

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

Trade Mark No. 40201925529Y

**APPLICATION FOR EXTENSION OF TIME TO FILE COUNTER-STATEMENT  
BY FCA US LLC  
("APPLICANT")**

Principal Assistant Registrar See Tho Sok Yee  
Decision date: 17 July 2020

*Application for extension of time – application for extension of time to file counter-statement – extension of time under special circumstances*

**I. INTRODUCTION**

1. In the face of the global pandemic in 2020, a number of legislative amendments were enacted in Singapore. These address different pressing issues that arose in a time of severe business disruptions and constraints, among other concerns. In the realm of intellectual property law, such amendments included a new provision in the Trade Marks Rules (Cap 332, 2008 Rev Ed)<sup>1</sup>, in the form of Rule 77C as follows:

**Extension of time limits in special circumstances**

**77C.** –(1) Despite anything in these Rules, where the Registrar is of the opinion that there are –

- (a) circumstances beyond the control of a party concerned: or
- (b) other special circumstances,

the Registrar may, before the expiration of the period of time prescribed or allowed by or under these Rules for –

- (c) the giving, sending, filing or serving of any notice, application or other document; or
- (d) the doing of any act,

extend that period for one or more periods of time, and subject to conditions, as the Registrar thinks fit.

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<sup>1</sup> All references to "Rules" in this written decision are references to rules under the Trade Marks Rules.

(2) Paragraph (1) does not apply where the Act specifies the circumstances in which the period of time for any matter referred to in paragraph (1)(c) or (d) may be extended.

2. The new Rule 77C took effect on 5 June 2020, immediately after the period of excluded days declared by the Registrar in Practice Direction No. 2 of 2020<sup>2</sup>.
3. If the criteria under this Rule are met, the Registrar can unilaterally grant an extension to all pending deadlines without the need for applicants (or their agents) to file any extension of time forms. Special circumstances justifying the exercise of the Registrar's discretion may include national measures in Singapore (e.g. national "circuit breaker"<sup>3</sup>) deemed to affect the majority of applicants and other users of Registry services.
4. In situations where the majority of users are not affected, but where there are nevertheless some who are affected by circumstances beyond their control or other special circumstances, such users may request an extension of time by way of a written request under Rule 77C. Such requests will be assessed on a case-by-case basis and granted only under exceptional circumstances (e.g. an overseas applicant has been affected by a national emergency or measure in that foreign country (e.g., national movement control order) such that it is not able to take the required action by the expiry of the deadline).
5. An additional feature of Rule 77C is that if the criteria are met, a user might obtain an extension of time beyond the ordinary statutory limit prescribed in the Rules, because of the phrase "Despite anything in these Rules".

## II. EVENTS LEADING UP TO THE REGISTRAR'S DECISION

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<sup>2</sup> The Registrar declared excluded days in response to the national "circuit breaker" imposed from 7 April 2020 to 1 June 2020.

The national "circuit breaker" is described in the Ministry of Health's press release highlight dated 3 April 2020 at <https://www.moh.gov.sg/news-highlights/details/circuit-breaker-to-minimise-further-spread-of-covid-19> in its context as follows: "The Multi-Ministry Taskforce will be implementing an elevated set of safe distancing measures, as a circuit breaker to pre-empt the trend of increasing local transmission of COVID-19. The aim is to reduce much more significantly movements and interactions in public and private places. To do this, we will move towards full home-based learning for our schools and close most physical workplace premises, save for those providing essential services and in selected economic sectors which are critical for our local and global supply chains. Work and business activities that can be carried out via telecommuting from home should continue."

<sup>3</sup> See footnote 2 on what "circuit breaker" refers to.

6. In trade mark opposition proceedings, the opponent and the applicant file their pleadings in turn. After the opponent's notice of opposition is received by the applicant, the latter's counter-statement is due within two months. This deadline may be extended but the extended deadline shall not exceed four months after the applicant's receipt of the notice of opposition, see Rule 31(5) of the Trade Marks Rules.
7. The Applicant in this case originally faced a deadline of 20 May 2020 to file its counter-statement. This was extended to 20 July 2020, which is four months after its receipt of the notice of opposition. This is the maximum extension allowed under Rule 31(5).
8. On 2 July 2020, the Applicant, through its agent (Drew & Napier LLC<sup>4</sup>) wrote to the Registrar seeking an extension of time under Rule 77C due to special circumstances. It made the following representation:

Our client's office is located in New York, while the Applicant's office is located in Michigan. Both states are presently facing a rapidly changing situation in the face of the COVID-19 pandemic and both the client and our Applicant are facing much uncertainty at the moment regarding their work arrangements. The states and American Bar Association have also recommended employees work remotely as much as possible to contain the spread of the pandemic. Their present situations are therefore far from a state of normality.

As such, we would be grateful if the Registrar could grant a (*sic*) client a further extension of time to prepare the relevant materials and file the counter-statement for the subject opposition.

9. In response, the Registrar asked for more elaboration and more precise justification for an extension of time under Rule 77C. For example, particularization on why, despite the remote working arrangements, (under which, for example, email instructions are still possible), the Applicant is not able to file its counter-statement by 20 July 2020, would be useful. The Registrar also noted that the pending document is a counter-statement, not a statutory declaration, the latter of which would entail more challenging steps (e.g. notarization). The Applicant was also directed to state the period of extension sought. The Opponent was to let the Registrar have its representations, if any, after the Applicant's response.
10. D&N sought an extension of time to respond, and the crux of its response, eventually on 15 July 2020, is as follows:

We reiterate that due to the COVID-19 pandemic situation in the USA, both the client and the Applicant have both implemented remote working arrangements.

