

O-103-16

TRADE MARKS ACT 1994

**APPLICATION No. 3099925 BY KEVIN O'TOOLE
TO REGISTER A LOGO BASED ON THE NAME N-TRANCE**

AND

OPPOSITION No. 404712 BY MICHAEL LEWIS

Decisions on a retrospective extension of time and whether an opposition should be deemed withdrawn for lack of evidence

1. At a case management conference (“CMC”) held on 23rd February I decided to refuse Mr Michael Lewis’s application for a retrospective extension of time. The extension sought was for three months from 23 November 2015 to 23 February 2016. The initial date was the deadline for Mr Lewis to file evidence in support of his opposition to trade mark application 3099925. The application was filed by Mr Kevin O’Toole. It is to register a logo version of the name N-Trance for various goods and services, including live musical performances and disc jockey services. Mr Lewis opposes the registration of the mark for disc jockey services.

2. Mr Lewis’s reasons for the required extension were set out in an email dated 29th December 2015 and repeated in a formal application on Form TM9R filed on 29th January 2016. In essence he said that his priorities had been disrupted after his sister suffered a stroke, and that he found the stress of dealing with these proceedings too much to cope with at the time when the evidence was due.

3. Mr Lewis said that the purpose of the required extension of time was to *“trace and submit further evidence that [he was] indeed a founding member of the band N-Trance [in 1991] and to show that [he has] also been an active member of the band since the agreement in 2010”*. The reference to the 2010 agreement bears on one of the claims in the notice of opposition: that Mr O’Toole and Mr Lewis reached a verbal agreement in 2010 that Mr Lewis *“would retain the indefinite rights and revenue from any N-Trance related disc jockey sets”*.

4. Mr Lewis relied on these matters to support the principal contention in his opposition under s.5(4)(a) of the Act; namely, that he had *“been using the [N-Trance] logo for printing and promotional uses and it will be [him] that the public will be expecting to see when they book N-Trance DJ”*.

5. A counterstatement to the notice of opposition was filed on Mr O’Toole’s behalf. The counterstatement denied that:

- a) Mr Lewis was a founding member of the band N-Trance;
- b) Mr Lewis had used the N-Trance logo included in his notice of opposition;
- c) There was any verbal agreement in 2010 between Mr Lewis and Mr O’Toole under which Mr Lewis retained the rights to, and revenue from, all N-Trance DJ sets;
- d) Mr Lewis was the owner of the goodwill under the logo identified in the notice of opposition in relation to disc jockey services, and that such goodwill dates from 1991.

Mr O’Toole put Mr Lewis to proof of the matters he denied.

6. The counterstatement was served on Mr Lewis on 21st September 2015 and, in accordance with Rule 20(1) of the Trade Mark Rules 2008, he was given until 23rd November to file evidence in support of his claims. The letter serving the counterstatement explained the difference between evidence and submissions (arguments) and explained that evidence could be served by witness statement, affidavit or statutory declaration. The letter also provided a link to the IPO's online Work Manual, which contained further information about the form of evidence. The letter also told Mr Lewis that if he did not file evidence by the due date, his opposition may be deemed withdrawn.

7. Mr Lewis did not file evidence by the due date. Accordingly, the case worker wrote to him on 15th December stating that he was minded to deem the opposition as withdrawn in accordance with Rule 20(3) of the Trade Mark Rules 2008. He gave Mr Lewis until 29th December to identify any reasons why the opposition should not be deemed withdrawn.

8. This seems to have prompted the email from Mr Lewis of 29th December 2015, described above. In his email he asked for time *"to gather the information requested"* and he attached to it a copy of a letter dated 9th October 2015 from his solicitors, Sheridans, to JMW Solicitors LLP, who appear to have acted for Mr O'Toole in prospective passing-off proceedings against Mr Lewis. The letter from Sheridans disputed the basis for the threatened passing off proceedings. Attached to it were copies of various emails and a Facebook page. These were said to show that at the times of the alleged acts of passing off, Mr Lewis was a member of the band and/or responsible for the administration of bookings and the band's website. Consequently, there was no misrepresentation by him or damage to the band's goodwill.

