

TRADE MARKS ACT 1994

**IN THE MATTER OF AN INTERLOCUTORY HEARING IN RELATION TO
OPPOSITION NO 49257 BY LEE ALEXANDER MCQUEEN TO TRADE MARK
APPLICATION 2158217 IN THE NAME OF NICHOLAS STEPHEN CROOM T/A
MCQUEEN CLOTHING CO.**

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5 **IN THE MATTER OF** an interlocutory hearing
in relation to opposition number 49257 by Lee Alexander McQueen
to trade mark application 2158217 in the name of
Nicholas Stephen Croom t/a McQueen Clothing Co.

10 **BACKGROUND**

1. The trade mark:

15 **McQueen Clothing Co.**

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25 was applied for on 14th February 1998 in the name of Nicholas Stephen Croom t/a McQueen
Clothing Co. It was duly published for opposition purposes. On 2nd December 1998 Lee
Alexander McQueen lodged formal opposition and a counter statement to defend the application
was then filed. The opponents' evidence in chief was due to be filed on 5th June 1999. The
opponents eventually filed evidence on 5th May 2000, that is, after they had been granted a total
of four extensions of time ('EOTs') on the basis of ongoing negotiations. The period for filing
the applicants' evidence under rule 13(9) of the Trade Marks Rules 2000 was then set at 8th
September 2000. A first EOT was granted up to 8th December 2000 on the basis of ongoing
negotiations. A second EOT was granted up to 8th March 2001, again on the basis of
30 negotiations. A third EOT was granted up to 8th June 2001, on the basis of negotiations,
although the applicants' agents said on their Form TM9¹, filed on 7th March 2001, that evidence
had been drafted at the time the EOT was requested. Although they had been given the
opportunity, at no time had the opponents objected to these extensions.

35 2. On 8th June 2001, the applicants filed, by fax, part of their evidence in the form of a witness
statement by Nicholas Croom, at the same time asking for an extension of 2 weeks to 'complete
the filing of its evidence'. On 20th June 2001, the agents for the applicant telephoned the registry
confirming that an error had been made in their request for an extension filed on 8th June, and that
they had meant to request a further 2 months, not 2 weeks, to file their evidence. On 27th June
40 2001, the registry sent out its preliminary view that the extension of 2 months should be allowed,
subject to either party filing a request to be heard or written arguments against the preliminary
view by 11th July 2001. By the time the registry had issued its preliminary view, the formal
evidence of Nicholas Croom had been received on 20th June, together with a witness statement

¹ The official form used to request an extension of time

by Stephen Mucklow. The opponents subsequently objected to the extension and requested to be heard and a hearing was set down for 3rd August 2001. The applicants, meanwhile, filed more evidence in the form of a witness statement by Bruce Clarke on 25th July 2001.

5 3. In short, the question to be resolved at the hearing was whether the applicants should be granted an EOT from 8th June 2001 to 8th August 2001 and thus whether the evidence already filed, plus any that was ready to be filed, should be admitted into the proceedings.

10 4. At the hearing on 3rd August 2001, Mr Malynicz of Counsel represented the applicants, and Mr Engelman, also of Counsel but attending in his capacity as a non-executive director of Autumnpaper Ltd (beneficial opponents), represented the opponents. Although the hearing was appointed to determine an extension of time, before this issue could be determined, it was necessary at the hearing to decide two preliminary issues: the first was an application to adjourn the hearing, and the second was a dispute as to whether Mr Croom's evidence was filed within the disputed extension of time or within the previous undisputed extension. At the hearing I declined to adjourn or vacate, but reserved my decision on the status of Mr Croom's evidence and the substantive issue of an extension of time. My subsequent decision confirming the status of Mr Croom's evidence, and to allow the applicants an extension of time up to close of play on 15 8th August 2001, was given by letter dated 6th August. I am now asked to give my statement of 20 reasons.

Application to adjourn or vacate the hearing.

