

TRADE MARKS ACT 1994

IN THE MATTER OF A JOINT HEARING IN RELATION TO A REQUEST
BY N.V. SUMATRA TOBACCO TRADING CO.
TO ARGUE AGAINST THE PRELIMINARY DECISION BY THE
REGISTRAR TO REFUSE TO ACCEPT A FORM TM7 FILED
IN RELATION TO APPLICATION **m** 2172992
IN THE NAME OF SUPER COFFEEMIX MANUFACTURING LTD

TRADE MARKS ACT 1994

5 IN THE MATTER of a joint hearing in relation to a request by
N.V. Sumatra Tobacco Trading Co.
to argue against the preliminary decision by the
registrar to refuse to accept a Form TM7 filed
against application m 2172992 in the name
of Super Coffeemix Manufacturing Ltd

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Following a joint hearing on 11 May 2000, I issued the following decision by letter on 17 May 2000:

15 “Having very carefully considered the submissions made by counsel at the hearing I find that there
was nothing substantial put forward to lead me to overturn the preliminary decision to refuse to
deem the Form TM7 as having been filed on or before the due date”.

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

Background

25 Application number 2172992 was applied for on 24 July 1998 and, following examination, was
advertised in the Trade Marks Journal, issue 6296 on page 12478, on 29 September 1999. Thus
the period within which opposition could be lodged ended on 29 December 1999.

30 A packet of documents was opened on 5 January 2000 in The Patent Office containing a Form
TM7 and Statement of Case against this application and which were receipted as received on that
date. The form was filed in the name of N V Sumatra Tobacco Trading Company by Marks &
Clerk.

35 By a letter dated 24 January 2000 Marks & Clerk were informed by the Trade Marks Registry
that the documents had been received outside the period in which opposition could be lodged and
consequently that the opposition could not be actioned. There followed an exchange of
correspondence regarding the refusal to accept the opposition. During this exchange of
correspondence, Marks & Clerk submitted an amended Form TM7 and statement of grounds in
the name of P T Sari Incofood Corporation on 28 January 2000, asking that it be substituted for
40 the original which had been filed in the incorrect name. In view of the refusal to accept the
opposition, no further action was taken on the substitution issue.

Following this exchange of correspondence the Trade Marks Registry maintained its refusal to
accept the opposition and a joint hearing was appointed for 11 May 2000.

Evidence

Prior to the hearing Marks & Clerk submitted a witness statement dated 8 May 2000 by Pamela Jane Withers, a partner in the firm, together with three exhibits. Ms Withers explains that “on or about” 22 December 1999 she prepared a Form TM7 and statement of grounds in respect of the application for registration which she filed “in the usual way” together with the appropriate fee sheet. These were, she says, despatched to the Trade Marks Registry on 23 December 1999 by First Class Post and Recorded Delivery. Ms Withers exhibits copies of the fee sheet compiled by Marks & Clerk on 23 December 1999 and a page from their postal register which show that packages of documents were prepared for posting. The witness statement goes on to explain what her office’s normal practice is in relation to the filing of opposition. There are also two further exhibits comprising copies of correspondence . These comprise two letters, one from Marks & Clerk and the other the reply from The Patent Office, regarding the general filing of documents by post, and copies of the exchange of correspondence between Marks & Clerk and the Trade Marks Registry after the filing of the TM7 in the instant case.

At the hearing, the prospective opponent was represented by Ms Jessica Jones, of counsel, accompanied by Ms Pamela Withers of Marks & Clerk. The applicant was represented by Ms Fiona Clark, of counsel, accompanied by Messrs Calamita and Greenfield of Frank B Dehn & Co.

During the hearing, I provided both counsel with a copy of a document entitled “Priority Services Delivery Note” (See Annex A). This is the document prepared by the Royal Mail which details the recorded delivery code numbers for packages to be delivered to a particular address on a particular day and for which a signature is required and stands as a record of receipt for those packages. It can be seen from the “walk date” that the two packages referred to in Ms Withers’ witness statement, code numbers RW 7311 3290 7GB and RW 7311 3291 5GB were to be delivered on 4 January 2000. The Patent Office was not, however, open for business on that day and the packages listed were therefore delivered and accepted on 5 January 2000. It can also be seen from this document that a further two packets, which the prospective opponent accepted were sent from the same office on a later date, code numbers RW 7311 3292 4GB and RW 7311 3293 8GB, were also received in the same delivery.

