

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2298378
in the name of Calor Gas Limited and in the matter
of Opposition No. 91039 thereto by Scottish and Southern
Energy Plc**

BACKGROUND

1. On 19 April 2002 Calor Gas Limited applied to register SWALEGAS as a trade mark for the following goods and services:

Class 4

Fuels; fuel gases; liquefied fuel gases.

Class 6

Containers for gas; valves; parts and fittings therefor.

Class 11

Gas powered and gas utilising apparatus, equipment and installations; apparatus and installations for lighting, heating, cooking, refrigerating, drying, cooling and air conditioning, all being gas operated; gas pressure regulators and gas valves; parts and fittings for all the aforesaid goods.

Class 35

The bringing together for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from gas showrooms or general retail, electrical or hardware stores; from a general merchandise catalogue by mail order and from a general merchandise Internet website.

The application was accepted and published for opposition purposes on 29 May 2002.

2. On 29 August 2002, Scottish and Southern Energy plc, filed a notice of opposition along with a statement of grounds in support of the opposition. The Form TM7 and statement of grounds was served on the applicant on 9 September 2002 and the deadline for the applicant to file a Form TM8 and counter-statement was set at 9 December 2002. No Form TM8 and counter-statement or request to enter into the cooling off period was received within the period allowed.

3. On 9 January 2003 the applicant was informed that as no Form TM8 and counter-statement was received within the period allowed the application would be deemed withdrawn in accordance with Rule 13(6) of the Trade Marks Rules 2000.

4. On 17 January 2003, the applicant, through their representative AA Thornton & Co., submitted in writing that due to a misunderstanding the request to enter into the cooling off period was not filed before the deadline of 9 December 2002. They explained that they wrote to Fitzpatrick's, the opponent's representative, on 2 December 2002 asking them whether their client would jointly enter into a cooling off period. Fitzpatrick's responded on 4 December 2002 agreeing to enter into the cooling off period and providing them with the countersigned request. (A copy of that request was attached).

5. AA Thornton & Co. went on to say that they thought that the countersigned request was a faxed copy of the original and that it had been filed by Fitzpatrick's at the Registry and that they misunderstood the covering letter from Fitzpatrick's such that the request had not been filed

6. AA Thornton & Co. asked that the proceedings be allowed to proceed and the cooling off period granted. They referred the Registrar to Rule 68(7) of the Trade Mark Rules 2002, which states:-

“Without prejudice to the above, in the case of any irregularity or prospective irregularity in or before the Office or the registrar which –

- (a) consists of a failure to comply with any limitation as to time or periods specified in the Act or 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) is attributable wholly or in part to an error, default (their emphasis) or omission on the part of the Office or the registrar and which it appears to her should be rectified,

she may direct that the time or period in question shall be altered in such a manner as she may specify upon such terms as she may direct.”

7. They go on to submit that there had been a default on the part of the Office and state that a “default” is a pre-set course of action. Rule 13(6) requires the Registrar to automatically deem an application withdrawn where a notice and counterstatement are not filed within the period prescribed by Rule 13(3), i.e. the application in question had been refused by the default of the Office.

8. In this case, both parties had intended to enter the cooling off period and this intention was formed prior to the deadline of 9 December 2002. The effect of refusing this application was that Calor Gas Limited will file another application for the same mark and further opposition proceedings are likely to be filed. The proceedings will therefore be duplicated (time and cost to both parties). They submit that this cannot be the intention of the rules or in line with the Woolf report where the overriding objective of the reforms is that justice is to be achieved through the recognition of the principles of equality, economy, proportionality and expedition.

9. In view of the foregoing AA Thornton & Co. submitted that it would be equitable to re-instate the application and to grant the cooling off period.

10. The Registrar responded on 20 January 2003 stating that in accordance with Rule 68(3) of the Trade Marks Rules 2000 the Registrar had no discretion to extend the periods in question, that is, the period for the filing of a Form TM8 and counter-statement as set out in Rule 13(3) or the period for filing a Form TM9c as set out in Rule 13(4). The Registrar also stated that Rule 68(7) allowed the Registrar to extend a time period in cases where an error, default or omission had occurred, none of which applied in the present case. Therefore, Rule 68(3) applied and the application would be deemed withdrawn in accordance with Rule 13(6).

11. In response to the Registrar's letter of 20 January 2003 AA Thornton & Co. filed a statement of grounds to appeal against the decision.

