

O-052-11

**In the matter of an application in the name of Kofi O Bempah
And a request under rule 77(5) to extend the period for filing opposition by
Cut4Cloth Ltd**

(Decision originally given by letter dated 24th January 2011)

1. I refer to the (joint) interlocutory hearing which took place by telephone conference today (24th January 2011) to determine a request by the opponent, represented by Mr Brown, to extend the period for filing opposition on the basis of an irregularity in procedure attributable to the registrar, and that the irregularity should be rectified. The applicant, Mr Kofi O Bempah, was unrepresented and you spoke on your own behalf in opposing the request.
2. At the hearing I reserved my decision and now give it, in full.

The facts, claims and issues to decide

3. This trade mark application was published on 16th July 2010. On 13th August 2010 the putative (ie inferred or intended) opponent filed notice of threatened opposition. In response to that notice, and although not produced before me I accept to be the case, Mr Brown says he received an electronic communication from the registrar. This, I know as fact, would have contained the words, " The opposition period for this mark has been extended to three months *from* the date of publication.(my emphasis)". I have attached by way of example such a notification. The electronic communication would have been sent by way of immediate response to the notice of threatened opposition, both being electronic transactions.
4. The wording on the electronic communication from the registrar directly conflicts with the wording of rule 17(2) and (3) of the Trade Marks Rules 2008 ("the rules") which provide:

“(2) Unless paragraph (3) applies, the time prescribed for the purposes of section 38(2) shall be the period of two months beginning with the date on which the application was published.

(3) This paragraph applies where a request for an extension of time for the filing of Form TM7 has been made on Form TM7A, before the expiry of the period referred to in paragraph (2) and where this paragraph applies, the time prescribed for the purposes of section 38(2) in relation to any person having filed a Form TM7A (or, in the case of a company, any subsidiary or holding company of that company or any other subsidiary of that holding company) shall be the period of three months *beginning* with the date on which the application was published (my emphasis).”

5. In other words, in accordance with rule 17(3), the period for filing opposition had to expire on 15th October 2010, on the basis that calculation of the three month opposition period had to *include* the date of publication. The wording on the electronic communication however, expressly says the period of opposition is calculated ‘*from*’ the date of publication, in other words the date of publication would be *excluded*, thus making the final filing date for opposition, according to the electronic communication, 16th October 2010.

6. The period for filing opposition appears in Schedule 1 of the rules and may only be extended under the following conditions, set out in rule 77(5):

“(5) A time limit listed in Schedule 1 (whether it has already expired or not) may be extended under paragraph (1) if, and only if—

(a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the registrar, the Office or the International Bureau; and

(b) it appears to the registrar that the irregularity should be rectified.”

7. By virtue of the electronic communication from the registrar, Mr Brown seeks to invoke rule 77(5). Indeed, the registry in a preliminary view expressed in a letter dated 22nd December 2010 (which reversed an earlier preliminary view expressed in a letter dated 5th November 2010) accepted that rule 77(5) provided an appropriate basis upon which to extend the period for filing opposition. Formal notice of opposition was actually filed by Mr Brown, on behalf of his clients, on 18th October 2010, and that would have been ‘in time’ as far as the electronic communication was concerned, since 16th October 2010 was a Saturday, the 17th, a Sunday, and so the first working day following those excluded days would have been the 18th October 2010, a Monday.

8. Mr Brown also notes he sent an e-mail to Mr Bempah on 13th August 2010, to which he replied on 15th August, saying “that the time for filing an opposition to

our mark expires on 16th October”. Mr Bempah sought to clarify this communication at the hearing but in the event my decision does not hang on this point.

9. This hearing has been occasioned however because, on 30th September 2010 the registrar published his TPN 4/2010. This TPN, which I shall not quote in full, clarifies the registrar’s position as regards the interpretation of rule 17(2) and (3).
10. Up to the publication of this TPN, the registrar and parties before him had worked on the basis that the 2 or 3 month opposition period calculation *excluded* the date of publication. As Mr Brown noted, prior to the threatened opposition procedure, opponents had three months to file opposition, this period being understood to be three calendar months. Thus in the past, the guidance published by the registrar (whether in respect of the more recent threatened opposition procedure or prior to that), as well as its correspondence, would all have been based on calendar months and in this case, if the publication date was 16th July, the filing date for opposition (assuming notice of threatened opposition had been filed) would be 16th October. The TPN sought to rectify that, and to alert the wider public, including of course practitioners, that in view of the wording of rule 17(2) and (3), case law (see *Trow v Ind Coope (West Midlands) Ltd* CA [1967] 2 QB 899 and *Zoan v Rouamba* [2000] 2 All ER 620) and the Interpretation Act 1978, the actual date for filing opposition was the day before monthly calendar anniversary, ie 15th October in this case, to take account of the fact that rule 17(2) and (3) *includes* the date of publication in its provision.
11. The TPN, which I understand was given wide circulation, also contains the following ‘transitional’ provision:

“ Application of this practice to existing proceedings

14. As a consequence of the Registry’s revised view of the Trade Marks Rules 2008 there are a number of opposition cases currently before the Tribunal which were filed late.

