

**Applications For Extension Of Time To File Counter Statements  
In Trade Mark Application Nos. 20051/00 and 20052/00  
By Asian Aisle Pte Ltd**

**And**

**Objection By  
Ricegrowers Co-operative Limited**

*Before Principal Assistant Registrar P Arul Selvamalar  
31 July 2002*

**Interlocutory hearing - applications for extension of time - Counter Statements not filed within 2 month deadline - applications for an extension of time not sought within 2 month deadline - objection by Opponent - whether Registrar has power to grant extensions - whether sufficient reasons given by Applicant for extensions**

On 22 March 02, the Opponents filed their Notices of Opposition to trade mark application nos 20051 & 20052 of 2000 within the extended deadline of 4 months. The Applicants did not file their Counter Statements within the deadline of 22 May 02 or make applications for extensions of time within the deadline. The Opponents wrote to the Registry on 29 May 02, that the applications should have been deemed withdrawn as no Counter Statements were filed. The Applicants filed their Counter Statements on 3 June 02 and applied for extensions of time to file them late on the same day. The Applicants submitted that they only realised that they had missed the deadlines after receiving the Opponents letter. The Applicants cited as authority the earlier case of TM 2256/98 where an extension of time was sought to file Counter Statement out of time and it was granted.

The Opponents submitted that the Registrar has no power to hear these applications because there is a difference between rule 29(1) which is directory and rule 31(3) which is mandatory and that under rule 31(3) the applications have been deemed withdrawn and that rule 83 did not apply as this was not a procedural irregularity.

**Held, denying the applications for extension of time:**

- The Registrar has the power to hear this application under rule 83. The Registry is bound by the decision of the High Court in TMA 10300/98 that the Registrar does have the power to correct irregularities under rule 83 in a case involving the late filing of a notice of opposition. That case applies as it dealt with rule 29(3) which relates to the late filing of a notice of opposition and the present case involves rule 31(4) which deals with the late filing of a Counter Statement and these 2 provisions are essentially the same.
- The power to correct an irregularity in procedure is a discretionary power. An earlier case was cited as a precedent where 2 oppositions were filed against one mark and they were placed on top of each other and thus it was wrongly assumed that there was only one opposition and as such only one Counter Statement was filed. The error as discovered upon review by the applicants and they sought an extension of time.
- In the present case, there is only one opposition against two of the Applicant's marks and the Counter Statements for neither application was filed by the Applicants. The error was discovered only when the Opponents wrote to the Registrar and the Applicants. The only reason given for the omission was that it was an inadvertent oversight.
- This reason did not persuade the Registrar to exercise her discretion in the Applicants' favour. The Applicants would have to suffer the inconvenience of re-filing their applications and face potential oppositions again. The Applicants failed to exercise diligence in policing their files such that deadlines are not missed and were only alerted by the correspondence from the Opponents' solicitors. The Registrar did not exercise her discretion in support of such behaviour.
- Trade mark application numbers 20051 & 20051 of 2000 are deemed withdrawn.

**Provisions of legislation discussed:**

- Trade Marks Rules 29, 31, 77, 83, 108(2)

- Rules of Court Ord 2 r 1, Ord 3 r 4, Ord 55D r 6, Ord 57 r 9
- Trade Marks Act (Cap 332 1999 Ed) section 108
- Trade Marks Act (Cap 332 1992 Ed) section 78

**Cases referred to:**

- Branov v Sleep Better Bedding Mfg Pty Ltd [1995] 32 IPR 171
- Re Application by Playground Supplies Pty Ltd [1985] 5 IPR 433
- Racecase Pty Ltd v Calder Park Promotions Pty Ltd [1995] 32 IPR 635
- Hunt-Wesson Inc's Trade Mark Application [1996] RPC 233
- Kaiser Aluminium & Chemicals Corp v Reynolds Metal Co. [1969] 120 CLR 136
- Erskine Communications Ltd v Worthington, Times, 8 July 1991
- Chen Chien Wen Edwin v Pearson [1991] 2 MLJ 501
- Tan Chai Heng v Yeo Seng Choon [1980-81] SLR 381

**Representation:**

- Mr Ian Fok (Rodyk & Davidson) for the Applicants
- Mr P Sivakumar (Ella Cheong & Gladys Mirandah) for the Opponents