

TRADE MARKS ACT 1994

IN THE MATTER OF A REQUEST BY TOTTENHAM HOTSPUR PLC (THE APPLICANTS) FOR AN EXTENSION OF TIME WITHIN WHICH TO FILE EVIDENCE IN OPPOSITION PROCEEDINGS (Opposition m 47905) AND OBJECTION RAISED THERETO BY PATRICIA HARD O'CONNELL AND MICHAEL O'CONNELL (THE OPPONENTS)

TRADE MARKS ACT 1994

IN THE MATTER of a request by Tottenham Hotspur Plc (the applicants) for an extension of time within which to file
5 evidence in opposition proceedings (opposition m 47905) and objection raised thereto by Patricia Hard O'Connell and Michael O'Connell (the opponents)

10 At an interlocutory hearing on 21 September 2000 I gave a decision, confirmed by letter the same day in the following words:

15 “After hearing the submissions I gave the following decision; that I would overturn the preliminary decision and refuse the requested extension of time. The case is now ready for a decision and the parties will be requested to indicate whether they wish to attend a hearing or are prepared to accept a decision from the papers.”

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

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Background

25 Application number 2130740, for the mark TOTTENHAM, was applied for on 24 April 1997, in classes 6, 9, 14, 16, 18, 20, 21, 24, 25, 26, 27, 28, 39, 41 and 42, and, following examination, was published in the Trade Marks Journal on 10 September 1997. On 10 December 1997 Patricia Hard O'Connell and Michael O'Connell filed a Form TM7 and Statement of Grounds of Opposition to this application.

30 The applicant filed their defence, by way of Form TM8 and Counterstatement, on the 16 March 1998. This was sent to the opponent under cover of a letter dated 20 March 1998 and the period for the opponent to file evidence in chief commenced, allowing three months from the date of the letter.

35 On 22 June 1998 the opponent requested, and was granted, an extension of three months for the filing of evidence. Subsequently further requests were filed on 21 September 1998 and 21 December 1998, and granted, each for a period of three months. In each case the request was on the basis of ongoing negotiations.

40 A further request for an extension of time was filed on 18 March 1999 for a period of two months with the opponent stating that negotiations were nearly concluded and that these proceedings were close to resolution. This extension was granted. On 20 May 1999 the opponent filed their evidence in chief with a request that a confidentiality order be placed on one of the exhibits.

45 There was then a period during which the Registrar corresponded with the parties on the issue of confidentiality of the exhibit. Eventually the opponent withdrew their request and the evidence was formally accepted into proceedings on 25 October 1999. The applicant was set until 25 January 2000 to file such evidence in support as they wished.

On 25 January 2000 the applicant requested an extension of time of three months giving the

reason as:-

5 “A main declaration is in the course of preparation. The applicant requires further time to confirm the full extent of the use made of the mark which is the subject of the application and advertising and turnover figures. In addition, the applicant is endeavouring to identify appropriate witnesses to provide evidence that the mark which is the subject of the application is distinctive of the applicant and to refute the allegations made in the opponent’s evidence. Further time is required for this exercise.”

10 This extension was granted. Subsequently, on 17 April 2000, the applicant requested a further extension of time of three months giving the reason as:-

15 “The applicant has produced some evidence demonstrating its use, reputation and goodwill in the mark which is the subject of the application. However, further time is required to produce more evidence to show the reputation and goodwill of the applicant in the mark which is the subject of the application in relation to the goods and services applied for.

20 In addition, the applicant requires further time to locate and interview independent witnesses to provide independent evidence to the Registry concerning the association of the mark which is the subject of the application with the products and services of the applicant. In addition, further time is required by the applicant to examine the circumstances under which the correspondence between G & N Agencies and the applicant referred to at Exhibit PM4 of the Declaration of Paul Myers, given the period which has elapsed since the correspondence took place.”

25 This extension was granted. A Form TM33 was filed on 30 May 2000 to change the professional representation of the applicant for all their trade marks and proceedings before the Registrar.

30 On 24 July 2000 the applicant requested a further extension of three months, giving the reason as:-

35 “The applicant has recently changed its professional representatives. This has involved considerable disruption, including the transfer of relevant files from the previous representatives. The new representatives require further time to consider all aspects of the case and to compile the necessary evidence in support of the application. This involves examining the applicants archived materials, which is problematic during the close season when the applicant operates with a reduced staffing level. The applicants representatives also wish to ascertain how the mark is used on a match day and obviously this will not be possible until the start of the next football season (mid August).”

