

TRADE MARKS ACT 1994

IN THE MATTER OF A REQUEST BY WILSON SPORTING GOODS CO  
(THE OPPONENTS) FOR AN EXTENSION OF TIME WITHIN WHICH TO  
FILE EVIDENCE IN OPPOSITION PROCEEDINGS (No 49938) IN  
RELATION TO APPLICATION NUMBER 2169994

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IN THE MATTER of a request by Wilson Sporting Goods Co  
(the opponents) for an extension of time within which to  
5 file evidence in opposition proceedings (no 49938) in  
relation to application number 2169994

10 At an interlocutory hearing on 1 June 2000 I gave a decision, confirmed by letter on 5 June 2000  
in the following words:

15 “After the submissions I gave the following decision, that the requested extension of time for the  
filing of evidence would be granted but that I did not expect to see any further requests for  
extension of time. In the event you were able to file evidence within the period granted and the  
applicant now has three months from the date of that filing within which to file their evidence, that  
is until 2 September 2000, under Rule 13(9) of the Trade Marks Rules 2000.”

20 The applicant has requested a statement of the reasons for my decision, as provided by rule 62(2)  
of the Trade Marks Rules 2000.

### *Background*

25 Application number 2169994 was applied for on 18 June 1998 and, following examination, was  
advertised in the Trade Marks Journal, issue 6270 on page 3223, on 31 March 1999. On 30 June  
1999 Wilson Sporting Goods Co filed a Form TM7 and Statement of Grounds of Opposition to  
this application citing a number of sections of the Trade Marks Act 1994 which required the filing  
of evidence.

30 The applicant filed their defence in the form of a Form TM8 and Counterstatement on the 31  
August 1999, this was copied to the opponent on 2 September 1999 and the period for filing  
evidence under Rule 13(4) of the Trade Mark Rules 1994 (as amended) commenced allowing  
three months from the date of the letter. On 26 November 1999 the opponent requested an  
extension of three months for the filing of evidence giving the reason for the request as:-

35 “Active steps are being taken to prepare and complete evidence in support of the Opposition in the  
form of Statutory Declarations by a principal officer of the opponents and from a representative  
of the opponents’ United Kingdom operation. Draft declarations are under consideration by the  
opponents and the necessary evidence in support of the Opposition is expected to be received from  
40 the opponents’ UK operation very shortly. Further time is required within which to arrange for the  
finalisation and execution of the proposed evidence.”

45 This extension was granted by the registrar and subsequently, on 2 March 2000, a request for a  
further extension of three months for the filing of evidence was received, giving the reason as:-

“Preparation of the evidence in support of the opposition is underway and we are awaiting further  
details from our contact at the opponent’s United Kingdom operation. Once we have this further  
information, we will be able to complete the draft declaration for review by the opponents. We  
fully expect this exercise to be completed within the period of time now requested.”

The Registrars preliminary view was to grant this further extension, after this was communicated to the parties the applicant raised objections, on the basis of these objections this preliminary view was reversed and the opponent then requested an interlocutory hearing.

5 The hearing took place before me on 1 June 2000 with Mr Havelock, of D Young & Co, representing the opponent and Mr Krantz, of Courts & Co, representing the applicant.

### *Submissions*

10 Mr Havelock described the discussions which had taken place between his company and the opponents, detailing the problems that ensued from the opponent being a United States company with its European operation based in both Germany and the United Kingdom. The exhibits had been acquired from the United Kingdom operation and had been forwarded with the finalised Declaration to the head office in America for completion. He stated that he had been pressing the  
15 opponent to return this since 25 May 2000. Further he contended that the case had been progressing and if this case was dismissed on the basis of the opponents failure to file evidence this would merely lead to multiplicity of proceedings as they would then launch an invalidation action.

