

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

Trade Mark Application No. T0816999H
28 July 2011

APPLICATION FOR AN EXTENSION OF TIME TO FILE EVIDENCE

BY SOS INTERNATIONAL A/S

AND

OBJECTION THERETO

BY

**(1) AEA INTERNATIONAL HOLDINGS PTE LTD
(2) BLUE CROSS TRAVEL SERVICES B.V.**

Principal Assistant Registrar Sandy Widjaja
5 August 2011

Interlocutory Hearing – Application for an extension of time to file evidence made 13 days late – objection by the Opponents to extension of time – whether late filing under rule 33 can be allowed – rule 83 of the Trade Marks Rules (2008 Rev Ed)

The Applicant, SOS International A/S, applied to register its trade mark in Classes 36, 39, 44, 45 in Singapore via International Registration 983169 – Singapore Trade Mark number T0816999H, ("the Mark"). The date of International Registration was 25 September 2008 and the date of notification was 4 December 2008. The Opponents, AEA International Holdings Pte Ltd and Blue Cross Travel Services B.V. lodged their Notice of Opposition on 24 March 2010. The Applicant lodged its Counter-Statement on 8 October 2010. The Registrar, via a letter dated 11 January 2011, provided the maximum timelines for the parties to file their evidence respectively. The Opponents' evidence was due 1 year and 2 months from the filing date of the Counter-Statement and the Applicant's evidence was due 6 months from the filing date of the Opponents' evidence. The Opponents filed their evidence on 8 April 2011. Thus, based on the Registrar's letter of 11 January 2011, the maximum timeline for the Applicant to file their evidence was 8 October 2011. But it was also made clear in the Registrar's letter of 11 January 2011 that the maximum timeline is subject to the usual statutory deadlines and that the maximum timeline given would not negate the requirement to request for an extension of time as necessary. On 21 June 2011, the Applicant wrote in to request for an extension of time to file its evidence. In its letter, the Applicant noted that the actual deadline for the filing of its evidence was 8 June 2011 but they had overlooked this deadline due to their mistaken belief that the Registrar had granted an extension till 8 October 2011 for the Applicant to file their evidence. On 29 June 2011, the Opponents

informed that they do not consent to the request for an extension of time. In light of the above, the Registrar, via a letter dated 1 July 2011, informed that the request for an extension of time was disallowed. The Applicant then requested for a hearing pursuant to rule 67 of the Trade Marks Rules (Cap 332, 2008 Rev Ed) ("Rules") on 14 July 2011.

Applicant's submissions

The Applicant submitted that rule 83 applies in the current case. The Applicant submitted that when considering whether to exercise the discretion under rule 83, the Registrar ought to adopt the principles applied by the Court of Appeal in *The "Tokai Maru"* [1998] 2 SLR (R) 646 ("*Tokai Maru*"). The principles expounded by the *Tokai Maru* include:

- (i) *The rules of civil procedure guide the courts and litigants towards the just resolution of the case and should of course be adhered to. Nonetheless, a litigant should not be deprived of his opportunity to dispute the plaintiff's claims and have a determination of the issues on the merits as a punishment for a breach of these rules unless the other party has been made to suffer prejudice which cannot be compensated for by an appropriate order as to costs.*
- (ii) *Save in special cases or exceptional circumstances, it can rarely be appropriate then, on an overall assessment of what justice requires, to deny a defendant an extension of time where the denial would have the effect of depriving him of his defence because of a procedural default which, even if unjustified, has caused the plaintiff no prejudice for which he cannot be compensated by an award of costs.*

Applying the principles in the *Tokai Maru*, the Applicant submitted that in the current case, the delay was only 13 days (in the *Tokai Maru* it was a delay of 9 months). The Applicant submitted that the Opponents will not suffer any prejudice should the Applicant's request for an extension of time be granted in view of the maximum timeline of Oct 2011 as directed by the Registrar for the Applicant to file their evidence. Importantly, the Applicant submitted that the Applicant should not be deprived of their opportunity to dispute the Opponents' claims and have a determination of the issues on the merits as a punishment for a procedural breach. The Applicant submitted that in the unlikely event that the Opponents have suffered some prejudice, the Opponents will be more than adequately compensated by means of an award of costs. On the other hand, the Applicant will suffer real prejudice if the request for an extension of time is disallowed as the Opponents' intervening application will block any fresh application which the Applicant may file. Further, to take out an invalidation action against the Opponents' intervening application would entail a reversal of the burden of proof (in comparison to that in an opposition action) for the Applicant.

