

O-165-07

TRADE MARKS ACT 1994

IN THE MATTER OF an interlocutory hearing
in relation to application No. 2376138
in the name of Kathy Pavey and Julian Fidler (a Partnership),
trading as Synergy Employment Law
and opposition No. 94119 thereto
by Synergie (Societe Anonyme)

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Background

1. Application No. 2376138 is for the trade mark Synergy and was applied for on 20 October 2004 by Kathy Pavey and Julian Fidler (a Partnership), trading as Synergy Employment Law. The application as published showed that the applicants were represented by a firm called Be, at a London address. The application was published on 4 November 2005 and notice of opposition was filed against the application on 3 February 2006 by Synergie (Societe Anonyme). The proceedings followed the usual course with the filing of a Form TM8 and counterstatement in defence by Be, this time from a Brighton address. A chronology of events and clerical errors leading up to the hearing follows.

2. A preliminary indication, under rule 13B(4) of the Trade Marks Rules 2000 (as amended) was issued by the Registrar on 5 June 2006 which was sent to the London address. The opponent filed a Form TM53 on 16 June 2006 to continue the proceedings, brought solely under section 5(2)(b) of the Trade Marks Act 1994. Within the statutory period of three months allowed under rule 13C(1)(a), the opponent filed its evidence-in-chief, on 27 September 2006. It sent this to the Registry and to the applicants, initially to the applicants' London address and subsequently to the Brighton address. The Registry set the statutory time period, under rule 13C(4), for the applicants to file their evidence. This expired on 28 December 2006.

3. The applicants' representative, Be, filed a Form TM9 to request an extension to this time period on 22 December 2006. The reason given was:

“Our principle client has been unavailable throughout the period for evidence preparation on maternity leave. She hopes to return to work in the New Year and we have a conference with Counsel booked for January to progress this matter.”

No fee accompanied the form. The Form TM9 asks, in box 2:

“Is this request for a trade mark:
(a) application which has not had a hearing;
(b) application which has had a hearing; or
(c) which is in dispute, for example, under opposition, invalidation, revocation, or rectification”.

There are explanatory footnotes on the form, the first of which says:

“1. There is no fee if this request is for an application for a trade mark which has not had an ex parte hearing, that is, if you answer (a) to question 2. The fee is £50 if the application has had an ex parte hearing or is in dispute, that is if you answer (b) or (c) to question 2.”

The applicants’ representative answered “a”, presumably because the application had not had an ex parte hearing. Following the logic of that choice, it sent no fee with the form. It is unfortunate that it did not answer “c” and follow the logic of that choice as set out in the explanatory note.

4. The immediate consequence of the failure to file a fee with the Form TM9 was that the Registry wrote to the applicants’ representative, Be, on 11 January 2007 regarding the deficiency. It sent this letter to the London address. On 16 January 2007, the applicant’s representative filed the requisite fee of £50, together with a letter in which it pointed out that its address had changed to the Brighton address. It also said that its instructing client was still on full maternity leave but had attended a conference with Counsel the previous week to progress the finalisation of the applicants’ evidence. Further, that the opponent’s evidence was voluminous which required detailed consideration and significant time in which to do this. Finally, the letter said that every effort was being made towards the speedy completion of the applicants’ evidence.

5. It is apposite for me to mention, at this point, that the Trade Marks Registry recorded a Form TM33 on 25 May 2006. A Form TM33 is to record an appointment or change of agent or contact address. When the application was published, the address appearing in the Trade Marks Journal entry for Be was “183 Swaton Road, London, E3 4EP.” The representative is still Be, but at a different address: “42 Devonshire Place, Brighton, East Sussex, BN2 1QB, United Kingdom”. The electronic register shows that the Form TM33 concerned this change of address which took place a week after the filing of the Form TM8 which also showed the Brighton address. It appears that the Trade Mark Registry did not update its file until Be wrote its letter of 15 January 2007 (received at the Registry the following day) regarding the deficient Form TM9.