40 The Registrars’ preliminary view was that the request should be granted. On 17 August 2000 the opponent wrote to the Registrar (see Appendix A) objecting to the granting of the extension.

45 On 18 August 2000 the applicant filed a Form TM21 requesting that each class specification for the application be amended by the addition of the phrase “all relating to Tottenham Hotspur Football Club”. This amendment was published on 4 October 2000. The opponent stated, in a letter dated 11 September 2000, that this amendment of the specifications would not resolve the proceedings.

50 The hearing took place before me on 21 September 2000 with Mr Rackham, of Lloyd Wise, Tregear & Co, representing the opponent and Mr Baker, of Trade Mark Owners Association Limited, representing the applicant.

Submissions

5 In his opening submission Mr Rackham referred at length to the opponent's letter of 17 August 2000, he made the point that the present attorneys acting for the applicant may not have delayed but asked the question - what had the applicant themselves done prior to this latest request for an extension of time? He suggested that it was irrelevant what had occurred after July 2000 and that consideration should only be given to what had been done prior to the request.

10 Further, he went over the events following the filing of the opponent's evidence; that there had been a period of five months during which the issue of confidentiality of an exhibit was determined; there then followed the statutory period of three months; this was followed by a further two periods of three months each prior to the requested period under consideration; thus, he argued, the applicant had a total of fourteen months between receiving a copy of the opponents evidence and the latest request for an extension of time.

15 He went on to analyse the applicants requests and suggested that this did not actually demonstrate progress; in the first stating that a main declaration was being prepared; in the second referring to some evidence having been produced; in the third there is the implication that none of this had actually been done, the applicants archived material had yet to be examined. In summary he suggested that this gave no clear indication that anything had been done towards the preparation of evidence.

20 In closing he referred to the four cases mentioned in the letter of 17 August 2000, these being the *SAW* case, [1996] RPC 507, the *Levy's* case, [1999] RPC 291, the *Liquid Force Trade Mark* appeal case, [1999] RPC 429, and the *Genius* case, [1999] RPC 741

25 Mr Baker, in his submission, accepted the facts as laid out in the opponents letter of 17 August 2000 with regards to the sequence of events; with regard to the earlier requests for extension of time he was unable to comment on what the previous attorneys had done; the previous attorneys had dealt with the applicant company through a law firm and there was no indication of direct contact. He argued that since taking over the case the new attorneys had been diligent and had prepared several binders of exhibits, although this had not been formalised he suggested it could be filed within the period requested.

30 With regards to negotiations, he suggested that there had been negotiations but only for a period of a few months, March to May, in 1999 and this did not validate the opponents requested extensions of time. As far as he was aware the parties were in contact and negotiating again.

35 In closing he sought to differentiate this case from those referred to by the opponent; that the *SAW* case was under the previous Act and Rules and should not be followed; that unlike the *Levy's* case they did have evidence to hand, albeit not finalised; that the *Liquid Force* case established the width of discretion open to the Registrar, they had prepared evidence and that this case established that a case should be heard on all the evidence and not merely that of the opponent; and that the *Genius* case was not relevant to these proceedings.

40 In reply Mr Rackham accepted that the opponents requests for extension of time had not been objected to by the applicant, but suggested that negotiations had been ongoing and when these came to nothing the opponent had their evidence ready to file. He argued that there was no principle of equity in extension of time requests and that the decision should be based on the

situation on and before 25 July 2000.

With regards to the cases referred to in the opponents letter of 17 August 2000 he accepted that the Registrar had a wide discretion, but also argued that the cases the opponent had cited were of relevance to these proceedings. He particularly referred to the comments in the *Liquid Force* case to the effect that requests for extension of time should not be automatically granted even if refusal could lead to another action and that negotiations did not relieve a party of the obligation to file evidence, he commented that throughout the earlier negotiations the opponent had continued to prepare their evidence in chief.

Decision

The power vested in the Registrar to grant extensions to certain periods of time determined in the Trade Marks Rules is discretionary, the periods allowed for the filing of evidence are not excluded from this discretionary power. At the date the request was made the relevant parts of Rule 68 in the Trade Marks Rules 2000 read:

68. - (1) The time or periods-

(a) prescribed by these Rules, other than the 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, or on the initiative of the registrar, be extended by the registrar as she thinks fit and upon such terms as she 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, 25, 31, 32, 33 or 34, 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(3) and 13(5) (time for filing counter-statement), rule 13(4) (cooling off period) save as provided for in that rule, rule 23(4) (time for filing opposition), rule 25(3) (time for filing opposition), rule 29 (delayed renewal), rule 30 (restoration of registration), rule 31(2) (time for filing counter-statement), rule 32(2) (time for filing counter-statement), rule 33(2) (time for filing counter-statement), and rule 47 (time for filing opposition).

