

BL O/1161/24

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTERS OF THE CONSOLIDATED OPPOSITION NO. OP 432 939 AND CANCELLATION
ACTIONS NOS. CA 506 754 AND CA 506 759

BETWEEN

STOKELEY-VAN CAMP, INC.

AND

KREMEZZAT GMBH

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF N RHEA MORRIS DATED 10 JUNE 2024.

DECISION

Introduction

1. When an applicant for an extension of a deadline requests reconsideration at a hearing of a preliminary view, is the hearing officer limited to considering the material that was before the IPO when forming its preliminary view, or can she consider all the relevant material presented at the hearing? That is the question raised in this appeal of a procedural decision made in the course of Consolidated Opposition Proceedings No. OP 432 939 and Cancellation Actions Nos. CA 506 754 and CA 506 759. The parties are Stokeley-Van Camp, Inc. ("**Appellant**") and Kremezzat GmbH ("**Respondent**").
2. On 26 April 2022, the Appellant filed the Opposition based upon ss. 5(2)(b), 5(3) and 5(4)(a). There was a cooling-off period from 21 July 2022 until 27 November 2023. On 5 December 2023, the Respondent filed the two non-use Cancellation actions.
3. On 7 December, the IPO stayed the Opposition action pending the filing of the TM8s in the non-use actions. On 7 March 2024, the Opposition action and the two defended non-use Cancellation actions were consolidated, and a deadline of 7 May was set for the Appellant to file its evidence.
4. On 1 May 2024, the Appellant filed a TM9 seeking a prospective one-month extension of time until 7 June 2024. At part 7, the reasons were stated as comprising:

"The Opponent and Registered Proprietor in these consolidated proceedings has drafted a well advanced witness statement supporting their claim to reputation and goodwill and to defend the two non-use cancellation actions filed by the Applicant. However there are some final changes that are required. The collation of evidence has been co-ordinated through a global team effort and this is time consuming. The non-use cancellation actions pose a serious threat to the Opponent's business as the marks are in use in the UK and are an integral part of their commercial activities. We request a further one month to robustly

defend the Opponent and Registered Proprietor's position by finalising the witness statement and having this signed off by the global team."

5. On 3 May 2024, the IPO indicated as a preliminary view that an extension of time would only be granted until 21 May 2024. A deadline of 17 May 2024 was set to request a hearing about this preliminary view, which the Appellant duly requested on the same date. On 23 May 2024, a CMC was scheduled for 7 June 2024.
6. The Appellant's evidence was filed on 4 June 2024. Although the CMC was initially vacated, it was reinstated and heard on 7 June 2024. Following the hearing, the Hearing Officer refused permission by way of letter dated 10 June 2024 ("**Decision**").
7. On 26 July 2024 the Appellant filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.

The Hearing Officer's decision

8. The Hearing Officer's Decision stated (bold in original):

"The essence of Ms Reid's submission was that the 2-week extension period granted was very short given that the two consolidated revocation actions involve periods of alleged non-use spanning over 10 years. Ms Reid further submitted that it was anticipated that observing the extended deadline of 17 May 2024 would be difficult due to her attendance at the International Trademark Association Conference in Atlanta.

Mr Taylor submitted that the particular reasons provided by SVC in the hearing were not reflected in its original request for an extension of time filed by way of Form TM9 on 1 May 2024. On the matter of the breadth of the period of SVC's alleged non-use, Mr Taylor submitted that if SVC were able to file evidence supporting use within the most recent relevant period, then that would suffice, and it would not be necessary to file evidence to cover the entire 10 years or so.

I remind myself that my discretion is limited to the narrow issue of whether, in the light of the information available **at the time that the Form TM9 was filed**, the Registry was justified in issuing the preliminary view to refuse the request for a further one-month period in favour of a shorter period of two weeks. In exercising my discretion, I must therefore be careful not to be swayed by reasons which were not provided at the time of filing of the Form TM9.

