

TRADE MARKS ACT 1994

**In the matter of an Interlocutory Hearing
in relation to a request by World Challenge
Expeditions Ltd (the Applicants) for an extension
of time within which to file evidence in support of
Application N° 2149765 in Opposition Proceedings
(Opposition N° 48772)**

TRADE MARKS ACT 1994

IN THE MATTER OF an Interlocutory Hearing in relation to a request by World Challenge Expeditions Ltd (the Applicants) for an extension of time within which to file evidence in support of Application N° 2149765 in Opposition Proceedings (Opposition N° 48772)

Following an Interlocutory Hearing on 13 August 1999, I:

- a) granted the applicants a final extension of time to the date of the hearing, i.e. 13 August 1999 to allow 2 statutory declarations brought to the hearing into the proceedings

I am now asked, by the applicants, for my written grounds of decision.

Background

The background facts are as follows:

World Challenge Expeditions Ltd have applied, under application No. 2149765 to register the mark:



in Classes 39 and 41 for the following specifications:

- | | |
|-----------|--|
| Class 39: | The travel arrangements and transportation of people within the UK and overseas. |
| Class 41: | Development training through the organisation of and participation in expeditions and other adventurous activities |

The application was advertised, with the above specifications, for opposition purposes on 8

April 1998, in Trade Marks Journal 6220. On 7 July 1998, Gap Activity Projects (GAP) Limited, filed opposition in accordance with Section 38(2) of the Trade Marks Act 1994. The applicants filed a Form TM8 and counter-statement on 12 October 1998 together with a Form TM33 appointing Fry, Heath & Spence as the agent and address for service for the applicants.

On 13 October 1998, the Registrar sent to the opponents a copy of the Form TM8 and counter-statement and invited the opponents to file evidence in support of their opposition within three months of the date of the letter i.e. by 13 January 1999. On 13 January 1999, the opponents requested an extension of time of three months, i.e. to 13 April 1999, to file evidence in support of their opposition. The reasons given were:

“Draft declarations have been prepared and sent to the Declarants. These are being finalised. Further, certain enquiries are ongoing. The requested time is required in order to enable enquiries to be finalised and Declarations to be amended, sworn and filed. It is expected that these matters will be completed within the time now requested. Your indulgence would be appreciated.”

The Registrar subsequently granted the extension of time sought. Evidence filed in support of the opposition was received by the Registrar on 29 January 1999 and 3 February 1999. By way of a letter dated 24 February 1999, the Registrar informed the opponents that there appeared to be an error in the declaration of Brigadier J R Cornwall with regard to a reference to an exhibit. The opponents subsequently filed an amended declaration on 19 March 1999.

On 31 March 1999, the Registrar advised the applicants of the receipt of the evidence filed on behalf of the opponents and invited the applicants to file evidence in support of their application within three months of the date on which a copy of the opponents' evidence was sent to them, i.e. 19 June 1999. On the 21 June 1999, the 19th being a Saturday, the applicants filed the following evidence in support of their application:

- i) Statutory Declaration of Charles Rigby with Exhibits CR1 - CR10
- ii) Statutory Declaration of Dr J H Marshall with Exhibit JHM1
- iii) Statutory Declaration of R D N Carstairs with Exhibit RC1
- iv) Statutory Declaration of M Fawcett

together with a Form TM9 requesting an extension of time of a further 2 months i.e. to 19 August 1999, for submitting further evidence in support of their application. The reasons given were as follows:

“Further evidence has been found relating to the use of the term “gap” as a descriptive term, but additional time is required to settle the relevant Statutory Declaration or Declarations.”

By way of a letter dated 23 June 1999, the Registrar advised the opponents of the receipt of the evidence filed on behalf of the applicants. The aforementioned letter also outlined the Registrar's preliminary decision to grant the extension of time to 19 August and in line with Registry Practice set a period of 14 days from the date of the letter for either party to provide full written arguments or to request a hearing against the grant of the extension of time.

Under cover of a letter dated 6 July 1999 from their Trade Mark Attorneys, Boulton Wade Tennant, the opponents requested a hearing in this matter as follows:

“The reasons given by the applicant for the requested extension of time do not explain why the materials could not be prepared within the time requested and why a period of two months is required simply to have Declarations sworn. The applicants was put on notice of the opponent’s objection to the opposed application well before the opposition was filed. The applicant has known of the opponent’s objection to the opposed application since at least February 1998. The applicant has had more than adequate time to prepare its evidence. Further, the applicant has been put on notice on several occasions that the opponent would not agree to any extension of time.”

That completes my review of the background. At the Interlocutory Hearing held on 13 August 1999, Mr P R Muir of Fry, Heath & Spence, accompanied by Ms L Barlow of Morgan Cole represented the applicants for registration and Mr D J Rickard of Boulton Wade Tennant represented the opponents.

