

**TRADE MARKS ACT 1994
IN THE MATTER OF AN INTERLOCUTORY HEARING
IN RELATION TO A REQUEST BY
KABUSHIKI KAISHA NAMCO (NAMCO LIMITED)
(THE APPLICANT FOR REGISTRATION) FOR AN EXTENSION OF TIME
WITHIN WHICH TO FILE EVIDENCE IN SUPPORT OF
THEIR APPLICATION NO. 2068253 AGAINST AN OPPOSITION NO. 45735 BY
THE EDGE INTERACTIVE MEDIA INC AND
THE EDGE INTERACTIVE MEDIA LIMITED (JOINT OPPONENTS)**

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BACKGROUND

15 At an Interlocutory Hearing held on 28 May 1998 I acceded to a request from the applicant for registration for further time in which to file evidence in respect of opposition proceedings against them. I am now asked for written grounds of the decision.

20 Kabushiki Kaisha Namco (Namco Limited) have applied to register the trade mark SOULEDGE in Classes 9 and 28. This has been opposed by the joint opponents, the Edge Interactive Media Inc and the Edge Interactive Media Limited on a number of grounds, including under Section 5(2). The opponents own what they consider to be confusingly similar earlier trade marks registered in Classes 9, 16 and 28. The Notice of Opposition was filed on 16 October 1996 and the Counterstatement was received within the three month period set for a response, on 28 January 1997. The opponents sought from, and were granted by, the Trade Marks Registry an extension of time of three months up to 5 August 1997 to file their evidence in support of the opposition. The applicants did not object to this request. The opponents' evidence was subsequently filed on 5 August 1997. The applicants for registration were given until 8 November 1997 to file their evidence in support of the application for registration, they subsequently sought and were granted a three months extension of time until 8 February 1998 to file their evidence. Within that period Statutory Declarations by Roger Stuart Grimshaw and David William Blake were filed together with a request dated 9 February 1998 for a further extension of time of 2 months in order to enable a Statutory Declaration by a Mr Kazuya Kiyoshima of the applicants to be admitted into the proceedings together with some further evidence. The opponents objected to this request for an extension of time and as the reasons given were not considered by the Trade Marks Registry to be detailed or compelling the request was refused. The applicants agents subsequently requested a Hearing. A hearing was appointed in the normal way, under the provisions of Rule 48 of the Trade Marks Rules 1994. The Trade Marks Registry notified the parties on 24 April 1998 that the Hearing was to take place on 28 May 1998 at 10.45 at the Patent Office in London.

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45 On 19 May 1998 Dr Tim Langdell, on behalf of the opponents wrote to the Trade Marks Registry asking for the Hearing to be postponed because a) Dr Langdell who is based in the United States, had only just learned of the date of the Hearing and b) the date was not convenient. As the notice of the Hearing had gone to the opponents address for service in the United Kingdom (and the Trade Marks Registry had confirmation of its receipt) and because in accordance with the Trade Marks Registry's practice direction on the matter no alternative date agreed between the parties was put forward, the hearing went ahead as notified.

At the Hearing held on 28 May 1998 the opponent was not present or represented but I did have available to me the above letter dated 19 May from Dr Tim Langdell which also commented on the applicants request. Mr Roger Grimshaw, of Mewburn Ellis, represented the applicants. He submitted first of all that evidence on behalf of the applicant in the form of a Statutory Declaration from himself and Mr David William Lake had been filed within the extended time allowed. However, as indicated on the request for the extension of time filed on the Form TM9, additional time was required in order to admit Statutory Declarations by Mr Kazuya Kiyoshima submitted to the Trade Marks Registry on 11 February 1998 and by Mr Akira Aoyagi submitted on 15 April.

The first declaration of Mr Kiyoshima should have been completed and submitted by the applicants Senior Managing Director, who was an English speaker. However, because, in the event, he had not been available it had proved impossible to have him sign and swear a declaration covering that particular piece of evidence, it had become necessary for the information to be considered and verified by the Deputy General Manager, Mr Kiyoshima, who was not an English speaker. This meant that the Declaration had to be amended as well as having it translated first of all into Japanese and then back into English. This was going to take time and therefore the deadline for filing evidence in support of the application was likely to be missed, hence the Form TM9 dated 9 February 1998 had been filed. Also, it had been considered necessary to file evidence of turnover in respect of goods sold under the trade mark in suit in the United Kingdom at an early point in time in these proceedings but the information had had to be sourced in the United Kingdom and verified in Japan. That also took time (bearing in mind the need to translate communications in both directions) and hence the request covered also an extension of time to admit the declaration of Mr Aoyagi.

The opponents, in correspondence, expressed concern that under the procedure adopted by the Trade Marks Registry for considering extensions of time, tight control should be exercised over the granting of such requests. In this particular case the opponents considered that the applicants were seeking, unreasonably, to delay the proceedings by seeking an extension of time, particularly as their reasons given on the Form TM9 were not very compelling. The opponents also referred to earlier requests, by them and by the applicant, which had been granted but I did not consider that they were altogether relevant to the particular issue before me on 28 May. In summary the opponents submitted that the extension of time request should not be granted as the information contained in the Statutory Declaration of Mr Aoyagi was not of a nature that would have required a great deal of research or time to compile and the availability or otherwise of officials of the company should not be used as an excuse to delay proceedings.

Having considered all of the oral submissions and the written submissions by the opponent I concluded that an extension of time was justified in this particular case. I was satisfied that the reasons given by the applicant were reasonable in that information compiled in the United Kingdom may have needed to be verified in Japan before the information could be sworn in evidence by way of a Statutory Declaration. Similarly, I could understand that it may have been necessary to revise and amend a Statutory Declaration in order to have evidence filed by an officer of the company, the most appropriate official being unavailable. In the particular circumstances of this case I considered that an extension of time was justified. In reaching this view I took account of the SAW case [1996] RPC 17, page 507. At all the material times

those involved were pursuing matters with diligence and the delays which occurred were, in my view, fully accounted for. In those circumstances I granted the applicants' request for an extension of time to admit the Statutory Declarations of Mr Kazuya Kiyoshima and Mr Akira Aoyagi.

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The effect of the decision was that the remainder of the applicants' evidence round was complete. I allowed the opponents therefore three months from the date of the Hearing to file evidence in reply.

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Subsequently, the opponents were in touch with the Trade Marks Registry indicating their shock that the Hearing, which as indicated above had been properly notified under the Registrar's Practice Direction and under the Rules, had gone ahead given that as an American company they would have wished to attend in person. I should record that the opponents do have an address for service in the United Kingdom as required by the Trade Marks Rules and correspondence was sent to that address (and received at that address), well before the date of the Hearing. In the circumstances there was no reason for delaying the Hearing date, not least because Dr Langdell's letter contained comments on the request which I was able to take into account.

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I note that there is a common thread running through this file that documents and letters sent to the opponents address for service in the United Kingdom do not arrive timeously with Dr Langdell, who I understand spends most of his time in the United States. This must be an area or concern to the opponents, given the number of occasions they have had to approach the Trade Marks Registry indicating that documents or letters have not been received.

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Dated this 24 day of November 1998

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**M KNIGHT
Principal Inter Partes Hearing Officer
for the Registrar
The Comptroller General**

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