

1 THE APPOINTED PERSON: Patricia Hard O'Connell and Michael
2 O'Connell are the opponents in opposition proceedings brought
3 on 10th December 1997, in relation to trade mark application
4 number 2130740, filed on 24th April 1997, in the name of
5 Tottenham Hotspur Plc. The application was advertised in the
6 Trade Marks Journal on 10th September 1997. The application,
7 as advertised, is shown in annex A to this decision.

8 The evidence in support of the opposition (which
9 consisted of four statutory declarations) was quite
10 substantial. The declarations were filed and in the hands of
11 the applicant on or about 20th May 1999. However, due to a
12 minor dispute about confidentiality in relation to one
13 exhibit, the opponents' evidence was not formally accepted
14 into the proceedings until 20th October 1999. Thereafter,
15 the applicant sought and obtained extensions of time within
16 which to file evidence in support of the opposed application.
17 The time for filing its evidence was initially due to expire
18 on 25th January 2000. A first extension of three months was
19 granted over until 25th April 2000; a second extension of
20 three months was granted over until 25th July 2000. On 24th
21 July 2000, the applicant requested a further extension of
22 time over until 25th October 2000.

23 The Trade Marks Registry indicated in correspondence
24 that it was willing in principle to grant the requested
25 extension. However, the opponents raised an objection to the

1 request. A hearing was then appointed to consider the
2 opponents' objection. This took place before Mr. G.J.
3 Attfield, acting as hearing officer for the Registrar of
4 Trade Marks, on 21st September 2000. The hearing officer
5 refused the request for an extension of time at the
6 conclusion of the hearing before him. He subsequently stated
7 his reasons for doing so in a written decision issued on 19th
8 March 2001.

9 On 12th April 2001, the applicant gave notice of appeal
10 to an Appointed Person under section 76 of the Trade Marks
11 Act 1994. In substance, the applicant contends that justice
12 and fairness required that it should be given the extension
13 of time that it had requested, particularly having regard to
14 the fact that it had appointed new agents to act on its
15 behalf in May 2000 and the new agents needed time to progress
16 matters to the required standard.

17 Pages 2 and 3 of the Hearing Officer's decision contain
18 a review of the course of the proceedings. There is no
19 dispute as to the accuracy of the summary given by the
20 hearing officer. I adopt it for the purposes of my decision
21 on appeal.

22 On page 4, and up to the top of page 5 of his decision,
23 the hearing officer summarises the submissions of the
24 parties, which were largely similar to those advanced at the
25 hearing before me.

1 On page 6 of his decision, the hearing officer recorded
2 the fact that the applicant had no evidence ready to file at
3 the date of the hearing before him. At this point, I should
4 observe that evidence has subsequently been tendered on
5 behalf of the applicant. Two witness statements were
6 forwarded on 23rd November 2000. One further witness
7 statement was forwarded on 11th April 2001 and one final
8 witness statement was forwarded on 11th May 2001. It is to
9 be noted that this evidence would be out of time, even if the
10 requested extension of time (over until 25th October 2000)
11 had been granted by the hearing officer on 21st September
12 2000, or was now granted by me on appeal.

13 In other words, the effect of acceding to the requested
14 extension would be to trigger yet another application to the
15 registrar for time to be extended.

16 In his written decision, the hearing officer reviewed
17 the pertinent case law relating to extensions of time. His
18 conclusion on the merits of the application before him was as
19 follows:

20 "In looking at the wording of the latest request for
21 extension of time the current representatives state that they
22 need time to examine the archived materials of the applicant
23 company, this implies that this had not been done and is
24 confirmed by the comment in the submissions that there had
25 been no direct contact between the applicant company and the

1 previous representatives. This does not demonstrate any
2 diligence on the part of the applicant company and is
3 compounded by a reference to the difficulties experienced by
4 the applicant company as the request was filed during the
5 soccer close season when they have a reduced staffing level.
6 A generous view would be that the applicant had already had a
7 period of nine months in which to carry out this activity and
8 most of that period was during the soccer season when the
9 applicant would presumably have been fully staffed.

