

## Applications for extension of time (other than under rules 13(3) and 13(6))

The Trade Marks Rules fix periods of time for filing documents or completing actions. Some, though not all of these periods, may be extended where circumstances justify extra time. The Registrar himself may set a time frame for the completion of a certain step in the proceedings. This chapter outlines the procedure and the principles that the Registrar applies in relation to applications for extension of time other than those made under rules 13(3) and 13(6). For extension of time requests under rules 13(3) and 13(6), please refer to the chapter “Time limits in the examination process”.

The Rules give no guidance on how the Registrar should exercise his discretion to extend time. The Registrar will accordingly apply the principles contained principally in the following judgments:

- *Mobil Petroleum Company Inc. and another v The Director of Intellectual Property in his capacity as the Registrar of Trade Marks* (2001) 1 HKLRD 225:

“... all matters, including the adequacy of any reason for delay, must be considered, the one weighed against the other, in the exercise of the court’s discretion.” – *per* Hartmann J.

- *Zida Technologies Ltd v Tiga Technologies Ltd* (2001) 4 HKC 163:

“... a court will consider:

- (a) the prospect of injustice;
- (b) the length of the delay;
- (c) the reason for the delay;
- (d) the degree of prejudice to the other party.

Under the modern approach the first criterion (above) is the critical one.

...

But the merit – the prospect of the appeal (or application) succeeding and/or its intrinsic importance from the perspective of justice – is now the dominant consideration, as ‘the overriding principle was that justice must be done’ ...” – *per* Deputy High Court Judge McCoy SC.

- *Deutsche Telekom AG v The Director of Intellectual Property in his capacity as the Registrar of Trade Marks* (2002) 1 HKC 675:

“... the Registrar must, in the exercise of his discretion, take the merits of an opponent’s case into account when determining whether to give that opponent an extension of time to prepare and present its evidence. An opposition with no merit should not be allowed to delay the inevitable. But that does not mean that the Registrar must fully determine the issue: that in itself would be an injustice. In my judgment, in an application for an extension of time, it is sufficient for the Registrar to determine that an opponent has an arguable case, one that has been brought in good faith and can credibly be presented when the substantive issues are determined.” – *per* Hartmann J.

## **Proceedings or acts where time cannot be extended**

Certain time limits under the Trade Marks Rules are not extendible (rule 95(1)-(3)). The Registrar has no discretion to grant extension of time in these cases.

## **Procedure**

An application for extension under rules 16(4), 17(3), 94(1), 121(2) or 121(3) commences with the filing of Form T13 together with the specified fee (currently \$200).

The application must be supported by full reasons for the request. Simply stating that the applicant needs more time is tautologous, as clearly the application would be unnecessary unless the applicant needed more time. “Reasons” such as the ones shown below are unlikely to be considered satisfactory :

- “The applicant is considering how to proceed.”
- “The intended opponent needs more time to consider whether to file a notice of opposition.”
- “The publication of the mark has only recently come to our notice and we need more time to consider the matter.”
- “We are awaiting instructions from the applicant/opponent.”

The applicant needs to state “why” more time is required and to provide an outline, together with relevant dates, of the steps that have been taken to prepare the pleadings or compile the evidence within the specified time frame. The Registrar may require documentary evidence in support of the reasons advanced, e.g. where the party alleges “on-going negotiations” (rule 89).

The failure to include full reasons will result in an exercise of discretion based on the material before the Registrar. If subsequently a formal hearing is requested in an *inter partes* matter during which reasons are advanced which could have been included with the application, a costs award in favour of the other party will almost be inevitable.

A request for an extension of time under rule 94 may be made after the relevant time or period in question has expired (rule 94(7)), however, in addition to the reasons

advanced to support the extension sought, a further explanation will be needed to explain why it is late.

A request for extension of time under rule 16(4), 17(3), 121(2) or 121(3) must be filed before expiry of the period for which extension is sought.

Rule 94(2) requires the party filing the request to send a copy of Form T13 and the reasons supporting his request to each of the other parties to the proceedings, when a time extension is sought for the filing of :

- Opponent's evidence under rule 18 in opposition proceedings;
- Applicant's evidence under rule 19 in opposition proceedings;
- Opponent's evidence in reply under rule 20 in opposition proceedings;
- Applicant's evidence under rule 38 in revocation proceedings for non-use;
- Applicant's evidence under rule 42 in other revocation and invalidation proceedings;
- Owner's evidence under rule 43 in other revocation and invalidation proceedings;
- Applicant's evidence in reply under rule 44 in other revocation and invalidation proceedings; and

- Applicant's evidence in reply under rule 50(7) in variation and rectification proceedings.

The requirements under rule 94(2) also applies to an extension of time request for the following :

- Any time specified under rule 74 (except the time within which a request for a hearing is made pursuant to rule 74(2)) or a request for reasons for decision under rule 91(2); and
- Any time specified by the Registrar for translation of documents under rule 120(7).

