

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

Trade Mark Application No. T0913773I
1 April 2021

**APPLICATION FOR EXTENSION OF TIME
TO FILE EVIDENCE
IN A TRADE MARK REVOCATION
BY SYMPHONY HOLDINGS LIMITED**

AND

**OBJECTION THERETO
BY SKINS IP LIMITED**

Principal Assistant Registrar Sandy Widjaja
28 May 2021

Interlocutory hearing – application to file a late request for an extension of time to file evidence – objection by the applicant for revocation / respondent – whether the irregularity can be corrected under Rule 83 of the Trade Marks Rules (Cap. 332, 2008 Rev. Ed.) (Rules)¹

Background

- (i) The main proceeding to which this interlocutory decision relates is the application for revocation (“**Revocation**”) of Trade Mark No. T0913773I:



in Classes 10, 18, 25 and 28 (“**Registered Mark**”).

Skins IP Limited (the applicant for Revocation / respondent, hereafter “**Applicant**”) sought to revoke the **Registered Mark** on 26 August 2019.

¹ All references to Rules are to *Trade Marks Rules (Cap. 332, 2008 Rev. Ed.)*.

Evidence and written submissions

- (ii) Parties submitted the following documents:
- (a) **Registered Proprietor's** written submissions ("**RWS**");
 - (b) **Registered Proprietor's** evidence, which comprises of a statutory declaration made by Ms Michelle Gai Gorton, the principal of the legal practice, BMGNY Pty Ltd trading as Gorton IP, for and on behalf of the **Registered Proprietor**, dated 18 March 2021 ("**Registered Proprietor's SD**");
 - (c) **Applicant's** written submissions ("**AWS**"); and
 - (d) **Registered Proprietor's** letter of 31 March 2021 and **Applicant's** letter of 8 April 2021.²

Brief Facts

- (iii) On 28 February 2020, at a Case Management Conference, the Registrar issued deadlines concerning when parties are to file their respective evidence in the form of statutory declarations:³

| Stage | Specified Period | Maximum Estimated Date |
|-----------------------------------|------------------|------------------------|
| <i>Applicant's SD</i> | 2 months | 28 April 2020 |
| <i>Registered Proprietor's SD</i> | 2 months | June 2020 |
| <i>Applicant's SD in Reply</i> | 2 months | August 2020 |
| Pre-Hearing Review | 1 month | September 2020 |
| Full Hearing | Approx. 3 months | December 2020 |

After four requests for extensions of time,⁴ the **Applicant** filed its evidence on 10 December 2020.⁵ Accordingly, the deadline for the **Registered Proprietor** to file its evidence was 10 February 2021 ("**Deadline**").⁶

- (iv) On 15 February 2021, the **Applicant's** agent wrote to the Registry to enquire if the **Registered Proprietor** had filed a statutory declaration in reply.⁷ On 16 February 2021 i.e. **4 working days** after the expiration of the **Deadline**, the **Registered Proprietor** filed a late request for an extension of time.⁸ On the same day, the

² These were filed following the **Applicant's** notification on 30 March 2021 that it will not be attending the hearing.

³ **Registered Proprietor's SD** at [9].

⁴ **Registered Proprietor's SD** at [11].

⁵ **Registered Proprietor's SD** at [12].

⁶ **Registered Proprietor's SD** at [13].

⁷ See **RWS** at Annex A.

⁸ See **RWS** at Annex B.

Applicant's agent wrote to the Registry to state the *Applicant's* objections to the late request.⁹

- (v) Given the *Applicant's* objections, the Registrar informed the parties, via correspondence dated 17 February 2021, that she was “not inclined to allow the late filing of the *Registered Proprietor's* request for an extension of time”.¹⁰
- (vi) The *Registered Proprietor* then filed two letters in response, one dated 18 February 2021 and the other 22 February 2021.¹¹ In light of this development, the Registrar then indicated, via a letter dated 24 February 2021, that she was inclined to grant the late request in light of the *further* representations (more below) made by the *Registered Proprietor*.¹² However, the *Applicant* maintained its objection via its letter dated 25 February 2021 and requested for an interlocutory hearing.¹³
- (vii) The interlocutory hearing on 1 April 2021 was via written submissions only as both agents subsequently informed that they would not be attending the hearing.¹⁴

Issue and relevant provision

- (viii) The issue for determination in this interlocutory decision is whether the *Registered Proprietor's* late application for an extension of time to file its evidence can be allowed. The applicable provision is Rule 83:

83. 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.