9. At the CMC, Mr Lewis was assisted by his nephew, Mr Waller. Mr O'Toole was represented by Mr Lee Curtis of HGF Ltd, Trade Mark Attorneys.

10. Mr Lewis elaborated a little on the information provided in his written application for a retrospective extension of time. He said that his sister had had a stroke about four months ago and this had affected his ability to process the opposition because she had been helping him with it. Mr Lewis had continued to work as a DJ, but a number of his bookings had been cancelled after objections were raised by, or on behalf of, Mr O'Toole.

11. I pointed out that the three months extension of time sought expired on the date of the CMC and I asked Mr Lewis whether he had, or was in a position to, file evidence in support of his case. He told me that he had not realised that any "further" evidence was required. He had understood that the purpose of the CMC was to argue the merits of the opposition. However, Mr Waller assured me that if I allowed a

further short extension of time, Mr Lewis would collect and file the necessary evidence.

12. Mr Curtis submitted that I should reject Mr Lewis's request for an extension of time because:

- a) He had not explained what he did to collect evidence during the two month period allowed for doing so;
- b) His sister's unfortunate illness did not justify an extension of time of three months;
- c) It was Mr Lewis's opposition and he had a duty to attend to it;
- d) His client was being unfairly affected by the delay in determining the proceedings.

13. The Registrar has a discretion to extend time limits, even retrospectively, under Rule 77 of the Trade Mark Rules 2008. It is well established that applications for extensions of time should set out what was done within the original period for taking the action, what remains to be done, why that was not possible within the original period, and how much longer is realistically required to complete the action. Additionally, where the extension of time is sought after the period has already expired, there should also be an explanation as to why no extension was sought before the period had expired.

14. Mr Lewis's primary position at the CMC appeared to be that he had not realised that any "further" evidence was required. In my view, Mr Lewis should have realised that evidence was required because he was told as much in the IPO's letter of 21st September 2015. Further, prior to the CMC he had twice indicated in writing that he wanted time to gather evidence. It is therefore difficult to understand why Mr Lewis did not realise that evidence was required. I accept that Mr Lewis is unfamiliar with the process for filing evidence, but he was told that information about this was available on the IPO's website. There is nothing to indicate that he used this information, or otherwise informed himself as to how to go about filing evidence.

15. I agree with Mr Curtis that Mr Lewis's sister's illness, upsetting and distracting as I accept it was for Mr Lewis, does not justify a retrospective three months extension of time. This is longer than the whole of the original period allowed for filing evidence. Further, given that the evidence was not in fact prepared within the extended period either, there would have been no point in agreeing to the requested extension without also agreeing a further extension of time after the CMC to allow Mr Lewis to collect and file his evidence. On the basis of what has happened (or not happened) so far, I did not consider that I would be justified in granting a further extension of time, even if I was confident that Mr Lewis would be able to file relevant evidence within that period (which I was not).

16. As Moore-Bick L.J., Vice-President of the Court of Appeal stated in *R (Hysaj) v Secretary of State for the Home Department*¹ and Tomlinson L.J. and King L.J. agreed:

“... if proceedings are not to become a free-for-all, the court must insist on litigants of all kinds following the rules. In my view, therefore, being a litigant in person with no previous experience of legal proceedings is not a good reason for failing to comply with the rules.”

17. In *Robert Bosch GmbH v Roman Khan*² Mr Geoffrey Hobbs Q.C., as the Appointed Person, agreed that the same applies to proceedings before the Registrar under the Trade Marks Act.

18. In all the circumstances, I was not satisfied that the application for a retrospective extension of time was justified. Moreover, I accepted Mr Curtis’s submission that allowing yet more time for Mr Lewis to submit evidence would be unfair to Mr O’Toole. This is because he is entitled to have his application determined in a reasonable and predictable timescale.

