

TRADE MARKS ACT 1994

IN THE MATTER OF

APPLICATIONS 10322 AND 10323

IN THE NAME OF ASSOCIATED NEWSPAPERS LTD

FOR REVOCATION OF REGISTERED TRADE MARKS 1430384 AND 1432461

IN THE NAME OF DONOVAN DATA SYSTEMS LTD

DECISION

Rules 13, 31 and 62 of the Trade Marks Rules 1994 (as amended by the Trade Marks Rules 1998) provide as follows:

13. Opposition proceedings; s.38(2) (Forms TM7 & TM8)

(1) Notice of opposition to the registration of a trade mark shall be filed on Form TM7 within three months of the date on which the application was published under rule 12, and shall include a statement of the grounds of opposition; the registrar shall send a copy of the notice and the statement to the applicant.

(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 counter-statement, in conjunction with a notice of the same, on Form TM8; where such a notice and counter-statement 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.

(3) Where a notice and counter-statement are not filed by the applicant within the period prescribed by paragraph (2), he shall be deemed to have withdrawn his application for registration.

(4) Within three months of the date upon which a copy of the counter-statement 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.

(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paragraph (4) above in support of his opposition, he shall, unless the registrar otherwise directs, be deemed to have withdrawn his opposition.

(6) If the person opposing the registration files evidence under paragraph (4) above or the registrar otherwise directs under paragraph (5) above, the applicant who has filed a notice and counter-statement under paragraph (2) above may, within three months of the date on which either a copy of the evidence or a copy of the direction is sent to him, file such evidence by way of statutory declaration or affidavit as he may consider necessary to adduce in support of his application for registration and shall send a copy thereof to the person opposing the application.

(7) Within three months of the date upon which a copy of the applicant's evidence is sent to him under paragraph (6) above, the person opposing the application may file evidence in reply by statutory declaration or affidavit which shall be confined to matters strictly in reply to the applicant's evidence, and shall send a copy thereof to the applicant.

(8) No further evidence may be filed, except that, in relation to any proceedings before him, the registrar may at any time if he thinks fit give leave to either party to file such evidence upon such terms as he may think fit.

(9) Upon completion of the evidence the registrar shall request the parties to state by notice to him in writing whether they wish to be heard; if any party requests to be heard the registrar shall send to the parties notice of a date for the hearing.

31. Procedure on application for revocation, declaration of invalidity and rectification of the register; ss 46, 47 & 64 (Forms TM26 & TM27)

(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.

(2) Where any 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.

(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 counter-statement together with Form TM8 and the registrar shall send a copy thereof to the applicant:

Provided that where an application for revocation is based on the ground of non-use under section 46(1)(a) or (b), the proprietor shall file (within the period allowed for the filing of any counter-statement) 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.

(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 section 46(1)(a) or (b), the application shall be granted where no counter-statement is filed.

(5) Any person, other than the registered proprietor, claiming to have an interest in proceedings on an application under this rule may file an application to the registrar on Form TM27 for leave to intervene, stating the nature of his interest and the registrar may, after hearing the parties concerned if so required, refuse such leave or grant leave upon such terms or conditions (including any undertaking as to costs) as he thinks fit.

(6) Any person granted leave to intervene (the intervener) shall, subject to the terms and conditions imposed in respect of the intervention, be treated as a party for the purposes of the application of the provisions of rule 13 to the proceedings on an application under this rule.

(7) When the registrar has made a decision on the application following any opposition, intervention or proceedings held in accordance with this rule, he shall send the applicant, the person opposing the application and the intervener (if any) written notice of it, stating the reasons for his decision; and for the purposes of any appeal against the registrar's decision the date when the notice of the decision is sent shall be taken to be the date of the decision.

62. Alteration of time limits (Form TM9)

(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, be extended by the registrar as he thinks fit and upon such terms as he 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, 18, 23 or 25, 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 13(2) (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), and rule 41 (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 this discretion, extend the period or time if he is satisfied with the explanation for the delay in requesting the extension and it appears to him to be just and equitable to do so.

(6) Where the period within which any party to any proceedings before the registrar may file evidence under these Rules is to begin upon the expiry of any period in which any other party may file evidence and that other party notifies the registrar that he does not wish to file any, or any further, evidence the registrar may direct that the period within which the first mentioned party may file evidence shall begin on such date as may be specified in the direction and shall notify all parties to the dispute of that date.

