

TRADE MARKS ACT 1994

IN THE MATTER OF AN INTERLOCUTORY HEARING  
IN RELATION TO A REQUEST BY DONOVAN DATA SYSTEMS LIMITED  
TO ALLOW INTO PROCEEDINGS LATE FILED FORMS TM8 AND  
COUNTERSTATEMENTS TO DEFEND REGISTRATION **m**'s 1430384 & 1432461  
IN REVOCATION PROCEEDINGS (REVOCATION **m**'s 10322 & 10323)

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in relation to a request by DONOVAN DATA SYSTEMS LIMITED  
to allow into proceedings late filed forms TM8 and counterstatements  
to defend Registration **m**'s 1430384 & 1432461  
in Revocation proceedings (REVOCATION **m**'s 10322 & 10323)

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Following an interlocutory hearing, on 8 July 1999, I refused the registered proprietors  
request to allow into proceedings forms TM8 and counterstatements filed after the prescribed  
period.

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I am now asked for my written grounds of decision.

*Background*

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The background facts are as follows:

Donovan Data Systems Limited registered the mark MEDIABASE in Classes 35, Registration  
**m** 1430384, and 9, Registration **m** 14332461.

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Associated Newspapers Limited applied, on 30 September 1998, to revoke these registrations,  
the applications for revocation were made under Section 46 of the Trade Marks Act 1994. On  
9 October 1998 the Registrar sent to the Address for Service shown on the Register, Edward  
Evans & Co, copies of the applications and invited the registered proprietor to file forms  
TM8, along with counterstatements and evidence of use of the mark, within three months of  
30 the date of the letter, i.e. 9 January 1999.

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On 5 January 1999, Edward Evans & Co, filed two statutory declarations, each with three  
exhibits, one statutory declaration for each set of proceedings. These statutory declarations  
were made by Michael Arthur Lynd, a partner in Edward Evans & Co, on behalf of the  
35 registered proprietor.

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Subsequently, on 19 January 1999, and following a telephone enquiry to the Registry, the  
forms TM8 and counterstatements were filed by Edward Evans & Co under cover of a letter  
stating that these were omitted when the statutory declarations and exhibits had been filed.

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The Registrar replied to this letter on 22 February 1999, stating that these documents had  
been filed outside the period allowed under the terms of Rule 31(4) and therefore revocation  
of both registrations would proceed. The letter allowed a period of fourteen days within which  
to request an interlocutory hearing to argue against this decision.

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Edward Evans & Co responded to this letter on 24 February 1999 seeking an interlocutory  
hearing in the matter. They also stated that the person in charge of these proceedings was on  
leave due to a family bereavement and that the omission did not come to light until after the

expiry of the prescribed period.

After notifying the parties that the Registrar was considering this matter further the Address for Service of the Applicant for Revocation, Haseltine Lake, made a number of observations in a letter dated 17 March 1999.

That completes my review of the background. At the interlocutory hearing held on 8 July 1999, Mr M D Bilewycz, Edward Evans & Co, represented the registered proprietor and the applicant for revocation was not represented, but relied upon the observations in their letter of 17 March 1999 as a written submission. At the hearing I reserved judgement and notified the parties by letter of my decision on 10 August 1999.

#### *Registered Proprietor's Submissions*

Mr Bilewycz submitted that the Registrar's view that the time allowed for the filing of the form TM8, counterstatement and evidence of use was a non-extendable period of three months was in error. In his view revocation proceedings were subject to the provisions of Rule 31, and Rule 31(3) set out the time limit for the filing of these documents. That this period was extendable at the Registrar's discretion under the provisions of Rule 62(1) because Rule 31(3) was not excepted from the provisions of Rule 62(1) by being included in Rule 62(3) as a Rule which set a non-extendable period.

In his view, the provisions of Rule 31(4) which apply the provisions of Rule 13 (Opposition Proceedings) to revocation proceedings did not thereby apply the provision of a non-extendable period for the filing of the form TM8, counterstatement and evidence of use. This was because, in his view, Rule 31(4) did not apply the substantive provisions of Rule 13, but merely the appropriate procedures.

Further, he contended that Rule 31(4) only referred to granting the application for revocation where no counterstatement had been filed, there being no reference to a form TM8 in that Rule. Referring to the Trade Marks Work Manual Chapter 15, section 5.11, he asserted that all the elements on the checklist found in that section were to be found within the statutory declaration and that although irregular, the statutory declaration could be taken in lieu of a counterstatement. In his view this "irregularity" could be corrected under Rule 60 and in this way the terms of Rule 31(4) would be satisfied and the proceedings could continue.

Finally, Mr Bilewycz submitted that the filing of the evidence demonstrated that the registered proprietor had an intention to defend these registrations and that paragraphs 5 to 7, inclusive, of the statutory declarations clearly showed use of the mark. He therefore asserted that to allow the application for revocation in the face of this was to put form above substance and was also contrary to public and judicial policy.

