

O-345-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF A REQUEST BY  
FORMULA ONE LICENSING BV (THE APPLICANTS)  
FOR AN EXTENSION OF TIME WITHIN  
WHICH TO FILE AN APPEAL IN  
OPPOSITION PROCEEDINGS NO 94004**

## **TRADE MARKS ACT 1994**

### **In the matter of a request by Formula One Licensing BV (the applicant) for an extension of time within which to file an appeal in opposition proceedings No 94004**

#### **Background**

1. Application number 2277746C, for the trade mark “F1”, was filed on 13 August 2001 and was published for opposition purposes in Trade Marks Journal 6600 on 23 September 2005. The applicant being Formula One Licensing BV (hereafter FOL).
2. On 21 December 2005 Lloyd Wise, on behalf of RACING-LIVE (Société Anonyme à Directoire) (hereafter RL), filed a Form TM7, Notice of opposition. The statement of grounds accompanying the opposition set out the grounds of the action as being that the trade mark application was contrary to the provisions of Sections 3(1)(b), 3(1)(c) and 3(1)(d) of the Trade Marks Act 1994.
3. A Form TM8, with a counter statement, was filed by McDermott Wills & Emery UK LLP on behalf of FOL to defend the opposition proceedings.
4. Commencing on 24 March 2006 the parties were given time, under the Rules, to file evidence.
5. On 26 June 2006 RL filed two witness statements, with a combined total of fifteen exhibits, as their evidence in chief, they also filed a request for an extension of time to consider filing additional evidence. This request was granted till 24 September 2006 but on 11 September 2006 they wrote informing the registry that they would not be submitting any additional evidence.
6. On 20 September 2006 a period of time was set for FOL to file their evidence in support and on 19 December 2006 they filed a single witness statement with four exhibits.
7. On 11 January 2007 a period was set for RL to file evidence in reply, but on 8 March 2007 they responded stating that they would not be filing any further evidence.
8. On 14 March 2007 the parties were notified that the proceedings were ready to proceed to a decision and on 4 April 2007 RL notified the registry that they wished to have a hearing rather than a decision from the papers on file. Accordingly a date for the hearing was set, 6 June 2007, and on 12 April 2007 the registry was informed that as of 2 April 2007 Hammonds had taken over responsibility for these proceedings on behalf of FOL .

9. The hearing took place on 6 June 2007 and the decision was issued on 14 June 2007. This decision concluded that the application for registration of the trade mark should be refused.

10. In the covering letter the routes of appeal were described and it was explained that the period for filing an appeal was twenty eight days from the date of the letter. Therefore an appeal had to be filed on or before 12 July 2007.

11. On 12 July 2007 FOL filed a Form TM9, request for an extension of time, for a period of one month giving the reason for the request as:-

“The applicant has commenced its preparations for an appeal against the Registrar's decision. This has included detailed research into the Registrar's analysis and acceptance of parts of the opponent's evidence. In particular, the applicant has been progressing an analysis of the evidence extracted from the Internet to ascertain whether this proves what has been alleged. Given the nature and scope of the Registrar's decision, the applicant has not yet had sufficient time to complete its analysis and investigations. Accordingly, further time is required to do so and to appeal. If the applicant's analysis to date continues to show that an appeal is warranted.”

12. The registry responded to this request by facsimile on 20 July 2007 stating that:-

“ . . . having considered your request the Registrar is of the opinion that the reasons given do not justify the length of time requested. Therefore your request has only been granted until 26 July 2007.”

13. On 26 July 2007 FOL sent a facsimile requesting a hearing and providing submissions arguing that the Registrar's decision was incorrect. Their submissions are reproduced in the skeleton argument later in this decision.

14. The date for the hearing was fixed as 14 August 2007, however FOL wrote on 31 July 2007 stating that this date was not convenient, requesting that the hearing be rescheduled and suggesting the week commencing 27 August 2007 as a suitable alternative.

