

**Application for Extension of Time to File Counter-statement
In Trade Mark Application T0804529F
By Alliance Cosmetics Sdn Bhd (“Applicants”)**

And

Objection

**By (1) Procter & Gamble Business Services Canada (Opponent 1)
and (2) The Procter & Gamble Company (Opponent 2)
(collectively, “Opponents”)**

*Principal Assistant Registrar Lee Li Choon
30 September 2009*

Interlocutory hearing – application for an extension of time to file Counter-statement – objection by Opponents – 2 sets of Notice of Opposition; one set of Notice of Opposition by Opponent 1 and one set by Opponent 2 – Applicants filed Counter-statement in response to Notice of Opposition by Opponent 1 within time but failed to file Counter-statement in response to Notice of Opposition by Opponent 2 - whether late filing of the Counter-statement in response to Notice of Opposition by Opponent 2 can be allowed.

On 19 June 2009, the Opponents filed 2 sets of Notice of Opposition against application T0804529F in Class 3 (subject application) with the Registrar. The 2 sets of Notice of Opposition pertain to one set of Notice of Opposition by Procter & Gamble Business Services Canada (“Opponent 1”) and one set of Notice of Opposition by The Procter & Gamble Company (“Opponent 2”). The 2 sets of Notice of Opposition were filed with the Registrar together with a cover letter dated the same day with the indication,

“cc Clients

M/s Shearn Delamore (By Fax +603 2072 2758 & Courier)”.

The Applicants filed their Counter-statement with the Registrar on 19 August 2009. Their cover letter dated 17 August 2009 showed the indications, “2 sets of Form TM 12 and the Counter-statement” and “a cheque of S\$325 being the requisite fee”. It is to be noted that the payment was in respect of one set of Counter-statement. Despite the indications on the cover letter, only one set of Counter-statement in response to the Notice of Opposition by Opponent 1 was filed with the Registrar on the said date.

The Applicants’ case for the late-filing is that they were not served the Notice of Opposition by Opponent 2. The Applicants relied on 3 grounds for their application:

- i. The Applicants alleged that there was incomplete service of the Notice of Opposition as they were not served the Notice of Opposition by Opponent 2.
- ii. The service of the Notice of Opposition by the Opponents was defective in that the Notice of Opposition was served on the Applicants’ agent’s (M/s Shearn Delamore & Co) address in Kuala Lumpur, Malaysia and not on the address for service in Singapore that is on the record.
- iii. The Applicants acted in good faith as can be seen from their Counter-statement wherein they stated that the registered proprietor of trade mark No. T06/19887G and T06/19889C (i.e, Opponent 2) did not oppose the subject application. From this, the Applicants aver that they were not aware that Opponent 2 had also opposed the subject application and therefore, they had acted in good faith.

The Opponents objected to the Applicants’ application on the following basis:

- i. On the face of all documents and correspondences exchanged between the parties and the Registrar, starting from the Opponents’ letter to the Applicants’ agent, Shearn Delamore & Co dated 17 April 2009, it had been made clear to all parties that there were 2 Opponents and 2 sets of Notice of Opposition.
- ii. The Notice of Opposition by Opponent 1 which was undeniably received by the Applicants also showed, in the Statement of Grounds, that there was another opposition in that it was stated that there was another related company that had also opposed the subject application.

Further, the Opponents sought to justify their service of documents on the Applicants’ address in Malaysia on the basis that the correspondences from the Applicants to the Opponents had consistently emanated from their agent’s address in Malaysia and that further, the Applicants had not objected to being served documents at their agent’s address in Malaysia, even though they had an address for service in Singapore.

Pursuant to the Opponents' objection to the Applicants' request to be granted an extension of time to file their Counter-Statement in response to the Notice of Opposition by Opponent 2, an interlocutory hearing was conducted on 30 September 2009.

Held, allowing the extension of time for the Applicants to file Counter-statement in response to Notice of Opposition by Opponent 2 by 19 October 2009.

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 stated 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. Rule 83 is applicable in this case as Applicants' request for the extension of time was not made within 2 months from the date of their receipt of the Notice of Opposition by Opponent 2.
2. The following factors were considered by the Registrar in exercising the discretionary power under rule 83 to allow the extension of time:
 - i. The Applicants would be prejudiced if the extension of time is not granted as the Applicants would be deemed to have withdrawn the subject application by virtue of rule 31(3) of the Trade Marks Rules (2008 Rev Ed). This, in turn, would prematurely determine the outcome of the opposition proceedings. The effect is undesirable as the opposition proceedings should be determined based on the merits of the case after a full and proper adjudication.
 - ii. If the extension of time is allowed, it would still be within the maximum time frame allowed for the filing of Counter-statement, which is 4 months from the receipt of the Notice of Opposition, and which, in this case, expires on 19 October 2009.
3. Accordingly, the Registrar orders the Applicants to file their Counter-statement in response to the Notice of Opposition by Opponent 2 by 19 October 2009. In addition, the Opponents are hereby awarded costs of \$450.
- 4.

Legislation References

- Trade Marks Rules (2008 Rev Ed), rule 31, rule 83

Case References

- *Asian Aisle Pte Ltd v Ricegrowers Co-operative Limited* (TM Nos. 20051/00 and 20052/00) (31 July 2002)
- *Kok Han Marketing Services v Sing Brothers Hardware Pte Ltd* (TM No. 8671/01) (3 December 2002)
- *Neutrogena Corporation v Neutrogen Pte Ltd* (TM No. 11833 of 2004) (14 March 2005)

Representation

- Mr Angus Tiong (Shearn Delamore & Co) for the Applicants
- Ms Tan Wei Yi and Ms Helen Wheeler (Wong & Leow LLC) for the Opponents