I note that the justification provided by SVC in its request of 1 May 2024 was that, although a well-advanced Witness Statement had been drafted, final changes were necessary, and that collation of the evidence had been time-consuming. It was stated that a further one month was needed to enable SVC to robustly defend its position. I note that there was no mention of attendance at the aforementioned conference within the Form TM9. I also bear in mind that evidence deadlines are intended to be observed and that, as per the Tribunal Practice Notice (2/2011), it is only in **exceptional circumstances** that extensions of time will be granted.

In the light of the foregoing, my view is that SVC did not, at the time of filing Form TM9, provide sufficient justification for the Registry to grant a further full month in which to file its evidence. I am satisfied that the further 2-week period granted was, on the basis of the information provided by SVC on 1 May 2024, sufficient, if not generous. It would

not be appropriate for me to make a concession regarding attendance at the aforementioned conference, because that is a circumstance that SVC would have been able to raise at the time that it filed its Form TM9.

I therefore confirm that the preliminary view given by the Registry on 17 May 2024 stands, and direct that the evidence subsequently filed by SVC on 4 June 2024 will not be admitted into the proceedings”.

Grounds of Appeal

9. The Appellant’s contends that the Hearing Officer exercised her discretion in refusing to grant a one-month extension of time on a false basis, namely that:
 - a. **Ground 1:** She failed to appreciate her role was not simply to review the preliminary view taken by the IPO in its letter of 3 May 2024, but was to conduct a hearing *de novo* on the issue, and as such she was not limited to considering the material that had been before the IPO when it formed its preliminary view, rather she could and should have considered all the relevant material that bore upon the matter (for example, the Appellant’s solicitor’s attendance at INTA’s conference, which was held between 18-22 May 2024);
 - b. **Ground 2:** She failed to appreciate that her discretion to grant the extension of time was not limited to “exceptional cases”, as that purported limitation has no basis in statute or binding jurisprudence, rather it was her duty to consider all relevant matters;
 - c. **Ground 3:** She failed to provide any justification for implicitly concluding that the unchallenged evidence of the Applicant that it required one month in which to perfect its evidence was not a credible and reasonable estimate of the time required, especially given the fact that (i) the Appellant’s evidence was in fact served on 4 June 2024; and (ii) she had no basis for concluding that two weeks would be sufficient;
 - d. **Ground 4:** She failed to give any, or any proper, weight to (i) the way in which the Respondent had pleaded its case, and as a consequence what were the evidential burdens placed upon the Applicant that were outside of its control; and, (ii) what was the most proportionate and efficacious way in which to resolve the various disputes between the parties; and
 - e. **Ground 5:** She failed to take into account the consequences of her refusal to extend time in which to permit the Appellant’s evidence to be filed, in particular (i) the likelihood of other proceedings being commenced; (ii) the unjustified loss of property rights of the Appellant, which would be inequitable; (iii) the consequential unjustified windfall benefit to the Respondent; and (iv) the complete lack of any prejudice that the Respondent would suffer if the requested extension of time were granted.
10. The Appellant’s Counsel, Mr Edenborough KC, expanded upon the above in his skeleton argument and at the hearing, and I set out below further details as are necessary to understand my overall conclusions. The Respondent filed a Respondent’s Notice and skeleton argument and its trade mark attorney, Mr Taylor, expanded on those arguments in the hearing. I am grateful to both advocates for their clear and detailed written and oral submissions, which I found very helpful.

Standard of review

11. The approach to be adopted in an appeal hearing has been laid down a number of times in case law. It was summarised in *Axogen v Aviv* [2022] EWHC 95 (Ch) at §24-25:

“Appellate Function

24. Although I was referred to numerous cases on the subject (including *English v Emery Demibold & Struck Ltd* [2002] 1 WLR 2409, *REEF Trade Mark* [2003] RPC 5, *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5, *Shanks v Unilever Plc* [2014] RPC 29, *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17, *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch), *Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 and *NINEPLUS O/039/21*), the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:

- i) The appeal is by way of a review, not a rehearing (see *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [52(i)]);
- ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference (*NINEPLUS O/039/21* at [14]);
- iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible" (*Actavis Group* at [81]);
- iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question (*REEF Trade Mark* [2003] RPC per at [26]). There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision" (*TT Education* at [52(ii)]), with decisions of primary fact at one end of the spectrum and multi-factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.
- v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education* at [52(iv)], *REEF* at [28] and *Fine & Country* at [50]-[51]).
- vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible (*Actavis Group* at [80]).
- vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal" (*REEF* at [26], *Actavis Group* at [78]). Expert tribunals

are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts (*Shanks* at [28] citing the warning given by Baroness Hale in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49).

- viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden" (see *REEF* at [29]). The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted (*English* at [17], *Fage* at [115]). The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained (*English* at [19]).
- ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account (*TT Education* at [52(vi)]).

12. I shall bear all the above in mind when reviewing the Decision.

Discussion

(1) Failure to take further evidence and arguments into account

- 13. The Appellant contends as follows. The Hearing Officer had an unfettered discretion that ought to have considered all the relevant factors, not just those raised in the Form TM9. At the CMC, the Hearing Officer wrongly approached the matter as if she were reviewing the preliminary decision in an appellate capacity. That is wrong as a matter of principle, as the Hearing Officer has no appellate jurisdiction. Rather, the preliminary view is just that - a view formed on the then current, but commonly, incomplete evidence and submissions. When it comes to making a decision on the request, the Hearing Officer is considering the matter fully for the first time. It is not even a re-hearing (and even less so, a review) - rather it is the first, proper, full hearing of the matter. There is nothing narrow about what should have happened at the CMC. That failure to appreciate her proper role in making the Decision fatally undermines the cogency of the Decision.
- 14. Rule 77(1) of the Trade Marks Rules 2008 ("**2008 Rules**") states:

"Subject to paragraphs (4) and (5), the registrar may, at the request of the person or party concerned or at the registrar's own initiative extend a time or period prescribed by these Rules or a time or period specified by the registrar for doing any act and any extension under this paragraph shall be made subject to such conditions as the registrar may direct".
- 15. It is common ground that paragraphs (4) and (5) are not engaged on the facts in this appeal.
- 16. The 2008 Rules are silent as to the interaction between a preliminary view and a subsequent hearing. However, Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person in *Style Holdings* O/464/01, said:

“The offer of a hearing at which to consider the matter appears to have been treated as the offer of an opportunity for the opponent to do orally what it had failed to do in writing: provide detailed and compelling reasons for the extension of time it required.

By not simply confining the hearing to the question whether the reasons put forward in writing on 2nd March 2000 were adequate as a basis for the exercise of discretion in the opponent's favour, the hearing officer effectively allowed the opponent to renew its request orally on 1st June 2000 (one day less than three months after the expiry of the extension of time granted in December 1999) and to do so on the basis of facts and matters which had not previously been brought to the attention of the Registrar or the applicant.

Since the point does not appear to have been raised before the hearing officer, I propose to leave on one side the question whether the reasons put forward on 2nd March 2000 were so perfunctory that significant expansion or clarification of them must inevitably have amounted to the making of a substantive request after the expiry of the previously granted extension of time.

I take the view that if it was appropriate to allow the opponent to expand and clarify the written reasons for its request, it was no less appropriate to require it to reduce the intended expansion and clarification to a true and accurate statement in writing.

I think it is regrettable that the Registrar did not insist that if the opponent intended to offer an amplified explanation with regard to the preparation of the evidence and the reasons for the delay in filing it, it should do so in writing in advance of the hearing so that the request for an extension of time could be fully and effectively considered against the background of a properly stated case”.

17. Mr Edenborough KC (who co-incidentally was involved in *Style Holdings* as Counsel) contends that *Style Holdings* is no longer good law, because the Trade Mark Rules then in force have been changed. Whereas I acknowledge that factor, I cannot see that anything in the 2008 Rules overrides the principle espoused by Mr Hobbs QC. In my view, the principle that *Style Holdings* establishes – that any expansion and/or clarification of the written reasons for a request for an extension should be reduced to writing – remains equally applicable to matters proceeding under the 2008 Rules.
18. It is therefore clear that, whereas the Hearing Officer is not limited to consideration only of the materials set forth in the Form TM9, any further materials relating to the initial request which are not contained in the TM9 should be reduced to writing by the applicant prior to the hearing. I note that that requirement is reflected in the Trade Marks Manual, which states:

“On receipt of a properly filed TM9 the Tribunal will make a preliminary decision on its grant or refusal and notify the parties accordingly, in writing. A period of fourteen days from the date of the letter will be allowed for either party to the proceedings to provide full written arguments against the decision and to request a hearing. If no such response is received within the time allowed, the decision will automatically be confirmed”.
19. Whereas neither the Trade Marks Manual nor *Style Holdings* have any force as a strict rule of law, they both constitute guidance, which should be followed save perhaps in exceptional circumstances. In my view, the guidance is there for a very sound reason – to ensure that the parties at a hearing are not taken by surprise by anything raised at the hearing.