Applicants’ Submissions

At the outset of the hearing, Mr Muir advised me that he had brought to the hearing two sworn statutory declarations which could be filed that day and he went on to say that there were another four statutory declarations that the applicants were hoping to be able to file by the extended deadline of 19 August 1999, though additional time past this period may have been required. The sworn statutory declarations Mr Muir had brought to the hearing were:

- i) Statutory Declaration of Ian David Stafford Beer with 1 exhibit
- ii) Statutory Declaration of David Jordan

Mr Muir opened his submissions by commenting on the fact that the applicants had filed evidence, the declarations of Messrs Rigby, Marshall, Carstairs and Fawcett, within the three month period set by Rule 13(6), whereas the opponents had not filed any evidence within the three month period set by Rule 13(4) but instead had filed what Mr Muir described as “substantial evidence” following an extension of time of three months granted by the Registrar.

As stated above, Mr Muir argued that the applicants had lodged some evidence within the period prescribed by Rule 13(6), but had sought an extension of two months in order to file further evidence. Mr Muir explained that the declarations were difficult to produce as initially research was carried out into the use of the term and further research was carried out in relation to the Gap Committee. Mr Muir further informed me that people were subsequently identified who could provide evidence to support the applicants’ case, but that there had been difficulty in tracing the potential declarants as many were now retired. Another factor which Mr Muir said had to be taken into account was the fact that these investigations and approaches to potential declarants took place over the holiday period.

In relation to the opponents’ objections to the applicants’ extension of time request outlined in a letter dated 6 July 1999, from their representatives Boulton Wade Tennant, Mr Muir stated that the applicants had been diligent in the collation of evidence. Mr Muir stated that this was proved by the evidence filed on 21 June 1999 on behalf of the applicants.

In reply to the opponents’ comments that:

“The applicant has known of the opponent’s objection to the opposed application since at least February 1998. The applicant has had more than adequate time to prepare its evidence”

Mr Muir argued that the applicants were under no obligation to prepare and collate evidence until the period for the filing of evidence was set.

In relation to the adequacy of the period sought, Mr Muir paraphrased the following passage from *SAW* [1996] RPC 508 at line 37:

“After consultation with the professional bodies it was thought six months was adequate in most instances. Nevertheless it was recognised that even this period would be insufficient on occasions.”

Mr Muir acknowledged that the applicants had been put on notice by the opponents that the opponent would not agree to any extension of time sought.

Mr Muir made reference to a second passage from *SAW* [1996] RPC 509 line 19 onwards:

“The Registrar said in his decision:

“As I indicated at the hearing the Registrar is always reluctant to refuse an extension of time in a case where evidence has been filed [I should say that eventually some was produced months later] but in this case I am of the opinion that I had little option but to do so because of the lack of action on the part of the opponents during the relevant period of six months for filing evidence. If this had been satisfactorily explained then I would have accepted that the period of four months for preparation of the evidence by the new agents was not unusual or unacceptable. However, in exercising discretion in cases such as these, it is relevant as to what the party did during the period allowed for the filing of evidence, not what they did subsequently”

That is an impeccable statement of the position.”

Mr Muir submitted that it was in the interests of natural justice for the Registrar’s Hearing Officer to be able to consider all the evidence at the Main Hearing of these proceedings.

Mr Muir closed his submission by asking for costs on an indemnity basis.

Opponents’ submissions

Mr Rickard of Boulton Wade Tennant gave submissions on behalf of the opponents to support their objection to the extension of time and in reply to the applicants’ submissions.

He argued that this was a straightforward case. He stated that the opponents objection to the use of the trade mark went further back than the commencement of the instant proceedings, back to September 1997.

He submitted that the position was made clear to the applicants, that the opponents would object to any extension of time request. He argued that the applicants were aware of this and that they had therefore requested the extension at their own risk and as such should pay the penalty.

It was further submitted on behalf of the opponents, that there had been considerable instances of confusion in the marketplace and the opponents were anxious to bring these proceedings to a conclusion. He stated that further delays were unacceptable.

Regarding Mr Muir’s submissions in respect of the Gap Committee, Mr Rickard said that Mr

Muir had made no comments as to when the applicants first made contact with the Gap Committee.

Mr Rickard stated that the applicants request for an extension of time filed on 21 June 1999 gave a reason for the extension as “additional time is required to *settle* [my emphasis] the relevant statutory declaration or declarations”. Mr Rickard argued that in legal parlance “settle” meant that the declarations were final and as such were awaiting to be sworn. He reiterated the point raised in his letter dated 6 July 1999 as to why two months was required simply to have declarations sworn.

I brought to Mr Rickard’s attention the extension of time request dated 13 January 1999, filed by himself on behalf of the opponents to file Rule 13(4) evidence. The opponents were seeking an extension of time of three months as draft declarations had been prepared and sent to the declarants, and the requested time was required for the declarations to be amended, sworn and filed. Mr Rickard responded by saying that this was one of the reasons used in that extension of time request, but that as also detailed in the request, certain other enquiries were ongoing.

He argued that the applicants in their submissions had given no explanation why the evidence could not have been filed within the three month period set down by Rule 13(6).

