

O-194-16

TRADE MARKS ACT 1994

IN THE MATTER OF CONSOLIDATED CROSS-PROCEEDINGS BETWEEN
TELUGU NRI FORUM AND TELEGU NRI FORUM CORPORATION

NAMELY:

APPLICATION NO 3099108 AND OPPOSITION NO 404744 THERETO

AND

APPLICATION NO 3099266 AND OPPOSITION NO 404665 THERETO

Background

1. The history of the proceedings set out on the cover page of this decision is regrettably lengthy, primarily because of the actions or omissions of the parties, and I do not propose to set it out in full. It is sufficient to note that:

- On 3 July 2015, Telugu NRI Forum filed a notice of opposition to application No 3099266 standing in the name of Telugu NRI Forum Corporation and that it bases its opposition on numerous grounds under the Trade Marks Act 1994. The proceedings were joined on 1 November when the latter-named party filed a notice of defence and counterstatement;
- On 23 July 2015, Telugu NRI Forum Corporation filed a notice of opposition to application No 3099108 standing in the name of Telugu NRI Forum on the basis of a single ground. The latter-named company filed a notice of defence and counterstatement on 6 October, though for reasons that I do not need to record, it was not admitted into the proceedings immediately.

2. At this stage, I directed the appointment of a Case Management Conference (“CMC”) which took place before me on 11 December. At that CMC, I warned the parties as to their future behaviour and directed that the later filed defence and counterstatement would be processed with the two sets of proceedings being consolidated. I indicated that a further letter would be sent to them setting the period for both parties to file their evidence to a common timetable. I indicated that I expected the timescales to be met by both parties. That further letter was issued later the same day and allowed the parties until 11 February 2016 to file their respective evidence.

3. Telugu NRI Forum Corporation filed evidence within the period allowed. By way of an email received 9 February, the agent then acting for Telugu NRI Forum requested an extension of the period allowed to it for the filing of its evidence. The agent was advised that such a request would only be considered if it was made in proper form.

4. On 11 February, Telugu NRI Forum filed a Form TM9 formally requesting an extension of time and paid the appropriate fee. The request was considered and, by way of a letter dated 19 February, the parties were advised that the registrar’s preliminary view was to refuse it. The parties were advised that if either disagreed with that view, they should request to be heard otherwise the preliminary view would be confirmed automatically. The agent seeking the extension of time sought to be heard and, following further delays, a second CMC in these proceedings took place before me on 15 March.

5. Following the CMC I wrote to the parties the same day to confirm my directions. My letter stated:

“Taking into account the submissions of both parties, I gave the following directions:

- I allowed Telugu NRI Forum an extension of time until today for filing its evidence in chief in these consolidated proceedings;

- The witness statements of Dr Soma Sekhara Rao Vemuri together with Exhibit A cover sheet and Exhibit A (consisting of pages 1 -89), Mr H Kuttambakam, Mr K Mummaneni, Mr C Chandra and Mr B Kakarla have now been received and will be admitted into the proceedings;
- Both parties, having now filed their evidence in chief, are allowed until close of play on 16 May 2016 to file their evidence and/or submissions in reply to the evidence already filed by the other side.”

6. Under cover of an email dated 21 March 2016, Telugu NRI Forum Corporation filed a request for a statement of reasons for the registrar’s decision in relation to:

“1. Written statement of explanation to reject our opponents TM9 for extension of time to submit Evidence in Chief.

2. Written statement of explanation to accept our opponents TM9 for extension of time to submit Evidence in Chief, in the CMC on 15th Mar 2016.”

Statement of reasons

7. I proceed on the understanding the point 1 above refers to the preliminary view to refuse the request which was notified to the parties in the registrar’s letter of 19 February 2016. This letter was not written or signed by me but for the sake of economy of both time and cost, I deal with it in this statement of reasons as all of the material is available to me and I am the Hearing Officer with overall responsibility for these proceedings.

8. There is no automatic “right” to an extension of time for filing evidence. Rather, it is a matter of discretion which will be exercised taking into account all relevant factors. In considering such requests, the registrar bears in mind the comments made in *Siddiqui’s* Application BL O/481/00 where the Appointed Person stated:

“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.”

9. In its Form TM9 received on 11 February (the last day of the period originally allowed to it for the filing of its evidence), the agent then acting for Telugu NRI Forum requested an extension of that period. In support of that request, it provided reasons as follows:

“Our client was abroad and returned to UK recently and we therefore were unable to obtain further instructions. We confirm that we have now spoken to

our client and obtaining further instructions to submit the necessary evidence and submissions.

In light of the above we would appreciate if you could grant us an extension until the 22nd February 2016 to submit our client's (sic) evidence and submissions."

10. That request was considered bearing in mind the guidance set out in paragraph 7 above. The letter which contained the preliminary view to refuse that request stated:

"The official letter of the 11th December 2015 clearly set the deadline and it is the Registrar's view that sufficient time was given to prepare the evidence, notwithstanding your client's trip abroad. Also, Mrs Corbett in her letter following the CMC held on 10 December 2015 stated when referring to the matter of evidence being filed 'I expect those timescales to be met by both parties'."