20. No further written materials were filed by the Appellant prior to the hearing, and therefore *prima facie* the Hearing Officer was within her rights to decide not to take into account the further oral information imparted at the hearing.
21. However, in the subsequent case of *Ministry of Sound* O/136/03, Geoffrey Hobbs QC said:
- "I think that in this part of his decision the hearing officer may have been reading more into my observations in Style Holdings PLC's Application than I intended to be the case. As I have already indicated, the concerns I had in mind when giving my decision in Style Holdings PLC's Application were that applicants should not proceed to a hearing without having previously foreshadowed in writing the reasons for their request for an extension of time and that an application which is not actually based on reasons intimated in a Form TM9 filed before expiry of the relevant time limit is liable to be regarded as an application under rule 68(5) for an extension out of time".*
22. Rule 68(5) of the Trade Mark Rules 2000 laid down additional criteria for extensions out of time over applications made in-time, namely *"Where the request for extension is made after the time or period has expired, the registrar may, at her discretion, extend the period or time if she is satisfied with the explanation for the delay in requesting the extension and it appears to her to be just and equitable to do so"*. That distinction is now abolished under the 2008 Rules, rule 77(2) of which states *"A request for extension under this rule may be made before or after the time or period in question has expired and shall be made ... (b) in any other case, on Form TM9"*.
23. Mr Taylor for the Respondent contended that *Ministry of Sound* can no longer be good law, because applications for extension of time periods where the period has already expired must now be in writing using Form TM9R. It is common ground that no such Form TM9R has been filed. However, nothing in the 2008 Rules mandates the use of Form TM9R, and in my view the fact that a TM9 had already been filed satisfies the requirement in Rule 77(2). In any case, it would be open to an Examiner or Hearing Officer to treat a request as one made outside the relevant period and to require the requesting party to file the form TM9R as a condition of proceeding.
24. As I read Mr Hobbs QC's statement in *Ministry of Sound*, he was not laying down any hard and fast rule that a hearing officer must regard any new evidence and/or reasons provided for the first time at the hearing as an application for an extension out of time. Rather, he was saying that the hearing officer has a discretion to do so. Had the Hearing Officer stated, with reasons, that in accordance with her discretion she was not taking the oral evidence and reasons into account, such a decision would be virtually impossible to appeal.
25. However, from my reading of the Decision, that is not what the Hearing Officer did. Rather, it is apparent that from her statement *"I remind myself that my discretion is limited to the narrow issue of whether, in the light of the information available at the time that the Form TM9 was filed, the Registry was justified in issuing the preliminary view to refuse the request for a further one-month period in favour of a shorter period of two weeks"* that she proceeded on the basis that she could not take any such new evidence and reasons into account.
26. In doing that, the Hearing Officer made two errors – one hypothetical (on the facts), and one real. First, she erred in not considering whether the new evidence could be seen as an expansion of the original request (it being clear from *Style Holdings* and *Ministry of Sound* that not all expansions and supporting materials do constitute a request for an extension out of time). On these particular facts, that error is hypothetical, as it is clear that the oral evidence

provided at the hearing was in fact genuinely new, as opposed to simply being expansive of the material in the Form TM9.