10 Additionally, the request goes on to state that they
11 need to see how the mark is used on a match day, and that
12 could not take place until the next soccer season commenced
13 in mid-August 2000. However, the relevant date for these
14 proceedings is the date of application, 24th April 1997, and
15 what is done on match days during the 2000/2001 soccer season
16 has no bearing on these proceedings.

17 Taking all this into account, but principally the
18 period which had elapsed during which the applicant could
19 file evidence, in a generous light nine months or a more
20 critical light 14 months, and the apparent lack of diligence
21 on the part of the applicant with regard to these
22 proceedings, I overturned the preliminary decision and
23 refused the requested extension of time."

24 In *Liquid Force Trade Mark*, [1999] RPC 429 at page 437,
25 I observed that the essential purpose of proceedings by way

1 of appeal under section 76 of the Act is to provide a means
2 of altering decisions which can properly be said to have been
3 erroneous for one reason or another. I went on to say that
4 it is generally difficult to persuade an appellate tribunal
5 that a decision taken in the exercise of a discretion should
6 be regarded as erroneous, not least because such decisions
7 usually depend for their legitimacy upon balancing a variety
8 of relevant considerations within limits which allow for the
9 possibility of more than one "right" answer to the question
10 in hand.

11 At page 438 of the decision, I referred to the decision
12 of the Court of Appeal in **Mortgage Corporation Ltd -v-**
13 **Sandoes**, as authority for the proposition that the absence of
14 good reason for failure to comply with a time limit was not
15 always and in itself sufficient to justify refusal of an
16 extension of time. The true position being that it is for
17 the party in default to satisfy the tribunal that, despite
18 his default, the discretion to extend time should
19 nevertheless be exercised in his favour, for which purpose he
20 could rely on any relevant circumstances.

21 Also on page 438, I noted that under section 40(3) of
22 the Trade Marks Act 1994, the rights conferred by
23 registration of a trade mark date back to the date of the
24 application for registration and that, in the interests of
25 legal certainty, it is plainly desirable that valid

1 applications for registrations should succeed and valid
2 objections to registrations should be upheld without undue
3 delay.

4 I stand by those observations. I would additionally
5 refer to the observations of Mr. Simon Thorley QC, sitting as
6 the Appointed Person in **Siddiqui's Application** (9th October
7 2000) where he emphasised that it is incumbent on the party
8 applying for the extension of time to put forward facts which
9 merit the requested extension. He said:

10 "In a normal case, this will require the applicant to
11 show clearly what he has done, what he wants to do, and why
12 it is that he has not been able to do it. This does not mean
13 that in an appropriate case, where he fails to show that he
14 has acted diligently but that special circumstances exist, an
15 extension cannot be granted. However, in the normal case it
16 is by showing what he has done and what he wants to do and
17 why he has not done it that the registrar can be satisfied
18 that granting an indulgence is in accordance with the
19 overriding objective, and that the delay has not been used so
20 as to allow the system to be abused."

21 I agree with those observations.

22 Mr. Baker, on behalf the applicant, has referred me to
23 the observations of the Master of the Rolls, Sir Thomas
24 Bingham, in the case of **Costellow -v- Somerset County**
25 **Council**, [1993] 1 WLR 256 at page 264, where he said:

1 "Cases involving procedural abuse (such as the **Hytrac**
2 case [1983] 1 WLR 44 or questionable tactics such as **Revici**
3 **-v- Prentice Hall** Incorporated [1969] 1WLR 157) may call for
4 special treatment. So, of course, will cases of contumelious
5 and intentional default and cases where a default is repeated
6 or persisted in after a peremptory order. But in the
7 ordinary way, and in the absence of special circumstances, a
8 court will not exercise its inherent jurisdiction to dismiss
9 a plaintiff's action for want of prosecution unless the delay
10 complained of after the issue of proceedings has caused at
11 least a real risk of prejudice to the defendant. Save in
12 special cases or exceptional circumstances, it can rarely be
13 appropriate, on an overall assessment of what justice
14 requires, to deny the plaintiff an extension (where the
15 denial will stifle his action) because of a procedural
16 default which, even if unjustifiable, has caused the
17 defendant no prejudice for which he cannot be compensated by
18 an award of costs. In short, an application under Ord. 3 r.
19 5 should ordinarily be granted where the overall justice of
20 the case requires that the action be allowed to proceed."

