BEFORE:

MR M G CLARKE QC

IN THE MATTER OF TRADE MARKS ACT 1994

AND

IN THE MATTER OF APPLICATION NO 8834 BY
MR R GROENEVELD FOR THE REVOCATION
OF TRADE MARK REGISTRATION NO 1343470 IN CLASS 34
IN THE NAME OF ANDRE JACQUES LEVY &
MAIRADE ANN LEVY

AND

IN THE MATTER OF TRADE MARK APPLICATION NO 2007109 BY
ANDRE JACQUES LEVY & MAIRADE ANN LEVY AND
OPPOSITION NO 445519 THERETO BY R GROENEVELD

APPEAL OF OPPONENT FROM THE DECISION OF MISS V DOUGLAS
FOR AN EXTENSION OF TIME

MR J PENNANT (of Messrs D Young & Co London) appeared as Agent
on behalf of the Applicant/Opponent

MR A J LEVY appeared in person

MR M KNIGHT appeared on behalf of the Registry Office

D E C I S I O N
(as approved by the appointed person)

Mr Clarke: This is an appeal against a refusal by the Hearing Officer for an extension of time to R Groeneveld to file their evidence in chief under rule 13(3) of the 1994 Trade Mark rules.

The Registrar is exercising a discretion when he receives an application for an extension of time in such circumstances. In particular, that discretion is exercised under rule 62(1) of the 1994 rules, the language of which makes it clear that the discretion is a wide one.

It has to be borne in mind that in the present proceedings what we are concerned with is an appeal and not a rehearing of the merits or otherwise of the application for the extension. That means, in my view, that the appointed person is only entitled to interfere with the decision of the Registrar if it can be demonstrated that the discretion has been exercised in, what might be described as, an unreasonable fashion.

In the context of the present case, it has to be borne in mind also that there already had been an extension of three months granted albeit without objection. This is set against the background that the provisions of the statute provide that the evidence has to be filed within three months.

It seems to me that when an extension of three months has been granted it is incumbent upon the party to whom it has been granted to ensure that, if any other extension is to be sought, strong and compelling reasons for such an extension are put forward. When the matter is opposed and there has to be a hearing, it is, in my view, essential that the applicant makes the best case for a further extension at that hearing. If that is not done and matters are left on an equivocal or uncertain basis, then it seems to me that the applicant must live with the consequences of that.

On 3 July 1997 Messrs D Young & Co sought a further extension of three months to make a total of nine months available to 6 October 1997. In their supporting letter Messrs D Young stated as follows:

> "We have been in correspondence with our instructing principals in Holland with

regard to the opponent's proposed declaration for filing evidence in support of the above opposition. The opponent has been very heavily tied up with the worldwide launch and has therefore been unable to deal with this in the time allotted. It is anticipated that the opponent's evidence will be ready for submission to the Registrar before the end of the term requested."

In the present case, the applicant, Mr Groeneveld, had neither himself nor through his representatives produced, prior to the hearing, any sign that active steps had been taken to collate the necessary evidence. At the hearing all that was said in that respect, as I read the Hearing Officer's decision, was that Mr Pennant on behalf of Mr Groeneveld said that evidence could be filed by the end of the day of the hearing. Although, Mr Pennant has today before me explained what lay behind that and what he meant by that, viz that he was in a position to file a declaration from his client which had been sworn on 11 September 1997, he provided me with no satisfactory explanation as to why it was, if that evidence was available prior to the hearing, it had not been produced to the Hearing Officer. What is more, as Mr Knight for the Registrar has explained to me, there was nothing to prevent that evidence having been lodged with the Registrar at any time prior to the hearing for the purposes of it being placed on the file, which would have then indicated to the Hearing Officer that some steps had been taken in advance of the hearing to collate at least some of the evidence.

I consider that I have to proceed on the basis of the submissions and material that were placed before the Hearing Officer and the explanations that were given at that time and, unless I am satisfied that something has clearly gone wrong in that respect, it is on that material that I have to judge as to whether the discretion was exercised reasonably or not.

The plain fact of the matter in the present case is that no evidence had been filed before the hearing and no satisfactory evidence was given to the Hearing Officer as to why that remained the position notwithstanding the previous extension of three months what had been given, plus the number of weeks that had elapsed since the expiry of that period.

I have come to the conclusion that the Hearing Officer cannot be criticised in the

circumstances of this case in reaching the conclusion that there had been no real evidence of diligence being exercised in this matter during the substantial period of time that had elapsed since the expiry of the initial period of three months for filing evidence.

I should say that in my opinion, and contrary to what was submitted by Mr Pennant, the remarks of Jacob J in the Swiss Army Knife case [1996] RPC 507 are equally applicable to the position in the present case, though it arises under the 1994 Act, as they were in relation to the 1938 Act, in particular his Lordship's statement that "six months is a very generous period for the filing of evidence", (at page 508).

For the aforegoing reasons the appeal in my view fails to be dismissed.

Mr Levy: Could you make an order for casts as well?

Mr Clarke: There was an order made by the Hearing Officer.

Mr Levy: They are still outstanding. We are still waiting to receive those costs.

Mr Clarke: That was to the extent of £200.

Mr Levy: Yes, it was.

Mr Pennant: I do not have any submissions to make on this point.
Mr Clarke: The figure that was thought appropriate on the previous occasion was £200.

Mr Levy: In reality it bears no relation to the real cost. I do understand the Trade Mark Registry's practice, but nevertheless there has to be some reality. We are individuals as is Mr Groeneveld with significantly fewer resources at our disposal.

Mr Clarke: I think perhaps the approach that has been taken on previous occasions is that there is a presumption the expenses will be somewhat greater for this type of hearing than

before the Hearing Officer, but that might not be an assumption that should be treated as if it was an invariable assumption.

There has been an uplift given in other cases from the sort of figure granted by the Hearing Officer. Mr Knight, can you help me on this?

Mr Knight: That is right, sir. Your colleague, Mr Hobbs, acting as the appointed person awarded costs to a party that were slightly above the costs awarded by the Hearing Officer, but, of course, they would be in addition to the original costs.

Mr Clarke: Yes, certainly. I think in all the circumstances it would be appropriate to direct that the appellant pays the applicants a sum of £300 as a contribution to their costs.

Following my usual practice, I will produce a written decision which may or may not elaborate on the points I have already made in support of the decision I have given.