

**IN THE HEARINGS AND MEDIATION DIVISION OF
THE INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
REPUBLIC OF SINGAPORE**

Trade Mark Application No. T1003190F
24 November 2010

**APPLICATION FOR EXTENSION OF TIME
TO FILE COUNTER-STATEMENT
IN A TRADE MARK APPLICATION
BY KPR SINGAPORE PTE LTD**

AND

**OBJECTION THERETO BY
PSE ASIA-PACIFIC PTE LTD**

Principal Assistant Registrar See Tho Sok Yee
24 November 2010

Interlocutory hearing – *application for extension of time to file Counter-Statement made 16 days after 4-month deadline – objection by Opponents to extension of time – whether late filing outside the maximum 4-month deadline for the filing of Counter-Statement under rule 31(5) can be allowed – rule 83 of the Trade Marks Rules (2008 Rev Ed)*

KPR Singapore Pte Ltd ("the Applicants") applied on 17 March 2010 to register the trade mark, "KPR & device" under Application No. T1003190F ("the Application"). PSE Asia-Pacific Pte Ltd ("the Opponents") opposed the Application on 17 June 2010.

On 17 August 2010, the Applicants applied for an extension of time to file their Counter-Statement. On 1 September 2010, the Registrar granted a final extension of time up to 17 October 2010 to file the Counter-Statement, in accordance with rule 31(5) of the Trade Marks Rules. The same letter granting the extension was copied to and received by the Opponents.

The final deadline of 17 October 2010 expired and no Counter-Statement was filed. Thus, on 25 October 2010, the Registrar applied rule 31(3) and wrote to the Applicants to inform them that the Application was deemed withdrawn. The Applicants called the Registry on 28 October 2010 upon receipt of the 25 October 2010 letter, to say that they did not receive the Registrar's earlier letter of 1 September 2010. The Applicants indicated that they would write in to appeal the Registrar's decision. On 2 November 2010, the Applicants wrote to the Registrar seeking reconsideration on the deemed withdrawal of the Application. They furnished copies of their log book records (for the

period from 24 August 2010 to 12 October 2010) which typically log all incoming letters from the Registrar. The Applicants, however, did not copy the Opponents on their letter.

The Registrar replied the Applicants on 4 November 2010, enclosing mailing records (Form TM 85) that showed the Registrar's letter of 1 September 2010 was sent out on the same date. A one-week extension up to 11 November 2010 was given to the Applicants to file their Counter-Statement. On 8 November 2010, the Opponents wrote to the Registrar to object to the extension of time given to the Applicants. On 9 November 2010, the Applicants filed their Counter-Statement. An interlocutory hearing was held on 24 November 2010 to determine whether an extension of time should be given to the Applicants to file their Counter-Statement outside the maximum 4-month deadline.

Both parties filed written submissions and authorities in support of their position. The Applicants' agents maintain that they did not receive the Registrar's letter of 1 September 2010 granting them the extension of time. Even though the Applicants' agents were aware that the final deadline to file the Counter-Statement fell on 17 October 2010, it was their firm's practice to only record the deadline in their system upon receipt of the Registrar's letter stating the deadline. Hence, they missed the deadline to file the Counter-Statement by 17 October 2010.

The Applicants note that the Registrar has usually considered the public interest in such cases, and the innocent party (the Opponents here) normally gets the benefit. However, they submit that the present case is different because the Opponents alleged fraud and bad faith on the part of the Applicants. It is critical for the latter to deny the allegations at earliest opportunity, i.e. in the present opposition. Otherwise, issues of estoppel and adverse inference will arise should criminal action for fraud be taken against the Applicants in the courts. On the other side of the same coin, the Applicants' Counter-Statement contains allegations of bad faith on the part of the Opponents. There is therefore a public interest in hearing the matter. Moreover, the opposition has already started and the Counter-Statement has already been filed, in contrast with other instances where prospective opponents missed the deadline to file the Notice of Opposition to start the opposition. On a balance of convenience, the Applicants' Counter-Statement has already been filed, albeit late, and the opposition should be allowed to continue.