6. The Registry, in a letter of 23 January 2007 (sent to the correct, Brighton, address) was satisfied with Be’s explanation for the error on the Form TM9 and admitted the form as a retrospective request for an extension of time under rule 68(5). However, it was not satisfied that the reasons given for the request itself were sufficient to grant the extra time requested - three months to 28 March 2007- and gave a preliminary view to refuse the request. Be responded in a letter dated the 6 February 2007, attaching witness statements from Kathy Pavey and Julian Fidler, the applicants. I will address the witness statements later in this statement of grounds. The covering letter made several points, the most relevant of which were:

- (i) the opponent’s evidence was only received on or about 20 October 2006 (the evidence was received in the registry on 28 September 2006) “due to it originally being sent to our previous address in East London as a result of a misunderstanding between the professional

representatives in this matter”. It was therefore only available for review by the applicants after Ms Pavey had already started her maternity leave on Monday 23 October 2006;

- (ii) the opponent’s evidence runs to about 420 pages and significant time was required to review and answer it;
- (iii) the applicants are the only two partners in a small, specialist law firm with extremely limited time to devote to evidence preparation; Ms Pavey’s maternity leave has put great strain upon Mr Fidler’s workload for a temporary period which coincides with the time allocated to prepare the evidence;
- (iv) Counsel (Mark Engelman) had been instructed and consulted and progress was being made towards producing the evidence within the requested time;
- (v) if the preliminary view was to be maintained, the applicants requested a hearing, adding that time and resources would be better spent in finalising the applicants’ evidence.

The applicants requested to be heard in the event that the extension request was not allowed.

7. The opponent’s representative, Claire Lazenby also wrote to the Registry on 6 February 2007 to say that once she had become aware that Be had been writing to her practice on letter headed paper which was out of date, i.e. showing the old, London, address, she moved very quickly to ensure a copy of the opponent’s evidence was sent to them again. She submitted that on 26 May 2006 she had written to Be at the Brighton address because that was what was showing on the official Registry database. On 5 June, Be replied from a London address. She sent the evidence on 27 September 2006 to the London address as this had now become the most recent address she had on her file for Be. Ms Lazenby attached the original of the recorded delivery note from Royal Mail to show that the evidence was sent by recorded delivery on 27 September 2006 to the Swaton Road (London) address. On 16 October 2006, Royal Mail informed Ms Lazenby that it had been unable to deliver the evidence to the London address; she says she immediately wrote and faxed Be at all the addresses she could find for them to ask where they wanted the evidence sent to. Be replied from their Brighton address on 17 October 2006 and Ms Lazenby sent the evidence there on 18 October 2006. She also objected to the extension of time request, not for the procedural irregularities, but for the reasons advanced in support of the request.

8. The parties were notified in a letter dated 1 March 2007 that the hearing would take place via the video conference link on Thursday 15 March at 10.30am. Ms Lazenby asked for it to take place by telephone, to which I had no objection and no objection to that seems to have been made by Be, the applicants’ representative. Be however did write to the Registry on 6 March 2006 asking for a fuller explanation of the Registrar’s reasoning for refusing the extension request, ahead of the deadline for submitting skeleton arguments, which was 13 March 2007. I note that the Registry,

regrettably, again used the London address for the hearing notification, but it is obvious from the letter from Be of 6 March 2007 that they received the Registry letter of 1 March 2007. Earlier correspondence mentions redirection arrangements from Royal Mail.

9. The Registry replied to Be's enquiry on 7 March 2007, saying (in summary):

- (i) the Registry has to be satisfied that diligent efforts have been made in the three months allowed to produce evidence; reasons for the delay and also what further action is required need to be submitted;
- (ii) the fact that Be did not receive the evidence on time is not an issue for the Registry to consider; the onus was on Be to keep records updated;
- (iii) maternity or other type of leave is not an issue for the registry, and neither are internal staffing problems or the small size of a firm issues for the Registry to consider;

