

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

Trade Mark Application No. T0905684D
6 July 2011

**APPLICATION TO ALLOW
LATE FORM FOR EXTENSION OF TIME TO OPPOSE
BY SINGAPORE PRESS HOLDINGS LIMITED**

AND

**OBJECTION THERETO
BY ALIBABA GROUP HOLDING LIMITED**

Principal Assistant Registrar See Tho Sok Yee
7 July 2011

Interlocutory hearing – application for extension of time to file Notice of Opposition – consent of Applicant given and request in writing to Registrar made before deadline – Form TM 48 filed 4 working days after deadline – whether late filing of Form TM 48 allowed.

The Applicants' trade mark application was accepted and advertised on 18 March 2011 for opposition purposes. The deadline to oppose or to request an extension of time to oppose fell on 18 May 2011. The prospective Opponents wrote to the Applicants on 18 May 2011 to seek their consent to an extension of time to oppose. On the same day, the prospective Opponents sought an extension of time from the Registrar by way of correspondence.

On 19 May 2011, the Applicants wrote to the prospective Opponents consenting to an extension of time to oppose. The prospective Opponents notified the Registrar of the Applicants' consent on 23 May 2011. The prospective Opponents then filed the formal form requesting an extension of time to oppose, Form TM 48, on 24 May 2011.

In view of the late filing of Form TM 48, 4 working days after the deadline of 18 May 2011, the Registrar wrote to the Applicants on 16 June 2011 enquiring whether they consent to the late filing of Form TM 48. The Applicants responded on 17 June 2011 that they object to an extension of time to oppose due to the prospective Opponents' failure to comply with the requirements of Rule 29(3) of the Trade Marks Rules.

The prospective Opponents submit that the Applicants had already consented to an extension of time on 19 May 2011. Hence, there is no prejudice to the Applicants if the extension of time is granted. Any inconvenience to the Applicants arising from the interlocutory hearing can be compensated for with a cost award. On the other

hand, not to allow the extension of time to oppose would mean a premature determination of the opposition proceedings to the prospective Opponents' and the public's prejudice. While there is public interest in ensuring certainty from compliance with rules, there is also public interest in ensuring that justice is done. The need to ensure proper adjudication based on the merits of the case outweighs the procedural irregularity that occurred. The defect is relatively minor and has been rectified quickly within 4 working days of the deadline. If the extension of time is granted, it will still be within the maximum statutory deadline allowed for the filing of the Notice of Opposition.

The Applicants submit that their consent on 19 May 2011 was given based on the legitimate expectation that the prospective Opponents would comply with the procedure of the Trade Marks Rules. Their awareness that the prospective Opponents intend to apply for an extension of time should not justify the Opponents' non-compliance with procedural requirements. There is a public interest in ensuring that trade mark applicants who rely on the Trade Marks Rules have the benefit of certainty that the rules provide. The Applicants are prejudiced as the delay in filing Form TM 48 led them to think that their trade mark application may not have been opposed. The prospective Opponents have also not provided good and sufficient reasons for the late filing of Form TM 48. Inadvertent oversight cannot constitute a good and sufficient reason. If the extension of time is not allowed, the prospective Opponents can still take out invalidation proceedings after the mark is registered. The public interest is still served by an invalidation hearing.

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 18 July 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 T0020051I and T0020052G (*Asian Aisle Pte Ltd v Ricegrowers Co-operative Limited*) following the High Court's decision in TM No. T9810300B. 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. Rule 83 is applicable in this case as the prospective Opponents' request for an extension of time via Form TM 48 was filed late, 4 working days after the deadline, thus breaching rule 29(3).

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 whether to exercise 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 claim to be prejudiced as the delay in filing Form TM 48 led them to think that their trade mark application may not have been opposed. They cite *Neutrogen Ptd Ltd v Neutrogena Corporation* [2005] SGIPOS 7 in support. However, that case is distinguishable as the prospective Opponents only sought the Applicants' consent and the extension of time after the deadline. The Principal Assistant Registrar there found that the Applicants are prejudiced as the delay in filing

the Notice of Opposition (and the subsequent late request for extension of time) would have led them to believe that their application would not be opposed.