[Emphasis in italics and bold mine]

Held, allowing the late request for an extension of time to file the *Registered Proprietor's* evidence:

- 1. The term “irregularity in procedure” in Rule 83 includes matters in respect of time.¹⁵ The relevant factors for consideration include:¹⁶
 - (i) the length of the delay;
 - (ii) the reasons for the delay;

⁹ See *RWS* at Annex C.

¹⁰ See *RWS* at Annex D.

¹¹ See *RWS* at Annex E.

¹² See *RWS* at Annex F.

¹³ See *RWS* at Annex G.

¹⁴ *Registered Proprietor's* letter of 31 March 2021 and *Applicant's* letter of 30 March 2021 (see also footnote 2 above).

¹⁵ See *Application for Extension Of Time To File Evidence in a Trade Mark Opposition by BEABA and Objection Thereto by Biba (Zhejiang) Nursing Products Co., Ltd [2021] SGIPOS 1 (“Beaba”)* (*RWS* at [20]).

¹⁶ *Beaba* at [1] citing the applicable cases on this issue.

- (iii) the overall conduct of the applicant for an extension of time;
 - (iv) the stage of the proceedings;
 - (v) the degree of prejudice/detriment to the respondent if the application is granted;
 - (vi) whether there are exceptional circumstances; and
 - (vii) the public interests of certainty and transparency versus the need to adjudicate based on the merits of the case in the interest of justice between the parties.
2. Applying the above to this case:
- (i) the delay was 4 working days;¹⁷
 - (ii) there was a lapse on the part of the **Registered Proprietor as a result of COVID-19** (more below);
 - (iii) the late request for the extension of time was filed on 16 February 2021¹⁸ and this was **before** IPOS issued its notification for a Pre-Hearing Review (“**PHR**”).¹⁹ Further, the evidence for **Revocation** is now ready to be filed;²⁰
 - (iv) the prejudice to the **Applicant** can be compensated by costs. In this regard, the **Applicant** would have been **well aware** of the **Registered Proprietor’s** objections in view of the parties’ involvement in other proceedings.²¹

In addition, I also note that, as mentioned at paragraph (iii) under *Brief Facts* (above), the **Applicant** had itself previously been granted **four** extensions of time.

3. The **Applicant** resisted the late request for an extension of time as “there is no ‘exceptional circumstance’, or ‘good and sufficient reason’ to justify the late extension request”.²² In that regard, the Applicant submitted:²³

[13]...It could have been the case that the Registrant’s counsel was not even aware of its oversight and were only **alerted** to it after receiving the Applicant’s letter of 15 February 2021.

[14]...the late extension request was obviously made on **hindsight**, and there was simply an oversight or mistake on the part of the Registrant’s Singapore and/or Australian solicitors. Even if we were to assume Ms Gorton was so preoccupied with taking care of her family members and was in no position to provide timely instructions to the Singapore solicitors, **it does not explain why no one else in her firm could not have handled the work and made sure the**

¹⁷ **RWS** at [29(a)].

¹⁸ **Annex B** of **RWS**.

¹⁹ **RWS** at [29(b)(ii)].

²⁰ See **Registered Proprietor’s** letter of 31 March 2021, referred to above.

²¹ **RWS** at [33(j)].

²² **AWS** at [16].

²³ **AWS** [13] – [15].

deadlines were timely dealt with. The monitoring and management of deadlines are part and parcel of everyday work of IP firms.

[15] ...no explanation has been forthcoming as to why the Registrant's Singapore solicitors failed to timely file the extension of time request to preserve the Registrant's rights. They *would have been aware* if the Registrant intended to file its SD in Reply and if it were indeed in the process of collating evidence for that purpose in the weeks leading up to the deadline. It would have been evident to the Registrant's Singapore solicitors, even if Gorton IP were indeed completely non-functioning during the relevant time, that it was necessary to *preserve* the Registrant's rights by applying to extend the deadline.

[Emphasis in italics and in bold mine]

4. For the avoidance of doubt, as I indicated in the case of *Application for Extension Of Time To File Evidence in a Trade Mark Opposition by BEABA and Objection Thereto by Biba (Zhejiang) Nursing Products Co., Ltd [2021] SGIPOS 1 ("Beaba")*:²⁴

[8]...the presence of COVID-19, while difficult and unprecedented, is *not* a licence to be careless about deadlines. Nonetheless, it is not disputed that these are unusual times, and as such, mistakes which occur during this period should be viewed with some degree of compassion.