10. Claire Lazenby, acting for the opponents, submitted her skeleton arguments as required by the deadline on the afternoon of 13 March 2007, two days before the hearing. On this day, Be also filed skeleton arguments for the applicants. In its covering letter, Be informed the Registry Hearings Clerk that the applicants would be represented by Counsel. I mention this for the following reason. The letter to the parties of 1 March 2007 regarding the arrangements for the hearing expressly said "the Registrar should be informed immediately if Counsel are attending the Hearing". This plainly did not happen. I had already consented to the hearing taking place over the telephone by the time I was informed that the applicants would be represented by Counsel and that not only was I to conduct the hearing by telephone from Newport with Ms Lazenby and Mr Engelman (Counsel) in two different locations, but that Ms Clare Griffiths of Be, in a fourth location, also wished to be present by telephone at the hearing. If it had not been so late in the day, it would have been preferable by far to have conducted the hearing by video conference as originally planned; however, I did not deem it to be so inconvenient that it was necessary to rearrange and thereby protract the proceedings even further. The main point about this is that the request by Be for this statement of grounds was accompanied by an enquiry from Mark Engelman, via Be, as to the existence of a verbatim report of the hearing. There was no transcript because it was not apparent, until it was too late to change the arrangements for the hearing, that Counsel was representing a party (a stenographer is not automatically appointed even then).

11. The hearing took place before me on 15 March 2007 at 10.30am by telephone conference. The applicants were represented by Mark Engelman, with his instructing client (Be) in attendance also, but from a different location. The opponent was represented by Claire Lazenby. I wrote to the parties on the same day to give my decision, following receipt of some documents which the parties wished to disclose prior to reaching my decision. The substance of my letter said:

"Mr Engelman listed some nine or so factors for me to consider. He submitted, both in skeleton argument and at the hearing, that the overriding

objective indicates that it would be just and equitable to allow the extension because the circumstances of maternity leave in a small firm is a reasonable explanation for the lack of progress made in the initial statutory period allowed. The evidence from the opponent was not received by the applicant until nearly a third of the allotted time had passed. The evidence had been sent to the Registry (it was received the day before the hearing) and should be available for the Hearing Officer determining the substantive ground in order for him to adjudicate fairly. The applicant had attempted to get the opponent to consent to the extension request prior to filing it formally. The opponent had not complained of any prejudice. Mr Engelman also referred to a meeting between Julian Fidler and Be of 19th December 2006, which was not mentioned in the papers on file.

Ms Lazenby submitted by way of her skeleton argument and at the hearing, that the applicants had not shown due diligence or a sense of priority in their management of the case. In the witness statement of Kathy Pavey of 6 February 2006, she said that she would turn her attention to the matter in March 2007, three months after the end of the statutory period for filing evidence, and there did not appear to have been any action until then, resulting in the recently filed witness statements. Ms Lazenby pointed out that paragraph 6 of the said witness statement said that even if the opponent's evidence had been received on time, the applicant would not have dealt with it. Ms Lazenby questioned why Kathy Pavey had not sought to hand over this matter as part of her caseload before she went on planned maternity leave. Further, that the applicant's professional representative, Be, had received a letter from the Registry sent on 6 October 2006 confirming receipt of the opponent's evidence, but that there had been no enquiries from the applicant or their representative as to where it was. Ms Lazenby said that all the explanations were of inactivity; rather than spending the time producing witness statements about inactivity, the time could have been spent putting together evidence. As it was drafted, each document could have been shown the Registry as evidence that progress was being made. If information that drafting was underway had been forthcoming earlier, Ms Lazenby would not have objected to the extension request.

I have considered the papers before me and the oral arguments. I asked Mr Engelman about the December 2006 meeting between Julian Fidler and Be; I wished to know what the substance of that meeting was. Ms Griffiths, of Be, who also attended the telephone hearing, said that it was not a face-to-face meeting, but a lengthy telephone conversation. I did not get an answer to my question about the substance of the meeting. Three days later, the Form TM9 was filed. My conclusion from that is that no progress was made up until that time, beyond a decision to ask for extra time so that evidence would be filed in March, as Ms Pavey had said in her witness statement. Nothing had been done in that first three months and I do not believe that exceptional circumstances existed whereby no preparatory work could have been made and revealed as part of the extension request. I have borne in mind the various case law references made during the course of the hearing; particularly *A.J. and M.A. Levy's Trade Mark*, *Liquid Force Trade Mark*, *Muslim Parliament*

and *S.A.W.* regarding inactivity and the filing of evidence shortly before the hearing.