(7) Without prejudice to the above, in the case of any irregularity or prospective irregularity in or before the Office or the registrar which -

- (a) consists of a failure to comply with any limitation as to times or periods specified in the Act, these Rules or the old law as that law continues to apply and which has occurred or appears to the registrar as likely to occur in the absence of a direction under this rule, and
- (b) is attributable wholly or in part to an error, default or omission on the part of the Office or the registrar and which it appears to him should be rectified.

he may direct that the time or period in question shall be altered in such manner as he may specified upon such terms as he may direct.

On 30th September 1998 Associated Newspapers Ltd (“**Associated**”) filed applications under Rule 31(1) for revocation of the following trade mark registrations standing in the name of Donovan Data Systems Ltd (“**Donovan**”): (i) MEDIABASE (word only) registered under number 1430384 as of 5th July 1990 for use in relation to “dissemination of data and information, all relating to business and advertising; provision of computerised data and information, all relating to business; all included Clause 35”; (ii) MEDIABASE (word only) registered under number 1432461 as of 17th July 1990 for use in relation to “computer programs; software; solid state memory devices; all included in Class 9”.

In each case revocation was requested under Section 46(1) of the Trade Marks Act 1994 on the basis that there had, by 1st July 1998, been no genuine use of the trade mark in the United Kingdom, by or with the consent of the registered proprietor, in relation to any goods or services for which it was registered, for a continuous and uninterrupted period of not less than 5 years and there were no proper reasons for such non-use.

The Registrar sent copies of the applications for revocation to Donovan’s address for service on 9th October 1998. Donovan then had 3 months under Rule 31(3) of the Trade Marks Rules 1994 within which to file: (1) pleadings (Forms TM8 and counter-statements) stating the grounds (if any) upon which it resisted the applications for revocation; and (2) evidence of the use (if any) upon which it relied in answer to Associated’s allegations of non-

use. It was incumbent upon Donovan to plead and prove such use in accordance with the provisions of Section 100 of the Trade Marks Act 1994.

Donovan filed evidence in answer to Associated's allegations of non-use on 5th January 1999. However, its pleadings in answer to Associated's applications for revocation were not presented for filing until 19th January 1999. By then the period of 3 months prescribed by Rule 31(3) had expired. The Registrar took the view that revocation of Donovan's trade mark registrations was therefore inevitable on the basis that the failure to file pleadings in answer within the period prescribed by Rule 31(3) rendered Associated's applications for revocation unanswerable under Rule 31(4) in the same way as failure to file pleadings in answer within the period prescribed by Rule 13(2) renders oppositions to registration unanswerable under Rule 13(3).

Donovan requested an interlocutory hearing at which to argue against the Registrar's interpretation of Rule 31(4). The hearing took place on 8th July 1999. Several lines of argument were pursued on behalf of Donovan. I think I am right in saying that one of them was an argument substantially to the following effect:

[A] in opposition proceedings the consequence prescribed by Rule 13(3) is the inevitable result of a failure to file pleadings in answer within the time limit prescribed by Rule 13(2) because the time limit prescribed by Rule 13(2) is excluded by Rule 62(3) from the Registrar's power to extend time under Rule 62(1) and is therefore a time limit which cannot be extended, after it has expired, under Rule 62(5);

- [B] the consequence prescribed by Rule 31(4) in relation to applications for revocation under Section 46(1) (a) or (b) is not the inevitable result of a failure to file pleadings in answer within the time limit prescribed by Rule 31(3) because the time limit prescribed by Rule 31(3) is not excluded by Rule 62(3) from the Registrar's power to extend time under Rule 62(1) and is therefore a time limit which can be extended, after it has expired, under Rule 62(5);
- [C] the Registrar is not required by the provisions of Rule 31(4) to equate the extendable time limit prescribed by Rule 31(3) with the non-extendable time limit prescribed by Rule 13(2);
- [D] in the present case it was therefore open to the Registrar under Rules 62(1) and 62(5) to extend the time limit prescribed by Rule 31(3) so as to permit late filing of the pleadings presented for filing on 19th January 1999.

However, the Registrar's Hearing Office, Mr. G.J. Attfield, considered that he was constrained by Rule 31(4) to regard the periods of 3 months prescribed by Rule 31(3) and Rule 13(2) as equally non-extendable under Rule 62 with the result that the Registrar had no alternative but to grant Associated's applications for revocation following Donovan's failure to file pleadings in answer within 3 months of the date (9th October 1998) upon which copies of the applications for revocation were sent to it under Rule 31(2).