[Emphasis in the original]

5. In fact, until today, COVID-19 *was, has been and is*, still in the backdrop and its nature has *not yet been fully grasped*. It continues to cause many deaths and disruptions globally. Any allegation of an oversight in the monitoring and management of deadlines²⁵ must be seen in this light.
6. In this case, the deadline was 10 February 2021.²⁶
7. The *Registered Proprietor's* instructing firm's principal's ("*Ms Gorton*") son exhibited COVID-19 symptoms on 8 February 2021.²⁷ The situation was exacerbated by the fact that the young lad was considered to be in a *high risk* category due to his history of respiratory illnesses.²⁸ To add to *Ms Gorton's* woes, around the same time, her husband exhibited cold symptoms as well.²⁹ *Both* son and

²⁴ At [8].

²⁵ *AWS* at [14].

²⁶ Above at (iii) of *Brief Facts*.

²⁷ *Registered Proprietor's SD* at [16(a)].

²⁸ *Registered Proprietor's SD* at [16(a)].

²⁹ *Registered Proprietor's SD* at [16(c)].

father had to *be tested for COVID-19* on 11 February 2021 and the results were only received the next day on 12 February 2021.³⁰

8. *Ms Gorton* deposed that her son's and husband's conditions only improved on the weekend of 13 and 14 February 2021. It was only then when she had the peace of mind to catch up on her work. Due to the backlog of matters, it only came to her attention that the deadline had passed on 15 February 2021 upon which she immediately asked the *Registered Proprietor's* agent in Singapore³¹ to file for an extension of time.³² In this regard, *Ms Gorton* deposed that this was before she was updated on the *Applicant's* letter.³³
9. In light of the above, it seems to me that *but for* the intervening event of her family members, in particular, her son, exhibiting COVID-19 symptoms *two working days* before the deadline, *Ms Gorton* and in turn, the *Registered Proprietor*, would have been able to provide the relevant instructions in time to file a request for an extension of time *before* the expiry of the deadline.
10. In general, a request for an extension of time must be made *before* the expiry of the deadline. Parties must make arrangements to ensure that deadlines are met. The Registrar does not make any judgment as to the appropriateness of the arrangement between, in this case, the instructing solicitors and the *Registered Proprietor's* Singapore agent.³⁴ However, if parties only provide for a short buffer to review impending deadlines, then they will have to accept the risk that there may not be enough time to rectify matters in a timely manner if an unpredicted event (such as what happened in this case) occurs.
11. In this instance, the lapse could well have been averted had it not been for COVID-19 in the backdrop. As I mentioned in the case of *Beaba*, “[i]f COVID-19 does not qualify as an ‘exceptional circumstance’ which *contributed* to the [*Registered Proprietor's*] lapse here it is hard to imagine what other events would so qualify.”³⁵
12. On the other hand, any prejudice suffered by the *Applicant* is one which can be compensated by costs. As submitted by the *Applicant* itself, the prejudice it has suffered is “[t]he Applicant had an expectation that if the Registrant did not file an SD in Reply, the proceeding would progress to the next step of a Pre-Hearing Review”.³⁶ However, this must be assessed in light of the fact that:
 - (i) the late request was made *before* IPOS issued its notification in relation to the *PHR*; and

³⁰ *Registered Proprietor's SD* at [16(d)].

³¹ *Quahe Woo & Palmer LLC*, see below.

³² *Registered Proprietor's SD* at [18].

³³ *Registered Proprietor's SD* at [18].

³⁴ Below.

³⁵ *Beaba* at [20].

³⁶ *AWS* at [20].

