

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION **m** 2107451  
H S JACKSON & SON (FENCING) LIMITED  
TO REGISTER THE TRADE MARK

**EUROGARD**

AND

IN THE MATTER OF OPPOSITION BY  
BY GROUP 4 TOTAL SECURITY LIMITED  
THERE TO UNDER OPPOSITION **m** 47876

## DECISION

### Background

H S Jackson & Son (Fencing) Limited applied on 12 August 1996 to register the trade mark EUROGARD in Class 6 for:

- 5       ‘Fencing; fencing products of metal; fences, gates, gate posts, traffic barriers,  
boundary rails, guard rails; parts and fittings for all the aforesaid goods.’

The Application was advertised on 1 September 1997 and was subsequently opposed by Group 4 Total Security Limited, who submitted a Notice of Opposition dated 1 December 1997. The Opponents were late in submitting their evidence under rule 13(4) of the Trade  
10 Mark Rules 1994 (as amended) and requested a number of extensions of time to be allowed to do so. These were granted using the discretion the Registry has under rule 62. However, a final extension request was refused in a letter from the Registry dated 6 January 1999 and the Opponents requested a Hearing under rule 48(1).

This was held in the Newport Office video conference facility with Mr Blum appearing for the  
15 Applicants at the London office and Mrs Zartarian attending at Newport for the Opponents. The refusal to grant a further extension of time was confirmed, and under rule 13(5) the Opposition is deemed withdrawn. I am now required to give detailed reasons for this decision.

### Chronology

20 Following their Notice of Opposition, three extension of time requests were received from the Opponents. The first of these arrived on the 5 March 1998 requesting an extension of time of 3 months, until 30 June 1998. The reasons given were as follows:

- 25       ‘Without prejudice, negotiations are in place and a counter-proposal has been put to the Applicants and is under active consideration. Further time is therefore required to allow these without prejudice, negotiations to continue unfettered, and both parties it is anticipated would appreciate the Registrar’s forbearance in this respect.’

The requested was granted, being unopposed by the Applicants.

Another request appeared on 29 June 1998, but was dated 25 June 1998. This again asked for  
30 time to submit the evidence required by rule 13(4), and the period requested was again 3 months. The reasons were stated as:

- ‘Without prejudice, negotiations continue apace. Further proposals have been put forward by both parties with a view to amicably settling this matter, and it is anticipated that the matter will be settled within this further three month period. It would be greatly appreciated therefore if the Registrar could grant this request.’

Again, this request was unopposed by the Applicants and the Registry granted it until 30 September 1998.

The third request arrived on 1 October 1998, but was dated 29 September, and contained the following statement:

5       ‘We should be grateful if a further extension of three months could be granted in connection with the above numbered proceedings, as we are still in the process of negotiating an amicable settlement to these Opposition proceedings. This further extension of time should hopefully be sufficient for the parties to reach an agreement regarding the co-existence of their respective Trade Marks.’

10       This time the Applicants opposed the request, it was initially refused by the Registry and a Hearing was requested by the Opponents. This was held on 26 November 1998.

At this Hearing, the Opponents said that the Mark was very important to them, but delay had apparently been caused because they needed to consult with 6 different companies within their business group on the negotiations referred to in the successive extension of time requests. In response the Applicants said that the Opponents had already had nearly ten months in which to lodge their evidence and the reason they had given for the delay were not valid. Further, although negotiations had taken place, the Opponents have always been extremely dilatory in their responses and they had been waiting for nearly four months for a response to their last proposal.

20       Following a firm assurance from the Opponents Agent at this Hearing that the evidence was very close to completion - a reference was made to a draft copy the Agent had in his papers - and that it would be available by the end of December, I granted an extension until 29 December 1998. However, I made it very clear this was to be regarded as final.

Subsequently, no evidence was produced by that date; instead another extension of time request arrived on 24 December<sup>1</sup>, which contained the following statement:

25       ‘One month extension of time request is hereby requested in order to engross in an appropriate fashion a Statutory Declaration together with supporting Exhibits, the draft of which was inadvertently signed and completed on the 23rd December 1998, and received here on the 24th December when clearly the draft only required approval given that various Exhibits had to be engrossed. We enclose a copy of the completed draft Declaration as proof positive of the aforementioned statement, and whilst this could of course be submitted in the proceeding, the Declaration is not complete given that no Exhibits have been engrossed nor completed. The Exhibits are now being prepared and are being forwarded to our clients for completion, and this one month extension request should be more than sufficient to formalise completion of the evidence.’

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<sup>1</sup>It should be noted that the Applicants gave notice that they intended to appeal the final extension to 29 December, but this was withdrawn when the Opponents failed to meet this deadline.

Whilst we do appreciate that the extension up to the 29th December “must be regarded as final”, we do trust that we have proven satisfactory to the Registrar that we have not been sitting idly by, but rather working towards completion of our evidence, and the only encumbrance in the process has been a mis-understanding in procedure on our clients part.  
5 We anticipate filing the evidence within the one month extension request, and should the Applicants object, then we wish to be heard in Newport.’

As this was refused, a Hearing was requested and this was held on 26 January 1999. The Opponents argued that, though the last extension of time request granted in November was to be ‘regarded as final’, this could not be taken as an unconditional statement as it always open  
10 to parties to ask for a further extension of time. They explained that the evidence had been ready by the deadline of the last extension, but had not been engrossed. However, in view of the fact it was made available only 14 days after this deadline, and was ‘on the table’ at this Hearing, it submitted to be in the public interest to grant the new extension to allow the evidence in. Further, the length of time between the submission of the counterstatement in  
15 these proceedings and production of the evidence was 13 months, which the Opponents did not consider to be excessive, particularly as the preparation of evidence over this period was slowed in view of the negotiations taking place with the Applicants.