On 10th September 1999 the Hearing Officer issued a formal decision refusing to entertain any application by Donovan for late filing of its pleadings and allowing Associated's applications for revocation. Donovan appealed to an Appointed Person under Section 76 of the 1994 Act. The appeals came on for hearing before me on 20th January 2000. I now have to decide whether the Hearing Officer was correct in interpreting Rule 31(4) in the way that he did.

The following table (overleaf) compares and contrasts the procedure under Rules 13 and 31, taking account of the express provisions of Rule 62:

	RULE 13	RULE 31
(1)	<u>Rule 13(1)</u> : Notice of opposition to the registration of a trade mark must be filed on Form TM7 with a statement of the grounds of opposition and the notice must be filed within 3 months of the date on which the application for registration was published. The time limit cannot be extended under Rule 62: see <u>Rule 62(3)</u>	<u>Rule 31(1)</u> : An application for revocation under Section 46 of the Act or a declaration of invalidity under Section 47 of the Act must be filed on Form TM26 with a statement of the grounds on which the application is made. No time limits are prescribed by the Rules for the filing of the Form TM 26 and statement of grounds.
(2)	<u>Rule 13(1)</u> : The Registrar must send a copy of the Form TM7 and statement of grounds to the applicant for registration.	<u>Rule 31(2)</u> : If the application under Rule 31(1) was made by a person other than the proprietor, the Registrar must send a copy of the Form TM26 and statement of grounds to the proprietor of the registered trade mark.
(3)	<u>Rule 13(2)</u> : The applicant for registration has 3 months from the date on which a copy of the opponent's Form TM7 and statement of grounds is sent to him by the Registrar within which to file a counter-statement with notice of the same on Form TM8. This time limit cannot be extended under Rule 62: see <u>Rule 62(3)</u> . The applicant for registration <i>"shall be deemed to have withdrawn his application for registration"</i> if he fails to file a Form TM8 and counter-statement within the period of 3 months prescribed by Rule 13(2): see <u>Rule 13(3)</u> .	<u>Rule 31(3)</u> : The proprietor of the registered trade mark has 3 months from the date on which a copy of the applicant's Form TM26 and statement of grounds is sent to him by the Registrar within which to file a counter-statement together with Form TM8. This time limit is not excluded from the Registrar's power to extend time under Rule 62(1). The Registrar <i>"may"</i> treat the proprietor's opposition to an application for revocation under Section 46(1)(a) or (b) of the Act as having been withdrawn if the proprietor fails to file evidence of use <i>"within the period allowed for the filing of any counter-statement."</i> However an application for revocation on the grounds of non-use under Section 46(1)(a) or (b) of the Act <i>"shall be granted where no counter-statement is filed"</i> : see <u>Rule 13(4)</u> .
(4)	<u>Rule 13(2)</u> : If the Form TM8 and counter-statement <i>"are filed within the prescribed period"</i> , the Registrar must send a copy thereof to the opponent.	<u>Rule 31(3)</u> : The Registrar must send a copy of the Form TM8 and counter-statement to the applicant.

(5)	<u>Rule 13(4)</u> : The opponent has 3 months from the date on which a copy of the counter-statement is send to him by the Registrar within which to file evidence in support of his opposition. This time limit is not excluded from the Registrar’s power to extend time under Rule 62(1). If the opponent files no evidence in support of his opposition <i>“he shall unless the registrar otherwise directs be deemed to have withdrawn his opposition”</i> : see <u>Rule 13(5)</u> .	(No corresponding provision in Rule 31).
(6)	<u>Rule 13(6)</u> : The applicant for registration has 3 months from the date on which a copy of the opponent’s evidence under Rule 13(4) or a copy of the Registrar’s direction under Rule 13(5) is sent to him within which to file evidence in support of his application for registration. This time limit is not excluded from the Registrar’s power to extend time under Rule 62(1).	(No corresponding provision in Rule 31).
(7)	<u>Rule 13(7)</u> : The opponent has 3 months from the date on which a copy of the applicant’s evidence under Rule 13(6) is sent to him within which to file evidence confined to matters strictly in reply to the applicant’s evidence. This time limit is not excluded from the Registrar’s power to extend time under Rule 62(1).	(No corresponding provision in Rule 31)
(8)	<u>Rule 13(8)</u> : No further evidence may be filed without the permission of the Registrar.	(No corresponding provision in Rule 31).
(9)	<u>Rule 13(9)</u> : Upon completion of the evidence the Registrar must ask the parties to state by notice in writing whether they wish to be heard; if any party asks to be heard the Registrar must send all parties notice of a date for the hearing.	(No corresponding provision in Rule 31).