The breadth of the discretion afforded the Registrar by this Rule was dealt with by the Appointed Person in the *Liquid Force Trade Mark* appeal, at pages 437 & 438, and allows that where any relevant circumstances are brought to her attention the registrar can exercise this discretion.

In this case the period for the filing of evidence had been extended, twice, until 25 July 2000, the requests referred to preparation of a declaration, collating of evidence and identifying appropriate witnesses. When this latest request was provisionally granted the opponent objected.

It was clearly laid down in the *SAW* case that six months is a long time for the filing of evidence, and whilst I agree that this was a decision under the previous Act and Rules the basic tenet of that

5 decision was confirmed in the *Levy's* case. In these proceedings the applicant has had the initial period of three months. This was extended by two further periods each of three months and they then requested a further three months. They have therefore already had a period of nine months within which to file any evidence to support their case and if this latest request were granted they would then have had a period of one year.

10 The applicant argued before me that the *Levy's* case was different from these proceedings in as far as in that case the parties had no evidence to hand to file whereas here the applicant did have evidence to hand. I cannot agree with that premise, *Levy's* is an appeal decision and at the original interlocutory hearing the applicant argued that they were in a position to file evidence on the day of the hearing, this fact is referred to in the appeal decision, notwithstanding that the hearing officer refused the request for an extension of time. At the hearing before me the applicant argued that they did have evidence to hand but this was merely a series of binders with collected exhibits, they admitted that there were no formalised documents, no actual statutory declaration, affidavit or witness statement. They therefore had no evidence ready to file at the date of the hearing.

15 Further to this, in the *SAW* decision Jacob J. at page 509, line 28 stated:-

20 “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.”

25 For a considerable period of time the applicant appears to have done very little towards the collation and preparation of evidence to be filed in these proceedings, I will return to this point later.

30 Besides giving guidance on the registrar's discretion in determining an application for an extension of time the *Liquid Force* case also dealt with other issues relevant to these proceedings. Whilst the *Liquid Force* decision refers to the opponent, in that case it was the opponent requesting the extension of time, the same points must also be applicable to the applicant. At page 440, commencing at line 36, Geoffrey Hobbs QC, sitting as the Appointed Person, stated:-

35 “The period of time which matters for present purposes is the period allowed for the filing of evidence under Rule 13(3). In accordance with the provisions of Rule 13(3) that period commenced when the Registrar sent a copy of the Counterstatement to the Opponent in May 1997. I agree with the Principal Hearing Officer that delay should be assessed with reference to the period after the date on which the Counterstatement was sent to the Opponent because the Opponent was under no obligation prior to that date to incur costs in connection with the preparation of evidence that might turn out to be unnecessary when and if the Counterstatement was filed. However, the fact that there were no surprises for the Opponent in the Counterstatement as filed is relevant, in my view, to the question whether the Opponent worked with due diligence to file its evidence in support of the Opposition within the time allowed.”

45 I believe that what Mr Hobbs was saying was that as there were no surprises to the opponent in the counterstatement, then they could have already been preparing their evidence and should have been in a position to file their evidence with no undue delay. By analogising that statement to these proceedings then there was a period of five months during which the applicant was in possession of the opponent's evidence, the period for the filing of evidence had not formally commenced but there was only a dispute over whether one exhibit attached to one of four statutory declarations, which had a total of sixteen exhibits, should be declared as confidential to be decided. Whether that particular exhibit were declared confidential or not would not affect in

any way the case put forward by the opponent and the applicant could have usefully used this period to be preparing evidence in advance of the period for the filing of evidence formally commencing. If this is taken into account then the applicant actually had a period of fourteen months during which to have prepared and filed evidence prior to the latest request for an extension of time.

It was also clearly stated by the appellate tribunal in the *Liquid Force* decision that opposition proceedings should be brought to a conclusion without undue delay.

