

**TRADE MARKS ACT 1994**

**IN THE MATTER OF A REQUEST BY  
THE CONSORTIUM OF BICYCLE RETAILERS LIMITED  
FOR AN EXTENSION OF TIME WITHIN WHICH  
TO FILE AN APPEAL TO THE APPOINTED PERSON  
AGAINST THE DECISION OF THE REGISTRAR  
IN RELATION TO APPLICATION NO: 2115347**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF a request by  
The Consortium of Bicycle Retailers Limited  
for an extension of time within which  
to file an appeal to the Appointed Person  
against the decision of the Registrar  
in relation to application No: 2115347**

**BACKGROUND**

On 11 November 1996, the Consortium of Bicycle Retailers Limited (COBR) applied to register the following as a series of two marks:

The image shows two trade mark designs for the phrase "Cycling IS ...". The top design is the phrase "Cycling IS ..." in a bold, sans-serif font, enclosed in quotation marks. The bottom design is the same phrase, but with "Cycling" on one line and "IS ..." on the line below, also in a bold, sans-serif font and enclosed in quotation marks. A mouse cursor is visible over the top design.

in respect of specifications of goods which read:

Class 25 - clothing, footwear and headgear

Class 35 - advertising, all relating to the cycling industry.

The application was accepted by the Registrar and advertised for opposition purposes on 19 March 1997. On 17 June 1997, Halfords Limited filed notice of opposition. Only the opponents filed evidence. The matter was heard on 26 November 1999, when the applicants were represented by Mr S Walters of Trade Mark Consultants Co and the opponents by Mr B Dunlop of Wynne-Jones, Laine & James. Although a range of pleaded grounds were considered at the hearing, the opponents were ultimately only successful under Section 3(1)(b) of the Act.

The Registrar's decision (BL No:0/450/99) was issued on 21 December 1999, together with an indication that if an appeal was to be sought, it would need to be filed by 18 January 2000 if the appeal was made to the Court, or by 21 January 2000 if the appeal was to be made to the Appointed Person.

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Under cover of a letter dated 21 January 2000, the agents acting for the applicants, Trade Mark Consultants Co (TMC) faxed to the Registrar (on Sunday 23 January 2000) a Statement of Case and Grounds of Appeal to be passed to the Appointed Person. In an official letter dated 26 January 2000, the Registrar drew the late filing of the appeal to TMC's attention, and indicated that it would be necessary for them to file a retrospective extension of time request on Form TM9, together with a full explanation as to why the delay had occurred. As no response to this letter was received, the Registrar contacted TMC by telephone on 10 February 2000. Form TM9 with the following reasons was received on the same day:

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"The Statement of Grounds of Appeal and Statement of Case were not faxed to the Registry until Sunday 23<sup>rd</sup> January 2000, when the due date was Friday 21<sup>st</sup> January 2000.

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It was assumed that weekends did not count when calculating the due date. However, it was forgotten that the Statements were only officially received at the Registry on 24<sup>th</sup> January 2000 and that therefore an extension of time was required.

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Accordingly, the minimum period of a one month extension of time is requested, to extend the time by which the Statements were filed by one day.

A copy of this request has been faxed to the opponents agents".

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In a letter dated 11 February 2000, the agents acting for the opponents, Wynne-Jones Laine & James (WJLJ) explained that they had never received the applicant's grounds of appeal. The letter also contained a number of general criticisms of TMC's handling of the application and in particular that over three weeks had expired since the due date. WJLJ asked for the extension of time request to be refused. TMC responded in their letter of 11 February 2000, explaining that a copy of the appeal had been sent to WJLJ on 24 January 2000, and added that a further copy had now also been sent. In so far as the explanation on the form TM9 was concerned, they said:

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"As regards the need to file a form TM9 extension of time request, an honest mistake was made and we await the Registrar's decision on this matter".

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The official letter of 16 February 2000 stated that the extension of time request had been refused for the following reasons:

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"1) The due date for filing an appeal in the above matter was 21 January 2000. The appeal was filed by fax on 23 January 2000. Our letter dated 26 January 2000 requested full reasons why an extension of time should be allowed. These were not included with the form TM9 filed on 10 February 2000.

2) Any request for an extension of time in which to appeal in the above matter should have been filed on or before 21 January 2000. The TM9 was filed on 10 February 2000. No reasons were given for the late filing of the request for an extension of time”.

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The parties were allowed until 1 March 2000 to request a Hearing under Rule 48(1). In a letter dated 1 March 2000, TMC requested an interlocutory hearing. The request was made in the following terms:

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“The applicant requests that a hearing be appointed to determine the admissibility of its appeal to the appointed person. An honest mistake was made in filing the appeal and if the papers were not admitted, this would seriously prejudice the applicant’s application”.