The Agent representing the Applicants, Mr Blum, repeated his view given at the last Hearing in November that the ‘negotiations’ that had been used to justify previous extensions had been  
20 slow and dilatory. Also, the Opponents had 13 months to date in which to submit straightforward evidence and had failed to do so. He further suggested that it was not in the public interest to take well over a year to produce the necessary evidence.

I decided not to grant this fourth extension for the following reasons. First, it should be noted that the extension granted at the Hearing on 26 November could be regarded as a generous  
25 exercise of the Registrar’s discretion in view of the time the Opponents had taken to that date and the reasons they provided for the delay. That extension was granted in view of the Opponents firm assurance that the evidence was prepared and would be available by the December deadline.

I was also assured by the Opponents Agent, at the November Hearing, that they took the  
30 matter very seriously and that the mark under discussion was a very important brand to them. This is belied by their failure to gather the evidence and submit it with exhibits by the 29 December. The reason for this is given as an administrative failure to ensure the evidence was correctly ‘engrossed’. In view of the assurances given by the Opponents this seems incredible, particularly as I made it clear at that the 26 November Hearing that the extension given must  
35 be regarded as final, and that the Opponents were ‘drinking in the last chance saloon’.

Third, the evidence was produced at the Hearing in January and is not complex, consisting of one two page statutory declaration and three exhibits. The exhibits are:

! a Certificate of Incorporation and Change of Name,

! copies of advertising brochures, and

! examples of the use of the EUROGARD mark.

5 The second exhibit appears to be of peripheral relevance to the Opponents case and neither this nor the brochures seem to be material that would have been difficult to compile over the 12 months they had at their disposal. Though the last exhibit consists of a large collection of copies of invoices, contracts and other literature, again, 12 months seems a more than adequate time period in which to assemble the examples provided.

10 Finally, I did not regard the existence of ‘negotiations’ as significant reason for long the delay in the preparation of the evidence. Further, the Applicants disputed the seriousness of the Opponents’ commitment to these negotiations. In particular they said that settlement negotiations had not continued ‘apace’ as claimed in the second extension of time request dated 25 June 1998, but they had received only three letters in 11 months from William A Shepard & Son, the Opponents agents. This was not disputed by the Opponents at either of  
15 the Hearings.

The fact that late evidence is finally made available at a hearing is not of itself enough to require its submission into the proceedings. Jacob J<sup>2</sup> quoted in the S.A.W. case the following extract from the Registrar’s decision:

20 “As I indicated at the hearing the Registrar is always reluctant to refuse an extension of time in a case where evidence has been filed .. but in this case I am of the opinion that I had little option but to do so because of the lack of action on the part of the opponents during the relevant period of six months for filing evidence. If this had been satisfactorily explained then I would have accepted that the period of four months for preparation of the evidence by the new agents was not unusual or unacceptable. However, in exercising  
25 discretion in cases such as these, it is relevant as to what the party did during the period allowed for the filing of evidence, not what they did subsequently.”

The SAW case was concerned with a period of 6 months - described by Jacob J as ‘a very generous period for the filing of evidence’ - while this case is concerned with a period of over 12 months. In a recent Decision<sup>3</sup> the Appointed Person stated:

30 ‘...even if the default does not appear to involve an abuse of process, it may yet be the case that the delay in producing such evidence is inordinate, inexcusable and so seriously prejudicial to the opposite party that no indulgence should be given to the party in default in accordance with the principles laid down and reaffirmed by the House of Lords in *Birkett v.*

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<sup>2</sup>*R v REGISTRAR OF TRADE MARKS ex parte S.A.W COMPANY S.A* [1996] R.P.C 17, p 509.

10 <sup>3</sup>*APPLICATION FOR AN EXTENSION OF TIME TO FILE EVIDENCE IN OPPOSITION 46366 AND APPLICATION 2069509 FOR THE TRADE MARK LIQUID FORCE, NOVEMBER 1998.*

James [1978] AC 297 and Department of Transport v. Chris Smaller (Transport) Ltd [1989] AC 1997.

5 For these reasons I consider that the natural reluctance of the Registrar to refuse an extension of time for filing evidence which has belatedly come to hand cannot be elevated to the status of an invariable rule. In order to leave room for justice to be done I think it is necessary to recognise that a contested application for an extension of time to file evidence should not necessarily “follow the event” (i.e. succeed if the evidence is available at, the hearing of the application and fail if it is not) and should not automatically succeed on the basis that refusal is liable to result in the commencement of another action between the same parties covering essentially the same subject matter. I nevertheless agree that these are important factors to be taken into account when deciding whether an extension of time should be granted or refused.’

15 These factors were fully considered at the Hearing on 26 January. The Applicants stated that the public interest is not served by the time the Opponents have taken to produce what is uncomplicated evidence and I am inclined to believe that their failure to do so in the extended period eventually allowed them is inexcusable and seriously prejudicial to the Applicants’ case. I do not consider that the evidence should be allowed into the proceedings at this stage and did not grant the extension of time.

**Dated this 26th day of March 1999**

20 **Dr W J Trott**  
**Principal Hearing Officer**  
**For the Registrar, the Comptroller-General**