15. The Registrar intends to regard any TM7A/TM7 (admitted up to and including the date of this notice), which was filed late, according to the interpretation of Rule 17, expressed in this notice, as having been the subject of an irregularity of procedure partly attributable to an error by the Office. This is due to the fact that guidance material including the Manual of Trade Marks Practice and the Opposition booklet supplied by the Registry and published on our web site contain inaccurate wording in respect of the calculation of time periods for filing opposition proceedings and extensions of time for doing so. The appropriate guidance has now been updated in line with this notice.

16. The Registrar does not intend to initiate a review of the admissibility of any TM7/7A already filed. If the matter of lateness is raised by either of the parties to an opposition the Registrar proposes to use the powers in Rule 74 and 77(5) to extend any relevant time limit retrospectively, so that it expires on the date that was understood to be the final date for filing a TM7/TM7A under the previous guidance.

17. If, within **14 days** of the publication of this notice, any party wishes to argue that they have been prevented from filing a **new** TM7/TM7A on time because of earlier inaccurate guidance from the Office, they should write to the Registry accordingly and ask for the matter to be corrected as an irregularity in procedure. The Registrar will only consider such cases where the date for filing a new TM7/TM7A has passed. Each case will be assessed on its merits.”

12. Thus, as far as notices of opposition filed on or before 30th September 2010 are concerned, the TPN anticipates an automatic invocation of rule 77(5) to correct an irregularity. However, in this case the notice of opposition was filed on 18th October 2010, *after* the TPN had been published and outside the 14 day period from which it was published. Mr Bempah, as applicant contends that, by virtue of para 17 of the TPN, Mr Brown has ‘missed the boat’, since his request (in effect, and although he did not expressly invoke that rule) to invoke rule 77(5) was first made on 29th October 2010, outside the 14 day period stipulated in that para 17. He notes also in this regard, the TPN says that, “The registrar will only consider such cases where the date for filing a new TM7/TM7A has passed.” As the opposition period for this mark expired on 16th (or rather, 15th) October 2010, Mr Brown cannot avail himself of rule 77(5) relief, the time limit for which was 14th October 2010. That is his primary position.

13. Even if Mr Bempah’s primary position is not correct, Mr Brown (on behalf of his client of course), has still invoked rule 77(5) too late. He should have read the TPN at the time and cannot plead ignorance. Apparently, says Mr Bempah, ITMA (the professional Institute for Trade Mark Attorneys) sent an e-mail to all members on 1st October 2010 alerting them to the TPN. Mr Brown is not a member of ITMA. Nonetheless, Mr Bempah says the onus was on him to keep abreast of practice and he should have acted on that TPN at the time and filed his notice of opposition within the clarified and correct deadline of 15th October 2010.

Decision

14. As a matter of law, the express wording of rule 77(5) (a rule made by the Secretary of State and Parliament) cannot be fettered in any way by secondary guidance published by the registrar. In particular in this case, any 14 day period

for invoking rule 77(5), put in place for operational expediency or any other reason, cannot be allowed to prevent the appropriate invoking of rule 77(5), *at any time, and if the circumstances merit. It is furthermore irrelevant when the period for opposition or threatened opposition has expired or may yet expire. Insofar then, as para 17 of TPN 4/2010 sought or implied any fetter around the fair application of rule 77(5), it simply cannot do that.*