4. The Applicants rely on another decision, *Tianjin Zhongxin Pharmaceutical Group Corporation Ltd and Anor v Lerentang Pharmaceutical Co Ltd* [2008] SGIPOS 16 ("*Tianjin Zhongxin Pharmaceutical*"), where, before the deadline, the prospective Opponents faxed a single page cover letter requesting an extension of time to file the Notice of Opposition, but Form TM 48 only arrived by post after the deadline. The Principal Assistant Registrar there refused the extension of time. However, the case is distinguishable as it was not satisfactorily shown that the Applicants' consent was ever sought or given.

5. In the present case, it is material that the prospective Opponents sought the Applicants' consent in time and that the Applicant consented to an extension of time for the Notice of Opposition to be filed. Further and significantly, the Applicants did not just know of the prospective Opponents' intention to seek an extension of time: the Applicants knew of the latter's actual request for an extension of time. This is because the prospective Opponents' letter of 18 May 2011 to the Registrar requesting an extension of time was copied to the Applicants. The Applicants' own written submissions also bear out this material fact.

6. Since the Applicants had consented to an extension of time upon knowledge of the prospective Opponents' written request to the Registrar seeking such extension of time, it is difficult to understand what the prejudice is if the Registrar should allow the late Form TM 48 to shortly follow the earlier written request which was supported by the Applicants' consent. In the Applicants' letter of 19 May 2011 consenting to the extension of time, the only condition was that of reciprocity. By then, the Applicants had already known of the prospective Opponents' written request to the Registrar for an extension of time (without Form TM 48) but did not object to the non-filing of Form TM 48. It was only upon receipt of the Registrar's letter of 16 June 2011 enquiring whether the Applicants consented to the late filing of Form TM 48 that this became an issue to the Applicants. The Applicants' submission that they are prejudiced as the delay in filing Form TM 48 would have led them to believe that their application would not be opposed is not tenable, as an actual written request had already been made by the prospective Opponents to the Registrar by the deadline and the Applicants knew of this when they gave their consent.

7. Having found no prejudice to the Applicants should the irregularity be corrected, it must be said that the prospective Opponents' inadvertence in failing to file Form TM 48 by the deadline is not condoned. As made clear in *Tianjin Zhongxin Pharmaceutical*, "compliance with the rules should be an entrenched practice by now, eight years after the amendments. A diligent reading of rule 29 will in any case make clear to prospective opponents what they have to do to either institute opposition proceedings or apply for an extension of time to do so." It is now eleven years after the relevant amendments to the trade marks rules and compliance is to be expected. Had the Applicants not given their consent upon knowledge that a written request for extension of time was made in time (without Form TM 48), the outcome of this matter would probably have been different. This decision therefore does not serve as a general precedent for future prospective opponents who fail to seek consent on time and/or fail to file their requests for extension of time via Form TM 48 on time. Every

decision turns on its facts and the Registrar will engage in a balancing exercise to determine how best to serve the interests of justice within the legislative framework.

7. In conclusion, the Registrar allows the late filing of Form TM 48 and grants the extension of time for the prospective Opponents to file their Notice of Opposition by 18 July 2011. The Applicants are awarded costs of \$350 for the preparation of this interlocutory hearing and \$150 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 (TM Nos. T0020051I and T0020052G) (31 July 2002)

Neutrigen Ptd Ltd v Neutrogena Corporation [2005] SGIPOS 7

Tianjin Zhongxin Pharmaceutical Group Corporation Ltd and Anor v Lerentang Pharmaceutical Co Ltd [2008] SGIPOS 16

Representation:

Ms Margaret Law (Margaret Law Corporation) for the Applicants

Mr Cheah Yew Kuin (Wong & Leow LLC) for the prospective Opponents