 confirming intention to appeal and asking if a form TM9R would be required. The answer was yes, and in the circumstances, it ought to be acceptable.”*

5. The request was accompanied by a Form TM55P and grounds for appeal.

6. The request for a retrospective extension of time was provisionally refused because the reasons given were deemed insufficient.

7. The matter was listed for a case management conference ("CMC") scheduled for 20<sup>th</sup> September. The CMC took place via a teleconference facility. Acquisition was represented by Mr Philip Hannay of Cloch, Solicitors. Westar was represented by Ms Kate McCormick of Trade Mark Direct.

8. At the CMC Mr Hannay relied on the same matters mentioned in the form TM9R. Acquisition is in liquidation. Therefore, control of the company is vested in the liquidators. I understand these are two members of a firm of professional accountants. In these circumstances, I saw little merit in the explanation that the delay in filing the appeal, or in asking for an extension of time in which to do so, was due to the difficulty in obtaining instructions during the 4 weeks between 5<sup>th</sup> August and 2<sup>nd</sup> September. I find it particularly difficult to accept that no one with responsibility for the liquidation of the company could even provide an instruction to seek an extension of the appeal period.

9. I am fortified in this view by the fact that on 19<sup>th</sup> August Cloch solicitors filed written submissions on behalf of Acquisition asking for an exceptional award of costs following my decision of 5<sup>th</sup> August. This suggests that someone was taking decisions on behalf of Acquisition during the appeal period.

10. In *The Muslim Parliament of Great Britain*<sup>1</sup> Mr Simon Thorley QC, as the Appointed Person, rejected an appeal against the registrar's decision to refuse an extension of time to file evidence. He said:

*"It must always be borne in mind that any application for an extension of time is seeking an indulgence from the tribunal. The Act and the rules lay down a comprehensive code for the conduct of prosecution of applications and for the conduct of opposition. The code presumes a normal case and provides for it. There is a public interest which clearly underlies the rules that oppositions and applications should not be allowed unreasonably to drag on.*

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<sup>1</sup> Case BL O/481/00

*In all cases the registry must have regard to the overriding objective which is to ensure fairness to both parties. Thus, it can grant an extension when the facts of the case merit it. Accordingly, it must be incumbent on the application for the extension to show that the facts do merit it. 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.”*

11. In the case of an application for a retrospective extension of time to appeal, the first question is what the would-be appellant did during the period allowed for appeal. Therefore, the fact that Acquisition’s solicitor telephoned the IPO on 4<sup>th</sup> September (two days after the end of the period allowed for appeal) and signalled to someone in the IPO that it intended to appeal does nothing to explain the failure to act during the appeal period.

12. The need to provide good reasons for extensions of time is particularly important where the purpose of the extension is to file an appeal. The Trade Mark Rules provide a specific period within which to appeal. Mr Thorley (again, as the Appointed Person) made a similar point in *White-Line Windows v Brugmann Frisoplast GmbH*<sup>2</sup>. In that case the appellant had been given an extension of time to appeal. Mr Thorley noted that:

*“An extension of time was granted by Mr Parker acting on behalf of the Registrar so as to permit the late filing of this appeal. Whilst I accept that the Registry has power under the Trade Marks Rules 1994, rule 62 and under the current Trade Marks Rules 2000, rule 68, to extend the time of 28 days*

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<sup>2</sup> Case BL O/288/00

*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 interests of everyone that appeals are disposed of timeously. Extensions of time in which to enter notices of appeal are therefore not to be encouraged.”*

13. The registrar’s letter of 5<sup>th</sup> August (see paragraph 2 above) made it crystal clear that action was required by 2<sup>nd</sup> September to contest the registrar’s decision. However, not only was no appeal filed within the period allowed, nor was any request made for an extension of that period. In my view, Acquisition thereby displayed an overly casual attitude to the observance of this deadline. The period for appeal having come and gone, Westar was entitled to believe that the opposition proceedings were closed. In these circumstances, there would have to be compelling reasons to permit a retrospective extension of time for Acquisition to appeal. I do not find the reasons provided by Acquisition compelling. I find them weak.

14. At the CMC, Mr Hannay submitted that there was another reason to allow the extension and, therefore, admit the appeal; namely, that there were good grounds for appeal. However, as I explained at the CMC, the merits of the appeal can only be assessed by the appellate tribunal. The registrar cannot review his own decisions and factor the result of such a review into the exercise of his discretion to permit (or refuse) an extension of time to appeal. This would be the same whether the decision on the extension of time request is taken by the Hearing Officer who made the original decision, or by a different Hearing Officer.

15. For the reasons given above, the request for a retrospective extension of time to appeal is refused.

**09 October 2019**

**Allan James  
For the Registrar**