

O-357-17

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NOS. 3097280, 3097283, 3097284, 3097285 &
3098940**

**IN THE NAME OF BUTE TECHNOLOGY LTD
FOR THE TRADEMARKS**

DRIVEREYE, DRIVERTEK, DRIVERSSENS, CVPROTECT, DRIVERDEFEND

**IN CLASSES 9 AND 12
AND THE LATE FILING OF A FORM TM9R
IN RELATION TO CONSOLIDATED OPPOSITION PROCEEDINGS
(OPPOSITION NO. 404548 & OTHERS)
LAUNCHED BY
FUELDEFEND GLOBAL LIMITED**

Background

1. Decision No O-520-16 was issued on 7th November 2016. The parties were advised by a covering letter that any appeal against that decision should be filed on or before 5th December 2016. No such appeal, nor any request to extend the period for appeal, were received by that date.

2. There was an exchange of correspondence during the period December 2016 to January 2017 regarding the costs which had been ordered to be paid by the applicant. A further letter from the applicant on 6th February, sought to contest both the costs award and the decision itself. In a letter from the registrar dated 1st March 2017, the parties were notified that the decision had been implemented as no appeal had been filed within the period allowed. The letter also advised that if any appeal was to be filed, it would be necessary to file a request for a retrospective extension of the appeal period on Form TM9R, along with reasons both for the request and to explain the delay.

3. Nothing further was heard from the applicant until 19th May 2017 when a Form TM9R was received. The applicant asked for a period of “3 weeks from now” within which to file an appeal. The opponent objected to that request on 24th May. By way of a letter dated 25th May 2017, the registrar issued a preliminary view refusing the request. The applicant disagreed with that preliminary view and sought to be heard.

4. A hearing took place before me on 3rd July 2017. Mr Jamie MacSween represented Bute Technology Limited whilst Mr Cameron McKenzie of Herstels represented FuelDefend Global Limited.

Decision

5. In relation to the filing of an appeal, Rule 71 of the Trade Mark Rules 2008 states that:

71. 1(A) Where the appeal arises in proceedings between two or more parties, notice of appeal to the person appointed under section 76 shall be

filed on Form TM55P, which shall include the appellant's grounds of appeal and his case in support of the appeal.

(2) Forms TM55 or TM55P shall be filled within the period 28 days beginning immediately after the date of the registrar's decision which is the subject of the appeal ('the original decision').

6. In relation to extension of time requests the Rules state that:

77.—(1) Subject to paragraphs (4) and (5), the registrar may, at the request of the person or party concerned or at the registrar's own initiative extend a time or period prescribed by these Rules or a time or period specified by the registrar for doing any act and any extension under this paragraph shall be made subject to such conditions as the registrar may direct.

(2) A request for extension under this rule may be made before or after the time or period in question has expired and shall be made—

(a) where the application for registration has not been published and the request for an extension relates to a time or period other than one specified under rule 13 and is made before the time or period in question has expired, in writing; and

(b) in any other case, on Form TM9.

(3) Where an extension under paragraph (1) is requested in relation to proceedings before the registrar, the party seeking the extension shall send a copy of the request to every other person who is a party to the proceedings.

7. In making a decision in this matter, I note the guidance set out in the 'Siddiqui' case (BL O/481/00) by Mr Simon Thorley Q.C. acting as the Appointed Person when he emphasised the following factors:

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 prosecution of applications and for the conduct of oppositions. The code presumes 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.

8. The reasons for requesting an extension of time as stated in the TM9R were that:

"...It has taken a considerable length of time for the Applicant to gather evidence in order to prove that the Opponents provided False Statements. This has in part been delayed by defamation proceedings that Messrs

MacSween and Meechan have ongoing against FuelDefend Global Ltd and Mr Fowler.

A request for a retrospective extension of time is hereby requested. Whilst it is appreciated the appeal is well beyond usual timescales we believe that the exceptional circumstances vindicate this request. Also this will negate the need for a new action to be brought by the applicants in relation to the Marks, Costs and damages against FuelDefend Global Ltd and Mr Fowler...”

9. In considering the extension of time request I must bear in mind two questions. Firstly the reasons why the extension was requested and secondly the reasons for its late filing. In the hearing Mr MacSween submitted that he had not made an appeal by the due date of 5th December 2016 as he had been advised by his then legal representatives that there were no grounds on which to appeal. Following this and during subsequent other legal proceedings for defamation, Mr MacSween now believes evidence presented to the hearing officer in the opposition cases may have been false. Mr MacSween also said that confirmation of this new information had not become available until at least May 2017, hence the delay in requesting the extension of time. Mr MacSween subsequently included this new information with his skeleton argument.