(10)	(No corresponding provision in Rule 13).	<u>Rule 31(5):</u> The Registrar may permit a person (other than the registered proprietor) claiming to have an interest in the proceedings to intervene.
(11)	(No corresponding provision in Rule 13).	<u>Rule 31(6):</u> A person permitted to intervene shall (subject to any terms and conditions imposed in respect of the intervention) be treated as a party for the purposes of applying the provisions of Rule 13 to the proceedings under Rule 31.
(12)	(No corresponding provision in Rule 13, but Rule 14(1) corresponds).	<u>Rule 31(7):</u> The Registrar must send the parties (and any intervener) written notice of his decision on the application, stating the reasons therefor.

Four points appear quite clearly from the above table. First, proceedings under Rule 13 are governed by detailed provisions which specifically require the Registrar to reject applications for registration if they are opposed and not defended by means of pleadings filed in the correct form within the time limits allowed for that purpose. Defaults in the filing of a defence are automatically penalised in all cases to which the Rule applies and the time limit for filing pleadings by way of defence is made unalterable by the provisions of Rule 62. Second, proceedings under Rule 31 are governed by detailed provisions which do not specifically require the Registrar to grant undefended applications *unless* they are undefended applications for revocation under Section 46(1)(a) or (b) of the 1994 Act. Defaults in the filing of a defence are not automatically penalised in all cases to which the Rule applies and the time limit for filing pleadings by way of defence is not made unalterable by the provisions of Rule 62. Third, in order to reach stage (4) in proceedings under Rule 31 it is necessary to satisfy procedural requirements which are explicitly different from those

which must be satisfied in order to reach the same stage in proceedings under Rule 13. Fourth, in order to progress beyond stage (4) in proceedings under Rule 31 it is necessary (having regard to the provisions of Section 69 of the 1994 Act and Rule 49 of the 1994 Rules) to adopt procedures of the kind required to progress proceedings under Rule 13 from stage (4) to stage (9).

With these considerations in mind it seems to me that Rule 31(4) of the 1994 Rules cannot realistically be taken to mean that “*subject to paragraph (2) above and paragraphs (6) and (7) below, all of 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*”. That interpretation of Rule 31(4) would require the express provisions of Rule 13 and the express provisions of Rule 31 to be applied cumulatively to proceedings under the latter Rule, even though the two sets of provisions establish different and clearly independent requirements for the conduct of proceedings down to stage (4). I cannot think that the draftsman of the Rules intended to subject applications under Rule 31 to such an unnecessarily complex and illogical regime.

In my view the express provisions of Rules 31(1) to 31(3) are intended to apply to applications under that Rule independently of Rule 13. Rule 31(4) then and thereafter proceeds to draw upon Rule 13 as a supplementary source of rules for the further conduct of ongoing proceedings under Rule 31. In other words Rule 31(4) envisages that “*subject to paragraph (2) above and paragraphs (6) and (7) below the provisions of rule 13 shall apply to the further conduct of ongoing proceedings relating to the application as they apply to*

the further conduct of ongoing 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 section 46(1)(a) or (b), the application shall be granted where no counter-statement is filed". If Rule 31(4) was not confined to the further conduct of ongoing proceedings, it would require the Registrar to blindly grant all applications left undefended for 3 months under Rule 31(3) in the same way as all applications for registration left undefended for 3 months under Rule 13(2) must blindly be rejected under Rule 13(3); in which case the specific exception in Rule 13(4) for applications "***on the grounds of non-use under section 46(1)(a) or (b)***" would be as unnecessary as it was incomplete. On the view I take of the matter, the specific exception is neither unnecessary nor incomplete because Rule 31(4) is confined to the further conduct of ongoing proceedings and it does not require the Registrar to blindly grant all applications left undefended for 3 months under Rule 31(3) cf. the course of proceedings in Corgi TM [1999] RPC 549 at 552 to 554. The independent effect to be given to the provisions of Rules 31(1) to 31(3) has the further consequence that the time prescribed by Rule 31(3) is not excluded by Rule 62(3) from the Registrar's power to extend time under Rule 62(1) and is therefore a time limit which can be extended, after it has expired, under Rule 62(5).

