

Intellectual Property Office of Singapore Case Summary: Metrojaya Bhd. and Metrojaya Sendirian Berhad v. The East India Company Holdings Pte Ltd [2015] SGIPOS 16 (Interlocutory Hearing)

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This is the first time an interlocutory matter involving a late request for an extension of time to file a counter-statement has been decided in the context of revocation proceedings (as opposed to opposition proceedings).

The Applicants (*The East India Company Holdings Pte Ltd*) commenced revocation proceedings in respect of six of the Registered Proprietors' (*Metrojaya Bhd. and Metrojaya Sendirian Berhad*) trade marks, as these trade marks had been cited against the Applicants' own trade mark applications. However, the Registered Proprietors did not file a counter-statement nor a request for an extension of time to file their counter-statement in time. Instead, they wrote to the Registrar on 1 April 2015, 4 months and 9 days after the applications for revocation were filed, stating that they would file a formal request for an extension of time to file their counter-statements, and that they did not do so earlier arising from administrative exigencies due to: (a) staff movement, in particular, the resignation of [the Registered Proprietors'] Administrative Manager and Human Resources Executive and (b) office relocation, in particular, the relocation of [the Registered Proprietors'] corporate headquarters in Malaysia.

The Registrar held that whilst the consequences of failing to file a counter-statement (or an extension of time for the same) are more serious in revocation proceedings than in opposition proceedings, there is nothing in the wording of the legislation to suggest that a less stringent test should be adopted when considering whether to allow a late extension of time to file a counter-statement for revocation proceedings. Therefore, the application of the Trade Marks Rules will be construed in the same manner for both types of proceedings.

In the present case, administrative exigencies did not amount to "exceptional circumstances", sufficient for the Registrar to exercise his discretion to grant an extension of time. As the request for an extension of time was denied, the applications for revocation were consequently granted, pursuant to the application of Rule 58(10) of the Trade Marks Rules.

In coming to her decision, the Assistant Registrar also noted that there was an inordinately long period of delay before the Registered Proprietors sought an extension of time in the present proceedings (see [2]-[6] as to calculating the period of delay). There was also no previous communication with the Applicants before the late request for an extension of time was first mentioned in the 1 April 2015 letter. This led the Applicants to develop a reasonable expectation that their applications for revocation would be granted. The Assistant Registrar also briefly examined whether the Registered Proprietors had a reasonable defence in the revocation proceedings, and concluded based on the documents before her that this was not the case.

Disclaimer: The above is provided to assist in the understanding of the Registrar's grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at <https://www.ipos.gov.sg/resources/hearing-mediation>.