#### *Applicant for Revocation's Written Submission.*

In their letter of 17 March 1999 the applicant for revocation made two points, the first of which was that Rules 31(3) and 31(4) were clear in the time limits they set out, that they regard them as non-extendable and that these Rules clearly set out the consequences of failing to meet these limits. The second point is that the registered proprietor was approached in

September 1996 with a request for consent to the registration of two applications filed by the applicants for revocation. This original approach and subsequent reminders were not acknowledged and this culminated in the current proceedings.

5 *Decision on Request to Allow Into Proceedings Late Filed Forms Tm8 and Counterstatement.*

Those of the Trade Marks Rules 1994 (as amended) which are relevant to this request are set out below:

10 **Rule 31**

15 31.-(1) An application to the registrar for revocation under section 46 or declaration of invalidity under section 47 of the registration of a trade mark or for the rectification of an error or omission in the register under section 64 shall be made on Form tm26 together with a statement of the grounds on which the application is made.

20 31.-(2) where an application is made under paragraph (1) by a person other than the proprietor of the registered trade mark, the registrar shall send a copy of the application and the statement to the proprietor.

25 31.-(3) Within three months of the date on which the registrar sends a copy of the application and the statement to the proprietor, the proprietor may file a counterstatement together with Form TM8 and the registrar shall send a copy thereof to the applicant:

30 Provided that where an application for revocation is based on the grounds of non-use under section 46(1)(a) or (b), the proprietor shall file (within the period allowed for the filing of any counterstatement) evidence of the use by him of the mark; and if he fails so to file evidence the registrar may treat his opposition to the application as having been withdrawn.

35 31.-(4) Subject to paragraph (2) above and paragraphs (6) and (7) below, the provisions of rule 13 shall apply to proceedings relating to the application as they apply to opposition proceedings for the registration of a trade mark, save that, in the case of an application for revocation on the grounds of non-use under 46(1)(a) or (b), the application shall be granted where no counterstatement is filed.

**Rule 13**

40 13.-(2) 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 counterstatement, in conjunction with a notice of the same, on Form TM8; where such a notice and counterstatement are filed within the prescribed period, the registrar shall send a copy of the Form TM8 and the counter-statement to the person opposing the application.

45 13.-(3) Where a notice and counterstatement are not filed by the applicant within the period prescribed by paragraph (2), he shall be deemed to have withdrawn

his application for registration.

5 13.-(4) Within three months of the date upon which a copy of the counterstatement is sent by the registrar to the person opposing the registration, that person may file such evidence by way of statutory declaration or affidavit as he may consider necessary to adduce in support of his opposition and shall send a copy thereof to the applicant.

10 13.-(5) If the person opposing the registration files no evidence under paragraph (4) above in support of his opposition, he shall, unless the registrar otherwise directs, be deemed to have withdrawn his opposition.

## **Rule 62**

15 62.-(1) The time or periods-

(a) prescribed by these Rules, other than the times and periods prescribed by the rules mentioned in paragraph (3) below, or

20 (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, be extended by the registrar as he thinks fit and upon such terms as he may direct.

25 62.-(2) Where a request for the extension of a time or periods prescribed by these Rules-

30 (a) is sought in respect of a time or periods prescribed by rules 13, 18, 23 or 25, the party seeking the extension shall send a copy of the request to each person party to the proceedings;

35 (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.

40 62.-(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 13(2) (time for filing counterstatement), rule 23(4) (time for filing opposition), rule 25(3) (time for filing opposition), rule 29 (delayed renewal), rule 30 (restoration of registration), and rule 41 (time for filing opposition).

45 It is, I think, clear under the provisions of Rule 31(1) to 31(4) that once an application for revocation (Form TM26 and Statement of Grounds) on the grounds of non-use has been received the registrar has a duty to send a copy to the registered proprietor (or his address for service) and thus allow him the opportunity to oppose the application by filing a Form TM8, a counterstatement and evidence of use of his mark. The first part of the submission raises the issue of whether the period for so doing is fixed at three months or whether the period may be

extended beyond that.

5 Mr Bilewycz argued that as the time period set by Rule 31(3) was not included in the time periods listed in Rule 62(3) as excepted from the general provision of Rule 62(1) then the provisions of Rule 62(1), which allow the registrar to grant extensions of time, must apply. The matter therefore turns on how far the provisions of Rule 13 extend to revocation proceedings in accordance with Rule 31(4).

10 In my view, the Rules are designed to provide, wherever possible, a single and consistent set of provisions and procedures for dealing with proceedings before the Registrar. These are set out as in Rule 31(4) and I do not believe that, in approving the Rules, Parliament intended to have a different set of provisions for the filing of a counterstatement depending upon the nature of the action. I therefore reject Mr Bilewycz's view that the application of Rule 13 to revocation proceedings relates only to the procedures and not the substantive provisions. In my view Rule 31(4) brings to bear on revocation proceedings all of the substantive provisions of Rule 13 including the provision of a three month non-extendable deadline for the filing of the Form TM8 and counterstatement. The request to allow into these proceedings the Forms TM8 and counterstatements filed after the prescribed period must therefore be refused.

20 Neither in correspondence prior to nor at the interlocutory hearing itself was a request for an extension of time within which to file the Forms TM8 and counterstatements made. No Forms TM9 have been received and the prescribed fees have not been paid. I do not, however, take these facts into consideration in reaching this decision.