15. On 2 August 2007 RL wrote to the Registrar stating that they would not be represented at the hearing and would not be submitting any arguments for consideration at the hearing.

16. The date for the hearing was reset and took place before me on 30 August 2007. At the hearing, which was via the video link, Mr Chris McLeod, of Hammonds, appeared for the applicant (FOL) and the opponent was unrepresented.

## The Hearing and Submissions

17. Prior to the hearing I received written submissions from Mr McLeod, and these are reproduced below:

### “SKELETON ARGUMENT

1. On 14 June 2007 the Trade Marks Registry's hearing officer, Mr Landau, issued his decision in the above matter.
2. The covering letter of the same date set a deadline of 12 July 2007 for appeal to the Appointed Person or the High Court.
3. On 12 July 2007, following considerable discussion and correspondence regarding its options, the applicant filed Form TM9 by fax, requesting an extension of time of one month for filing an appeal.
4. The reasons given were as follows: *"The applicant has commenced its preparations for an appeal against the Registrar's decision. This has included detailed research into the Registrar's analysis and acceptance of parts of the opponent's evidence. In particular, the applicant has been progressing an analysis of the evidence extracted from the internet to ascertain whether this proves what has been alleged. Given the nature and scope of the Registrar's decision, the applicant has not yet had sufficient time to complete its analysis and investigations. Accordingly, further time is required to do so and to appeal if the applicant's analysis to date continues to show that an appeal is warranted."*
5. On 20 July 2007, in a letter received by Hammonds on 23 July 2007, the Trade Marks Registry's Hearings and Appeals team leader, Sally Howls, declined the request, stating that: *"..having considered your request the Registrar is of the opinion that the reasons given do not justify the length of time requested. Therefore your request has only been granted until 26 July 2007."*
6. This letter also stated that appeal against this preliminary view was possible on or before 26 July 2007.
7. On 26 July 2007, Hammonds wrote to the Trade Marks Registry to confirm that the applicant wished to appeal. The reasons set out in that letter are as follows:
  - *"It has taken 8 days for the Registrar's opinion to be issued which leaves only 6 days, 2 of which are not working days, for the applicant to finalise and submit its appeal;*
  - *We submit that the amount of time taken for the letter to be issued is disproportionate given the effect that this has had on the applicant;*

- *We dispute that the reasons given in the attachment to the Form TM9 filed on 12 July 2007 make a 2-week extension of time applicable and not a 1-month extension;*
- *The reasons given on behalf of the applicant are valid, honest and show what steps the applicant has taken and those that it intends to take;*
- *Accordingly, we believe that the applicant has satisfied the current requirements to the extent that a 1-month extension of time is justified.*
- *It is difficult for the applicant to state in great detail why it disagrees with the preliminary view given the opacity of the statement in your letter that "having considered your request the Registrar is of the opinion that the reasons given do not justify the length of time requested";*
- *Accordingly, it is only equitable for the applicant to be heard in relation to this matter;*
- *Whereas the applicant has given what it considers to be detailed and compelling reasons, the Registrar has not".*

8. The date for the interlocutory hearing has been scheduled for 30 August 2007.

9. Based on the above submissions, we respectfully request that the applicant be granted the amount of time initially requested, i.e. 1 month.

10. During the period from the date of the extension request, 12 July 2007, until the date of the hearing, 30 August 2007, the applicant's position has been placed in doubt by delays on the part of the Trade Marks Registry.

11. For example, a grant of an extension of time to 26 July 2007 in a letter dated 20 July 2007 but received on 23 July 2007, would have been of no assistance to the applicant because it would have been left with 3 days in which to finalise its position and file its notice of appeal.

12. Likewise, with the hearing taking place on 30 August 2007, if the applicant is successful, it is not clear whether the extension of time will be retrospectively granted to 12 August 2007 and will therefore have expired.

13. Accordingly, the applicant requests that if it is successful in this hearing, it is granted an extended period of one month from the date of the hearing within which to appeal."