20 Mr Krantz went through the points raised in his letter of 22 March 2000, in particular analysing the wording of the two extension requests and suggesting that there in fact had been no progress by the opponent in the preparation of the evidence. He argued that there should be no need for the evidence to be handled in America as this case was within the UK jurisdiction and all evidence should relate to that jurisdiction. Further he argued that these proceedings were prejudicing the  
25 applicant in as far as this application was not progressing to registration and the opponent had effectively had a *de facto* extension of time.

### *Decision*

30 The power vested in the Registrar to grant extensions to certain periods of time determined in the Trade Marks Rules is discretionary, the periods allowed for the filing of evidence are not excluded from this discretionary power. At the date the request was made the relevant parts of Rule 13 in the Trade Marks Rules 1994 (as amended) read:

35 62. - (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  
40 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  
45 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),  
50 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).

5 The breadth of the discretion afforded the Registrar by this Rule was dealt with by the appointed person in the *Liquid Force Trade Mark* appeal, 1999 [RPC] 429, at pages 437 & 438, and allows that where any relevant circumstances are brought to her attention the registrar can exercise this discretion.

10 I was satisfied that the opponent has been making progress, albeit not as quickly as the applicant may have wished, and was hampered by the commercial set up of the opponent company. There are semantic deficiencies in the two requests when they are closely compared and analysed but at the hearing the opponents agent expanded and clarified on this to my satisfaction. I take particular note of the decision of the Court of Appeal in *Mortgage Corporation Ltd v Sandoes*  
15 [1996] TLR 751 in which it was commented to the effect that the absence of good reason for failure to comply with a time limit was not always and in itself sufficient to justify refusal of an extension of time, the true position being that it is for the party in default to satisfy the court that despite the default, the discretion to extend time should nevertheless be exercised in his favour, for which purpose he could rely on any relevant circumstances.

20 Whilst the applicants agent argued correctly that any evidence must relate to the UK market it is not unusual for a multi-national corporation, such as the opponent in these proceedings, to be domiciled outside the United Kingdom and for its major executives and legal representatives to be involved in the vetting and completion of evidence relating to their business. This can lead to  
25 communication and prioritisation difficulties when the party outside the UK does not understand the urgency with which matters need to be progressed following the introduction of the Woolf reforms to civil justice in this country.

30 Also there is a need to take into account the public interest aspect of this case and the potential for there to be a multiplicity of actions. This, in general terms, accords with the observations of Laddie J. in the appeal case *Hunt-Wesson Inc's Trade Mark Application* [1996] RPC 233 at 241:

35 "An opposition may determine whether or not a new statutory monopoly, affecting all traders in the country, is to be created. Refusing permission to an opponent who files evidence late affects not only him but also may penalise the rest of the trade. ... although the matter is not clear, it is probable that if the evidence is excluded and the opponent, as a result, loses then he will be able to return again in separate proceedings to seek rectification of the register. An advantage of allowing in the evidence ... is that it may well avoid a multiplicity of proceedings."

40 It must be borne in mind that these observations were made in the context of proceedings where one of the parties had further evidence to hand that they wished to be taken into account as they wanted the proceedings to be determined on its merits.

45 In these proceedings there is a public interest aspect in as far as the owners of these marks are in dispute over a new statutory monopoly which may have an impact on the public and other members of the relevant trade. At the hearing the opponents agent made it clear that if these proceedings were settled on a technical issue then the opponent would file to have what would then be a registration declared invalid.

I took note of the fact that the period requested was about to expire at the end of the day following the hearing and also the opponents agents assurances that the evidence was completed and was imminently expected by courier.

5 I took all the above into account when arriving at my decision, which was to exercise discretion in favour of the opponent and grant the requested extension of time within which they could file evidence. In giving this decision I made it clear that I did not expect to receive a further request to extend the period for filing the opponents evidence in chief.

10 Neither party made representations on the issue of costs.

**Dated this 5<sup>th</sup>. day of February 2001**

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**Mr G J Attfield  
Hearing Officer  
For the Registrar, the Comptroller-General**