The relevant rules in force at the time were the Trade Marks Rules 1994 (as amended). In relation to the filing of opposition, the relevant rule is rule 13(1) which states:

13.-(1) Notice of opposition to the registration of a trade mark shall be filed on Form TM7 within three months of the date on which the application was published under rule 12, and shall include a statement of the grounds of opposition; the registrar shall send a copy of the notice and the statement to the applicant.

From this, as stated earlier, the last day for the filing of opposition was 29 December 1999. In interpreting rule 13(1) rule 2(3) is relevant and states:

2.-(3) In these Rules references to the filing of any application, notice or other document are to be construed as references to its being sent or delivered to the registrar at the Office.

The rules do allow for the late filing of documents in certain circumstances. These are set out in rule 61 which states:

61.-(1) Where, on any day, there is-

(a) a general interruption or subsequent dislocation in the postal services of the United Kingdom, or

(b) an event or circumstances causing an interruption in the normal operation of the Office,

the registrar may certify the day as being one on which there is an “interruption” and, where any period of time specified in the Act, or these Rules for the giving, making or filing of any notice, application or other document expires on a day so certified the period shall be extended to the first day next following (not being an excluded day) which is not certified.

(2) -

(3) If in any particular case the registrar is satisfied that the failure to give, make or file any notice, application or other document within any period of time specified in the Act or these Rules for such giving, making or filing was wholly or mainly attributable to a failure or undue delay in the postal services in the United Kingdom, the registrar may, if he thinks fit, extend the period so that it ends on the day of the receipt by the addressee of the notice, application or other document (or, if the day of such receipt is an excluded day, on the first following day which is not an excluded day), upon such notice to other parties and upon such terms as he may direct.

Submissions

Ms Jones submitted that the issue to be decided was not the date of posting of the Form TM7 nor the date of its receipt at the registry. The relevant issue was what filing date should be given to it.

Ms Jones argued that the postal system was uncertain and subject to delays. The question to be answered was who should take the responsibility for those delays. Her client, she submitted, had to rely on the postal system and that placing the burden for the delay in the postal service on her client was disproportionate. She suggested that in order to achieve legal certainty, a “two day rule” whereby documents would be accorded a deemed filing date two days after posting should be adopted. In this way, she argued, persons not based in London and its environs or in Newport would not be disadvantaged. The “two day rule” would, she submitted, avoid legal uncertainty and would be fair and reasonable. Ms Jones referred to Rule 97 of the Patent Rules whereby documents can be given a deemed filing date.

Ms Jones went on to make submissions that the fundamental principles of European Community Law, which affected trade mark law in the United Kingdom, required Member States to interpret domestic legislation in a manner consistent with Community law and that due regard should be paid to the regime operated at OHIM . Whilst the objectives of the European Treaty are, I believe, well known, United Kingdom trade mark law is governed by the Trade Marks Act and associated rules and, to that extent, the Trade Marks Registry is not bound by European Community regulations.

The notice of opposition was, she said, posted on Thursday 23 December 1999 with two clear

working days left before the due date. The delay was exceptional, could not have been anticipated and was not one for which her clients should be penalised. Whilst due care was taken, there was also the matter of the public interest to be considered in that there was a substantive objection to the registration of an application.

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Responding, Ms Clark began by referring to the wording of rule 13(1) which makes it clear that the Form TM7 had to be “filed” within the 3 months period. Although this appears to be at odds with the wording of Rule 2(3) which interprets filing as referring to sending or delivering, she contended that the use of the word “filed” indicated that a positive act needed to be carried out and was intended to provide an increased degree of certainty.

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Ms Clark stated that the Rule 13 time periods were set on a basis of actions by the registry, giving all parties a degree of certainty, with the proviso that in the event of a serious dislocation in the post then the dates can be reset. She submitted that it was unrealistic for the Office to inspect all incoming mail and check to see if it should be deemed to have arrived on an earlier date than that on which it was actually received.