The *Genius* case which was referred to by the opponent provides further guidance in relation to these proceedings. During these proceedings the applicant changed its representative and, whereas the current representative may have been trying to progress the case, there is a duty on the actual applicant to ensure that proceedings are prosecuted diligently throughout, it is after all their trade mark, their intellectual property. In his submission, Mr Baker acting for the applicant, drew my attention to the chain of communication between the previous representatives and the applicant company and commented that there had been no direct contact, this is very similar to the *Genius* case. At page 747, line 15, the Hearing Officer stated:-

“Mr. Gee’s declaration, put succinctly, sets forth to justify the granting of the extension of the time on the basis that the applicants had not been properly or fully instructed as to the need for filing evidence in support of their application in order to counter the evidence of the opponents. He declares that “the reason no evidence has been provided by the Applicant was not due to any disinterest in pursuing this application on their part, but because of a complete breakdown in the chain of communication between the former U.K. and Taiwanese Agents and the Applicant, for reasons unknown to the Applicant. This situation only became apparent to me when I was able to take instructions directly from the Applicant’s principals.” Mr. Gee also mentions geographical and language difficulties.

Behind Mr. Gee’s argument there is a presumption that the applicant arrogates all responsibility for his application to his agent, that he does not have a duty to make sure that the proceedings are prosecuted diligently. I do not consider that this view is correct. The parties in proceedings do have a responsibility in relation to the progressing of the proceedings as much as their representatives. I also consider that the position of Mr. Gee is contradictory to the SAW case (1996) RPC 507, which in many ways deals with similar circumstances to the matter in hand.

At page 509 lines 8-19 Jacob J states:

“In my judgement no reasons were put forward to explain the conduct of these **applicants** (*my emphasis*) during at least most of the six months period. A firm called Pickering Kenyon wrote to the Registrar on 20 December 1994 saying that they now acted for the opponents and:

“We learned on December 16, due to a breakdown in communication between ourselves and our clients and their intermediaries that evidence for this opposition had to be filed as a matter of urgency.”

That makes it abundantly plain that the matter had only just become urgent and that the explanation offered does not in any way deal with why that happened.”

As I have emphasised in the text Jacob J. refers to the applicants, not to their current or quondam representatives.”

In looking at the wording of the latest request for extension of time the current representatives state that they need to examine the archived materials of the applicant company, this implies that this had not been done and is confirmed by the comment in the submissions that there had been

no direct contact between the applicant company and previous representatives. This does not demonstrate any diligence on the part of the applicant company and is compounded by a reference to the difficulties experienced by the applicant company as the request was filed during the soccer close season when they have a reduced staffing level. A generous view would be that the applicant had already had a period of nine months in which to carry out this activity and most of that period was during the soccer season when the applicant would presumably have been fully staffed.

Additionally the request goes on to state that they need to see how the mark is used on a match day, and that could not take place until the next soccer season commenced in mid August 2000. However, the relevant date for these proceedings is the date of application, 24 April 1997, and what is done on match days during the 2000/2001 soccer season has no bearing on these proceedings.

Taking all this into account, but principally the period which had elapsed during which the applicant could file evidence, in a generous light nine months or a more critical light fourteen months, and the apparent lack of diligence on the part of the applicant with regard to these proceedings, I overturned the preliminary decision and refused the requested extension of time.

Dated this 19th. day of March 2001

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

**Lloyd
Wise**

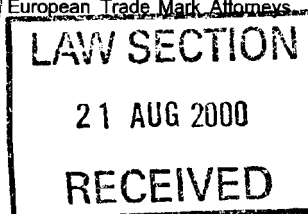
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Our Ref: ACR/SS/M9157 *

The Registrar,
The Trade Marks Registry,
The Patent Office,
Newport,
Gwent.

17th August, 2000.

Dear Sir,

re. Application No. 2130740 in the name of Tottenham Hotspur Plc
and Opposition thereby Patricia Hard O'Connell and Michael O'Connell
Opposition No. 47905

We refer to the request for extension filed on Form TM9 on 24th July, 2000 by the new attorneys for the applicants and also to your letter of 3rd August granting that extension. You have also granted a period of fourteen days until today for the Opponents to object and to provide full written arguments against the decision.

We have instructions now from the Opponents to object to this extension of time and we will set out below our reasons why we feel that the extension should not be granted. If you feel unable to accept those reasons, then we ask that a Hearing be appointed under Rule 54(1).

At the outset it is probably useful to detail some of the history of this opposition. A notice was filed and a Counterstatement was filed, of course, very quickly. This was then followed, with admittedly some delay, by the filing of the Opponents' evidence. However, as was made clear in all requests for extensions of time at that time, there were very active negotiations proceeding between the parties. These went so far as the production of draft settlement documents. For reasons that are not relevant here, those negotiations did not achieve success. As a result, the Opponents then quite quickly filed their evidence.