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In their letters of 2 and 15 March 2000, WJLJ commented that in their view the admissibility of the appeal was not the issue. In their opinion, the issue which the request for a hearing ought to have addressed, was the refusal of the extension of time request. WJLJ concluded that as no such request had been made, TMC were “out of time” to request a hearing on that issue and as such it would be inappropriate to discuss the appeal. The Registrar’s response of 15 March 2000 explained that the issue of whether or not a timely request for a hearing on the refusal of the extension of time request had been filed would be dealt with as a preliminary point at the interlocutory hearing. It added that if it was decided that a timely request had been made, the applicants’ retrospective extension of time request would then be considered.

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### **THE HEARING**

The interlocutory hearing before me took place on 28 March 2000. The parties were as in the main proceedings mentioned above, represented by Mr Walters of TMC (for the applicants), and Mr Dunlop of WJLJ (for the opponents).

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In so far as the preliminary point mentioned above was concerned, I heard submissions from both parties. Mr Dunlop argued that the official letter of 16 February 2000 made it quite clear that it was the extension of time request that was being refused and it was against this refusal that any hearing should have been requested. Not surprisingly Mr Walters took a different view, commenting that as the issues were inextricably linked, it was in his view implicit that their letter of 1 March 2000 was a request to be heard on both issues. Having considered both sides submissions, I took the view that TMC’s letter of 1 March 2000 to the Registrar ought to be read as requesting a hearing on both issues. Whilst I accept that the letter could have been more precisely worded, given that the request for a hearing would ultimately decide the fate of the appeal, there could be no other sensible reading of the applicant’s intentions.

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The preliminary issue having been decided in the applicant’s favour, the parties then addressed me on the substantive issue i.e. the retrospective request for an extension of time in which to file an appeal to the Appointed Person.

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## **APPLICANTS SUBMISSIONS**

The principle points emerging from Mr Walters' submissions were as follows:

- 5           - TMC had not been given the authority by the applicant to launch an appeal until two and a half weeks of the appeal period had elapsed;
- 10           - the appeal was drafted by 21 January 2000 (the due date), but was not complete. Mr Walters accepted that a request for additional time should have been filed on that day;
- 15           - Mr Walters faxed the completed appeal to the Registry on Sunday 23 January 2000. He was of course aware that this was an excluded day and characterised this error as a "mind block";
- 20           - in so far as the delay in responding to the official letter of 26 January 2000 was concerned, Mr Walters accepted that once again the error was his. He explained that the letter was received by TMC but was inadvertently placed in the file without the appropriate action being taken. As soon as the Registry contacted him, the oversight was spotted and the form TM9 was faxed to the Registry the same day;
- 25           - in Mr Walters' view the reasons given on the form TM9 were complete, in that an error had occurred;
- 30           - Mr Walters urged me to consider the applicants position, adding that the right of appeal was a fundamental one and that the applicants should not be disadvantaged because of errors on his part;
- 35           - finally Mr Walters commented that if the extension of time was not allowed, it was likely that the applicants would re-file the application and the whole process would have to begin again.

## **OPPONENTS SUBMISSIONS**

The principle points arising from Mr Dunlop's extensive submissions were as follows:

- 40           - in Mr Dunlop's view the TM9 filed by TMC did not give "good reasons" for the delay and in this regard he drew my attention to the Registrar's Practice Direction dated 3 September 1997 in relation to extension of time requests;
- 45           - Mr Dunlop also drew my attention to the comments in the SAW trade mark case ((1996) RPC 507), and in particular to the comments on Page 509 at lines 28-30, which read as follows:

“However, in exercising 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”.

5 - Mr Dunlop drew my attention to the provisions of Rule 62(5) of the 1994 Trade Mark Rules (as amended), and also the comments in the GENIUS trade mark case ((1999) RPC 741), and in particular the narrower discretion afforded by this rule and the successive nature of the test;

10 - that the opponent would be prejudiced if the appeal was allowed to proceed.

Mr Dunlop concluded that if I took these points into consideration, it was clear that the applicants request for additional time should be refused.

15 Having considered both sides submissions, my decision was to allow the retrospective extension of time request and in so doing to allow the applicants appeal to the Appointed Person to proceed. I made this decision at the hearing and wrote to both parties on this basis on 3 April 2000.

20 Following the issue of my decision, the opponents filed form TM5 requesting a statement of the grounds of my decision.

### **GROUNDS OF DECISION**

25 At the time of the interlocutory hearing, the Registrar’s power for extending time periods was provided for in Rule 62 of the Trade Mark Rules 1994 (as amended), which reads:

62 (1) The time or periods -

- 30 (a) prescribed by these Rules, other than 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,

35 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 on such terms as he may direct.