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Ms Clark referred to Section 7 of the Interpretation Act which states:

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“Where an Act authorises or requires any document to be served by post (whether the expression “serve” or the expression “give” or “send” or any other expression is used) then, unless the contrary intention appears, the service is deemed to be effected by properly addressing, pre-paying and posting a letter containing the document and, unless the contrary is proved, to have been effected at the time at which the letter would be delivered in the ordinary course of post”

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but Ms Clark argued that the Interpretation Act did not apply as there was a specific provision within the Trade Marks Rules, Rules 60 and 61, to deal with interruptions and dislocation in the normal operation of the Office and the postal service. Further, if the due date were missed there could be no prejudice as there were post registration actions which could be taken against the application and these did not require a *locus standi*.

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Ms Clark argued first, that the use of the wording “unless the contrary intention appears” means that the Interpretation Act cannot apply in this instance as there exists an absolute deadline, in Rule 13(1), and a specific provision, in Rule 61, for when there is a disruption in the post.

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Ms Clark went on to argue that if this was wrong then there was a second proviso, “unless the contrary is proved”. Referring to case law quoted in Halsbury’s Statutes of England and Wales¹ she suggested that this meant that if there was a deadline for the service of a document and it could be proven that the document was delivered on a date after the deadline expired, then it could not be deemed to have been served in time. As there was no dispute that the document was received by the Office after the due date then, on this basis, it could not be deemed to have been filed two days after posting.

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She argued further that, if this were found to be wrong also, case law supported the contention

¹4th ed. 2000 issue, pp580/1

5 that there was no rule requiring judicial notice to be taken of the ordinary course of post and that in every case the “ordinary course of post” is a question of fact to be proved in evidence. Taking this point further Ms Clark argued that the wording of the Civil Procedure Rules, Section A, Part 6.7-(1), was such that the “two day post rule” only applied to proceedings directly affected by the Civil Procedure Rules, and as these proceedings are handled under the Trade Marks Rules this does not apply.

10 She further contended that there was no evidence before the Registrar as to what the ordinary course of post at any time of year between Manchester and South Wales was. Continuing on this line she argued that although there were occasional strikes and disturbances it was common knowledge that the post was slower at Christmas and this was not a circumstance envisaged as being covered by the provision of Rule 61.

15 Finally, Ms Clark suggested that any prejudice which did exist was against her client in as far as there was a definite time period within which their application could be held up; as that period had expired with no valid opposition then they were being prejudiced by the non registration of their application.

20 In response Ms Jones argued that either the Interpretation Act applied to these proceedings or there was a discretion on the part of the Registrar to accept the documents as filed on time. She also returned to the wording of Rules 2(3) and 13(1), comparing “send” and “filed”, the words used in those rules.

25 *Decision*

30 Rule 13(1) makes it clear that Notice of Opposition shall be filed within 3 months of the application’s publication date. As the application was published on 29 September 1999, any notice of opposition should have been filed on or before 29 December 1999, which was not an excluded day. Notice of opposition was received 5 January 2000 and its receipt was therefore out of time.

35 The reference in rule 2(3) that “filing” of a document is to be construed as references to its being sent or delivered to the registrar at the office is, prima facie, at odds with the wording of rule 13(1) however, I believe the wording of rule 13(1) is quite clear and requires that notice of opposition should be with the registrar within the 3 month period. This period is definite and easily identified.

40 In case I am found to be wrong in this, I go on to consider whether the Interpretation Act applies. Under Section 7 of the Act, delivery of a document is deemed to have been effected at the time it would have been delivered in the ordinary course of post “unless the contrary is proved”. In this case, there is no dispute that the document was received by the registrar on 5 January 2000. On this basis, I do not believe the Interpretation Act to be of any assistance to the potential opponent.

45 Whilst there is no general provision in the Trade Marks Act or rules for a document to be deemed to have been received on a date other than the actual date of receipt, the rules do contain the

provision to allow for the acceptance of late delivered mail in circumstances where there is a failure or undue delay in the postal system. I therefore go on to consider whether there was such a failure or undue delay.