There was some slight delay after the Opponents' evidence was filed before a term was set for the Applicants to file their evidence. In that connection, there were some procedural matters regarding confidentiality. However, the Applicants had all of the Opponents' evidence from the 20th May 1999, and although a formal term appointing the term for filing evidence in reply was not officially set until 25th October, in fact there were no changes in the evidence and therefore no surprises in the evidence and the Applicants could reasonably have been expected to have started their preparation of their evidence from the 20th May, 1999.

The Registrar.

17th August, 2000.

The Applicants then asked for a first extension of time on 25th January, 2000 and the Opponents raised no objection to this. At that stage, we were told that a main declaration was in the course of preparation but more time was needed to get full figures and that the Applicants were identifying additional witnesses.

On the 13th April 2000 a further extension of time was requested and again the Opponents took no exception to this. The Applicants said they had produced some evidence but needed more time without really explaining what evidence they had achieved and that they still wanted to locate independent witnesses. Further they felt that they needed to examine the correspondence referred to Exhibit PM4 but at this stage of course they had been aware of that Exhibit for eleven months and appeared to have done little about it up to that point.

On the 24th July 2000 new attorneys for the Applicants applied for an extension of time. We fully accept that the transfer to the new attorneys would have caused some disruption and of course that the new attorneys might need time to consider matters. However, they are now saying in their extension request that they need time to "compile the necessary evidence in support of the application". It is not entirely clear what this means. One possible inference from that wording is that they are now starting the preparation of the evidence from scratch and to some extent this is reinforced by their comment that they also need to see how the mark is used on match day and that they need to look at the archives of the Applicants. Surely there has been sufficient time before the new attorneys took over for those archives to have been fully examined since after all there was the period from the 25th October, 1999 through to July to do this and as we pointed out above, in fact, there was the period from May 1999 to July 2000 to do this.

The Case Law and Practice of the Office supports our objection to an extension of time.

In particular, the Opponents will wish to point to the case of *R. v. The Registrar of Trade Marks ex parte S.A.W. Company S.A.* 1996 RPC page 507. It is very apt to note there that Judge Jacob indicated his approval of the Registrar's remarks appearing on page 509 lines 29 and 30 that

"It is relevant as to what the party did during the period allowed for the filing of evidence, not what they did subsequently".

Accordingly, the implication that very little preparation has taken place during the previous attorneys' handling of the case is we submit fatal to the current extension of time.

In the case of *A. J. and M. A. Levy's* trade mark 1999 RPC page 291, the point was made that there were no signs that active steps had been taken to prepare the necessary evidence prior to the seeking of extension. The history as we have set out above suggests that there is considerable doubt as to what evidence was prepared prior to the present extension of time.

In the *LIQUID FORCE* trade mark 1999 RPC at page 429 it can be inferred that even on-going negotiations, which is not the case here, do not relieve an Opponent of its obligations to be preparing evidence. Also it was notable here that the appointed person felt that since

The Registrar.

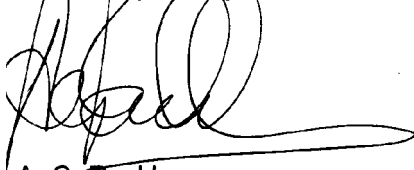
17th August, 2000.

there were no surprises in the Counterstatement one could in effect consider that right from the time of filing the Statement, the Opponent in that case could have started his preparation of the evidence. This is very similar to the situation which arose in the present case which was that the Applicants had the Opponents' evidence in May 1999 and could have started their preparation of the evidence from that date rather than the date which was officially appointed in October.

Finally, in GENIUS trade mark 1999 RPC at page 741 the Registrar's discretion for extending time was explained and the comments of Judge Jacob referred to above were noted with approval that no reasons had been put forward to explain the conduct of the Applicants in the earlier parts of their time period. Here in the present case we are faced with something which appears to be quite contradictory and unclear as to whether a serious attempt to prepare evidence had been made before the present attorneys took over the handling of the case and we submit that if no serious preparations had been taking place then that is fatal to any current application for extension of time.

In all the circumstances, therefore, we ask that the extension now be refused, or alternatively that a Hearing be appointed as requested.

Yours respectfully,



A. C. Rackham
Lloyd Wise, Tregear & Co.

cc. Trade Mark Owners Association Limited