

**Application to Correct an Irregularity under rule 83 to File Counter-Statement out of time
In Trade Marks Application T0805545C
By Martin Joseph Peter Myers (“Applicants”)**

And

**Objection
By GSM (Operations) Pty Ltd, GSM (Trademarks) Pty Ltd and Billabong International Limited
 (“Opponents”)**

*Principal Assistant Registrar Lee Li Choon
26 June 2009*

Interlocutory hearing – application to correct an irregularity in procedure under rule 83 of the Trade Marks Rules to allow the late filing of Counter-Statement – objection by Opponents – whether late filing outside the maximum 4-month period for the filing of Counter-Statement under rule 31(5) can be allowed.

On 3 November 2008, the Opponents filed a notice of opposition against application T0805545C in Classes 29, 30, 32 (subject application) with the Registrar. The same was served on the Applicants on the same day. On 31 December 2008, the Applicants applied for an extension of time to file the Counter-Statement. The Registrar granted the extension of time up to the maximum time of 3 March 2009 by way of a notification dated 14 January 2009 that was served on both the Applicants and the Opponents. In that notification, the deadline of 3 March 2009 was in bold and highlighted. On 5 March 2009, the Applicants filed the Counter-Statement via Form TM 12 and served a copy of the same on the Opponents. In their cover letter, the Applicants informed that they were making an application under rule 77B of the Trade Marks Rules to reinstate the application at the same time. The requisite Form TM 40 was lodged and all requisite fees paid. On 6 March 2009, the Applicants admitted their mistake and acknowledged that rule 77B does not apply in the circumstances and sought to rely on rule 83 of the Trade Marks Rules instead. Pursuant to the Opponents’ objection to the late filing of the Counter-Statement, an interlocutory hearing was conducted on 24 June 2009.

Held, allowing the irregularity in procedure to be corrected under rule 83 of the Trade Marks Rules by the acceptance of the out-of-time Counter-Statement as having been duly filed with the Registrar and served on the Opponent.

1. The Registrar has the power to hear this application under rule 83 of the Trade Marks Rules. This is clear from the decision of the Registrar in T20051/00 (Asian Aisle Pte Ltd v Ricegrowers Co-operative Limited). As applied in the aforesaid decision, “irregularities” in rule 83 refer to failures to comply with the procedural requirements of the Trade Marks Act and the Trade Marks Rules and this includes matters in respect of time.
2. The power to correct an irregularity in procedure is a discretionary power. The exercise of this discretionary power of the Registrar under rule 83 of the Trade Marks Rules is a balancing exercise, involving a consideration of the public interest in that rules relating to procedure are followed so that there is certainty for trademark owners who are guided by them and the need to ensure the proper adjudication of the case based on its merits in the interest of justice between the parties.
3. While the balancing exercise is to be carefully weighed and will turn on the particular facts and circumstances of each case, the overall consideration of public interest of certainty and transparency of the trade marks application procedure and the need to promote the expeditious disposal of disputes under the Trade Marks Act would warrant the Registrar not allowing the overstepping of time limits provided for in legislation under most circumstances.
4. In this case, the Applicants have overstepped the maximum time frame allowed for the filing of the Counter-Statement as stipulated in rule 31(5) of the Trade Marks Rules. Rule 31(5) provides that the total extension of time for which the Registrar may allow to file the Counter-Statement shall not exceed 4 months from the date of the receipt by the applicant of the notice of opposition. In this case, the Applicants had earlier requested for an extension of time and had been given the maximum 4-month period to file the Counter-Statement and this period expired on 3 March 2009. In the case of the filing of the Counter-Statement, time periods run from the receipt of a notice of opposition or are clearly stipulated in the Registrar’s notification to the applicant. Thus, generally, on a balance of things, there would hardly be justifications for the non-compliance of time periods for the filing of the Counter-Statement.
5. However, in this case, the following facts and circumstances have also to be taken into consideration. First, the Applicants were only 2 days late in filing the Counter-Statement with the Registrar and serving

the same on the Opponents. Second, the parties are already engaged in an earlier opposition involving the same mark and involving the same class of goods, albeit a narrower set of goods, in so far as one of the classes is concerned (T0515248B in Class 32) and that opposition has reached a mature stage whereby a hearing has already been fixed for 20 August 2009. The Applicants also submitted that the parties are also involved in a series of oppositions in other jurisdictions as well. Therefore, both parties are well aware of the ongoing dispute between them. Third, there is an intervening application lodged by the Opponents for the same mark for the same or similar set of goods in Class 32 as the Applicants' subject application (T0903503J filed on 30 March 2009). The significance of this is that the Opponents' intervening application would pose an obstacle to the Applicants applying for the mark in Class 32 should they decide to re-file pursuant to the subject application having been deemed withdrawn under rule 31(3). This may lead to a premature determination of the rights of the parties in the Opponents' favour insofar as the subject application in Class 32 is concerned which may in turn have implications for the ongoing dispute between the two parties.

6. On the whole, the need to ensure there is proper adjudication on the merits of the case in the interest of justice between the parties prevails over the procedural default by the Applicants. Importantly, it is taken into consideration that the Opponents did not allege that they would suffer any real prejudice or harmful consequences if the late filing of the Counter-Statement were to be allowed.
7. Accordingly, based on the special circumstances of the case, the Applicants' Counter-Statement filed on 5 March 2009 is allowed. In addition, the Opponents are hereby awarded costs of \$1,000.

Legislation References

- ♣ Trade Marks Rules (2008 Rev Ed), rule 31, rule 83
- ♣ Rules of Court Order 2 Rule 1

Case References

- Asian Aisle Pte Ltd v Ricegrowers Co-operative Limited (TM Nos. 20051/00 and 20052/00) (31 July 2002)
- The "Melati" [2003] 4 SLR 575
- The "Melati" [2004] 4 SLR 7
- Costello v Somerset County Council [The Times November 25 1992]
- Erskine Communications Ltd v Worthington Times, July 8, 1991 (CA)
- Cropper v Smith (1883) 26 Ch.D. 700
- Potomac Tobacco Company Limited v Ritkam Trading & Manufacturing Pte Ltd (TM No. 11318/00) (30 Oct 2002)
- Kok Han Marketing Services v Sing Brothers Hardware Pte Ltd (TM No. 8671/01) (3 December 2002)
- American Cigarette Company (Overseas) Limited v Kangaroo Industries (TM No. 9833/98) (5 Dec 2002)
- Neutrogena Corporation v Neutrogen Pte Ltd (TM No. 11833 of 2004) (14 March 2005)
- Nalli trade mark (TM No. 2256/98) (unreported)
- Charles Jordan Holding v Neel's Electronic Pte Ltd (TM No. T98/10300) (unreported)

Representation

- Ms Teresa O'Connor, Mr Vernon Chua (Infinitus Law Corporation) for the Applicants
- Ms Angela Leong, Ms Tay Sok Keng (Lloyd Wise) for the Opponents