

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

Trade Mark Application No. T0906747A
30 September 2011

**APPLICATION FOR EXTENSION OF TIME
TO FILE EVIDENCE
IN A TRADE MARK OPPOSITION
BY BUT FASHION SOLUTIONS –
COMERCIO E INDUSTRIA DE ARTIGOS EM PELE, LDA**

AND

**OBJECTION THERETO
BY SAO PAULO ALPARGATAS S.A.**

Principal Assistant Registrar See Tho Sok Yee
5 October 2011

Interlocutory hearing – application for restoration of trade mark application and for extension of time to file evidence – objection by Opponents – Applicants applied for extension of time 1 month late after Registrar notified Applicants of deemed withdrawal of trade mark application - whether restoration of trade mark application and late application for extension of time allowed

The Opponents, Sao Paulo Alpargatas S.A., opposed the registration of Trade Mark Application No. T0906747A in the name of the Applicants, But Fashion Solutions – Comercio E Industria de Artigos Em Pele, LDA.

The Opponents filed their evidence on 16 May 2011 and the Applicants' deadline to file their evidence fell on 18 July 2011 (since 16 July 2011 was an excluded day). The Applicants did not take any action by this deadline, neither filing their evidence nor applying for an extension of time to do so. On 8 August 2011, 3 weeks after the deadline, the Registrar notified the parties in writing that Trade Mark Application No. T0906747A was deemed withdrawn under Rule 33(3) of the Trade Marks Rules (Cap 332, 2008 Rev Ed). On 18 August 2011, 10 days after the Registrar's notification, the Applicants applied to restore Trade Mark Application No. T0906747A and submitted a statutory declaration by their agents explaining that the deadline was not diarised and the agents were not able to obtain instructions from their principals. On 22 August 2011, the Opponents wrote to the Registrar objecting to the restoration of Trade Mark Application No. T0906747A. An interlocutory hearing was subsequently fixed for 9 September 2011 but later vacated and re-fixed for 30 September 2011.

In their submissions, the Applicants contend that the Registrar has the power to hear the present case under Rule 83 of the Trade Marks Rules. The Applicants cite the reasons for the need for an extension of time as follows: (a) The Applicants' deadline was not duly entered into the Applicants' Counsel's diary by the relevant solicitor-in-charge; and (b) The said solicitor-in-charge (who has since left the employment of the Applicants' Counsel's firm), was not able to obtain instructions from the Applicants and because it was not clear whether the latter wanted to pursue their trade mark application, the agents did not record the deadline to file evidence. The agents went on at length to detail the challenges in communicating with their principals, the Applicants, who were in a different time zone, English illiterate, had intermediary agents who instructed the Singapore agents and who themselves had limited competence in English. The Opponents' evidence was voluminous with many pages worth of exhibits, adding to the time needed for the Applicants to prepare evidence. The Applicants also point out that the Case Management Conference ("CMC") timeline for them to file evidence, on 16 November 2011, is not exceeded. Also, the Opponents have had six extensions of time to file evidence while this is only the Applicants' first request for extension of time. Overall, the Applicants conclude that they have not been dilatory in the conduct of the opposition proceedings. The principals, the intermediary agents and the Singapore agents have made utmost efforts to coordinate and to communicate. This is not a case of failure to monitor the deadline because the agents have been consistently asking the principals for instructions.

On the other hand, the Opponents deny that the Registrar has any power to restore a trade mark application that has already been deemed withdrawn. Under Rule 33(3) of the Trade Marks Rules, the word "shall" in the phrase "shall be treated as having withdrawn his application" is mandatory and absolute, with no room for the Registrar's discretion. Rule 83 is not applicable for the Registrar to rectify any irregularity in procedure here because the Registrar has already deemed the application withdrawn by the operation of law. Therefore, there is no irregularity to be rectified. Even if the Registrar has the power to hear the present application under Rule 83, the Registrar's discretion is only exercised sparingly in exceptional cases. The Opponents argue that the Applicants have not given sufficient or valid reasons. The Applicants took action only after the Registrar had deemed their application withdrawn, and even so, their application for restoration came 10 days after the Registrar's notification. The Opponents also submit that a solicitor's oversight in itself is not a sufficient or valid reason for a late application for extension of time. There needs to be other extenuating factors. The Opponents submit that the present case is one of simple oversight on the part of the Applicants' agents in not entering the deadline into the office diary with no additional extenuating factors. There is a need for finality on rules prescribing time limits. The Opponents claim that they will be prejudiced if the Applicants' application were to be allowed. This is because the Opponents have a legitimate expectation that the Applicants' application would be deemed withdrawn by operation of law. As a result of the long delay of 1 month, the Opponents were in fact led to believe that the Applicants' application was deemed withdrawn. There is also a public interest in ensuring that rules relating to procedure are followed. Finally, the Opponents contend that CMC timelines have no relevance to the interlocutory hearing. The Applicants' reliance on their CMC timeline of 16 November

2011 is misconceived because the timeline is predicated on the appropriate requests for extensions of time being made.