15. In this case, plainly the wording of the electronic communication sent to Mr Brown on 13th August 2010 was in error, *in the light of TPN 4/2010*. The question is whether the publication of the TPN on 30th September 2010 effectively remedied that error, such that Mr Brown ought to have responded immediately or shortly thereafter by filing his opposition within the 'correct' period.
16. It is not for me to set out general principles of widespread application, but in the circumstances of this particular case, and as submitted by Mr Brown, I regard it as having been incumbent ("fair and reasonable" to adopt Mr Brown's words) upon the registrar, in *addition* to have published the TPN, to have notified, *individually and separately on any affected case*, those persons who had received the 'mistaken' electronic communication. Of course, as I have said, it will be understood that by using the word 'mistaken', I mean that it was 'mistaken' in the light of TPN 4/2010, and not consciously believed to be mistaken at time of issue. Wherever I use the word 'mistaken' below, this understanding applies.
17. Such a notification by the registrar would have set out the correct date for filing notice of opposition; if not expressly by reference to a particular date, then at least by way of clarification or correction to make it clear that the period of calculation *included* the date of publication. Such a notification should have been sent in each and every relevant (ie one where the mistaken electronic communication had been sent) case, whether the putative opponent is represented or not, it makes no difference. Nor does it make any difference when the opposition date expired, or has yet to expire. A putative opponent had or has, in my opinion, a legitimate expectation to receive, or have received, such a corrective notification in order to properly put right any mistaken electronic communication.
18. I also think it relevant in these particular circumstances, the belief the opposition period expires on a simple calendar anniversary date, (the calculation of which does not include the date of publication of the application), has been a long standing and historically engrained and embedded practice of attorneys and the registrar. Therefore, diary procedures and so forth would have been set up on that basis. The point I am making here, is that it is not irrelevant to this issue, and in particular my view as to what ought *also* to have happened as expressed above, the fact that the situation that has arisen here was one of embedded and

mutually accepted 'common practice'. What had been accepted as common practice for a sustained period, *in these circumstances (by which I mean the presence of the uncorrected electronic communication)*, required more than the mere publication of a TPN to dispel.

19. In other circumstances, and as I said at the hearing, it could well be that the publication of general guidance would have been or would be sufficient, but not in these where a common practice existed, reinforced by an express electronic communication. I may just add however, I would ultimately have arrived at the same conclusion in this case, even without the existence of a long standing, commonly accepted practice. In other words, this factor has not been determinative in my conclusion, but simply of relevance.

20. The registrar's mistaken electronic communication was thus compounded by his failure to rectify matters in the way I have indicated above in paras 17 and 18. So, notwithstanding the registrar went some way to put matters right by the publication of the TPN, the registrar did not appreciate at the time that more was needed where the 'mistaken' electronic communication had been sent.

21. Accordingly, Mr Brown does not have to demonstrate that, in some way, he 'relied' upon the mistaken electronic communication, nor is it material what dissemination the TPN had, and whether Mr Brown received it or not. The fact is that the missed opposition deadline (the 'irregularity' under rule 77(5)) in this case was attributable at least in part to an error, default or omission on the part of the Office or registrar, and that should be rectified in accordance with rule 77(5), parts (a) and (b). As I have said, the registrar omitted to issue a corrective notification along the lines I have said, and this alone provides grounds to invoke rule 77(5).

22. I therefore conclude that the period for filing opposition in this case should be extended up to 16th October 2010, and in consequence I admit the opposition as having been filed in time.

Further directions

23. I will refer the proceedings to the case worker to set in train subsequent proceedings in accordance with the rules.

Costs

24. I make no award of costs in the interlocutory matter before me and neither do I defer consideration of costs of the matter before me. In other words, this is a

final decision on costs. I have noted in this regard that neither party's case has been entirely without merit. In particular, Mr Bempah was fully entitled to adopt the position he did and it was based upon sound argument.

25. My decision, on behalf of the registrar, accepts at least partial error on his part, and in such circumstances it is especially hard to award one party costs to be paid by the other. I am sure Mr Brown appreciates this, and accordingly he made no request for costs from Mr Bempah on behalf of his client. For his part, and in the event he won, Mr Bempah said he had not incurred any costs either in connection with this hearing.
26. Should either party wish to appeal my decision on costs *only*, they are invited to contact the hearings clerk immediately for details on how to appeal.

Status of this decision under rule 77(5) and possible appeal

27. I have set out above my decisions and my reasons in full. Under rule 70 of the Trade Marks Rules 2008 my decision is an 'interim' one, in that it does not terminate proceedings and is not therefore not subject to '*independent*' appeal, except with leave (ie permission from me). What this means is that rule 70 does not act to bar any appeal at all, it simply acts to prevent an appeal *now, without first being given leave*.
28. Should either party request leave to appeal in relation to the issue I have decided (ie costs is a separate issue as above), this should be done in writing (copied to the other side) within 7 days from the date of this letter giving full reasons. This must be copied to the other side who have a further 7 days from receipt of the request in which to file any comments. A decision on leave will then be made. If leave is granted, the period for actually giving notice of appeal under rule 71 will run from the date leave is granted.
29. Alternatively, under rule 70, a party wishing to appeal the issue covered can wait until the final decision in relation to these proceedings, and then appeal against this interim decision alongside the final decision.
30. A letter on exactly the same lines and of the same date is being sent separately to the other side.

Dated this 24th day of January 2011

Edward Smith
Assistant Principal Hearing Officer, for the Registrar