I have decided to maintain the preliminary view to refuse the extension of time request. The consequence of my decision is that the applicant has not filed its evidence under rule 13C(4) of the Trade Marks Rules 2000 (as amended). The case will now proceed to main hearing stage, with both sides being afforded the opportunity to make written and/or oral submissions, depending on whether the parties elect for a decision from the papers or an oral hearing.

Costs

I direct that the applicant pay to the opponent the sum of £200 as a contribution towards the costs of this hearing.

This letter does not contain a full statement of reasons for this decision. If either party wishes to appeal the decision, they should file a Form TM5, together with the requisite fee (£100), requesting a statement of reasons within one month of the date of this letter.”

The applicants filed and Form TM5 on 28 March 2007 seeking a full statement of the reasons for my decision. This I now give.

The skeleton arguments

12. Prior to the hearing, I received skeleton arguments from both sides. In summary, Mr Engelman (for the applicants) said:

The Form TM9

- (i) that on 22 December 2006, the applicants had requested from the opponent agreement to an extension of time and that the opponent had purported to fail to understand the request and also refused the request. The applicant then, on the same date, filed the Form TM9, citing its reasons for the request as Kathy Pavey’s maternity leave and an intended conference with Counsel;
- (ii) the Form TM9, being ambiguous, needed amending and was filed with the fee outside the period. The delay arose because the Registry letter was sent to the applicants’ agent’s previous London address and not its then current Brighton address;
- (iii) the Registry said that the TM9 had been filed within the period but because the applicant had not paid the fee and had incorrectly filled in box 2 of the Form, the filing date took place outside of the period: Mr Engelman submitted this was wrong;
- (iv) the failure to pay the fee was not delay but a misunderstanding of the wording of the “new” Form TM9: “this was an application ‘which has

not had a hearing' as per (a) but might also and ambiguously be construed to fall within (c)";

- (v) the Schedule to the Trade Marks (Fees) Rules 2000 does not specify that a fee should be paid and does not distinguish between Rule 68(2)(a) and (b). The wording of Box 2 of Form TM9 is ambiguous and any failure should not affect the timing of its filing.

The Filing vs Service Issue

- (i) a dispute arose between the parties as to the date of serving rather than the date of filing of the opponent's evidence, a "serious" delay having occurred between the date the opponent filed its evidence and the date it served it: the period covering 27 September 2006 to 18 October 2006.
- (ii) the Rules do not accommodate for the service of evidence but merely the filing of it; given the importance of service, it was incumbent upon the opponent to ensure it had effected service, because the applicant would never have known.

The Extension of Time Request

- (i) Cases cited: *A.J. & M.A. Levy's Trade Mark* [1999] RPC 291; *LIQUID FORCE Trade Mark* [1999] RPC 429; *R v Registrar of Trade Marks, ex parte SAW Company SA* [1996] RPC 507; *Finnegan v Parkside Health Authority* [1998] 1 WLR 411 and *Mortgage Corporation Limited v Sandoes* [1996] TLR 751; *Genius Trade Mark* [1999] RPC 741. The absence of a good reason is not always sufficient to refuse to extend time (Liquid Force); the request is an indulgence; the applicant should show what he has done; what he wants to do and why he has not been able to do it; and where exceptional circumstances arise the application should be granted even where the applicant did not act diligently.
- (ii) it is a first extension request and all the relevant evidence was now before the registry [in fact, the evidence was not received at the registry until the day before the hearing];
- (iii) the applicants had shown what they had done; Kathy Pavey gave birth on 14 November 2006, shortly after the opposition evidence was received and there were insufficient staff in the applicants' company to deal with it instead of Ms Pavey;
- (iv) if the extension of time request had been granted (until 28 March 2007), the applicants' evidence would have been filed in time (received on 14 March 2007) – this shows diligence;
- (v) the circumstances are exceptional because the failure to file the fee was a misunderstanding of the wording of the Form TM9; the Rules/Act as

drafted do not contemplate the Form TM9 in its current form; the applicants' evidence was received late into the period and their reasons for an extension are wholly understandable.