- (ii) both parties would be *well aware* of the ongoing dispute between them having regard to:
 - (a) the ongoing multi-jurisdictional disputes;³⁷
 - (b) the *Applicant* having questioned the efficacy of the *Registered Proprietor's* evidence filed with the counter-statement.³⁸
- 13. As to whether the late request for an extension of time was filed as a result of the *Applicant's* letter, I accept *Ms Gorton's* evidence that she gave instructions to request for a late request for an extension of time *before* she was made aware of the *Applicant's* letter.³⁹
- 14. Last but certainly not least, while it is open to the *Registered Proprietor* to request for leave to file further evidence under Rule 35,⁴⁰ it will be more efficient, in terms of time and costs, to allow for the late request for an extension of time here. In fact, as mentioned above, the evidence for the *Revocation* is now ready to be filed.⁴¹
- 15. Accordingly, the late request for an extension of time (Form HC3) filed on 16 February 2021 is granted and the *Registered Proprietor* is directed to file its evidence within *one week* from the date of this decision, that is, on or before 4 June 2021.

Costs

- 16. As alluded to above, by providing for only a short buffer to review impending deadlines, the *Registered Proprietor* would have to accept the risk that there may not be enough time to rectify the matters in a timely manner. In this case, the risk eventuated in the form of a late request for an extension of time.
- 17. On the other hand, the *Applicant* has rigorously pursued an interlocutory hearing⁴² (albeit via written submissions only) despite the Registrar's inclination to grant the late request for an extension of time in light of the extenuating circumstances considered above.⁴³
- 18. The Applicant's main complaint was that like cases should be treated alike (on the basis of *Beaba*, where the Applicant's agent acted for one of the parties).⁴⁴

³⁷ *RWS* at [33(j)]. See also tab 3 of the *Registered Proprietor's SD*, in particular, the *Applicant's* letter of 21 Oct 2020.

³⁸ *RWS* at [33(i)].

³⁹ *Registered Proprietor's SD* at [18].

⁴⁰ *RWS* at [24].

⁴¹ *Registered Proprietor's* letter of 31 March 2021, referred to above.

⁴² In this regard, it is difficult to issue a full grounds of decision without having any written submissions / evidence provided by parties (see Annex G of *RWS* at [12] and [13]).

⁴³ *Annex F* of *RWS*.

⁴⁴ *Annex G* of *RWS*.

19. It is not disputed that like cases should be treated alike. However, this should be applied in a sensible manner. In this case, an application of the principle that “like cases should be treated alike” in all likelihood influenced the Registrar to indicate her inclination to allow the late request for the extension of time in light of the additional reasons provided, as set out above.⁴⁵
20. The *Beaba* case was the *first* case which involved a lapse occurring against the backdrop of COVID-19.⁴⁶ Such a scenario clearly necessitated a full interlocutory hearing to enable the matter to be properly considered. But this is not so in the instant case. The current matter could well have been resolved, having regard to the principles expounded in the *Beaba* case, without having to convene this interlocutory hearing.
21. It is to be recalled that IPOS is a low cost tribunal. In managing cases before her, the Registrar takes into consideration, as far as possible, the impact of procedural directions and orders on the resultant time and costs to be expended by parties.
22. As submitted by the *Registered Proprietor*, the Registrar has a discretion to provide an inclination *without* having to conduct a hearing under Rule 34 read with Rule 59.⁴⁷ As alluded above, the *Applicant* vigorously pursued an interlocutory hearing (albeit via written submissions only) despite the Registrar’s inclination to grant the extension of time sought.⁴⁸ At the same time, it is not disputed that the *Registered Proprietor* had not sought an extension of time *prior* to the expiry of the deadline.
23. Taking into account all the circumstances, *parties are to bear their own costs* for this interlocutory hearing.

Legislation discussed:

Trade Marks Rules (2009) Rule 34, Rule 35, Rule 59 and Rule 83

Cases referred to:

Application for Extension Of Time To File Evidence in a Trade Mark Opposition by BEABA and Objection Thereto by Biba (Zhejiang) Nursing Products Co., Ltd [2021] SGIPOS 1

Application for Extension of Time to File Counter-Statement by FCA US LLC [2020] SGIPOS 7

⁴⁵ *RWS* at [16] and *Annex F* of *RWS*.

⁴⁶ This is in contrast to *Application for Extension of Time to File Counter-Statement by FCA US LLC [2020] SGIPOS 7* which pertains to Rule 77C. An application under Rule 77C must be made *before* the expiry of the deadline.

⁴⁷ *RWS* at [25].

⁴⁸ *Annex G* of *RWS*.

Representation:

Mr. Martin Eddie Butler (Quahe Woo & Palmer LLC) for the *Registered Proprietor* (via written submissions only)

Ms. Francine Tan (Francine Tan Law Corporation) for the *Applicant* (via written submissions only)