18. The main points arising from the applicants' oral submissions at the hearing are as follows:

- that the mark "F1" is a core mark for the applicant and that class 41 encompasses its core activity.

- reference was made to extracts of evidence from the internet, particularly Wikipedia, which had to be researched.
- that whilst they had countered the opponents evidence the decision by the Hearing Officer altered the weight of that evidence and this needed to be addressed afresh.
- that the reasons given on the Form TM9 were reasonable, accurate and that the level of detail given had discharged the onus placed on the applicant in requesting the extension.
- that delays in the response by the Office were prejudicial to the applicant.
- that on balance it would be equitable to grant the extension of time.

19. I asked Mr McLeod, considering that as the original request was for a period of time that expired prior to the hearing, where was the applicant with regard to the preparation of the appeal. His response was that they had made no progress at all as they were in “limbo”. They were awaiting the outcome of the hearing before moving this forward.

20. I also made reference to the Tribunal Practice Notice 3/2000 and the comments by the Appointed Person in the appeal decision in the Whiteline Windows Limited v. Brugmann Frisoplast GmbH (O/299/00) proceedings.

### **The Decision at the Hearing**

21. At the conclusion of the hearing I informed Mr McLeod that I was going to maintain the preliminary view expressed in our letter of 20 July 2007 and that I would confirm this in writing. In a letter dated 31 August 2007 I informed the parties of my decision. The relevant part of my letter reads:

“The applicant filed an extension of time request, on 12 July 2007, for a period of one month to allow the applicant additional time within which to prepare an appeal. The hearing was to consider the Registrar’s preliminary view to grant the extension of time for only a limited period of two weeks, until 26 July 2007. I am now writing to confirm my decision.

You stated that this was a core trade mark and activity for the applicant; that the applicant was particularly interested in the registration of this mark; you argued that the reasoning on the Form TM9 was accurate and sufficient to have discharged the onus on the part of the applicant with regard to the level of detail required; that a delay in the response by the registry had caused prejudice to the applicant in as far as they were not able to complete the appeal documents by 26 July 2007 and that on balance it was equitable to grant the extension in full.

I asked how far the preparation of the appeal documents had progressed given that the applicant had had the requested period *de facto*, and with reference to

the request in the skeleton argument that if the extension be allowed that the month requested be allowed to run from the date of the hearing. You stated that as you were awaiting the outcome of this hearing the proceedings were in a state of limbo and the appeal documents had not been progressed any further, the applicant therefore needed additional time to consider and prepare the documents.

I also referred to Tribunal Practice Notice 3/2000 and the appeal decision *Whiteline Windows Limited v. Brugmann Frisoplast GmbH (O/299/00)* in which Mr. Simon Thorley Q.C. sitting as the Appointed Person commented on the granting of extensions of time for the filing of appeals.

Having reviewed the file, considered the skeleton arguments and the submissions made at the hearing my decision was to maintain the preliminary view and allow the period of two weeks granted as an extension of time within which to file an appeal. However, as no appeal documents were filed with the office on or before the due date of 26 July 2007 these proceedings are now closed as there has been no appeal to the Registrar's decision of 14 June 2007. This decision was taken bearing in mind all the relevant case law."

22. On 28 September 2007 FOL filed a Form TM5 requesting a statement of reasons for my decision.

### **The Law**

Rule 63 states:

#### ***“Appeal to person appointed; s. 76***

**63.** - (1) Notice of appeal to the person appointed under section 76 shall be filed on Form TM55 which shall include the appellant's grounds of appeal and his case in support of the appeal.

(1A) Such notice shall be filed with the registrar within the period of 28 days beginning on the date of the registrar's decision which is the subject of the appeal.

(2) The registrar shall send the notice and the statement to the person appointed.

(3) Where any person other than the appellant was a party to the proceedings before the registrar in which the decision appealed against was made, the registrar shall send to that person a copy of the notice and the statement."

Rule 68 states:

#### ***“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.

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

(a) is sought in respect of a time or periods prescribed by rules 13 to 13C, 18, 23, 25, 31, 31A, 32, 32A, 33, 33A or 34, 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 if the registrar so directs.