13. In summary, the contents of Ms Lazenby's skeleton argument were:

- (i) there is no automatic entitlement to any time beyond three months: it is the exceptional rather than the normal case where extensions will be granted (*The Muslim Parliament of Great Britain Trade Mark, O/481/00*);
- (ii) this applies all the more so when a request is made under rule 68(5): discretion plays a bigger part than under rule 68(1);
- (iii) the applicants cannot meet the first leg of the well-known three part test of "what the applicant has done, what he wants to do and why it is that he has not been able to do it;
- (iv) the 6 February witness statements are of inactivity during the first three month period ending in December 2006: "I considered that I would therefore be able to deal with this during the month of March";
- (v) being a small business is not a 'relevant circumstance' (*OLD BIKE MART, O/370/00*). A sudden illness in a small business might be a relevant circumstance, but maternity leave is not sudden;
- (vi) the overall picture is that this was not a priority for the applicants who are solicitors, aware that the overriding objective requires active case management;
- (vii) there is also the public interest to consider;
- (viii) the opponent seeks refusal of the request and an award of costs, regardless of the outcome of the interlocutory hearing.

The hearing and submissions

14. Before commencing the hearing, I sought to establish that the matter was restricted solely to the reasons advanced for the extension of time request, not the admissibility of the request itself, as Mr Engelman's skeleton argument covered both areas. The parties agreed that the hearing was in respect of the reasons for the request only; in essence, whether it was just and equitable to grant it since it was a request made out of time under rule 68(5).

15. Despite having established the above, Mr Engelman gave me a list of considerations which included reasons as to why the Form TM9 had been incorrectly filed. The considerations which he asked me to bear in mind were:

- the nature of the TM9
- the genuine attempt to fill in the Form TM9 correctly
- the late service of the opponent's evidence
- it was the first extension request
- small business (referring me to *YOUNG BOND Trade Mark, O/315/05*)
- the refusal of the opponent to consent to the applicants' extension request
- the evidence was now before the Registrar
- no prejudice had been claimed by the opponent
- the maternity leave of Kathy Pavey .

Mr Engelman illustrated each of his points with the case law referred to in his skeleton argument. Citing *A.J. & M.A. LEVY*, Mr Engelman said that all factors had to be taken into account. The explanation for the lack of activity in this case is the maternity leave and that explanation is reasonable. It is unnecessary that actual progress has been made; simply that the explanation is reasonable.

16. Mr Engelman then mapped out a timeline of events, not all of which were evident from the papers on the registry file. He said that in August 2006, Kathy Pavey had gone to Be for a meeting. On 28 September 2006 the opponent's evidence was received at the registry and on 16 October 2006, "or thereabouts", this evidence reached Be. On 23 October, Kathy Pavey went on maternity leave. On 19 December, Julian Fidler, Ms Pavey's business partner, had a "lengthy" conversation with Be. On 22 December 2006, the extension of time request was filed. Mr Engelman said that Be had tried to get 'consent' to the extension of time request from the opponent, but that it was not forthcoming (copies of letters showing this exchange were sent to me after the hearing). Mr Engelman referred me to *Mortgage Corporation Limited v Sandoes* [1996] TLR 751 in this respect. It seemed to me to confuse the issue, there being a lack of understanding on the part of the applicants as to the difference between an extension of time request and a request for a stay of proceedings.

