

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

Trade Mark Application No. T1100145H
6 December 2011

**APPLICATION TO ALLOW
LATE FORM FOR EXTENSION OF TIME TO OPPOSE
BY SEIKO HOLDINGS KABUSHIKI KAISHA**

AND

**OBJECTION THERETO
BY CHOICE FORTUNE HOLDINGS LIMITED**

Principal Assistant Registrar Sandy Widjaja
13 December 2011

Interlocutory hearing – application for extension of time to file Notice of Opposition – Form TM 48 filed 4 working days after deadline – whether late filing of Form TM 48 allowed.

The Applicants' trade mark application T1100145H ("the Application Mark) was accepted and advertised on 19 August 2011 for opposition purposes. The deadline to oppose or to request an extension of time to oppose fell on 19 October 2011. On 25 October 2011, the Opponents wrote to the Registrar seeking an extension of time to file the Notice of Opposition. The Opponents indicated that they had been just instructed by their clients who were considering opposing the subject application. The Opponents also indicated in the letter that they had concurrently written to the Applicants to request for their consent to the request for extension of time. On 11 November 2011, the Registrar granted the Opponents a final extension of time up to 19 December 2011 to file the Notice of Opposition. On 16 November 2011, the Applicants wrote to the Registrar stating that they would not consent to the out of time request for extension of time. They alleged that it was untrue that the Opponents had just been informed of the publication of the application as the Opponents had first written to the Applicants on 11 October 2011.

The Opponents submit as a preliminary point that the Registrar is *functus officio* and does not have the jurisdiction in the present proceedings to re-open the case. The Opponents submitted several authorities in support of their point in this regard. The Opponents submit that once the Registrar has exercised his discretion to grant the extension pursuant to Rule 29(8) of the Trade Mark Rules, he is *functus officio*. This means that any attempt to re-litigate the substantive merits of the decision or re-consider the decision that has already been rendered is impermissible. If the Registrar were to do so in the absence of any express statutory provisions affording the

Registrar the jurisdiction to re-open the case, it would be acting *ultra vires* the Trade Marks Act.

Further the Opponents submit that in the event that the Registrar finds that he has jurisdiction to re-open the case and re-consider whether an extension of time should be granted to the Opponents, the interests of justice are best served by allowing the late filing of TM 48 and granting an extension of time for the Opponents to file their Notice of Opposition. The Opponents submit that it is clear that the Registrar has the power to correct the irregularity occasioned by the late filing under rule 83 of the Trade Marks Rules. The Opponents submit that the Registrar's key consideration in deciding whether to exercise the discretion available under rule 83 is whether such irregularity in procedure is detrimental to the interests of any person or party. The Opponents submit that the Applicants have not suffered any prejudice, as the Applicants are aware of the Opponents' objections to the Application Mark as evidenced by the Opponents' letter to the Applicants of 11 October 2011. In the same letter, the Opponents demanded, amongst others, that the Applicants withdraw the Application Mark in its entirety, cease any and all use of the Application Mark and refrain from any and all future use and/or application for registration of the Application Mark. Further, the Opponents submit that the parties are involved in a series of oppositions in other jurisdictions as well, including opposition proceedings commenced by the Opponents against the Applicants in Hong Kong as well as the United States in or about May and November 2011 respectively and thus, the parties are well aware of the ongoing dispute between themselves. Further the Opponents submit that if the extension of time was granted, it would be within the maximum statutory time frame allowed for the filing of the Notice of Opposition.

The Applicants submit that the facts in this case echo that of *Neutrigen Ptd Ltd v Neutrogena Corporation* [2005] SGIPOS 7 ("*Nutrigen Case*"). The Applicants would be prejudiced if the extension is granted as the Opponents only sought their consent and the extension of time after the deadline has passed, leading them to think that their trade mark application may not be opposed. The Applicants submit that the Opponents' first letter to the Applicants on 11 October 2011 did not clearly state that the Opponents intended to oppose the application. The Applicants submit that the rules provide deadlines for the performance of every step so that the parties have the benefit of the certainty and finality that the rules provide. Further, the Applicants submit that the Opponents may still proceed with invalidation of the mark if the Opponents believe that they are prejudiced by the existence of the Application Mark on the register. The Applicants submit that as per the *Neutrigen Case*, substantial reasons are required when there is a complete failure to file an application for an extension of time within the deadline.