(2) Where a request for the extension of a time or periods prescribed by these Rules-

- 40 (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  
45 if the registrar so directs.

5 (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).

10 (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.

15 (5) Where the request for extension is made after the time or period has expired, the registrar may, at his 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) .....

(7) .....

20 I am satisfied that the applicants request was copied to the opponents in accordance with Rule 62(2)(a) and the period for which the extension of time was sought was not one of the periods excluded by rule 62(3). The request was made on Form TM9 together with the appropriate fee. The section of rule 62 which is relevant in this case, is rule 62(5) which is reproduced above.

25 In the exercise of my discretion under rule 62(5) there are therefore two issues upon which I must be satisfied. If I am not satisfied on either one the request for an extension of time will be refused. I must be satisfied both with the explanation for the delay in the request and that the request is just and equitable.

30 The following text appears in the head notes of the GENIUS trade mark case, and provides useful guidance as to how requests under rule 62(5) should be considered:

35 “The registrar’s discretion under rule 62(5) of the Trade Mark Rules 1994 to extend time for filing evidence was narrower than the discretion under rule 62(1). The discretion would be exercised only if both requirements of rule 62(5) were satisfied, namely that there was a good explanation for the delay in requesting the extension and that the grant of an extension would be just and equitable”.

40 It is in my view a fundamental right of any party to appeal against an adverse decision of the Registrar. Where a party chooses to exercise such a right, it is plainly desirable that the appeal should be filed in a timely manner, with any request for additional time requested ahead of the due date. This did not happen in this case. There were a number of errors made by the applicants agents, firstly that a request for additional time was not filed on 21 January 2000 (when it was clear that the appeal was incomplete), nor did the agents deal efficiently with the official letter of  
45 26 January 2000. At the hearing and as indicated above, Mr Walters explained the background to these errors and I accept that there is no question here of an abuse of process.

In the Liquid Force trade mark case (1999) RPC 429 Mr G Hobbs QC sitting as the Appointed Person said at page 439 lines 11 through 15:

5           “ And 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..”.

10           Notwithstanding Mr Dunlop’s comments as to the prejudice the opponents may suffer if the extension of time was allowed, I do not believe that the actions of the applicants are so seriously prejudicial to the opponents that no indulgence should be afforded to them. In this case the applicants filed a facsimile copy of their grounds of appeal on Sunday 23 January 2000 (which was an excluded day), the due date being Friday 21 January 2000. Clearly this was an error on their part. The Form TM9 which was requested in the official letter of 26 January 2000 should  
15           have been filed very quickly thereafter, accompanied by a full explanation as to why the delay had occurred. However, it was not filed until 10 February 2000, a delay of eleven days from the date of the official letter, and fourteen days from the due date of 21 January 2000. Once again this was as a result of an error on the part of the agent for the applicant.

20           At the hearing I made it clear to Mr Walters that his handling of the applicants appeal had left a lot to be desired, a point he readily accepted. Whilst errors are of course always regrettable, it is inevitable that in the conduct of business they will occur. Simply put, this is the case here. When considering the two arms of the test set by rule 62(5), I am satisfied that there is a good explanation for the delay, (in so far as errors can ever be considered good reasons), and that it  
25           is both just and equitable to allow the applicants to have the merits of their appeal heard.

In reaching this conclusion, I am mindful of the comments of Laddie J in Hunt Wessons Inc’s Trade Mark application (1996) RPC 233 at 241 where he said:

30           “ 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 may also penalise the rest of the trade.”

Laddie J added:

35           “Secondly, 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 at the appeal stage is that it may well avoid a multiplicity  
40           of proceedings”.

45           Although these comments refer to proceedings under the 1938 Trade Marks Act, they are equally applicable to proceedings under the 1994 Trade Marks Act and I find them particularly relevant to the case at hand. It is clear that there is a genuine dispute between the parties, the outcome of which may or may not create a new statutory monopoly. This alone is in my view sufficient to allow the appeal to proceed. However, as mentioned by Mr Walters if the additional time were not allowed, the applicants would probably re-file the application, which would result in another



5 set of proceedings. While it is clear from the decision in the Liquid Force trade mark case that a request for additional time should not automatically succeed on the basis that refusal is liable to result in the commencement of another action between the same parties covering the same subject matter, it is as mentioned in Hunt Wessons Inc's application, an issue which should be borne in mind.

For all the reasons indicated above, the retrospective extension of time request is allowed and the applicants appeal to the Appointed Person on the substantive issue will proceed.

10 Neither party requested their costs.

**Dated this 14 day of June 2000**

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**C J BOWEN**  
**Hearing Officer**  
**For the Registrar, the Comptroller-General**