Where the application for a time extension is in relation to an *inter partes* matter, the Registrar will allow the other party 14 days to comment on the application. If no comments are received from the other party within the specified time, the Registrar will assume that the other party does not oppose the application. In such a situation, it must not be assumed however that the application will be granted, as it is still a matter for the Registrar's discretion. If the party consents to the application, this will be a factor that will weigh in favour of a grant of the extension of time sought, but will not necessarily determine the issue. The parties must accept that it is the Ordinance and the Rules that set the time frame, not the parties themselves.

The following are exceptions to the procedure outlined above :

- In cases where the provisions of rule 94(6) are invoked by the Registrar, an extension of time may be granted without hearing the party to whom an earlier extension has been granted; and
- Where applications for extension of time to file notices of opposition under rule 16(1) or 121(1)(a) or counter-statements under rule 17(1) or 121(1)(b) are made, the other party will not be given time to comment on the applications. The

Registrar will issue a provisional determination based on the materials available subject to the parties' right to request a hearing.

At the expiration of the 14 days, the Registrar shall indicate, in writing, pursuant to rule 74(2), that unless any party requests a hearing within one month after the date of the notice, a decision can be expected to take the form as indicated in the notice. The period of one month to request a formal hearing is not extendible (rule 95(1)(r)).

When a party makes a written request to be heard, the Registrar will fix a date, time and place for the hearing and notify each party of those particulars in writing (rule 74(3)). The Registrar shall give not less than 14 days notice to the parties of the fixture (section 70(2)).

Each party then has two options :

- Any party wishing to appear at the hearing must file Form T12 within 14 days of being notified of the fixture (rule 74(5)). This time limit can be extended (rule 94).
- Any party who fails to file Form T12 will be regarded as not wishing to appear (rule 74(5)). That party may, however, file written submissions before the date appointed for the hearing.

If neither party files notice of intention to appear, the provisions of rule 75 will be triggered.

## **Deadline for lodging of pleadings**

An intended opponent is required under rule 16(1) to file a notice of opposition within 3 months beginning on the date on which particulars of the relevant application for

registration are published. Any request for extension of the above 3-month period must be filed by an intended opponent before its expiry. If a request for extension is allowed, the initial 3-month period will be extended by 2 months pursuant to rule 16(4). Such 2-month period will, in all cases, run immediately from the expiry of the initial 3-month period, regardless of the date on which the extension is allowed by the Registrar. Thereafter, no further request for extension of time to file the notice of opposition may be made.

Therefore, an intended opponent who has made a request for extension of the initial 3-month period must lodge his notice of opposition with the Registrar prior to the expiry of the 2-month period in order to preserve his position, even though his request for extension of time is still pending the determination by the Registrar. If his request is subsequently allowed by the Registrar, the notice of opposition so lodged by him will be treated as timely filed.

The above applies to requests for extension of time to file notice of opposition under rule 121(1)(a) and counter-statement under rule 17(1) or 121(1)(b).

### **Who may attend the hearing**

See corresponding section in the chapter on Hearings.

### **Decision**

See corresponding section in the chapter on Hearings.

### **Appeal**

See corresponding section in the chapter on Hearings.

## Processing a request for an extension of time

Upon receipt of Form T13, check that :

- The form is properly completed and signed;
- It is accompanied by the appropriate fee;
- The application relates to a time limit not excluded by rule 95; and
- Full reasons in support of the request are included. If the application is filed out of time, that an explanation has been included as to why it is late.

In addition, if the application is an *inter partes* one :

- In respect of applications to which rule 94(2) applies check that the applicant has indicated at Box 4(c) of Form T13 that notice of the request has been given to every other party to the proceedings;
- If the application is one to which rule 94(2) applies and the application does not appear to have been copied to every party to the proceedings, request the party applying to copy the other party and confirm that they have done so;
- If it appears to have been copied (or confirmation is subsequently received), bring it up upon the expiry of 14 days;



- Forward the file for a determination. Upon receipt of the determination, write to the parties giving notice that unless a request for a hearing is received within one month after the date of the notice, a decision can be expected to take the form of the notice;
- Enter the provisional determination in the computer database;
- If no request for a hearing is made within the specified time issue the final order; and
- Update the provisional order to final in the computer database.

Where a request is made for a formal hearing :

- Forward the file to AD(H) for allocation of a Hearing Officer;
- Inform the parties of the date, time and place fixed for the hearing;
- If the hearing room is not already booked for that hearing, reserve the room in the computer system;
- Enter particulars in the computer database including the expiration of 14 days for the filing of Form T12; and
- Advise the assigned Hearing Officer as each party files Form T12.

After a decision has been made, record the decision in the computer database and diary it for one month from the date the decision is sent out as the date for requesting a statement of the reasons for decision.

If no request for a statement for reasons is received, the opposition/revocation etc file continues from where it left off.

If a request for a statement for reasons for the decision is received :

- Check that it was received within one month from the date notice of the decision was sent;
- Refer the file to the Hearing Officer who made the decision;
- Diary it for 30 days from the date of the statement of reasons in the computer system; and
- If no leave to appeal is granted within that time, the opposition/revocation etc file continues from where it left off.

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