5 In her evidence Ms Withers states that “on or about the 22 December 1999 I prepared a form TM7
and Statement of Grounds”. These documents were actually dated 23 December 1999 and
entered as item 11 on a fee sheet completed by Janice Poole on the same date. The items
recorded on the fee sheet were to be submitted by post to the Trade Marks Registry, but there
is no actual indication of the recorded delivery code number under which this packet was sent.
10 Ms Withers exhibits a Recorded Posting Receipt form showing that two packets, code numbers
RW 7311 3290 7GB and RW 7311 3291 5GB, were submitted to the Royal Mail on 23 December
1999.

15 Ms Withers also exhibits a Patent Office fee sheet acknowledgement which demonstrates that a
packet of documents, identical in content to the fee sheet referred to previously was processed
on 5 January 2000, but again there is no indication of a corresponding recorded delivery code
number.

20 As noted earlier, at the hearing I gave counsel copies of the Priority Services Delivery Note
received by The Patent Office which shows that four packets were received from Marks & Clerk
Manchester office on 5 January 2000. These were code numbers RW 7311 3290 7GB, RW 7311
3291 5GB, RW 7311 3292 4GB and RW 7311 3293 8GB. These are said to be the two packets
posted on 23 December 1999 and two packets posted at a later date but I have no clear indication
of what package contained which documents.

25 In *Jones v. Great Western Railway Company* (1930) 144 L.T. 194 Lord MacMillan (dissenting
as to the facts, but not as to the applicable principles of law) said at 202:

30 “The dividing line between conjecture and inference is often a very difficult one to draw. A
conjecture may be plausible but it is of no legal value, for its essence is that it is a mere guess. An
inference in the legal sense, on the other hand, is a deduction from the evidence, and if it is a
reasonable deduction it may have the validity of legal proof.”

35 There is clear evidence linking the Form TM7 to the fee sheet prepared in the Marks & Clerk
office, and by inference I accept that the packet referred to on the Patent Office fee sheet
acknowledgement is the identical set of documents. However there is no evidential link, even of
a circumstantial nature, which clearly demonstrates, or allows for the inference, that this was one
of the two packets posted on 23 December 1999. I am therefore unable to find that the date of
posting is actually proven.

40 If I am wrong in this and assume that the packet containing the Form TM7 and Statement of
Grounds was despatched by recorded delivery on 23 December 1999 then I go on to consider the
effect of rule 61. I have to consider whether the late filing of the Notice of Opposition was due
to “a general interruption or subsequent dislocation in the postal services” as envisaged under
45 Rule 61(1) of the Trade Marks Rules 1994 (as amended). My view is that the provision of Rule
61(1) is there to cover those situations where there is, as it states, a “general” interruption, such
as a period of industrial action by staff of the postal system which then interrupts the flow of the

mail. In particular this Rule refers to the registrar “certifying” that a specific day or days are covered by the provisions of this Rule such that it would then be applicable to all mail to be received within a specified time period. No such certification was made and I do not therefore regard Rule 61(1) as applicable to these circumstances and would not invoke this Rule to deem the Form TM7 as filed on time.

I therefore go on to consider whether I should exercise discretion under Rule 61(3) to the extent that this particular packet was subject to an “undue delay in the postal services in the United Kingdom” and thus allow the potential opponent to gain benefit of this Rule by deeming the Notice of Opposition to have been filed on time. Assuming that the packet was posted on 23 December 1999, this is the height of the festive season. It is generally regarded to be the busiest time of year for the postal services and whereas there are almost certainly inequalities in this traffic in that mail going along one route may arrive several days ahead of mail sent along a different route it is well accepted that mail takes longer to be delivered at this particular time of year. This is evidenced by a press release from The Post Office dated 15 December 1999 (see Annex B) which recommends that mail under the First Class tariff must be sent by 21 December 1999 to arrive at its destination on 24 December 1999. This gives the only clear indication that I have of the “ordinary course of post”, to take a phrase from the Interpretation Act, at that particular time of that particular year.

In this instance the prospective opponent allowed only two working days for delivery of the Notice of Opposition. In the circumstances Ms Withers may have had “every belief that the opposition would be timely received even though it was the Christmas period” but given the time of year and the proximity of the Christmas shutdown, I do not believe this was a reasonable belief. Despite Ms Jones submissions that the delay was exceptional, I believe that there is a legitimate expectation that delays will occur in the postal system during the Christmas period, the more so given that this particular holiday season encompassed the Millennium celebrations. Whilst the registrar will utilise the provision of this rule where appropriate to enable the acceptance of documents which have been the subject of delays beyond those which could be considered usual in the normal course of post, I do not regard Rule 61(3) as applicable in these particular circumstances and cannot invoke this Rule to extend the period for the filing of the Form TM7.