27. Secondly, she erred by failing to appreciate that she had a discretion to allow the party to renew the request as one for a retrospective extension of time. She should have appreciated that she had that possibility and then gone on to consider whether (if she took the view that it was a request for a retrospective extension of time) procedural fairness permitted that application to be heard then, or whether it required an adjournment and subsequent application. Which of those two options is appropriate is dealt with by the comments of Geoffrey Hobbs QC in *Style Holdings*, namely whether the reasons for the request have been foreshadowed in writing prior to the hearing (and thus can be properly dealt with by the responding party) or whether they are being raised for the first time at any hearing (and so cannot be dealt with on that occasion without causing procedural unfairness to the other party on the basis that they are being “hi-jacked” by the argument).
28. Consequently, whereas she was right (or at least within her rights) not to take the further evidence and reasons into account in her reconsideration of the preliminary view in respect of the in-time application, she did have a discretion to take it into account when deciding whether the Appellant should nonetheless be granted a post-expiry extension, the extended deadline having expired by the date of the CMC. She accordingly fell into error by directing herself that she had no discretion to consider it.
29. I therefore allow this first ground of appeal, albeit on slightly different grounds than those contended by the Appellant. The impact of this ground will be considered below at ground 4.

(2) Failure to appreciate that exceptional grounds are not required

30. The Appellant contends that the Hearing Officer’s reference to TPN 2/2011, paragraph 2 of which states that “The Tribunal will, **in exceptional circumstances**, consider requests to extend the time allowance” (bold in the original) constitutes a wrongful fettering of her discretion. There is no statutory or binding precedent basis for limiting the Tribunal’s discretion in that manner, e.g. TMR 2008 r. 77 contains no such limitation. In contrast, each and every request for an extension of time ought to consider all the circumstances and reach a just and equitable decision. By wrongly fettering her discretion in this way, the cogency of the Decision is undermined completely.
31. The Appellant is right to say that the 2008 Rules make no such reference to any requirement of exceptionality. The requirement appears to emanate from the decision of Simon Thorley QC (as he then was), sitting as the Appointed Person in *Siddiqui O/481/00*. Mr Thorley said:

“It must always be borne in mind that any application for an extension of time is seeking an indulgence from the tribunal. The Act and the rules lay down a comprehensive code for the conduct of prosecution of applications and for the conduct of opposition. The code presumes a normal case and provides for it.

There is a public interest which clearly underlies the rules that oppositions and applications should not be allowed unreasonably to drag on.

In all cases the registry must have regard to the overriding objective which is to ensure fairness to both parties. Thus, it can grant an extension when the facts of the case merit it.

Accordingly, it must be incumbent on the application for the extension to show that the facts do merit it. In a normal case this will require the applicant to show clearly what he has done, what he wants to do and why it is that he has not been able to do it. This does not mean that in an appropriate case where he fails to show that he has acted diligently but that special circumstances exist an extension cannot be granted. However, in the normal case it is by showing what he has done and what he wants to do and why he has not done it that the registrar can be satisfied that granting an indulgence is in accordance with the overriding objective and that the delay is not being used so as to allow the system to be abused.

Jacob J made it clear in the SAW case that any perception that the registrar would grant extensions liberally was wrong and I take this opportunity to repeat that. In principle matters should be disposed of within the time limits set out in the rules and it is an exceptional case rather than the normal case where extensions will be granted." (my underlining).

32. That requirement is reflected in the Trade Marks Manual at 4.9.1, which mirrors the wording of TPN 2/2011:

*"The timetable is to be adhered to. It provides more than enough time, in the vast majority of cases, for facts or submissions pertinent to the pleaded grounds to be gathered and presented to the Tribunal. Parties should not regard this timetable as a 'starter for ten', to be varied at a later date. The Tribunal will, **in exceptional cases**, consider requests to extend the time allowance. Such requests will need to be fully supported with explanations as to not only what has been done to date but, more particularly, what is left to do and how long it will take to produce the evidence. The Tribunal will also need to be satisfied that the extra time is warranted in the context of the pleaded grounds and what is necessary to determine the case efficiently and fairly".* (bold in the original)