Held, refusing the applications to restore Trade Mark Application No. T0906747A and for an extension of time for the Applicants to file evidence

1. The Registrar has the power to hear this application under Rule 83 of the Trade Marks Rules. This is clear from the IPOS decision in *Asian Aisle Pte Ltd v Ricegrowers Co-operative Limited* [2002] SGIPOS 7, where the Registrar was bound by the High Court decision in Trade Mark No. 10300/98. "Irregularities" in Rule 83 refer to failures to comply with the procedural requirements of the Trade Marks Act and the Trade Marks Rules. This includes matters in respect of time. Rule 83 is applicable in this case as Applicants' request for an extension of time to file evidence was not made within the statutory deadline. Consequentially, the Registrar also has the power to restore an application that was earlier deemed withdrawn under Rule 33(3) of the Trade Marks Rules. If the latter were not the case, the Registrar's power to allow the correction of an irregularity under Rule 83 will be rendered otiose.

2. However, the mere fact that the Registrar has such discretion under Rule 83 does not justify its exercise in every case or where no good reasons are shown; it is also not sufficient to argue that the extension should be granted to a party because otherwise his case fails, see *Shin Chin Distributors Pte Ltd v Societe des Produits Nestle S.A.* [2003] SGIPOS 8 ("*Shin Chin Distributors*") and *PSE Asia-Pacific Pte Ltd v KPR Singapore Pte Ltd* [2010] SGIPOS 13 ("*PSE Asia-Pacific*") at [1]. The Registrar in *SOS International A/S v AEA International Holdings Pte Ltd and Anor* [2011] SGIPOS 10 ("*SOS International*") makes clear that "*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.*"

3. The onus lies on the party applying for the Registrar to exercise discretion in his favour, notwithstanding prescribed rules that result in an outcome against his favour. In the present case, under Rule 33(3), the Applicants' Trade Mark Application No. T0906747A was deemed withdrawn as the Applicants did not file their evidence or seek an extension of time to do so by the deadline. The Applicants are applying for the Registrar to exercise her discretion not to deem their application withdrawn notwithstanding Rule 33(3). Hence, the onus in this interlocutory hearing lies on the Applicants.

4. The Applicants have conflated the reasons why an extension of time is needed and the reasons why they were late in seeking an extension of time. This distinction is significant, as noted in *Neutrigen Pte Ltd v Neutrogena Corporation* [2005] SGIPOS 7 ("*Neutrigen*") at [4]. Otherwise, "*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. All the Applicants' submissions on the difficulties in communications between the agents and principals, and the additional time needed to cater to these difficulties, support a request for extension of time *per se*. Likewise the Applicants' point that the Opponents have enjoyed six extensions of time to file evidence while this is only the Applicants' first request for extension of time. As for whether their application should be restored and whether the late application for extension of time should be allowed, the Applicants' reasons are pared down to a mere oversight in recording and monitoring the deadline. The Applicants' written submissions state that "*Due to the problems communicating with the Applicant and its instructing agents, the solicitor-in-charge has failed to enter the stipulated deadline into the firm's diary*". At the hearing, the agents explained the nexus between communication problems and failure to monitor the deadline as such: The agents did not enter the deadline into the firm's diary because they did not know if the Applicants wish to pursue Trade Mark Application No. T0906747A. This is not persuasive. Communication difficulties is distinct from taking the necessary steps to meet a deadline, such as diarising the deadline, monitoring the deadline as it approaches and taking adequate action to preserve one's legal position, especially if it appears unclear how the Applicants wish to proceed.

6. In the present case, the Applicants only realized their deadline to file evidence had expired after the Registrar notified them that their application was deemed withdrawn. As was the case in *Shin Chin Distributors*, such conduct does not assist the Applicants against the plain application of legislation. Further, the delay in seeking an extension of time amounted to 1 month, which is much longer than in the IPOS decision in *SOS International*, where the Applicants were 13 days late.