(3) The rules excepted from paragraph (1) above are rule 10A(2) (failure to file address for service), rule 11 (deficiencies in application), rule 13(1) (time for filing opposition), rule 13A(1) (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), rule 31(3) (time for filing counter-statement and evidence of use or reasons for non-use), rule 32(3) (time for filing counter-statement), rule 33(6) (time for filing counter-statement), and rule 47 (time for filing opposition).

(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.

(5) Where the request for extension is made after the time or period has expired, the registrar may, at her discretion, extend the period or time if she is satisfied with the explanation for the delay in requesting the extension and it appears to her be just and equitable to do so.

(6) Where the period within which any party to any proceedings before the registrar may file evidence under these Rules is to begin upon the expiry of any period in which any other party may file evidence and that other party notifies the registrar that he does not wish to file any, or any further, evidence the registrar may direct that the period within which the first mentioned party may file evidence shall begin on such date as may be specified in the direction and shall notify all parties to the dispute of that date.

(7) Without prejudice to the above, in cases of any irregularity or prospective irregularity in or before the Office or the registrar which –

(a) consists of a failure to comply with any limitation as to times or periods specified in the Act or these Rules or the old law as that law continues to apply and which has occurred or appears to the registrar as likely to occur in the absence of a direction under this rule, and



(b) is attributable wholly or in part to an error, default or omission on the part of the Office or the registrar and which it appears to her should be rectified,

she may direct that the time or period in question shall be altered in such manner as she may specify upon such terms as she may direct.”

## **Decision**

23. At the hearing I was not referred to any authorities relevant to the consideration of requests for extensions of time. It was submitted that the reasons given for the extension of time were sufficiently detailed, strong and compelling to allow the request to be granted. That the Registrar had, through delays, placed the applicants position in doubt, both by a late response to the original request and then the late date of the hearing. This all being prejudicial to the applicant.

24. The Form TM9 requesting the extension of time was faxed to the Office on Thursday 12 July 2007, the very last day for the filing of any document, either for an appeal or for an extension of time within which to file such an appeal. This form is a fee bearing form and as such had to be sent from the document reception to the finance section for the fee to be processed and receipted, Friday 13 July 2007, before the form could be transferred to Law Section to be dealt with. It is stamped as received in Law Section on Monday 16 July 2007, the request was then considered and the preliminary view communicated to the parties on Friday 20 July 2007. This was within the internal target of five days for response to forms.

25. FOL requested a hearing in their letter of 26 July 2007, and a hearing was fixed for 14 August 2007. After notification of this date FOL requested that the hearing be rescheduled as the date set was not convenient to themselves. They suggested the week commencing Monday 27 August 2007 and the date was reset within this week. The registry arranged the hearing at as early a date as possible given that the parties must have fourteen days notice, and it was at the specific request of FOL that the hearing was rescheduled at the later date. Therefore the delay in the hearing is entirely attributable to FOL.

26. The breadth of the discretion afforded to the Registrar was dealt with by the Appointed Person in LIQUID FORCE (1999) RPC 429. The Appointed Person held that the Registrar’s discretion was as broad as that of the Court and where relevant circumstances were brought forward, the Registrar could exercise that discretion.

27. In Siddiqui’s Application (BL O/481/00) the Appointed Person said:

“In a normal case this will require the applicant to show clearly what he has done, what he wants to do and why it is that he has not been able to do it. This does not mean that in an appropriate case where he fails to show that he has acted diligently but that special circumstances exist an extension cannot be granted. However, in the normal case it is by showing what he has done and what he wants to do and why he has not done it that the Registrar can be satisfied that granting an indulgence is in accordance with the overriding

objective and that the delay is not being used so as to allow the system to be abused.”

