

**Application For Extension Of Time To Serve Notice Of Opposition
In Trade Mark Application No. 4611/02
By Societe Des Produits Nestle S A**

And

**Objection
By Shin Chin Distributors Pte Ltd**

*Before Principal Assistant Registrar P Arul Selvamalar
4 June 2003*

Interlocutory hearing - Notice of Opposition filed with the Registrar within extended deadline - served on applicants 8 days after filing - whether extension of time should be granted to serve notice of opposition late - rule 29(2) of Trade Mark Rules

The Opponents, Societe des Produits Nestle S A intended to oppose a trade mark application by Shin Chin Distributors Pte Ltd which had been accepted for registration and advertised. They missed the 2 month deadline to file their notice of opposition and applied for an extension of time to file Form TM 48. The Applicants objected, the application for an extension of time was heard and the Opponents were granted the extension of time. They lodged their Notice of Opposition within the extended deadline on 8 May 2003. However they did not serve it on the Applicants at the same time in accordance with rule 29(2). The Opponents did not realize their failure to serve until the Applicants wrote to the Hearings & Mediation Department on 14 May 03 to request that the registration certificate be issued. On 16 May 03 the Department informed the Applicants that the Notice of Opposition had been filed. The Applicants telephoned the Opponents on 16 May 03 and thereafter the Opponents served the Notice of Opposition on them on the same day. The Applicants applied to the Registrar for the opposition to be dismissed on the grounds that it was made out of time. They submitted that rule 29(2) is a mandatory provision and that the Registrar had no discretion to extend the time for service. The Opponents applied for an extension of time to serve the Notice of Opposition and argued that the Registrar had the discretion under rule 83 to grant the extension.

Held, denying the application for an extension to time to serve the Notice of Opposition,

- Rules 29(2) of the Trade Mark Rules requires the Opponent to serve a copy of the Notice of Opposition on the Applicant at the same time that it is filed with the Registrar. A breach of Rule 29(2) is a procedural irregularity that may be corrected by the Registrar under Rule 83. The failure to serve the Notice of Opposition at the same time as filing may be corrected by a grant of an extension of time from the date it was due until the date it was actually served. To persuade the Registrar to exercise her powers under rule 83, the Opponents must give good reasons and the Registrar must be convinced that the reasons justify the extension sought. The mere fact that the Registrar has the discretion does not justify the exercise of the power in every case or where no good reasons are shown. It is also not sufficient to argue that the extension should be granted because otherwise the Opponents' case fails.
- The only reason that the Opponents have given for their failure to serve the opposition is that there was an inadvertent oversight. The Opponents state that their intention to serve it is obvious from their letter to the Registrar filing the Notice of Opposition but for some inexplicable reason they failed to serve it. The Opponents only realised that they had not served the Notice of Opposition when the Applicants telephoned them on 16 May 03. Such conduct does not persuade the Registrar to exercise her discretion in favour of the Opponents. The circumstances in this case are aggravated by the fact that the Opponents missed the first deadline to file form TM 48 and had to argue an application for an extension of time at an interlocutory hearing on 24 April 2003. They were granted an extension of time to file and serve their notice of opposition at that hearing. Yet when they filed their Notice of Opposition within the extended deadline, they forgot to serve it.
- The Opponents also argued that if they are not given an extension of time to serve their notice of opposition and if their opposition is dismissed, they would not be able to oppose the trade mark application. However after the mark is registered, they may take out invalidation proceedings against the Applicants trade mark on the same grounds as those for opposition.

- The Opponents cited 2 precedents where the Hearings & Mediation Department has granted applicants extensions of time to serve their documents late and said that in those cases too the reasons were that there was an oversight. Those cases were heard in the years 2000 and 2001. The rules relating to the service of documents in opposition proceedings were amended in the year 2000. At that time the decisions may have been influenced by the fact that parties were unfamiliar with the amendments to the Trade Mark Rules in 2000. However 3 years after the amendments to the rules, such a consideration is not persuasive. The service of documents in opposition proceedings should be an entrenched practice by now.
- The application for an extension of time from 8 May 03 to 16 May 03 to serve the Notice of Opposition is therefore denied. As rule 29(2) requires the Opponents to serve the Notice of Opposition at the same time that it is filed, the Notice of Opposition that was filed is therefore dismissed. Trade Mark Application Number 4611/ 02 may proceed to registration.

Legislation referred to:

- Trade Marks Rules 1998, Rules 29 & 83

Cases referred to:

- In the matter of a Request by Dr M H Z Khan (UK Opposition No 50126)
- In the Matter of a Request by Emap Consumer Magazines Ltd (UK Opposition No 50104)
- Potomac Tobacco Company Ltd v Ritkam Trading & Manufacturing Pte Ltd (Singapore TMA 11318/00)
- American Cigarette Company (Overseas) Limited v Kangaroo Industries (Regd) (Singapore TMA 9833/98)
- Lyons & Anor v Registrar of Trade Marks & Anor 1 IPR 416
- Asian Aisle Pte Ltd v Ricegrowers Co-Operative Limited (Singapore TMA 20051/00 and 20052/00)
- Tan Chai Heng v Yeo Seng Choon [1980-1981] SLR 381
- In the Matter of a Request by Head Sport AG (UK Opposition No 0/460/01)

Representation:

- Ms Gooi Chi Duan (Donaldson & Burkinshaw) for the Opponents
- Ms See Tho Sok Yee (Allen & Gledhill) for the Applicants