33. For my part, the word "exceptional" may not be the most apposite word. It is understandable that Mr Thorley was seeking to remind parties that extensions will not simply be granted as a matter of course. However, as I see it, whereas the deadlines in the rules will suffice in normal cases, there may be cases falling somewhere between "normal" and "exceptional" which meet the requirement laid down by Geoffrey Hobbs QC (as he then was) in *Liquid Force Trade Mark* 1999 RPC 429 that "*it is for the party in default to satisfy the court that despite his default, the discretion to extend time should nevertheless be exercised in his favour, for which purpose he could rely on any relevant circumstances*".
34. I believe that the wording adopted by Arnold LJ in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207 (in the context of indirect confusion) – that there must be a "proper basis" for a request for an extension – is likely more accurately to reflect the range of circumstances in which an extension will be granted.
35. Be that as it may, in the present case I do not consider it can credibly be argued that the reasoned approach was rejected and that exceptional circumstances were demanded. Rather, what happened is that both the Registry and the Hearing Officer decided, in light of the evidence, not to reject the request entirely but rather not to grant an extension to the full extent sought. That decision was not made because the case was not exceptional, but was instead made because the Appellant had simply not satisfied either decision maker that more than two weeks was necessary.

36. As it is not necessary in this instance, and as I have not heard any arguments from the Registry on the matter, I decline to rule that the wording in the Trade Marks Manual, and any reliance placed on it by the Hearing Officer, was wrong.
37. I therefore dismiss this second ground of appeal.
- (3) Failure to provide any justification for implicitly concluding that the unchallenged evidence of the Applicant that it required one month in which to perfect its evidence was not a credible and reasonable estimate of the time required**
38. The Appellant contends that the Hearing Officer failed to provide any basis for concluding that the one-month extension was unreasonable or otherwise not a realistic estimate of the time required to perfect the evidence given that there was no basis to question the Appellant's trade mark attorney's estimate of the time needed and that was shown to be a good estimate as the evidence was in fact filed within the one-month sought, and given the breadth and complexity of the three matters.
39. I do not agree that the Hearing Officer fell into error as suggested when considering the in-time application at the hearing. As I have explained at paragraph 28 above, in the absence of any further filed written materials, she was right to consider the in-time application solely on the basis of the contents of the TM9 form. Plainly, the fact that the evidence was filed within the one-month extension sought is therefore not a relevant factor, as that fact was unknown when the TM9 form was filed. Nor do I agree that it was incumbent on the Hearing Officer to provide a basis for concluding that the one-month sought was not a realistic estimate of the time required. On the contrary, as is clear from the passage from *Liquid Force Trade Mark* cited at paragraph 33 above, the burden is on the applicant to persuade the Hearing Officer that the request is justified.
40. The details provided in the TM9 form (set out at paragraph 4 above) were very concise. The impression gained from the reference to "*well advanced witness statement*" and "*some final changes that are required*" is that the majority of the work had been done, and the remaining work was limited to tweaking and finalising the evidence.
41. In the letter dated 3 May 2024 setting out the preliminary view, the Registry said:
- "The Registry's preliminary view is that the extension of time request should only be granted until 21 May 2024.*
- In making this view the Registry has taken into consideration the reasons provided in support of the request, whilst also noting the direction given in Tribunal Practice Notice (2/2011) in respect of extension of time requests.*
- In this instance, the Registry is not satisfied that the reasons and information provided in the form enable the Registrar to exercise its discretion and allow the full extension of time that has been requested".*
42. That was a perfectly clear indication that the Appellant had simply not managed to satisfy the requirement laid down in *Liquid Force Trade Mark* "*that despite his default, the discretion to extend time should nevertheless be exercised in his favour*". The Appellant should therefore not have been surprised at receiving the same outcome when it renewed the request at the subsequent CMC but relying on the same written evidence.

