

**Application For Extension Of Time To File Notice Of Opposition In Trade Mark Application No 11833
Of 2004**

**By Neutrogena Corporation
(Applicant For Extension Of Time)**

And

**Objection By
Neutrigen Pte Ltd
(Respondent In Application For Extension Of Time)**

*Before P Arul Selvamalar, Principal Assistant Registrar of Trade Marks
14 March 2005*

Interlocutory hearing - application for extension of time to file Notice of Opposition made 9 days after 2 month deadline – objection by Respondent to grant of extension of time - whether good and sufficient reason shown by applicant for extension of time – rule 29, Trade Mark Rules 1998

Facts

Neutrigen Pte Ltd applied for the mark, “NEUTRIGEN SucoStop Advanced Fat Blaster Sugar Regulator & Device”, which was advertised in the Trade Marks Journal on 29 November 2004. Neutrogena Corporation intended to oppose the registration of this mark but they failed to file their Notice of Opposition within the deadline of 29 January 2005 in accordance with rule 29(1) of the Trade Mark Rules 1998; neither did they apply for an extension of time to file their Notice of Opposition by filing Form TM 48 in accordance with rule 29(3) by the same date. On 7 February 2005, they filed Form TM 48 late and sought an extension of time and the consent of the Respondent to the application for an extension of time. The Applicant had also intended to oppose 7 other marks that the Respondent had applied for which are at various stages of opposition proceedings. The Respondent had written to the Applicant from as early as 1 April 2004 with respect to these 8 applications and the Applicant had responded to them on 1 August 2004. Such communication shows that the Applicants were aware of the Respondents’ 8 trade mark applications and they state that their intention was to oppose all of them. Their only explanation for their failure to file the Notice of Opposition against this application in time was that they did not discover the advertisement of this mark until 5 February 2005. No explanation was given by the Applicant as to what transpired between 29 November 2004 and 5 February 2005 that they failed to discover the advertisement.

Held, denying the application for an extension of time,

1. The Applicants should have closely monitored the progress of all 8 applications to advertisement so that they could file oppositions to all of them. Their explanation that they failed to notice the advertisement of the mark up to 5 February 2005 and their lack of explanation as to what happened between 29 November 2004 and 5 February 2005 does not constitute a good and sufficient reason for the grant of an extension of time. The Applicants are aware that under the Rules they have 2 months from the date of advertisement of the mark to file an opposition. A failure to conduct a trade mark search for a period of more than 2 months is inexcusable. The Applicants should have monitored the progress of this trade mark application at close enough intervals to ensure that they file the opposition on time.
2. The Applicants submitted that as the Respondent was aware that oppositions are going to be filed against their trade mark applications, they will not be prejudiced by the grant of an extension of time. However the Respondents awareness cannot justify the Applicants’ failure to monitor the progress of the applications. The Respondents are prejudiced as the delay in the filing of the Notice of Opposition would have led them to believe that this particular mark will not be opposed. The Trade Mark Rules provide deadlines for the performance of every step in an opposition process so that the applicants and the opponents have the benefit of the certainty and the finality that the Rules provide.
3. The Applicant also submitted that they would suffer grave prejudice if the application is not granted. The Applicants have another course of action against the Respondents’ mark, namely, invalidation proceedings. This will cost the Applicant more time and therefore money and I have weighed that cost against the argument that the prejudice that the Respondent has suffered may also be compensated by an order as to costs. However I am of the view that the failure to monitor the progress of the Respondents’ applications is inexcusable.
4. Parties have repeatedly argued in interlocutory hearings where a deadline was not met, as if good and sufficient reasons for the grant of an extension of time from 2 months to 4 months, is the same as good

and sufficient reasons for the complete failure to meet a deadline. If that were the case, then there would be no distinction between those who meet the deadline to ask for an extension of time and those who completely missed the deadline and yet asked for another chance to apply for the extension of time. Substantial reasons are required when there is a complete failure to file an application for an extension of time within the deadline.

5. The Applicants are ordered to pay the Respondents a sum of \$170 as costs of this hearing within 2 weeks of the date of this decision is sent to the parties.

Provisions discussed:

- Trade Marks Rules 1998, rules 29 and 83

Cases referred to:

- Request by Emap Consumer Magazines Ltd for an Extension of Time (UK Opposition No 50104)
- American Cigarette Company (Overseas) Limited v Kangaroo Industries (Singapore TM No. 9833/98) (5 Dec 2002)
- Potomac Tobacco Company Limited v Ritkam Trading & Manufacturing Pte Ltd (Singapore TM No. 11318/00) (30 Oct 2004)
- Asian Aisle Pte Ltd v Ricegrowers Co-operative Limited (Singapore TM Nos. 20051/00 and 20052/00) 31 July 2002
- The Tokai Maru [1998] 3 SLR 105
- Ferocem Pty Ltd v Commissioner of Patents 28 IPR 243
- De Cruz v Guangzhou Yuzhitang Health Products Co Ltd & Ors [2003] 4 SLR 682
- Re Application by Playground Supplies Pty Ltd [1985] 5 IPR 433
- Application for Extension of Time in SiS International Holdings Ltd v SIS Swiss Financial Services Group AG (T03/10082) 18 Feb 2005 (unreported)
- Charles Jourdan Holding v Neel's Electronic Pte Ltd (T98/10300) (unreported)
- Societe de Produits Nestle S A v Shin Chin Distributors Pte Ltd (TM 4611/02)

Representation

- Ms. Jacqueline Baruch (Drew & Napier) for the Applicants
- Ms Lim Ai Leen (Colin Ng & Prs) for the Respondents