Held, allowing the late filing of Form TM 48 and granting the extension of time for the Opponents to file their Notice of Opposition by 19 December 2011

1. The Registrar has the power to hear this application under rule 83 of the Trade Marks Rules. This is clear from the interlocutory decision of the Registrar in *Asian Aisle Pte Ltd v Ricegrowers Co-operative Limited*. The term "irregularities" in rule 83 refers to failures to comply with the procedural requirements of the trade marks legislation, including matters in respect of time.

2. Rule 83 provides that "Any irregularity in procedure which, in the opinion of the Registrar, is not detrimental to the interests of any person or party may be corrected on such terms as the Registrar may direct." Hence, as part of the balancing exercise in exercising this discretion, the Registrar is to consider whether the correction of the present irregularity is detrimental to the interests of any person or party, in particular the Applicants in this case.

3. In this respect, the Applicants claimed they would be prejudiced as the delay in filing Form TM 48 led them to think that their trade mark application may not be opposed. They cite *Neutrigen Ptd Ltd v Neutrogena Corporation* [2005] SGIPOS 7 in support. In my view, that case is distinguishable from the facts of this case as the Opponents there were 9 days late.

4. In the present case, I have taken into consideration the following material factors. The Applicants must have been aware of the Opponents' objections to the Application Mark. The Opponents have, in their letter of 11 October 2011 to the Applicants, informed the Applicants of their objection to the registration of the Application Mark. The Opponents demanded that the Applicants, amongst others, (i) withdraw the Application Mark in its entirety; (ii) immediately cease any and all use of the Application Mark; (iii) refrain from any and all future use and/or application for registration of the Application Mark; and (iv) execute a Deed of Undertaking confirming the items above. Further, the parties are involved in a series of oppositions in other jurisdictions as well. Opposition proceedings were commenced against the Applicants for identical marks and in relation to the same class in Hong Kong and United States in or about May and November 2011 respectively. In both instances, the Opponents had, prior to commencing the said oppositions, sent demand letters to the Applicants to seek voluntary withdrawal of the Applicants' trade mark applications. The dates of these letters were 4 March 2011 (Hong Kong) and 11 October 2011 (United States). Taking all of the above into consideration, the Applicants are well aware at all material times of the Opponents' objection to the Applicants' marks, including the Application Mark. Further, the delay is only 4 working days (unlike the *Nutrigen Case*) and the Opponents had filed TM 48 and sought the Applicants' consent concurrently immediately on 25 October 2011. Further, even if the extension of time is granted, it would still be within the maximum statutory deadline for the filing of the Notice of Opposition.

5. Having found no prejudice to the Applicants should the irregularity be corrected, it must be said that the Opponents' inadvertence in failing to file Form TM 48 by the deadline is inexcusable. A diligent reading of rule 29 will in any case make clear to opponents what they have to do, which is to either institute opposition proceedings or apply for an extension of time to do so.

6. In conclusion, the Registrar allows the late filing of Form TM 48 and grants the extension of time for the Opponents to file their Notice of Opposition by 19 December 2011. The Applicants are awarded costs of \$350 for the preparation of this interlocutory hearing and \$200 for attendance.

Legislation discussed:

Trade Marks Rules (Cap 332, 2008 Rev Ed), rule 29, rule 83

Cases referred to:

Asian Aisle Pte Ltd v Ricegrowers Co-operative Limited
Neutrigen Ptd Ltd v Neutrogena Corporation [2005] SGIPOS 7

Representation:

Ms Teresa O'Connor (Infinitus Law Corporation as instructed by Henry Goh (S) Pte Ltd) for the Applicants
Mr Andy Leck and Mr Ang Kai Hsiang (Wong & Leow LLC) for the Opponents