19. This brings me to the second issue covered by the CMC; namely, whether the opposition should be deemed withdrawn for lack of evidence. The relevant parts of Rule 20 are as follows:

20.—(1) Where—

(a) -

(b) the opposition or part of it is based on grounds other than those set out in section 5(1) or (2) and the applicant has filed a Form TM8;

(c) -

the registrar shall specify the periods within which evidence and submissions may be filed by the parties.

(2) Where—

(a) -

(b) the opposition or part of it is based on grounds other than those set out in section 5(1) or (2);

(c) -

the person opposing the registration (“the opposer”) shall file evidence supporting the opposition.

¹ [2014] EWCA Civ. 1633 at paragraph [46]

² British Library BL-O-399-15 (see IPO website)

(3) Where the opposer files no evidence under paragraph (2), the opposer shall be deemed to have withdrawn the opposition to the registration to the extent that it is based on—

- (a) the matters in paragraph (2)(a) or (b); or
- (b) -.

20. The sole ground of opposition is based on s.5(4)(a) of the Act. So Rule 20(3) is applicable. I note that Rule 20(3) is expressed in mandatory terms. If no evidence is filed under Rule 20(2) the opposer “*shall be deemed to have withdrawn the opposition*”. Consequently, the only question I have to decide is whether Mr Lewis has filed evidence in support of his opposition.

21. At the CMC Mr Lewis suggested that he had. He referred me to statements made in the notice of opposition and attachments to his email of 29th December.

22. As to the statements in the notice of opposition, I note that the Form TM7 included a statement of truth, which Mr Lewis signed. Consequently, although not in the form of a witness statement, it could arguably constitute evidence under Rule 64(1)(b). This ‘evidence’ was clearly not filed under Rule 20(2) because it preceded the period allowed for filing evidence under Rule 20(1). Nevertheless, if it really was supporting evidence I cannot imagine that the opposition should be deemed withdrawn simply because it was filed too soon. In an appropriate case, I would be willing to treat evidence filed with a notice of opposition as though it had been filed under Rule 20(2). However, in this case the statements in the notice of opposition were essentially assertions that (i) Mr Lewis was a founding member of N-Trance, (ii) that he was an active band member, and (iii) that he made a verbal agreement with Mr O’Toole which gave him the rights to N-Trance in relation to DJ services.

23. Such assertions are common as pleadings, but they do not prove themselves. They are the bold claims, not the factual material which justifies those claims. Mr Lewis’s claims were denied in Mr O’Toole’s counterstatement (which I note also included a signed statement of truth) and Mr Lewis was put to proof of his claims. Mr O’Toole was entitled to do this because the evidential burden, at least in the first instance, is on Mr Lewis to establish the factual basis of his opposition.

24. The copy of the letter from Sheridans, and the attachments, were intended to show that Mr Lewis was not passing himself off as N-Trance. They did not purport to show that Mr O’Toole was passing himself off as N-Trance by using that name in relation to DJ services. Consequently, even if that email constituted ‘evidence’, it was not capable of providing the factual support required for Mr Lewis’s claims in this opposition.

25. In any event, I do not consider that the email constituted admissible evidence. This is because i) the Registrar’s letter of 21rd September 2015 told Mr Lewis that

evidence was to be filed by witness statement, affidavit or statutory declaration³, and
ii) Mr Lewis did not copy the email to the other side as required by Rule 64(6).
Consequently, it is deemed not to have been filed.

26. In these circumstances, it is impossible for me to determine the truth of the matters at issue without factual material and/or particularised statements from Mr Lewis which at least arguably establishes a basis for his claims, e.g. that since 2010 he received the revenue from, and has been promoted to the public as responsible for, the N-Trance DJ sets.

27. In the absence of such evidence, I find that Rule 20(3) applies and Mr Lewis's opposition is therefore deemed withdrawn. This means that the trade mark will now be registered in the name of Mr O'Toole, including for disc jockey services.

28. Mr Curtis indicated that the applicant applied for an award of costs. This will be the subject of a separate decision.

Dated this 29th Day of February 2016

**Allan James
For the Registrar**

³ And therefore constituted a direction under Rule 62(2)