43. Whereas the two-week extension granted in response to the in-time application may be seen as somewhat ungenerous, I must remind myself that the discretion was the Hearing Officer's, not mine. I can interfere only if it involved an error of principle, or was wrong, and in my view neither of those is made out on the facts.
44. I therefore dismiss this third ground of appeal.
- (4) Failure to give any, or any proper, weight to (i) the evidential burdens placed upon the Applicant that were outside of its control; and, (ii) what was the most proportionate and efficacious way in which to resolve the various disputes between the parties**
- (5) Failure to take into account the consequences of her refusal to extend time in which to permit the Appellant's evidence to be filed**
45. I address these grounds together. As I have already said, I do not agree that the Hearing Officer's decision to grant only a two-week extension in response to the in-time application can be challenged in this appeal. However, given that by the date of the CMC the extended deadline (21 May) had already passed, and the evidence filed on 4 June 2024 was out of time, the matter of whether an out of time extension should have been granted requires determination. Given that the Hearing Officer did not appreciate that she ought to have addressed that point, it now needs to be done. In principle, I could exercise that discretion myself – that would have the advantages of speed and low cost, as no further materials or hearings would be required. Against that, as there is no appeal from the Appointed Person, it would deprive the parties of the right of appeal against the exercise of my discretion.
46. The Respondent informed me that it was neutral as whether the case should be remitted, whereas the Appellant expressed a preference for it to be remitted to the Registry. Accordingly, I shall remit the matter to the Registry for a decision as to whether an out of time extension should have been granted to the Appellant.
47. The discretion is broad, and the decision maker is required to balance the various factors pointing towards and against an extension being granted. Without wishing in any way to limit the Registry's discretion, I agree with the Appellant that each of the factors identified in grounds 4 and 5 are likely to be relevant to the discretion.
48. There is an additional factor, namely the fact that the evidence in question had already been filed by the date of the CMC. In *Liquid Force Trade Mark*, Geoffrey Hobbs QC said:

"I consider that the natural reluctance of the registrar to refuse an extension of time for filing evidence which has belatedly come to hand cannot be elevated to the status of an invariable rule. In order to leave room for justice to be done I think it is necessary to recognise that a contested application for an extension of time to file evidence should not necessarily "follow the event" (i.e. succeed if the evidence is available at the hearing of the application and fail if it is not) and should not automatically succeed on the basis that refusal is liable to result in the commencement of another action between the same parties covering essentially the same subject matter. I nevertheless agree that these are important factors to be taken into account when deciding whether an extension of time should be granted or refused. In the present case the hearing officer took them into account without regarding them as determinative per se. I agree with that approach".

49. That principle is reflected in the Trade Marks Manual at 4.9.1: *“The fact that evidence is available at the time a Hearing/CMC on a contested extension of time takes place is not determinative, though it is an important factor”*.
50. Again, it is a matter for the Registry as to what weight is given to that factor.
51. I consider that it would be most unfortunate for the same scenario to arise in any subsequent determination by the Registry, i.e. for new evidence to be produced for the first time at a hearing. I accordingly direct that the parties shall file, within 14 days of this decision, written evidence and submissions, as they see fit, containing the totality of the matters they wish to draw to the Registry’s attention in relation to the extension request.

Summary as to best practice in Registry proceedings

52. I have not sought to make any changes to Registry procedure, but nonetheless believe it may be useful to draw together the various strands in this decision. In my view, the correct procedure for extension requests is as follows:
1. A party wishing to make an application for an extension of time, prior to expiry of the deadline, should make the application in writing using Form TM9.
 2. The Registry will issue a preliminary view. Should either party disagree with the preliminary view, they should request a hearing. That request should be made within 14 days of the preliminary view.
 3. Should the applicant wish to expand and/or clarify any of its reasons for the extension request, such further materials should be filed and served in writing prior to the hearing.
 4. In the absence of any such further written materials, the hearing officer will normally consider the request for extension only on the basis of matters set out in the Form TM9. However, the consideration of the extension request at the hearing is *ab initio* – it is not a review of the preliminary view. If any further written materials are filed before the hearing, they will be taken into account together with the contents of the Form TM9.
 5. Should a party who has not filed any further written materials seek to rely at the hearing on reasons and/or evidence not contained in the Form TM9, the hearing officer may treat the new reasons and/or evidence as an application for an extension out of time.

Conclusion

53. The appeal is allowed. The matter is remitted to the Registry for consideration of whether the Appellant should be granted a retrospective extension to 7 June 2024 to file its evidence.

Costs

54. Whereas the Appellant has succeeded in this appeal, it remains to be seen whether its overall application for an extension is successful. I accordingly reserve the issue of the costs of this appeal to the Registry.

Dr. Brian Whitehead

6 December 2024

Representation

Michael Edenborough KC of Counsel, instructed by D Young & Co for the Appellant

Kieron Taylor, trade mark attorney of Swindell & Pearson Limited for the Respondent