21 That was an action for personal injuries. The claimant
22 was in default of compliance with the rules relating to
23 pleading and disclosure of documents, but not, it would
24 appear from the report of the case, by a very large margin.
25 He applied for an extension of time within which to

1 legitimise his position and he offered an explanation, albeit
2 rather thin, as to how he came to be in the predicament in
3 which he found himself. The defendants in that case accepted
4 that the claimant's delay had not been prejudicial either to
5 them, or to a fair trial of the action. The Court of Appeal
6 was clearly of the view that the defendants had not suffered
7 any prejudice for which they could not adequately be
8 compensated by an award of costs in their favour.

9 The position in **Costellow's** case is not, I think, truly
10 analogous to the position which obtains in the present
11 opposition proceedings.

12 These opposition proceedings are not purely a private
13 matter between the parties. They also engage the public
14 interest in relation to the question whether a quite powerful
15 monopoly, in the form of a trade mark registration, for the
16 word TOTTENHAM, should or should not be granted as requested.
17 Pending the resolution of that question, the unresolved
18 application for registration is liable to operate as a sword
19 of Damocles over the heads of people such as the opponents in
20 the present case, who may be affected by the later grant of
21 the requested registration, with retrospective effect to the
22 date of the application. There is no means of compensating
23 traders in that position from the inhibiting effect of the
24 pending application while it remains unresolved. In such
25 circumstances, I do not think it can be right to allow a

1 party to pursue its own private interests in a way that is
2 wasteful of the time and resources available for the
3 determination of inter-parties registry proceedings.

4 The rules and procedures now in place were framed with
5 a view to avoiding the problem of delay, which was such a
6 conspicuous blight on registry proceedings in the not too
7 distant past.

8 It does not appear to me that the applicant can be held
9 to have improved or redeemed its position by changing its
10 agents in May 2000. No real excuse has been offered for the
11 delays which have occurred. All things considered, I am
12 unwilling to say that the hearing officer in the present case
13 was in error to exercise his discretion in the way that he
14 did. On the material before him, I think that I would have
15 exercised the relevant discretion in the same way. In the
16 circumstances, the appeal will be dismissed.

17 Would you like to address me on costs?

18 MS. SZELL: It is simply that we would like an order of costs
19 please. I think it is a normal matter.

20 THE APPOINTED PERSON: What did the hearing officer do? Did he
21 make any order?

22 MS. SZELL: No, he did not.

23 THE APPOINTED PERSON: Was that because he was not asked?

24 MS. SZELL: I was not there.

25 MR. BAKER: I think that is probably correct.

1 THE APPOINTED PERSON: But I now have a request so far as this
2 appeal is concerned. Mr. Baker, what would you like to say?

3 MR. BAKER: I would obviously ask that they follow the event.

4 This is not going to be the end of the matter. There are
5 going to be further applications and I submit they should go
6 with the eventual victor in the proceedings.

7 THE APPOINTED PERSON: What would you say to that, Ms. Szell?

8 MS. SZELL: That they should not go with the event. This appeal
9 does not directly affect the issue of whether the position is
10 with merit or not. Whether or not the opposition is with
11 merit, the applicants should have filed their evidence in
12 time. They did not file their evidence in time and they
13 could have stood by the registrar's decision. I do not think
14 the costs should go with the event.

15 THE APPOINTED PERSON: I take the view that the appeal before me
16 is a relatively self-contained matter in the course of these
17 proceedings. I think it is appropriate that there should be
18 an award of costs in favour of the successful party on the
19 appeal. That is to say, in favour of the opponents. I would
20 think that an appropriate figure, in all the circumstances,
21 would be an award of a contribution of ú500 towards their
22 costs of these proceedings. That sum to be payable within 14
23 days after the date of this decision, today's date. I think
24 that wraps it up.

25 MS. SZELL: Thank you very much for dealing with it so quickly.

1 MR. BAKER: Thank you.

2 THE APPOINTED PERSON: I will try to polish the transcript and
3 turn it into better English in due course. You will not get
4 it before I do that. Thank you very much indeed, both of
5 you. Your paper work was immensely helpful in enabling me to
6 prepare for this case.

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