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<sup>4</sup> Drew & Napier LLC will be referred to as "D&N" for short in this written decision.

There has been much difficulty on both ends in terms of obtaining instructions and collating and providing the relevant information to proceed.

In light of the above, we would be grateful if the Registrar could grant the client a further extension of time to gather the relevant information and instructions for purpose (*sic*) of filing the counter-statement for the subject opposition.

11. In a second letter on the same date, D&N indicated the period of extension sought, namely 2 weeks i.e. the extended deadline, if granted, would fall on 3 August 2020.
12. The Opponent wrote to the Registrar on 17 July 2020 to state that it did not object to the Applicant's request for an extension of time up to 3 August 2020, on the condition of reciprocity.
13. On the same day, I granted the Applicant an extension of time under Rule 77C to file its counter-statement by 3 August 2020. As this is the first time that the Registrar has received and granted a request for a special extension of time under Rule 77C in *inter partes* proceedings, the general considerations, and my specific considerations in this case, are explained below.

### III. CONSIDERATIONS

14. As set out in the introduction, Rule 77C was enacted in the throes of a global pandemic. The Prime Minister of Singapore has referred to the economic and social fallout as “the crisis of a generation”<sup>5</sup>.
15. It is clear from both the genesis and language of Rule 77C itself that the provision is not intended to be used under ordinary circumstances. In the preponderant majority of cases, the user who needs an extension of time will request one through an official form (such as Form HC3), and the request will be dealt with in the ordinary course of business.
16. In deciding whether the Registrar should exercise discretion under Rule 77C, some factors to consider in *inter partes* proceedings include:
  - a. The “circumstances beyond the control of a party concerned; or other special circumstances”

Usually, the applicant for the extension of time is expected to explain how these circumstances have affected its ability to take the required action before the end of the current deadline.

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<sup>5</sup> Refer to Prime Minister Lee Hsien Loong's address to the nation on 7 June 2020.

b. Duration of extension requested

The duration of extension requested should make sense in light of a. above.

It is also generally easier to obtain an extension that is shorter rather than longer, but again, this depends on the causal connection with the special circumstances relied on by the applicant for extension. A longer extension may still be granted if the special circumstances justify it.

c. Impact on others

The extent of prejudice to other parties in the proceedings would be considered. If the counter-party does not object to the extension, this would be a factor in favour of the applicant for an extension of time.

d. Whether it is open to an applicant to request an extension the usual way without an applicable fee

If the applicant is able to request an extension of time the usual way *without* an applicable fee, e.g. by filing Form TM48 to request an extension of time to file a notice of opposition or by filing Form HC3 to request an extension of time to file a counter-statement – both of which are free of charge – it is expected to exhaust these options before requesting the Registrar to exercise discretion in its favour under Rule 77C.

However, the converse situation does not apply. The above does not mean that if it is open to the applicant to seek an extension the usual way *with* a fee, its request under Rule 77C will be granted because the latter would entail cost savings for the applicant. Under normal circumstances, an applicant for extension would not be allowed to circumvent the need to pay an official extension fee by seeking an extension of time under Rule 77C instead.

17. In the present case, the following considerations had a bearing on my decision to grant the extension of time:

a. The “circumstances beyond the control of a party concerned; or other special circumstances”

D&N faced difficulty communicating with the Applicant, who was unresponsive. I took into consideration the state of affairs represented by D&N at [8] and [10] above. Further, from our own checks, the Applicant’s home state in the USA, namely Michigan, was under a state of emergency.

b. Duration of extension requested

The duration of extension requested was 2 weeks. This is reasonable in the special circumstances.

c. Impact on others

The Opponent represented that it did not object to the 2-week extension sought by the Applicant.

d. Whether it is open to an applicant to request an extension the usual way without an applicable fee

The Applicant had already obtained an earlier extension of time to file its counter-statement and it was facing its final deadline to do so. There is no other recourse to preserve its position temporarily.

## V. CONCLUDING COMMENTS

18. There are some practical pointers for parties in *inter partes* proceedings to take note of before submitting a request under Rule 77C:

a. Submit the request as early as possible

This is especially important in *inter partes* proceedings because the counter-party should be given the opportunity to make representations in response.

b. Particularise and explain as much as possible

The applicant should clearly highlight to the Registrar the causal connection between the special circumstances and its inability to take the required action before the end of the current deadline. Relevant particularisation and explanation go a long way in persuading the Registrar why discretion should be exercised in an applicant's favour.

c. Provide supporting documents if possible

This is especially important if the circumstances relied on by an applicant cannot be readily counter-checked on the internet.

19. This is the first time that the Registrar has received and granted a request for a special extension of time under Rule 77C in *inter partes* proceedings. The considerations in reviewing such a request for extension of time are not exhaustive nor limiting on the

Registrar's future exercise of discretion; and may be varied or added to in future. Nonetheless, the rarity and uniqueness of obtaining an extension of time by application under Rule 77C is underscored.

**Legislation referred to:**

Rules 31, 77C of the Trade Marks Rules (Cap 332, 2008 Rev Ed)

**Representation:**

Drew & Napier LLC for the Applicant in the opposition  
hslegal LLP for the Opponent in the opposition