For these reasons I consider that the Hearing Officer wrongly regarded the Registrar as powerless to entertain any application for an extension of time that Donovan might make under Rule 62(5) with a view to regularising the late filing of the pleadings it presented for filing on 19th January 1999. He then took that error to its logical conclusion by granting Associated's applications for revocation without determining whether they were well-

founded in point of fact and without stating whether he would or would not have allowed the extension of time that Donovan required in order to regularise its position. However, the adoption of that approach led to the making of orders for revocation which I find myself unable to uphold on the basis on which they were made. Bearing in mind that Donovan was seeking to obtain an extension of time if it possibly could, I think that the correctness of the orders for revocation depended and continues to depend upon the answer to the unresolved question whether the time prescribed by Rule 31(3) should be extended under Rule 62(5) so as to permit late filing of the pleadings presented for filing on 19th January 1999. If so, the orders for revocation should be set aside. If not, the orders for revocation should stand.

While the question of extension of time under Rule 62(5) remains unresolved, I cannot be confident that Donovan's appeal against the Hearing Officer's orders for revocation should be allowed. Even so, I do not think it would be right for me to determine that question de novo on appeal. I will therefore suspend the Hearing Officer's orders for revocation for a period of 14 days from the date of this decision (i.e. until midnight on 16th February 2000) and direct as follows with regard to each of the orders for revocation:

- (1) If no application is duly filed on behalf of Donovan within the specified period of 14 days requesting an extension of the time prescribed by Rule 31(3) so as to permit late filing of the pleadings presented for filing on 19th January 1999, Donovan's appeal against the order for revocation will (without further order) stand dismissed and Associated will (without further order) be at liberty to apply to the Appointed Person within 21 days after expiry of the specified period of 14 days for an award of costs in

respect of the rejected appeal (such application to be made in writing via the Treasury Solicitor with copies to Donovan and the Registrar).

- (2) If an application to the effect stated in paragraph (1) above is duly filed on behalf of Donovan within the specified period of 14 days, the order for revocation will remain suspended pending final determination of that application.
- (3) If upon final determination of that application the time prescribed by Rule 31(3) is not extended so as to permit late filing of the pleadings presented for filing on 19th January 1999, Donovan's appeal against the order for revocation will (without further order) stand dismissed and Associated will (without further order) be at liberty to apply to the Appointed Person within 21 days after such final determination for an award of costs in respect of the rejected appeal (such application to be made in writing via the Treasury Solicitor with copies to Donovan and the Registrar).
- (4) If upon final determination of that application the time prescribed by Rule 31(3) is extended so as to permit late filing of the pleadings presented for filing on 19th January 1999, Donovan's appeal against the order for revocation will (without further order) be allowed, the application for revocation will (without further order) stand remitted to the Registrar and Donovan will (without further order) be at liberty to apply to the Appointed Person within 21 days after such final determination for an award of costs in respect of its successful appeal (such application to be made in writing via the Treasury Solicitor with copies to Associated and the Registrar).

I wish to emphasise that my decision to determine Donovan's appeals in this manner is not based upon any reasoning or conclusion to the effect that a decision correctly issued by the Registrar in accordance with the Act and the Rules can be set aside pursuant to an application to extend time subsequently made under Rule 62(5): see further the decision of Mr. Simon Thorley Q.C. acting as the Appointed Person in Everest TM (25th January 2000). My decision proceeds upon the basis that Associated's applications for revocation were granted without due consideration of Donovan's prior request for an extension of time under Rule 62(5) and will have been granted incorrectly if it transpires that an extension of time should be granted upon due consideration of that request.

Geoffrey Hobbs Q.C.

2nd February 2000

Mark Engelman instructed by Messrs Edward Evans & Co appeared as Counsel on behalf of Donovan Data Systems Ltd.

Rebecca Weeks of Messrs Haseltine Lake Trademarks appeared on behalf of Associated Newspapers Ltd.

Mike Knight, Principal Hearing Officer, appeared on behalf of the Registrar of Trade Marks.