Applicant’s Submissions in Reply

Mr Muir in reply to Mr Rickard’s submissions made the point that the applicants could not prepare evidence in support of their case before the opposition was filed as they were unaware at that stage what the opponents’ grounds of opposition would be.

He re-iterated the point that detailed and lengthy investigations were carried out into the Gap Committee. He further re-iterated that these investigations, carried out over the holiday period, led to the identification of potential declarants, many of whom were retired which caused problems in obtaining the evidence.

Regarding Mr Rickard’s submissions in respect of the word “settle” in the applicants’ extension of time request, Mr Muir argued the contrary to Mr Rickard, in that the term did not mean that the declarations were in final form, but instead that it meant preparatory work had been undertaken in regard to content of declarations but the declarations were still to be prepared and finalised.

At the close of his submissions, I asked Mr Muir if he had anything further to add, to which he replied no. He went on to ask if he could ask his instructing principal whether there were any additional points she would like him to put forward. I consented to this request and following consultation with Ms Barlow, Mr Muir advised me that he had nothing further to add to his submissions.

Decision

At the time of the Interlocutory Hearing, the Registrar's power for extending time periods was provided for in Rule 62 of the Trade Mark Rules 1994 (as amended), which reads:

- 62 (1) The time or periods -
- (a) prescribed by these Rules, other than 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 on 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).
- (4) Subject to paragraph (5) below, a request for extension under paragraph (1) above shall be made before the time or period in question has expired.
- (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 and equitable to do so.
- (6)
- (7)

I considered that the extension of time request filed on 21 June 1999 satisfied the provisions of Rule 62 outlined above, in that the extension was sought to extend the period set down in Rule 13(6) which is not a period excepted by Rule 62(3). The request was copied to the opponents as set down by Rule 62(2)(a), made on Form TM9 as set out in Rule 62(2)(b)

within the parameters of Rule 62(4) and the appropriate fee paid.

I considered that the applicants had shown that they had been diligent in regard to the collation and production of the initial evidence filed on 21 June 1999, i.e. within the period set by Rule 13(6). The production of the two statutory declarations brought to the hearing before me on 13 August 1999 by Mr Muir, also showed a degree of diligence. However, I noted from Mr Muir's submissions that there was uncertainty over whether the further statutory declarations which the applicants were hoping to adduce, could be filed within the period sought i.e. to 19 August 1999. Mr Muir had stated during the course of his submissions that he was "hopeful they could be filed within the period sought", but that "further time may be required". This uncertainty was not contradicted by Mr Muir's instructing principle when he sought further instructions from her at the end of his submissions.

Taking account of the following passage of G Hobbs Q.C. sitting as the Appointed Person in *Liquid Force* [1999] RPC at page 438 lines 32 through to 38:

"In the interests 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".

I considered that from the submissions put before me an extension of time to allow the statutory declarations brought to the hearing into the proceedings was to use Mr Hobb's words "fair and reasonable".

In the same reported case, *Liquid Force* at page 439, lines 11 through to 15, Mr Hobbs states:

"And even if the default does not appear to involve an abuse of process, it may yet be the case that the delay in producing such evidence is inordinate, inexcusable and so seriously prejudicial to the opposite party that no indulgence should be given to the party in default..."

In the instant case evidence had been filed within the statutory period allowed by Rule 13(6) and further evidence was brought to the hearing. I do not think there was any default on the applicants in the instant proceedings and there is no question of any abuse of process in the actions of collating and filing evidence. However, from the applicant's own submissions, the uncertainty of whether and, if so, when further evidence could be filed and taking account of the submissions of Mr Rickard that the opponents were anxious to bring these proceedings to conclusion, in my view no further indulgence was to be given to the applicants.

I took account of the comments of Laddie J in *Hunt Wesson Inc's Trade Mark Application* [1996] RPC 233 at 241 which stated:

"An opposition may determine whether or not a new statutory monopoly, affecting all traders in the country, is to be created. Refusing permission to an opponent who files evidence late affects not only him but may also penalise the rest of the trade."

I would consider these comments to be equally applicable to cases where evidence is filed by an applicant.

I also took account of the comments of G Hobbs Q.C. sitting as the Appointed Person in *Liquid Force* [1999] RPC at page 438 line 32 (quoted earlier in this decision but set out again here) whereby he commented that:

“In the interests 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.” [my emphasis added]

In order for the Registrar to reach a decision on the substantive issues, I considered the Registrar should have the evidence brought by Mr Muir to the Hearing before her when taking a decision. I was not satisfied that any further time for filing evidence was justified.

My decision therefore was to grant the applicants, a final extension of time to 13 August 1999 to admit the declarations of D Jordan and I Beer, the declarations brought to the hearing, into the proceedings. I refused to allow any further extension of time.

In view of my decision in respect of the extension of time, I set the period for the opponents to file evidence in accordance with Rule 13(7) of the Trade Mark Rules 1994 (as amended), as three months from the date of the hearing, i.e. 13 November 1999.

I gave no order as to any award of costs at this stage of the proceedings.

Dated this 9th day of March 2000

J S PARKER

Acting for the Registrar
The Comptroller General