Despite Ms Jones’ submission that her client had to rely on the postal system, there are alternative methods of filing documents. I do not know whether it would have been possible or practical for the Notice of opposition to have been forwarded from her client’s Manchester office to their London office for onward, personal, delivery to the Trade Marks Registry. It is well accepted, however, that the Trade Marks Registry accepts documents by facsimile transmission. Use of this medium allows documents to be sent to and received by the Registry on the day they are prepared.

I was asked to exercise discretion and adopt the “two day postal rule” to deem the Form TM7 as filed on 29 December 1999, however, given the clear requirements of rule 13 and the specific discretion laid down in rule 61, I can find no basis to support the contention that I have such a general discretion and thus decline to do so.

As was accepted by both parties, the Notice of Opposition was received 5 January 2000, outside the period allowed. It was neither filed on time nor can it be deemed to have been filed on time. There is therefore no validly filed opposition to application number 2172992 and it can now proceed to registration.

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Dated this 1st. day of August 2000

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**Mr G J Attfield
Hearing Officer
For the Registrar, the Comptroller-General**

PRIORITY SERVICES DELIVERY NOTE

PAGE 001 OF 002

DELIVERY OFFICE: NP 7B NEWPORT PDO
 WALK ID: 0083
 WALK DATE: 04/01/00

			PREFIX TOTAL
DC 2454 9915 3GB ✓	DC 8972 1670 7GB ✓		DC: 2
RT 3474 8278 5GB ✓	RT 7513 0934 2GB ✓		RT: 2
RW 0522 5087 9GB ✓	RW 0892 0137 7GB ✓	RW 0892 0138 5GB ✓	
RW 1704 4336 5GB ✓	RW 1704 4339 1GB ✓	RW 3942 9767 1GB ✓	
RW 3942 9786 1GB ✓	RW 3942 9787 5GB ✓	RW 3942 9788 9GB ✓	
RW 4632 6717 3GB ✓	RW 4632 6718 7GB ✓	RW 4640 4555 8GB ✓	
RW 5287 9022 8GB ✓	RW 5525 9587 3GB ✓	RW 5562 2411 3GB ✓	
RW 6387 8159 4GB ✓	RW 6387 8160 3GB ✓	RW 6387 8161 7GB ✓	
RW 6387 8163 4GB ✓	RW 6387 8165 1GB ✓	RW 6930 0267 4GB ✓	
RW 6930 0269 1GB ✓	RW 7311 3290 7GB ✓	RW 7311 3291 5GB ✓	
RW 7311 3292 4GB ✓	RW 7311 3293 8GB ✓	RW 8203 0440 5GB ✓	RW: 27

NO OF ITEMS RECEIVED: 31 (THIRTY ONE)

COMPANY NAME (PLEASE PRINT)

ACCEPTING SIGNATURE SARAH

PLEASE PRINT NAME

TIME 9.00

DATE 5.1.00

About

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15th December 1999

UK PARCEL AND SECOND CLASS LAST POSTING DATES

The Post Office is today reminding customers the last posting date for sending UK parcels and Christmas cards and letters by Second Class post is just days away.

UK standard service parcels should be posted by Friday 17 December, and Christmas cards, letters, and packets using Royal Mail's Second Class service should be in the post by Saturday 18 December.

If customers miss the latest recommended dates, they still have time to get their Christmas greetings to friends and family in the UK by Tuesday 21 December using the First Class service. Or if sending parcels, they can take advantage of Parcelforce Worldwide's guaranteed Next Day and Parcelforce 48 services.

Royal Mail is predicting it will handle a record postbag of well over 2.5 billion cards, letters, and packets in the four weeks leading up to Christmas.

Parcelforce Worldwide will deliver more than a million parcels a day during the Christmas period - double the normal daily number of parcels at any other time of the year.

www.postoffice.co.uk