These then are the stated reasons for the preliminary view to refuse the request for an extension of time. The reasons provided to support the request were considered insufficient to justify its grant in the light of the above case-law.

11. I go on to provide a statement of reasons in respect of point 2 above.

12. At the CMC held on 15 March, both parties made oral submissions. Mr Muir-Wood, who appeared, following a change of representation, on behalf of Telugu NRI Forum, the party seeking the extension of time for filing evidence, confirmed that his clients had been out of the country during the period originally allowed and had not been contactable. As soon as they returned from their trip, contact had been established, instructions given and received and the preparation of evidence undertaken. Evidence in the form of witness statements from 5 witnesses had been prepared and filed with the registrar (copied to the other party) on 14 March.

13. Mr Alluri for Telugu NRI Forum Corporation objected to the grant of the extension of time. He submitted that both parties had been given the same deadline for filing that evidence: his company had met that deadline and it was unfair that the other side had already seen that evidence before filing its own. He was critical of the reasons submitted on the Form TM9, indicating, in effect, that modern communications meant contact should have been made and instructions given much earlier. He accepted that he had received a copy of evidence filed the previous day but stated that some of those pages were unclear or badly scanned and so could not be read.

14. In making the request for an extension, the only information provided on the Form TM9 relating to what had been done was that the client had been spoken to and instructions obtained. In terms of what still needed to be done, the request was silent although the implication was that, at the time of filing the request, it still needed to (at least) collect and submit that evidence. In respect of why it had not been able to collect and submit the evidence within the period originally allowed to it, the client being abroad and unable to be contacted was the only reason given. These are

wholly inadequate reasons to justify an extension of time and certainly are not “strong or compelling” (see *AJ and MA Levy’s Trade Mark* [1999] RPC 292). Whilst Mr Muir-Wood’s submissions added some detail, I was not persuaded that they made the reasons for the request that much stronger. That his client claimed it had a strong case, was keen to resolve matters and took the proceedings seriously were not particularly well shown by its response to the preparation of its evidence. All the indications were that it had not taken any action at all in relation to the identification and collection of its evidence, nor had it given instructions to its agent. It had not be shown to have acted with any diligence and was clearly in default. This was not an end to the matter, however, because, as set out in *Liquid Force* (supra), an extension may still be granted despite that default.

15. As indicated above, despite the preliminary view to refuse the extension request, Telugu NRI Forum did file evidence on 14 March. In *Liquid Force* (supra) Mr Hobbs Q.C. stated:

“...I consider that the natural reluctance of the registrar to refuse an extension of time for filing evidence which has belatedly come to hand cannot be elevated to the status of an invariable rule. In order to leave room for justice to be done I think it is necessary to recognise that a contested application for an extension of time to file evidence should not necessarily “follow the event” (i.e. succeed if the evidence is available at the hearing of the application and fail if it is not) and should not automatically succeed on the basis that refusal is liable to result in the commencement of another action between the same parties covering essentially the same subject matter. I nevertheless agree that these are important factors to be taken into account when deciding whether an extension of time should be granted or refused. In the present case the hearing officer took them into account without regarding them as determinative *per se*. I agree with that approach.”

16. Despite its failure to provide strong and compelling reasons for the extension of time, in the particular circumstances of these proceedings, I granted it until the 15 March, thereby allowing the admittance of the evidence filed the previous day. Whilst there is no doubt that 1) the failure to file evidence within the original period allowed and 2) the subsequent failure to provide adequate reasons to support the request for an extension of the time for filing evidence at the earliest opportunity, have led to yet more delay, both parties advised me that they were keen to see proceedings finalised. Given that these are cross-proceedings and bearing in mind the grounds of opposition pleaded, I considered it was in the interest of justice that the substantive issues between the parties are determined on their merits on the basis of evidence and not on the basis of a technical default. I also considered it was preferable that the determination was made in respect of both applications for registration at the earliest opportunity and as part of the current cross proceedings rather than as separate proceedings which would be the case should another action commence in respect of just one of them at some future point had the request for an extension been refused. I further allowed both parties until 16 May 2016 to file their evidence and/or submissions in reply to the evidence filed by the other side.

17. My decision is an interim one in that it does not terminate the proceedings and I have not made an award of costs. Thus, in line with Rule 70 of the Trade Marks Rules 2008, an appeal against my decision can only be made independently of any appeal against the final, substantive decision, with the leave of the registrar.

18. Any request for leave to appeal this decision independently of the final decision in these proceedings should be provided in writing within 7 days of the date of this letter and should be supported by full reasons for the request. The request should, at the same time, be copied to the other side, who are allowed a further 7 days from the date the request for leave to appeal is received by them, to file any comments they might wish to make; a decision on leave would then be made. If leave were granted, the period for actually giving notice of appeal under rule 71 would run from the date leave was granted.

Dated this 19th day of April 2016

**Ann Corbett
For the Registrar
The Comptroller-General**