25 5. Mr Malynicz asked for the hearing to be adjourned or vacated. I understood the basis of his submission to be that the applicants were at a serious disadvantage by the fact that they did not know until the day before the hearing that Mr Engelman would be representing the opponents. In essence, this submission went to the issue of 'equal footing', as an element of the overriding objective, to which civil proceedings in general are subject (see Rule 1.1 (2)(a) of the Civil Procedure Rules). In the event, Mr Engelman was not appearing as Counsel but as a non- 30 executive director of the beneficial opponents, Autumnpaper Ltd.

35 6. Mr Malynicz's second submission in relation to adjournment or vacation went to the fact that Mr Engelman's presence at the hearing in his stated capacity as a non-executive director of the beneficial opponents was, in some unparticularised way, irregular, having regard to the Bar Code of Professional Practice.

40 7. Mr Engelman opposed any adjournment. I gave my decision at the hearing that I would not adjourn or vacate the hearing. I gave no view on the alleged breach of the Bar Code of Professional Practice. Provided I could see nothing irregular as far as representation before the registrar's tribunal was concerned then there was no issue for me. Mr Engelman's capacity had been confirmed to the tribunal prior to the hearing. This confirmation corrected earlier information supplied in the week before by the applicants' agents. It is true that Mr Engelman's skeleton argument submitted the previous day was on his Chamber's headed paper, but there were certainly no grounds to infer any deliberately misleading intent in that. Mr Engelman said 45 that there had been a communication breakdown with the agents who had earlier assumed he was representing their clients as Counsel. The real position was that Mr Engelman was standing in

the shoes of the beneficial opponents (an assignment from Lee Alexander McQueen to Autumnpaper Ltd had not, at the time of the hearing, been finalised and registered, but a unsigned version had been furnished before the hearing) and not as Counsel.

5 8. In relation to the ‘equal footing’ issue, again I could find no compelling reason to adjourn the
hearing. The applicants had chosen to appoint Counsel themselves and the issue to be decided
was not a difficult one, such that Mr Malynicz, as Counsel himself, would not have had sufficient
10 of time ‘simple’; they rarely involve novel legal argument, the discretion being exercised on an
appraisal of the facts and limited case law. Another reason not to adjourn was that the applicants
had throughout the proceedings been professionally represented by a firm of trade mark
attorneys; a firm which had, during the day before the hearing, submitted their skeleton argument
by fax. The preparation for the hearing had thus been done; the applicants may have been thrown
15 somewhat by the late knowledge of Mr Engelman’s attendance, but not disadvantaged. The
action taken by the applicants’ agents was to appoint Counsel for their own clients, Mr
Malynicz. I felt this was entirely optional on their part. Because trade mark attorneys are
perfectly capable and used to representing their clients before the registrar’s tribunal on matters
such as extensions of time, there was no need to match Counsel with Counsel. Whether to engage
20 Counsel, and who that Counsel may be, is ultimately a matter for the individual party; but the
opponents and the applicants had a right to employ Counsel (see eg *Maltez v Lewis* [*The Times*
4th May 1999]). As I have said, then, given the nature of the issue and the background work done
by the applicants’ professional representative, I was happy that the playing field was level.

25 9. Another factor I considered relevant to the question of adjournment was the fact that any
delay could well have taken us beyond the period in dispute (the hearing took place on 3rd
August, the extension requested was to 8th August), although, given the registrar’s wide powers
and practice in relation to rule 68(1), this, of itself, would not have been determinative. Lastly,
there is the registrar’s stated practice in relation to postponements (TPN 1/2001), from which it
30 can be said that any change in a previously notified hearing date has to be fully justified in the
light of the potential knock-on effects of rearranged hearings (para 2 of the TPN).

Mr Croom’s evidence.

35 10. It is necessary to address the status of Mr Croom’s evidence which had been filed by fax
on 8th June (followed later with a hard copy), the day of expiry of the previous extension of time
allowed by the registry. The registry allows evidence to be filed by fax to meet a deadline,
provided that the original copy of the evidence is received within a reasonable time thereafter.
Mr Engelman contended that Mr Croom’s evidence was out of time and thus within the scope
of the disputed extension of time. Although it had been filed by fax within the last extension
40 period, it had not been faxed in its ‘entirety’ to the registry. The last sentence of para 31 of TPN
2/2000 reads:

Parties should take care to ensure that evidence filed by facsimile transmission is received by the Office
in its entirety and is legible.