7. Since the Registrar's discretion is exercised sparingly, there should be exceptional circumstances to justify its exercise, see *PSE Asia-Pacific* at [1] citing *GSM (Operations) Pty Ltd and Ors v Martin Joseph Peter Myers* [2009] SGIPOS 8 as an example where exceptional circumstances justified the Registrar's exercise of discretion to allow the late Counter-Statement. In the present case, there are no exceptional circumstances to justify the Registrar's exercise of discretion not to apply Rule 33(3).

8. As opined in earlier decisions such as *Neutrigen* at [2] and *PSE Asia-Pacific* at [4], 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. The Opponents will be prejudiced if Trade Mark Application No. T0906747A is restored, as the Applicants' failure to file evidence or seek an extension of time to do so, as well as the Registrar's notification on the deemed withdrawal of the application would have led the Opponents to believe that the application was indeed withdrawn. 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. Unlike in the case of *SOS International*, the Opponents have not filed an intervening application which will pose

an obstacle to the progress of a fresh application by the Applicants. There is no injustice to the Applicants in applying Rule 33(3), only inconvenience which was self-induced.

9. The Applicants venture a further argument supporting their late request for an extension of time, which is that the maximum CMC timeline of 16 November 2011 has not been exceeded. The Applicants cite *SOS International* at [4] in support, as the Registrar considered that "*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.*" I would say that there is a balancing exercise in every case. Some factors weigh in more heavily than others, though all relevant factors are considered in the balance. In *SOS International*, I would venture to say that the single most significant factor was the fact that the Opponents had filed an intervening application for a similar mark for the same or similar services as the Applicants'. Hence, this would pose an obstacle to the Applicants should they file a fresh application for the same mark and specification and lead to a premature determination of the respective rights of the parties in the present dispute. In contrast, as opined in [8] above, if the Applicants wish, they can quickly file a fresh application and if the Opponents wish, they can likewise oppose the fresh application, leading to a determination of the respective rights of the parties by the proper channel. The Applicants submit that this brings inconvenience to the Opponents as the latter have already filed their evidence here, but the Opponents have not raised any complaint of inconvenience when they had full opportunity to do so. On the contrary, the Opponents request that the Registrar upholds the original deemed withdrawal of the application. The other basic point about CMC timelines is that they do not negate the need for parties to apply for extensions of time in accordance with the Trade Marks Rules, see HMD Circular No. 4/2010. The fact that CMC timelines have not been exceeded could be a relevant factor pertaining to prejudice to the responding party in *SOS International*. However, in the present case, the Registrar had already notified the parties of the withdrawal of the application and the Opponents were justified in relying on this notification notwithstanding that the CMC timeline of 16 November 2011 had not expired. In the one month that it took for the Applicants to seek a late extension of time, it is reasonable for the Opponents to believe that the former's application had been deemed withdrawn in the interim.

10. Taking into account the Applicants' unsatisfactory reason for the delay in seeking an extension of time to file evidence and all the relevant circumstances of the case including particularly the delay of 1 month before the application for extension of time and the fact that the Registrar had already deemed the application withdrawn, the Applicants' applications to restore Trade Mark Application No. T0906747A and for an extension of time to file evidence are refused. In addition, the Opponents are awarded costs of \$550; \$400 being costs for preparation and \$150 being costs for attendance. Such costs are to be paid by the Applicants to the Opponents within 1 month from the date of this letter.

Legislation discussed:

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

Cases referred to:

Asian Aisle Pte Ltd v Ricegrowers Co-operative Limited [2002] SGIPOS 7
Shin Chin Distributors Pte Ltd v Societe des Produits Nestle S.A. [2003] SGIPOS 8
PSE Asia-Pacific Pte Ltd v KPR Singapore Pte Ltd [2010] SGIPOS 13
SOS International A/S v AEA International Holdings Pte Ltd and Anor [2011]
SGIPOS 10
Neutrigen Pte Ltd v Neutrogena Corporation [2005] SGIPOS 7
GSM (Operations) Pty Ltd and Ors v Martin Joseph Peter Myers [2009] SGIPOS 8

Representation:

Ms Kho Shu Yan (Gateway Law Corporation) for the Applicants
Mr Maurice Cheong and Mr Freddy Lim (Lee & Lee) for the Opponents