17. At this point in the hearing, I asked Mr Engelman what the substance of the meeting was between Julian Fidler and Be on 19 December 2006, to which he had referred. It seemed to me that it was of some importance to establish what steps, if any, were taken at that point to progress the applicants' evidence-gathering. There was some confusion between Mr Engelman and Claire Griffiths (of Be) as to whether it was a face to face meeting or a telephone one, but Ms Griffiths confirmed it had taken place over the telephone. I did not get an answer to my question as to the substance of the conversation, but have to conclude, on the balance of probability, that since a) it took place over the telephone and b) the extension of time request was filed three days later (six days before the deadline for evidence), that it is unlikely that evidence was being formalised and that it is likely that a decision was taken to ask for extra time to deal with the issue later, perhaps in March 2007, as mentioned in Ms Pavey's witness statement.

18. My attention was drawn to several authorities, some in rebuttal of those cited by Ms Lazenby in her skeleton argument. Concerning justice and prejudice, I was referred to *Finnegan v. Parkside Health Authority* [1998] 1 WLR 411, *Sandoes* and *Genius Trade Mark* [1999] RPC 741. Ms Lazenby had referred to *TELSTRA Trade Mark, O/370/00*, in which it was the paternity leave of the attorney, not the client which had delayed matters and *OLD BIKE MART, O/370/00* where it was the

attorney, not the client who caused a delay in proceedings by being out of the country on business. I did not feel that either of these cases was of great relevance; whilst the circumstances might seem superficially similar, each case turned on its particular facts and they did not, in my opinion, lend themselves to the extraction of general procedural principles. I was also referred to *YOUNG BOND Trade Mark*, 0/255/06, a case concerning a small firm overrun by litigation. The circumstances of the applicants in the present case are not on all fours with this case either. Mr Engelman concluded his submissions by reminding me that a third of the statutory period of three months had expired by the time the applicants received the opponent's evidence in chief.

19. Ms Lazenby said that it was plain that the applicants showed a lack of commitment/sense of priority in waiting until March 2007 (i.e. three months after the expiry of the initial statutory three month period) to file any evidence at all. She pointed out that this is exactly what they said they would do in paragraph 6 of Ms Pavey's witness statement of 6 February 2007. There also had not been any information about the timeline and meetings until Mr Engelman had mentioned them: no information had previously been given about progress in November or December. All the activity appeared to have been recent; it would have been preferable if the applicants had kept the registry informed as to progress, perhaps sending drafts of documents as they were prepared in order to show progress made. Ms Lazenby, referring to the two witness statements of Kathy Pavey and Julian Fidler, dated 6 February 2007, said that the explanations given in these as to the need for more time were all regarding inactivity and that the time would have been better spent preparing evidence for the case, rather than these witness statements.

20. Ms Lazenby submitted that the applicants' representative should not have used old letter-headed paper to write to her. She had thought that they had moved from Brighton to London because the London address was on the most recent correspondence (dated 5 June 2006) which she had received from them prior to her filing the opponent's evidence. Ms Lazenby further submitted that Be should have realised that the evidence had been filed and that they had not received it because they received a letter from the registry on 6 October 2006 acknowledging receipt of the evidence. I note that the registry erroneously sent this to the London address, for which the applicants' representative had set up a redirection service. Ms Lazenby sent the evidence to the Brighton address on 18 October 2006 having had a 'failure to deliver' notice from Royal Mail on 16 October 2006.

21. In her view, it was important to consider not only whether the opponent would suffer prejudice if the time was granted but also whether the applicants had acted with diligence. Referring to *LIQUID FORCE Trade Mark*, she said that they had not met the diligence test.

22. Mr Engelman replied that the case was not just about what had or has not been done; it was also about why the action had not been completed and what the applicants wanted to do further. He said that the applicants, swamped by work and the effect of impending maternity leave, would not have looked for the opponent's evidence. I pointed out that the opponent's evidence was not sent direct to the applicants: it was sent to the applicants' professional representative, Be, who would have been in a position to know when they should have received the evidence from

the opponent and to have queried non-receipt. Mr Engelman said that Be was under no obligation to chase the opponent's evidence and that Be was entitled to use more than one address; many firms operate from more than one address.