45 11. I do not agree with Mr Engelman’s submission. Mr Croom’s evidence; that is, the exhibits

rather than the witness statement itself, were physically incapable of being faxed. Like much evidence that is filed before the registrar the exhibits comprise bulky, 'physical' exhibits which are not in handy documentary form. In my view the exhibits simply could not have been passed through a normal fax machine. It would make no sense to require a party to do something which technology does not allow and the word 'entirety' in the relevant TPN can only be read as meaning that which is capable of being faxed. I concluded therefore the Mr Croom's evidence had been timeously filed; the fax version was followed by the originals which were filed on 20th June 2001.

The extension of time.

12. The registrar's power to allow a discretionary extension to file evidence under rule 13(9) of the Trade Mark Rules 2000 is set out in rule 68(1) which reads:

Alteration of time limits (Form TM9)

68. - (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, or on the initiative of the registrar, be extended by the registrar as she thinks fit and upon such terms as she may direct.

13. The request to extend the period had been made within the previous extension allowed and was formally in order. I allowed the extension up to close of play on 8th August 2001 for the applicants to file their evidence in chief. Excluding Mr Croom's evidence, which I have already dealt with above, the applicants had a series of witness statements from independent persons which they wished to comprise their evidence in chief. By the time the hearing took place, the registry had received from the applicants' agents witness statements from Stephen Mucklow and Bruce Clarke which were filed within the disputed period. Two further witness statements from Robert Moore and Mark Turner were filed by fax (later in hard copy) on 6th August, in accordance with my decision given by letter on 6th August 2001. Thus, the evidence was either to hand by the time the hearing took place or was ready to be filed. There was no uncertainty as if, and when, the evidence would be filed.

14. Both Mr Engelman and Mr Malynicz argued their respective cases combatively and at length, but I think I can distill their submissions as follows. Mr Englemans' main submission relied upon a self-evident absence of diligence on the part of the applicants, given that they had had a period running from 8th June 2000, when the opponents had filed their evidence, to file their own evidence, some 14 months. Of course, it would be considerably longer if one takes the view that the applicants ought to be compiling their evidence without waiting to see the opponent's. Mr Engelman's second main submission was that the applicants had misled the registry in their Form TM9 filed on 8th June 2001 by saying that:

“Settlement negotiations are being made (sic) to the opponent and are expected to be ongoing”.

5 This, said Mr Engelman, implies that during the period of the previous extension of time the applicant had made settlement representations to the opponent. In fact this was not the case and no response to the opponents’ revised delimitation agreement sent in March 2001 had been received. A response was only received from the applicants *after* the relevant Form TM9 requesting an extension was filed.

10 15. Mr Malynicz also relied on two main submissions: firstly, the lack of prejudice being suffered by the opponents, whose wait for the applicants’ evidence was only a matter of days; and secondly, that if the registrar refused to allow the evidence to be filed, the end result would most likely be an application to have the evidence admitted by leave of the registrar (rule 13(11)).

15 16. I should stress that I do not believe that either of Mr Malynicz’s submissions should be regarded as determinative of the issue of an extension of time. Likewise, nor should the fact that the evidence was either to hand, or ready to be filed at the hearing, be treated as determinative. These are all factors in an overall assessment whether to allow the extension, but to regard them as anything more would, I believe, lead to abuse and the registrar’s discretion being unduly restricted. There has to be room for justice.

20 17. Mr Engelman took me to all the, by now familiar, authorities on extensions of time: *R v Registrar of Trade Marks ex parte SAW Company SA* [1996] RPC 507; *AJ and MA Levy’s trade mark application* [1999] RPC 291 and *Liquid Force Trade Mark* [1999] RPC 429. Quite naturally, he selected from those cases elements which supported his opposition to the extension. From *SAW* he said that, as in that case, there was nothing to explain the conduct of the applicants in the preparation of their evidence for at least most of the 14 month period. From *Liquid Force*, he urged me not to accept the evidence just because it had been filed and also drew my attention to the length of time during which due diligence needs to be shown, ie from the filing of the counterstatement, if it contains no surprises. Of course, in *Liquid Force*, it was the opponents seeking the extension and not the applicants as in this case. From *Levy’s* case he urged that strong and compelling reasons for an extension need to be given.