28. I am also mindful of the comments of the Appointed Person in the appeal case *Whiteline Windows Limited v. Brugmann Frisoplast GmbH* (O/299/00) (unreported):

“Whilst I accept that the Registry has power under the Trade Marks Rules 1994, rule 62 and under the current Trade Marks Rules 2000, rule 68, to extend the time of 28 days provided for an appeal, this is a matter which must be approached with the greatest caution so as to ensure that the exercise of discretion does not undermine the purpose underlying the statutory provision. Appeals create uncertainty and it is in the interests of everyone that appeals are disposed of timeously. Extensions of time in which to enter notices of appeal are therefore not to be encouraged.”

and

“. . . I should not like it to be thought that extensions of time for serving appeal documents will be granted lightly.”

29. RL filed their evidence on 26 June 2006, this included all the internet evidence referred to in the Hearing Officers decision, and FOL responded to this in their evidence filed on 19 December 2006. They should therefore have had before them an analysis and their own opinion of this evidence before the Hearing Officers’ decision was issued. The main thrust of their request for an extension of time was that they were analysing and investigating this evidence. At the hearing Mr McLeod made specific reference to evidence from the Wikipedia internet site.

30. The Registrar did not refuse the request, but moderated the extension of time by granting a shorter period of two weeks. I was not privy to the examination process that arrived at that decision and I have only to determine whether it was a reasonable and equitable decision.

31. Whilst there were time delays in the notification of FOL as to the decision in respect of the request for the extension of time one would have expected them to continue the process of preparation of the appeal documents in expectation of a favourable outcome.

32. Having received an adverse outcome to their request, FOL were faced with two options. To prepare and file the appeal within the new deadline or request an interlocutory hearing. They did the latter. At this point they appear to have ceased work on the preparation of the appeal documents.

33. As stated in their skeleton argument, point 13, FOL required a further month following the interlocutory hearing within which to prepare and file their appeal. When asked the specific question about where FOL were with the preparation of their appeal the reply at the hearing was that they had made no progress as they regarded themselves in a state of “limbo”. They had effectively ceased work on the appeal.

34. The hearing, held on 30 August 2007, was to consider whether to grant the requested period of one month, from 12 July 2007 until effectively Monday 13 August 2007, rather than the period of two weeks which the preliminary view indicated was to be granted. Therefore an extension beyond the date of the hearing would have required a retrospective request for yet further time on the part of FOL.

35. At the date of the interlocutory hearing FOL had already had the original period of time requested *de facto*, and if they had continued with the preparation of their appeal could have been in a position to file the appeal documents at or before the hearing.

36. In reaching my decision to confirm the Registry's Preliminary View to allow the extension of time request for a period of two weeks only, I took account of the guidance provided by the Appointed Persons. I was satisfied that the reasons given for the request were properly considered, particularly in light of the comments of the Appointed Person in the appeal case *Whiteline Windows Limited v. Brugmann Frisoplast GmbH*. The evidence that FOL were analysing had been in their possession since 26 June 2006, they had already analysed it and provided evidence in response and they had the decision of the Hearing Officer for a month before they made their request for further time to prepare their appeal. Requests for an extension of time within which to file an appeal must be considered under a stricter regime than those requests made during the evidential stages of proceedings and thus the preliminary view that only two weeks be granted.

37. I also take particular note of the comment in the appeal case *Whiteline Windows Limited v. Brugmann Frisoplast GmbH*:-

“In the present case there has been no appeal against Mr Parker's decision to grant, what I regard as being an extraordinary length of extension of almost three months. It is therefore not necessary for me to comment further save to draw attention to the fact that I should not like it to be thought that extensions of time for serving appeal documents will be granted lightly. . . .”

If I were to have granted FOL not only the full period requested, which would have been of no value to them as they did not have the appeal documents ready to file, but a further period of one month following the hearing, as they have requested, they would then have had a total of three and a half months within which to prepare and file their appeal.

#### **Costs**

38. Neither party made a request for an award of costs to be made in their favour and I decided not to make an award.

**Dated this 21<sup>st</sup> day of November 2007**

**Graham Attfield  
For the Registrar,  
The Comptroller General**