23. Mr Engelman, citing *SANDOES*, cautioned against the tactical refusal of consent to an extension of time request and that costs should not be awarded to the opponent. As I have mentioned earlier in this statement of grounds, this was not intended to be a stay request, agreed or otherwise between the parties. It was an extension of time request and it was always intended as such, as revealed by the disclosed letters between the parties. I note the letter from Be to Ms Lazenby (22 December 2006) which included the following statement:

“...we thought it preferable to seek your agreement to the extension of time, rather than simply to copy you in on our request to the Patent Office.”

Extension of time requests are a matter for the Registrar's discretion, not a matter for the parties to agree between themselves. Even if parties are content for further time, it is for the Registrar to decide whether the request is merited, bearing in mind the overriding objective.

Decision

24. Alteration of time limits are provided for by rule 68 of the Trade Marks Rules 2000 (as amended). This states:

“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 to 13C, 18, 23, 25, 31, 31A, 32, 32A, 33, 33A 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 13A(1) (time for filing counter-statement), 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(3) (time for filing counter-statement and evidence of use or reasons for non-use), rule 32(3) (time for filing counter-statement), rule 3(6) (time for filing counterstatement), and rule 47 (time for filing opposition). (4) Subject to paragraph (5) below, a request for extension under paragraph (1) above shall be made before the time or period in question has expired.

(5) Where the request for extension is made after the time or period has expired, the registrar may, at her discretion, extend the period or time if she is satisfied with the explanation for the delay in requesting the extension and it appears to her to be just and equitable to do so.

(6).....

(7).....”

25. Rule 68(5) thus has two limbs which must be satisfied for an exercise of the Registrar’s discretion:

- (i) that the reasons for the delay in requesting the extension are satisfactory;
- (ii) that the Registrar deems it to be just and equitable to extend the time period.

In the present case, the first hurdle has been overcome. I therefore had to consider the merits or otherwise of extending the time, bearing in mind current jurisprudence on extension of time requests, the facts of this case itself and the lengthy submissions of Mr Engelman and those of Ms Lazenby at the hearing before me.

26. I heard argument as to what ‘relevant circumstances’ should be taken into account. In context, Geoffrey Hobbs Q.C., sitting as the Appointed Person, said in *LIQUID FORCE*:

“...it is for the party in default to satisfy the court that despite his default, the discretion to extend time should nevertheless be exercised in his favour, for which purposes he could rely on any relevant circumstances.”

The relevant circumstances in this case are the late receipt of evidence from the opponent; the instructing applicant’s maternity leave; and the lack of resources suffered by her colleague, managing their small firm by himself in her absence.

27. The circumstances surrounding the late receipt of the opponent’s evidence are unfortunate, stemming from a combination of the anachronistic letter-headed paper, and a delay in Royal Mail’s redirection of the evidence. The applicant’s representative did not inform the registry of the situation and did not ask for the time for its evidence in support to be re-started. Ms Pavey then went on maternity leave. What arrangements were made to deal with the dispute whilst her planned absence took place? It seems to me that little, if any, arrangements were made and that there was a conscious decision on the part of the applicants to leave the whole matter until March when Ms Pavey planned to return to work. This is borne out by her witness

statement (6 February 2007) in support of the extension request where she says, at paragraph 6:

“Even if the opponent’s evidence had been received on time, I would not have been able to give it due attention, given that during that period I had numerous external meetings and was out of the office on several days...We asked for an extension until the end of March, as I am intending to return from maternity leave at the end of February and considered that I would therefore be able to deal with this during the month of March”.

Ms Pavey’s witness statement runs to 3 pages whilst her colleague’s (Julian Fidler) runs to a little over four pages. His statement was also filed in support of the extension request on 6 February 2006. Both of these statements were therefore filed in the middle of the extra time period sought. I find it surprising that time was spent putting over seven pages of documentary evidence together to support a request for time to file different documentary evidence. It seems to me that it would have been of more benefit to the applicants to have sent in seven pages of evidence in support of their trade mark application instead; showing that progress was being made towards the collation of evidence somewhat earlier than filing it the day before the hearing the following month.

