

TRADE MARKS ACT 1994

**IN THE MATTER OF an interlocutory hearing
concerning attempted opposition by Renaissance
Hotels Holdings Inc to trade mark application number
1526253 in the name of Renaissance Software Inc.**

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Following an interlocutory hearing on 13 October 1997 I refused to admit notice of opposition filed by Renaissance Hotels Holdings Inc. against trade mark application 1526253 of Renaissance Software Inc. I held that the notice of opposition was not admissible because it was not accompanied by the necessary fee. A fresh notice of opposition, accompanied by the relevant fee, had been filed subsequently but by that time the period allowed for opposition of the mark had expired.

I am now asked to state in writing the grounds of my decision.

Background

On 8 February 1993 Renaissance Software Inc of Los Altos, California 94022, United States of America made four applications under the Trade Marks Act 1938 (as amended) to register the words RENAISSANCE SOFTWARE as a trade mark. On 19 February 1997 the four applications were advertised in Trade Marks Journal number 6163 as follows:-

1526251	Class 9	Computer software; computer programmes; all included in Class 9 but not including any such goods relating to the Renaissance.
1526252	Class 37	Installation, repair and maintenance of data processing apparatus and instruments and computers; all included in Class 37.
1526253	Class 41	Personnel training in the operation and/or use of data processing apparatus and instruments, computers and computer programmes.
1526254	Class 42	Computer programming; consultancy and technical assistance/aid in the field of computer hardware, software and programmes; computer software design; updating of computer software; rental of computer software; rental of data processing apparatus and instruments and of computers; maintenance of computer programmes; all included in Class 42.

Although all these applications were filed under the Trade Marks Act 1938 it is common ground that, following Schedule 3 paragraph 10(2) of the Trade Marks Act 1994, the procedure for opposing them is governed by the 1994 Trade Marks Rules.

On Monday 19 May 1997, which was the last day of the opposition period, Messrs A A Thornton & Co., acting for Renaissance Hotel Holdings Inc., filed notice of opposition using a single form TM7. This is the statutory form by which anyone wishing to oppose an action by another party, such as an application to register a new trade mark or an application to amend a registered trade mark, is required to notify the Registrar of his intention. In the space provided on the form for details of the application or registration to which the opposition relates A A Thornton entered details of all four of the Renaissance Software Inc. applications.

This notice of opposition was accompanied by a fee sheet which is reproduced as Annex 1 to this decision and a cheque. The fee sheet has entries relating to five transactions, one of which is:

Form Type	Form Number	Name Number or Other Identifier	Amount of Fee £
TM	7	1526251 + 3 Others Renaissance Software Inc. NG/JJR/kjf/O	200

(The final entry on the fee sheet also relates to an opposition to application 1526251, under reference EAD/pmas/0.15179, but this opposition is by a different party and has nothing to do with the present case).

It is relevant to state here what action the Patent Office takes when it first receives forms and fees.

Documents received at the Patent Office in Newport are handled initially by the office's Document Reception staff who accord each document a filing date, normally the date of receipt, and process all fees. Where forms are fee bearing - as in the case of form TM7 - Document Reception staff are required to check, inter alia by reference to an accompanying fee sheet, that the appropriate fee has been paid. Except where the Rules provide otherwise no filing date may be accorded to such a document until payment has been affected. Once these formalities are complete Document Reception staff pass the document to whichever part of the Patent Office is responsible for taking action on it.

For the convenience of its customers the Patent Office allows documents to be filed at its London front office. Documents deposited at the London office up to midnight on a given day are entitled to claim that day as their filing date, even though they will not reach Document Reception in Newport till later.

The form TM7 filed by A A Thornton on Monday 19 May 1997, which as already noted was the last day of the opposition period, was filed in London. When the forms came to be processed by the Document Reception staff in Newport the form TM7 was taken to have been

filed against application 1526251, the first of the four applications listed, because the fee sheet and accompanying cheque reflected a payment of only £200, sufficient to cover only one opposition.

On Thursday 22 May 1997 an official in Document Reception telephone Messrs A A Thornton to point out that the £200 fee paid was insufficient to cover four oppositions. That same day A A Thornton filed three separate notices of opposition accompanied by three more sets of fees. These notices were allocated a filing date of 22 May and passed to the Law Section of the Trade Marks Registry for action. Law Section declined to act upon them because they were filed outside the opposition period. The fees for the three extra oppositions were then refunded.

The argument

There were two ways in which the oppositions filed by A A Thornton departed from normal practice.

The first concerns the fact that a single form TM7 was filed in respect of opposition to four applications. Form TM7 itself says in the space provided at box 1

“Give details of the application or registration.... to which this opposition relates”

Similarly Rule 13(1) of the Trade Marks Rules 1994 reads

“Notice of opposition to the registration of a trade mark shall be sent to the Registrar on Form TM7”

This use of “application” and “registration” in the singular suggests that one form TM7 should be filed per application opposed, and this seems to be widely accepted among practitioners. Nevertheless, while the practice of using a separate form for each opposition is clearly desirable if confusion is to be avoided, it is not in my judgement a statutory requirement.

It seems to me therefore that had the form been accompanied by the correct fees, that is to say by a fee sheet referring to named and numbered applications and a corresponding cheque, then the opponent’s intention would have been so clear as to enable the Registry to proceed on the basis of the single form TM7 and to reproduce it internally to provide the separate copies needed.

The second departure concerns the failure of the opponents to pay the necessary fees.