The Opponents submit that the 4-month deadline to file the Counter-Statement is absolute and the Registrar has no discretion to extend the deadline. Even if she has the discretion, the Applicants have not given good and sufficient reasons in support. The Applicants should have either contacted the Registrar, or filed the Counter-Statement, before the 4-month deadline if they did not hear from the Registrar. The Applicants' failure to monitor their deadline was not excusable. The Opponents rebut that the Applicants' concerns on estoppel and adverse inference are unfounded because the allegations of fraud are not dealt with substantively at IPOS. The IPOS proceedings so far concern the Counter-Statement being filed outside the 4-month deadline, and even if the application is deemed withdrawn, the Applicants would not be deemed to have admitted to the allegations of fraud. Furthermore, previous IPOS decisions show that the Registrar was

not adverse to rejecting Counter-Statements, even if this meant that applications were deemed withdrawn.

Held, denying the application for an extension of time to file the Counter-Statement

1. The Registrar's discretionary power under rule 83 of the Trade Marks Rules (2008 Rev Ed) to grant an extension of time beyond the 4-month maximum deadline to file a Counter-Statement is exercised sparingly in exceptional cases, for example *GSM (Operations) Pty Ltd and Ors v Martin Joseph Peter Myers* (TM No. T0805545C). 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 party's case fails, *Societe de Produits Nestle S A v Shin Chin Distributors Pte Ltd* (TM No. 4611/02).
2. The Applicants' agents admit that they are aware of the final deadline of 17 October 2010 based on an application of rule 31(5) but their internal process was to await actual receipt of the Registrar's letter before logging the deadline into their system. The Applicants' agents should have monitored the final deadline with more care. Their application for extension of time was filed on 17 August 2010, two months before the final deadline. They therefore had ample time and opportunity to monitor the deadline, and to have taken the appropriate action if they did not receive the Registrar's letter confirming the extension of time. For example, before the final deadline expired on 17 October 2010, if they did not receive the Registrar's letter, they could have contacted the Registry or filed their Counter-Statement. If they took no action before the final deadline, the Registrar would not have known that they did not receive the letter granting the extension of time. That the Applicants' agents took action only after the Registrar informed the Applicants in writing that the Application was deemed withdrawn is not a factor in their favour.
3. The Applicants' argument that allegations of fraud have to be vigorously defended at first opportunity in this opposition is not entirely satisfactory. The present opposition has concluded by default on the part of the Applicants in not filing their Counter-Statement before the final statutory deadline. The substantive issues, such as allegations of fraud and bad faith, were not determined at this forum. In any case, it is now noted on record that the Applicants strenuously deny the Opponents' allegations of fraud and bad faith.
4. At the same time, the Opponents will be prejudiced if the Counter-Statement filed beyond the maximum 4-month deadline is accepted as the delay had led them to believe that the Application was deemed withdrawn, *Neutrogena Corporation v Neutrigen Pte Ltd* (TM No. 11833/04). There is a legitimate expectation that the opposition be dealt with in accordance with the rules of procedure, unless good and sufficient reasons displace this expectation.

5. There is also a public interest in ensuring that rules relating to procedure are followed, especially so in contentious proceedings. On the other hand, it is still open to the Applicants to file a new application after the Application is deemed withdrawn.
6. Having regard to all the circumstances and submissions made, the Applicants have not persuaded the Registrar that her discretion under rule 83 should be exercised in their favour.
7. The application for an extension of time from 17 October 2010 to 9 November 2010 to file the Counter-Statement is therefore denied. Trade Mark Application No. T1003190F is deemed withdrawn under rule 31(3) as on 18 October 2010.
8. The Applicants and the Opponents shall each bear their own costs in this matter. The Applicants will be refunded their filing fees for the Counter-Statement in view of the high likelihood that this was only incurred as a consequence of the Registrar's letter of 4 November 2010 directing them to file the Counter-Statement.

Legislation discussed:

Trade Marks Rules (2008 Rev Ed), rule 83, rule 31(5), rule 31(3)

Cases referred to:

Ricegrowers Co-operative Limited v Asian Aisle Pte Ltd (TM Nos. 20051/00 and 20052/00) (31 July 2002)

GSM (Operations) Pty Ltd and Ors v Martin Joseph Peter Myers (TM No. T0805545C) (26 June 2009)

Societe de Produits Nestle S A v Shin Chin Distributors Pte Ltd (TM No. 4611/02) (4 June 2003)

Neutrogena Corporation v Neutrogen Pte Ltd (TM No. 11833/04) (14 March 2005)

Representation:

Mr Han Wah Teng, Ms Tricia Dang & Ms Fayth Kuah (Nanyang Law LLC) for the Applicants for Extension of Time / TM Applicants

Mr Melvin Pang (Amica Law LLC) for the Respondents / Trade Mark Opponents