28. There is clear practice guidance on the Office’s website regarding extension of time requests and the criteria to be applied. The Law Practice Direction on “Extensions of time in Inter Partes Proceedings” quotes from the case of *Dr Ghayasuddin Siddiqui v Dr M H A Khan as a nominee of the Muslim Parliament of Great Britain* SRIS O/481/00. In that case, Simon Thorley QC, acting as the Appointed Person said:

- “1. It must always be borne in mind that any application for an extension of time is seeking an indulgence from the tribunal. The Act and the rules lay down a comprehensive code for the conduct of opposition. The code presumes for a normal case and provides for it.
2. There is a public interest which clearly underlies the rules that oppositions and applications should not be allowed unreasonably to drag on.
3. In all cases the registry must have regard to the overriding objective which is to ensure fairness to both parties. Thus, it can grant an extension when the facts of the case merit it.
4. Accordingly, it must be incumbent on the application for the extension to show that the facts do merit it. In a normal case this will require the applicant to show clearly what he has done, what he wants to do and why it is that he has not been able to do it. This does not mean that in an appropriate case where he fails to show that he has acted diligently but that special circumstances exist an extension cannot be granted. However, in the normal case it is by showing what he has done and what he wants to do and why he has not done it that the registrar can be satisfied that granting an indulgence is in accordance with the overriding objective and that the delay is not being used so as to allow the system to be abused.

Jacob J made it clear in the SAW case that any perception that the registrar would grant extensions liberally was wrong and I take this opportunity to repeat that. In principle matters should be disposed of within the time limits set out in the rules and it is an exceptional case rather than the normal case where extensions will be granted.”

29. To my mind, the assertion of Ms Pavey that she was intending to deal with the matter in March 2007, three months after the expiry of the statutory period allowed, thereby doubling the time taken to file evidence, does not satisfy me (in Mr Thorley’s words) “that granting an indulgence is in accordance with the overriding objective and that the delay is not being used so as to allow the system to be abused”. It seems to me that the system was being abused. There was no progress made in that first three months which I regard as lack of diligence on the part of the applicants and their representative, Be. They did not show what they had done in that first three months towards compiling evidence.

30. Crucially, within that period, Julian Fidler spoke with Claire Griffiths over the telephone on 19 December 2007. However, despite my asking at the hearing for details as to the substance of that conversation, no explanation was forthcoming. It is not permissible for me to press a party to make a better case for itself; it is up to the party to do that for itself. As Matthew Clarke Q.C., sitting as the Appointed Person said in *A.J. and M.A. Levy’s Trade Mark* [1999] RPC 291 said at lines 19 to 25 (an authority to which Mr Engelman directed me):

“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.”

In my view, matters were left on an uncertain basis as to the substance of that conversation which took place within the time allowed for filing evidence in support of the application. As I have said earlier, I have to conclude that the only progress made was an agreement to ask for an extension of time by way of the Form TM9, which was filed on 22 December 2007. The reason given for the request was:

“Our principle client has been unavailable throughout the period for evidence preparation on maternity leave. She hopes to return to work in the New Year and we have a conference with Counsel booked for January to progress this matter.”

This does not meet the criteria of the applicants showing what they had done, what they wanted to do and why they had not been able to do it, as per the practice direction referred to above.

31. The consequences of leaving matters on such an uncertain basis are that I considered that there had been an abuse of process in the applicants' decision deliberately to leave the filing of evidence of use until six months after the statutory period allowed for that purpose had started, and three months after it had expired. The evidence for this deliberate tactic is Ms Pavey's statement of 6 February 2007. I balanced this against the late receipt of the opponent's evidence. However, I did not consider that the overriding objective of fairness to both parties and the justice of the case (a normal one) would be best served by reversing the preliminary view to refuse the retrospective application for an extension of time. I therefore refused to admit the evidence filed on 14 March 2007 into the proceedings.

Dated this 12th day of June 2007

JC Pike
For the Registrar
The Comptroller-General