In the letter to the Registry dated 4 June 1997 Mr N Goodenough of A A Thornton acknowledged that the fee sheet which accompanied the TM7 filed on 19 May was completed incorrectly, and that the entry relating to these oppositions and the related payment should have been £800 and not £200. Despite this he considered that the TM7 filed on 19 May should be admitted in respect of all four oppositions because Section 38(2) and Section 79 of the Act and Rule 13(1) of the Trade Marks Rules 1994 did not require the fees to accompany the notice of opposition. In reference to these Sections of the Act and this Rule Mr

Goodenough is correct, because the rules governing the filing of fees are set down elsewhere, in particular in Rule 4(2) of the Trade Marks Rules 1994 and Rule 3 of the Trade Marks (Fees) Rules 1996. Rule 4(2) of the Trade Marks Rules 1994 says:

“Any form required to be filed with the Registrar in respect of any specified matter shall be subject to the payment of the fee (if any) prescribed in respect of that matter by those rules”.

It seems clear to me that Rule 4(2) means that if the fee is not paid the form is not filed. Rule 4(2) does not say when the fee should be paid but Rule 3 of the Trade Marks (Fees) Rules 1996 does. It says:

“Where a form specified in the Schedule as the corresponding form in relation to any matter is specified in the Trade Marks Rules 1994 that form shall be accompanied by the fee, if any, specified in respect of that matter (unless the Rules otherwise provide)”.

Form TM7 falls squarely within the above provision because it is specified in both the Schedule to the Trade Marks (Fees) Rules 1996 and in the Trade Marks Rules 1994 (where it is mentioned in Rule 13(1) and Rule 41). Nor do the Trade Marks Rules 1994 anywhere provide that form TM7 should be treated otherwise than as set out above.

It follows from this provision of Rule 3 of the Trade Marks (Fees) Rules 1996 that if a form is subject to a particular time limit, then any fee which is required to accompany that form must also be subject to the same time limit.

Mr Goodenough sought to persuade me at the hearing that Rule 11 of the Trade Marks Rules 1994 provided for a period of two months to be allowed to remedy any default in payment. However Rule 11 relates exclusively to deficiencies in a trade mark application and does not concern notice of opposition at all. In fact any extension of the time allowed for filing notice of opposition is specifically prohibited by Rules 13(1) and 63(3). Rule 13(1) says:

“Notice of opposition to the registration of a trade mark shall be sent to the Registrar on form TM7 within three months of the date on which the application was published”

and Rule 62(3) says that Rule 13(1) is excepted from the provisions of Rule 62(1), which is the rule allowing the Registrar to give extensions of time.

Mr Goodenough also argued that the provisions of Rule 60 should be applied to extend the time available for filing notice of opposition to 22 May. He claimed that

- 1 The Patent Office was at fault in not notifying him of the mistakes in the opposition documents in time for him to put things right
- 2 The very act of filing form TM7 should have constituted sufficient authorisation to remove the appropriate level of fees from his firm's deposit account.

Rule 60 of the Trade Marks Rules 1994 deals with the correction of irregularities, calculation and extensions of time. It says:

60 - (1) Any irregularity in procedure in or before the Office or the Registrar may be rectified, subject to paragraph (2) below, on such terms as he may direct.

(2) In the case of an irregularity or prospective irregularity -

- (a) which consists of a failure to comply with any limitation as to times or periods specified in the Act, these Rules or the old law as that law continues to apply and which has occurred or appears to the registrar as likely to occur in the absence of a direction under this rule, and
- (b) which is attributable wholly or in part to an error, default or omission on the part of the Office or the registrar and which it appears to him should be rectified,

He may direct that the time or period in question shall be altered in such a manner as he may specify.

I reject the claim that the Office was at fault in not notifying A A Thornton of the deficiencies in their opposition papers in sufficient time for A A Thornton to make good those deficiencies before the time available for opposition expired. As already noted the defective notice of opposition was filed on the last day of the opposition period. It was also filed in London, so that by the time the notice reached Document Reception staff in Newport the time allowed for opposing these applications had already expired.

I also reject the claim that the Office should have ignored the defective fee sheet and the shortfall on payment, should have inferred that there were four applications to be opposed rather than one and should then have drawn down the necessary additional fees from funds available in the agent's deposit account. The Office was faced, contrary to all normal procedures, with a single form TM7 such as would normally be associated with a single opposition. Accompanying it was a fee sheet itemising an amount sufficient for a single opposition and which referred to a single application number, and a cheque to correspond. The Patent Office tries to be helpful to its customers but there must be a limit to the number of errors which it can reasonably be required to put right on their behalf. It is I think beyond argument that responsibility for filing forms correctly, with the time specified by the Rules, rests with the originating party and not with the Patent Office.

I conclude that neither the Office nor the Registrar have been responsible for any error, default or omission, and that no rectification is appropriate under Rule 60.

Mr Goodenough considered that the late payment of the fee would not disadvantage the applicants. At the hearing Mr Kavanagh of Intelmark, who attended on behalf of the applicants, denied that his clients would not be inconvenienced. However even if the applicants had not objected I would still have decided that the extension could not be allowed.

In the result I find that the fee in respect of opposition to application 1526253 did not accompany the notice of opposition filed on 19 May 1997 and that consequently no opposition to that application was filed on that date. And I find that the notice of opposition filed on 22 May 1997 was filed after the expiry of the period allowed by the Rules for filing such notice and that consequently it may not be admitted.

Dated the 14th day of April 1998

VIRGINIA DOUGLAS
For the Registrar
The Comptroller General