25 I now go on to consider the point raised in the submission with regards to exercising powers under Rule 60, which is set out below:

**Rule 60**

30 60. Subject to rule 62 below, any irregularity in procedure in or before the Office or the registrar, may be rectified on such terms as the registrar may direct.

35 I was requested to exercise discretion under Rule 60 and accept that the statutory declaration could constitute a counterstatement, as suggested in Mr Bilewycz's submission detailed on page 2 above. However, on checking the relevant section of Chapter 15 of the Trade Marks Work Manual this clearly refers to the filing of, and checking upon receipt of, the Form TM8 and counterstatement together.

40 Whilst accepting that Rule 31(4) only refers to a counterstatement this is preceded by Rule 31(3) which clearly states “- - - , the proprietor may file a counterstatement together with Form TM8 - - -” (my emphasis). The checklist in the Trade Marks Work Manual referred to finishes with the words “all parts of the form, including the Counterstatement, have been completed and the form is signed and dated” (my emphasis) and this also clearly implies that the two elements must be submitted together. I will also point out that this checklist clearly states that these documents must be filed “- - - within three months of the TM26 being sent out”.

It would therefore be wrong to interpret the wording of Rule 31(4) so narrowly as to suggest

that this implies that a Form TM8 is not required and that filing only a counterstatement would halt the granting of an application for revocation. I therefore have no basis to exercise discretion under Rule 60 to allow the statutory declaration to stand in place of a counterstatement in these proceedings.

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The final point raised in the submission was that relating to whether the requirement for the Form TM8 and counterstatement was a matter of form or substance, given that the provision of the evidence had demonstrated an intention to defend the registration. In my decision on this issue I am supported by the decisions in *M's Application* [1985 RPC 249] and in *E's Application* [1983 RPC 231].

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In *M's Application* the applicant requested that a letter filed within the prescribed time be taken in lieu of the prescribed form. It was held by Falconer J, and upheld in the Court of Appeal, that where a specific form is prescribed within the Act or the Rules then it is mandatory for that form to be used and that this was then a matter of substance and not of form, p. 260 lines 7 to 15.

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“- - If there were not prescribed forms for the very many steps which have to be taken, an application or a step in an application might be taken in any form at all and, as it was put, the Office could not as a practical matter operate, and the only sensible system is to have prescribed forms for the various steps which have to be taken, as a matter of practicality and, indeed, workability. However that may be, under the statute it is mandatory that the prescribed form shall be used, and it is mandatory that you pay the prescribed fee; and I cannot regard mandatory requirements under the statute as being matters of form and not of substance.”

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In *E's Application* the applicant failed to take an action within a prescribed non-extendable time period and requested that this error be regarded as an irregularity and corrected under the provision of a general discretionary Rule, equivalent to the Trade Marks Rule 60. It was held in the Court, and upheld in both the Court of Appeal and the House of Lords, that it was not correct for a Rule giving general discretionary power to override a Rule dealing with specific provisions, p. 250 line 43 to p. 251 line 2.

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“- - An irregularity in procedure is simply a failure to observe procedural rules, whatever the cause of the failure may be. Where there is a discretion to rectify the failure, the reason for it may be of the utmost relevance to the way in which that discretion should be exercised; but if rule 100 confers upon the comptroller jurisdiction to excuse failure to observe a time limit which is made inextensible by rule 110(1) and (2), on the ground that it is an irregularity in procedure, that jurisdiction must extend to all such failures whatever the reason for them may be, with the result of rendering the express prohibition of extensions of specified time limits by rule 110(1) and (2) wholly nugatory. So to construe rule 100 in relation to rule 110 would be to turn on its head the well-established canon of construction *generalia specialibus non derogant*.”

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Taking this all together I find that as the Rules require the filing of a Form TM8 and counterstatement the filing of such documents is a matter of substance and not form, also as I have already found that the time period for the filing of these documents is non-extendable then the general discretionary powers under Rule 60 cannot be invoked to allow these documents into

proceedings after the expiry of the prescribed time limit.

5 During the submission on this issue Mr Bilewycz referred to the statutory declaration of Mr  
Lynd, specifically stating that this demonstrated use by the registered proprietor, in particular  
referring to paragraphs 5 to 7. However, on examination of this document it shows, at  
10 paragraph 4, that the registered proprietor has no customers in the United Kingdom,  
paragraphs 5 and 6 relate to supplying the proprietors German sister company with the  
relevant goods and services and paragraph 7 exhibits an unsigned draft agreement which offers  
the goods and service. Prima facie this does not demonstrate use of the mark but I do not give  
these facts any weight in reaching this decision.

15 The effect of this decision is that Registration m's 1430384 and 1432461, will be revoked  
under the provisions of Section 46 of the Trade Marks Act 1994, in the event that there is no  
appeal or that on appeal my decision is upheld.

**Dated the 10<sup>th</sup>. Day of September 1999**

20  
  
25 **G J Attfield**  
**Acting for the Comptroller**  
**The Registrar of Trade Marks**