12. On 24 February 2003 the Registrar informed AA Thornton & Co. that in order for an appeal to be processed the appellant must, in accordance with Rule 62(2), obtain a full statement of the reasons for the decision. The Trade Marks Registry went on to state that the letter of 20 January 2003 was not considered to be such a statement of reasons for the decision and if AA Thornton & Co. wished to appeal the decision they should first file a Form TM5 requesting a statement of the reasons for the decision.

13. On 28 February 2003 AA Thornton & Co. filed a Form TM5 requesting that the Registrar give a statement of grounds of the decision. This I now do.

DECISION

14. The opponent's Form TM7 and statement of grounds was correctly served upon the applicant on 9 September 2002. The applicant was invited to file a Form TM8 and counter-statement if they so wished, to defend the application for registration. The period for filing the Form TM8 and counter-statement is governed by Rule 13(3) of the Trade Mark Rules 2000 which states:

“13(3) Subject to paragraphs (4) and (5) below, within three months of the date on which a copy of the notice and statement is sent by the registrar to the applicant, the applicant may file a counter-statement, in conjunction with notice of the same of Form TM8; where such a notice and counter-statement are filed within the prescribed period, the registrar shall send a copy of the Form TM8 and counter-statement to the person opposing the application.”

15. The three month period set under Rule 13(3) is subject to the provisions of Rules 13(4) and 13(5) which state:

“13(4) Subject to paragraph (5), at any time before the expiry of the period prescribed in paragraph (3) above for filing of Form TM8 by the applicant the registrar may, on request, grant an extension of three months to that period where

such request is filed on Form TM9c and with the agreement of both the applicant and the opposing party (the “cooling off period”); the registrar may, on request, extend the cooling off period for a further three months where such request is filed on Form TM9c and with the agreement of both the applicant and the opposing party.”

“13(5) Within one month after the expiry of the cooling off period the applicant may file a counter-statement, in conjunction with notice of the same on Form TM8; where such a notice and counter-statement are filed within that one month period, the registrar shall send a copy of the Form TM8 and the counter-statement to the person opposing the application.”

16. No Form TM8 and counter-statement was received from the application within the period set out in the letter of 9 September 2002. Nor was a request received from either party to enter a cooling off period.

17. Under the Trade Marks Rules 2000, provision is made for the alteration of time periods in a limited set of circumstances. These are set out in rule 68, which states:

“(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), rules 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 opposition).

- (4)
- (5)
- (6)
- (7) Without prejudice to the above, in the case of any irregularity or prospective irregularity in or before the Office or the registrar which –
 - (a) consists of a failure to comply with any limitation as to times or periods specified in the Act or 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) 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 should be rectified,she may direct that the time or period in question shall be altered in such manner as she may specify upon such terms as she may direct.”

18. Rule 68(3) above sets out an exhaustive set of circumstances in which the time periods for particular acts may not be extended. The period allowed to file a Form TM8 and counter-statement (Rule 13(3)) and the period to file a request to enter into the cooling off period (Rule 13(4)) are excluded by that rule for extensions of the prescribed period.

19. Rule 68(7) does make provision for the registrar to alter a period if she is satisfied that there has been an error which is attributable wholly or in part to an error, default or omission on the part of the Office. In this case there has been no error, default or omission that can be attributed either in whole or in part to the Office, see *M's Application* [1985] RPC 249 and *Mills Application* [1995] RPC 339. The applicant in their letter of 17 January 2003 state that “the both parties had intended to enter the cooling off period”. The fact that the parties to the proceedings did not file a request to enter into the cooling off period cannot, in my view, be attributed as an error, default or omission of the Office. Default implies some failure to do something on the part of the office; I can see no such failure in this case.

20. In reaching this view I have also taken into consideration the comments made by the Hearing Officer in *Monster Munch Trade Mark* 1997 R.P.C. 721. In this case the Hearing Officer held that the power to correct an irregularity in procedure was governed by Rule 60(2) of the Trade Marks Rules 1994 and was limited to irregularities which the Patent

Office. The wording of Rule 68(7) of the Trade Marks Rules 2000 mirrors that of Rule 60(2) of the Trade Marks Rules 1994 and therefore should be applied in the same manner as that rule.

21. The Registrar has no discretion in the matter and cannot invoke Rule 68(7) to alter the period allowed for the applicant to file either a form TM8 and counterstatement or a request to enter into the cooling off period. The application for registration must therefore be deemed withdrawn in accordance with Rule 13(6) of the Trade Marks Rules 2000.

Dated this 14TH day of August 2003.

**Sally Long (Mrs)
For the Registrar
the Comptroller-General**