10. I explained to both parties that I could not be drawn in to reviewing evidence that either pertained to the original opposition decision or any defamation proceedings. Furthermore if I were to grant the extension and any subsequent appeal was lodged then it would fall to the Appeal body to decide on whether new evidence could be presented.

11. I asked if Mr MacSween had taken any other action to address the trade mark matters during this period outside of his attention to the defamation proceedings. Mr MacSween said the defamation proceedings and the gathering of evidence regarding the false statements had taken more time than initially anticipated but that he now felt it was a point of law to ensure that the truth was spoken.

12. Mr McKenzie responded with some points about the new evidence supplied with Mr MacSween's skeleton argument. Specifically in relation to the extension of time request, Mr McKenzie's view was that nothing material had changed in the case and that it was very late in the day to start reopening proceedings.

13. In terms of the factors outlined above, it is clear that the Trade Mark Act 1994 and the Trade Mark Rules 2008 were followed and the applicant was given the requisite 28 day period ending on 5th December 2016 to appeal when the opposition decision was issued on 7th November.

14. I must have regard to the fairness of this matter to both parties and to re-open a case that has been considered 'closed' for seven months is a serious issue. I note that there have been other ongoing legal proceedings between the parties during this time. However I am unconvinced by the reasons provided by the applicant as to why this extension of time should be granted after such a long period of time. There is undoubtedly a great deal of discontent about the outcome of the opposition cases, possibly because Mr MacSween states that he had relevant material available that could have been put before the hearing officer in the opposition cases but that he was advised against doing so by his then legal representatives. This discontent has probably been made more acute by the defamation proceedings. There has been sporadic email communication from the applicant during the last seven months outlining concerns about the decision and mentioning issues regarding false statements emanating from the defamation proceedings. I note that, having received an email from Mr MacSween on 6 February 2017 in which he stated that he wished to contest the opposition decision, the Tribunal informed him, in a letter dated 01 March 2017, that the case was closed but that if he wished to request a retrospective request for an extension of time to appeal, he would need to file a Form TM9R and explain why the request had been made "so late". Despite this clear explanation from the Tribunal as to what needed to be done and that any such request would already be considered as being "so late", no response was received from Mr MacSween until more than two and a half months later on 19 May 2017 when the Form TM9R was eventually filed. In all of the circumstances, bearing in mind the length of time that has passed since the appeal period expired and that ultimately I have not been shown any material that demonstrates the applicant has been actively working on

filing its grounds of appeal, I do not find there are sufficient reasons or the requisite special circumstances in this matter which allow me to grant the extension of time request.

Conclusion

15. The applicant's request for a retrospective extension of time to file its grounds of appeal is refused.

Costs

16. In the circumstances, I consider it appropriate to make an award of costs to the opponent in relation to the time it has spent dealing with the applicant's request for an extension of time. At the hearing, Mr McKenzie had stated his intention to email me a breakdown of the opponent's costs for my consideration. This email was subsequently received on 11 July 2017. The applicant was allowed a short period in which to comment upon that request. Comments were received from Mr MacSween on 12 July 2017.

17. The breakdown from McKenzie amounts to a total of £5000. This appears to be the actual fees charged by McKenzie to the opponent for his services in preparing for the hearing. However, as Mr MacSween points out, the opponent has made no request for costs above the normal scale of costs and neither has it claimed that the applicant has behaved unreasonably such as to warrant a departure from that scale. In the circumstances, I see no reason to depart from the usual scale of costs. The award will be based on what I consider to be a fair contribution towards the opponent's costs rather than full compensation. I have borne in mind that Mr McKenzie's submissions at the hearing were minimal and that his written submissions filed prior to the hearing were of little assistance to me. Using the guidance set out in the scale of costs in Tribunal Practice Notice 4/2007 (which was in force when the proceedings began), I award the opponent costs on the following basis:

Preparing for and attending the hearing (including filing submissions) £200

I order Bute Technology Ltd to pay FuelDefend Global Ltd the sum of £200. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this matter if any appeal against this decision is unsuccessful.

Dated this 27th day of July 2017

**June Ralph
For the Registrar,
the Comptroller-General**