Opponents' submissions

The Opponents referred to rule 33. The Opponents submitted that the request for an extension of time should not be allowed as there are no good and sufficient reasons. The

Opponents submitted that the main reason for the delay was the Applicant's misinterpretation of the Registrar's letter of 11 January 2011. The Opponents submitted that a misinterpretation of clear wordings does not constitute a good and sufficient reason for an extension of time. The Opponents referred to IPOS cases including *In Trade Mark Application Nos. 20051/00 and 20052/00 by Asian Aisle Pte Ltd and Objection by Rice Growers Co-operative Limited [2002] SGIPOS 7* where they submitted that the Registrar disallowed requests for the extensions of time under similar circumstances. Last but not least, the Opponents submitted that they have a legitimate expectation that cases shall be dealt with in accordance with the rules of procedure unless good and sufficient reasons displace such an expectation. In support of their submissions, the Opponents referred to *In Trade Mark Application by KPR Singapore Pte Ltd and Objection thereto by PSE Asia-Pacific Pte Ltd [2010] SGIPOS 13*.

Held, allowing the application

- 1 Rule 33 provides that any request for an extension of time must be made within 2 months from the date of receipt by the applicant of a copy of the opponent's statutory declaration. Rule 77 is the general provision which relates to requests for extensions of time to any prescribed periods of time under the Rules. It is noted that rule 77(6)(ca) specifically provides that rule 77 shall not apply to the filing of any statutory declaration under rule 33. Therefore, there is no general discretion granted to the Registrar to extend any prescribed time periods provided under rule 33. In view of the above, the provisions under rule 33 in relation to time periods are to be construed strictly unless there are exceptional circumstances which dictate otherwise.
- 2 Rule 83 relates to the discretionary power of the Registrar to correct any irregularity in procedure. The exercise of this discretionary power of the Registrar under rule 83 is a balancing exercise, involving a consideration of the public interest that rules relating to procedure are followed so that there is certainty for trademark owners 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 of each case, the overall consideration of public interest of certainty and transparency and the need to promote the expeditious disposal of disputes would warrant the Registrar not allowing the overstepping of time limits in the legislation under most circumstances.
- 4 However, in this case, the following facts have to be taken into consideration. Firstly, while the Applicant was 13 days late in filing the request for an extension of time to file its evidence, there is no statutory maximum timeline to file the said evidence. In fact, the Applicant is still within the maximum timeline allowed for the filing of its evidence as directed by the Registrar in accordance with the Registrar's letter dated 11 January 2011. Secondly, the case is already at the evidentiary stage. Parties are also engaged in several oppositions in other jurisdictions. Thus, both parties are well

aware of the ongoing dispute between them. Thirdly, there is an intervening application lodged by the Opponents for a similar mark for the same or similar set of goods in Class 36 (T1000421F). The significance of this is that the Opponents' intervening application would pose an obstacle to the Applicant should it decide to re-file pursuant to the subject application having been deemed withdrawn under rule 33. This may lead to a premature determination of the rights of the parties in the Opponents' favour insofar as the subject application is concerned.

- 5 On the whole, in the instant case, 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 Applicant. Importantly, it is taken into consideration that the prejudice suffered by the Opponents is not one which cannot be compensated by costs.
- 6 In view of all of the above, the Applicant is granted an extension of time of 13 days from 8 June 2011 to 21 June 2011 to request for an extension of time to lodge its Statutory Declaration. The Applicant is granted an extension of time of 2 months from the date of this decision to lodge its Statutory Declaration in support of the application. If the Statutory Declaration is not filed within this deadline, the application will be deemed withdrawn.
- 7 The Opponents, AEA International Holdings Pte Ltd and Blue Cross Travel Services B.V. are awarded costs in the amount of \$350 for preparing for the Interlocutory Hearing and \$150 as costs for attending the Interlocutory Hearing. The sum of \$500 is to be paid by the Applicant to the Opponents within 2 weeks from the date of this decision.

Legislation discussed:

Trade Marks Rules (Cap 332, 2008 Rev Ed), Rule 33, Rule 83

Cases referred to:

The "Tokai Maru" [1998] 2 SLR (R) 646

In Trade Mark Application Nos. 20051/00 and 20052/00 by Asian Aisle Pte Ltd and Objection by Rice Growers Co-operative Limited [2002] SGIPOS 7

In Trade Mark Application by KPR Singapore Pte Ltd and Objection thereto by PSE Asia-Pacific Pte Ltd [2010] SGIPOS 13

Representation:

Mr Prithipal Singh on behalf of Patrick Mirandah Co.(S) Pte Ltd for the Applicant

Ms Haniza Abnass (Rodyk & Davidson LLP) for the Opponents