30 18. I quite agree with Mr Engelman that the person seeking the indulgence of a disputed extension of time to file evidence has a diligence test to overcome.

35 19. It should be remembered , from the factual background set out above, that the opponents themselves had had over a year (through extensions of course) to file their own evidence. Towards the end of that period, the applicants refuted the suggestion from the opponents that negotiations had been ongoing as the reason for the opponents’ last extension. In support of the opponents’ extension, their agent said in a letter dated 22 March 2000:

40 “The applicants’ representatives had every opportunity to contest previous extensions of time requests (which included reference to ongoing negotiations) but did not do so”.

45 Each extension of time is decided on its own merits and therefore the length of time which the opponents had to file their own evidence is not a factor in my determination of this extension

of time. The opponents had ample opportunity to object to any of the previous extensions allowed to the applicants but did not do so. Accordingly, the previous extensions granted to the applicants were outwith the scope of this hearing, and therefore the opponents must be taken not to dispute that negotiations were ongoing during much of 14 month period - as stated on the applicants Form TM9s filed in support of earlier extensions. Mr Engelman's detailed chronology of exchanges between the parties appended to his skeleton argument indicate that negotiations were taking place during the 14 month period, albeit at a slow pace.

20. Nevertheless, since an extension of time in which to file evidence is the matter in dispute, it is incumbent on the applicants to say what they have done in respect of their evidence preparation. The Form TM9 filed on 7th March indicated that evidence had been drafted and was awaiting clients' approval. The TM9 filed on 8th June, the subject of this hearing, said that the evidence had been approved and was ready to be filed although it is not clear exactly which evidence is being referred to. I think it is safe to conclude from this that some draft evidence was available to the applicants as at March 2001, the preparation of such evidence may therefore be reasonably inferred as having taken place sometime before then, but it would be wrong of me to infer more than that. Suffice it to say that this does not appear to be a case where the applicants only addressed the issue of evidence preparation during the period of the disputed extension.

21. Mr Engelman also submitted that the applicants had disqualified themselves from having an extension because they had implied on the relevant Form TM9 filed on 8th June that an approach to the opponents had been made during the last extension period. In my experience, it is often the case that when a party seeks an extension before the registrar very sketchy details are provided on Form TM9. I would not say in this case that the words said on the Form TM9 (quoted in paragraph 14 above) are such that the only interpretation possible is that the applicants have approached the opponents during the previous extension. Clearly, if circumstances and evidence had been brought to my attention which suggested that the registrar had been actively misled by the TM9 into believing, for example, that negotiations were in some way in existence when patently they were not, I may have arrived at a different conclusion in the exercise of discretion. I do not think this is the case here though; the applicant is simply saying on Form TM9 that negotiations have not broken down.

22. Evidence that negotiations had not broken down, coupled with the filing of evidence which goes some way to support the argument that the applicants had been working for some time on the preparation of evidence, persuaded me to allow the applicants the extension they sought. The other factors in the equation I have already identified in paragraphs 15 and 16 above: namely, the fact that Mr Engelman did not identify any clear prejudice suffered by the opponents as a result of the extension being allowed ; the fact that the evidence had already been filed or was about to be; and, the probability that any refusal to admit the evidence in could have resulted in further delay and cost as the applicants would have then sought leave under rule 13(11) to have the evidence admitted as 'further' evidence. There would, of course, have been no guarantee of success had they pursued this route. The decision to grant this EOT has not, however, been given without some hesitation as I am mindful of the length of time these proceedings have taken so far.

23. No award of costs in respect of the hearing has been made. In response to a written application for costs from the applicants, the registry has confirmed that this will be determined at the conclusion of proceedings.

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Dated this 4TH day of October 2001

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Edward S Smith
Hearing Officer, acting for the registrar.