

Re Neel's Electronic Pte Ltd
[2001] SGHC 261

Case Number : OS No 601099/2001
Decision Date : 11 September 2001
Tribunal/Court : High Court
Coram : S Rajendran J
Counsel Name(s) : Hema Subramaniam (Attorney-General's Chambers) for the Attorney-General;
Dedar Singh Gill (Drew & Napier LLC) watching brief for Charles Jourdan Holding AG
Parties : —

Judgment:

Grounds of Judgment

1. This is an ex parte application under Order 53 of the Rules of Court by Neel's Electronics Pte Ltd ("NEP") for leave to apply for an Order of Certiorari to quash the decision of the Principal Assistant Registrar of the Registry of Trade Marks made on 24 May 2001 granting to M/s Charles Jourdan Holding AG ("Jourdan") - the opponents to an application for the registration of a trade mark by NEP - leave to file Notice of Opposition out of time.

2. The application to register the trade mark in question was made on 10 October 1998. The trade mark was accepted, under s 13(1) of the Trade Marks Act (Ch 332) for registration, and the application was published in the Trade Marks Journal on 23 February 2001. Under s 13(2) of the Trade Marks Act, any person may, "within the prescribed time", give notice to the Registrar of opposition to the registration. The "prescribed time" is contained in rule 29 of the Trade Marks Rules.

3. Rule 29(1) of the Trade Marks Rules allows the person opposing to file his Notice of Opposition "within 2 months" of the date of publication of the application for registration. Where the person opposing requires additional time to file the notice, the Rules allow the person to request for an extension of time but this too must be done "within 2 months" of the date of publication of the application for registration. This is provided for in rule 29(3) which reads:

"A request for an extension of time to file the notice of opposition shall be made by filing with the Registrar Form TM48 within 2 months from the date of the publication of the application for registration."

(Emphasis added.)

In this case therefore, since the application for registration was published on 23 February 2001, Jourdan had to file its Notice of Opposition or apply for extension of time to file the said Notice by 23 April 2001.

4. Jourdan did not file the required notice by 23 April 2001. Neither did Jourdan, by that date, apply under rule 29(3) for extension of time. It was only on 9 May 2001 - some 16 days after the cut-off date of 23 April 2001 - that Jourdan, through its solicitors, applied for an extension of time to file the Notice of Opposition.

5. The application for extension of time was heard by the Principal Assistant Registrar on 24 May 2001. NEP objected to any extension of time being granted on the grounds, inter alia, that:

(a) the Principal Assistant Registrar had power to grant an extension if, and only if, the application for extension had been made on or before 23 April 2001. In this case as the application was made after 23 April 2001, the Principal Assistant Registrar would have no powers to grant the extension.

(b) Rule 29(8) provides that the Registrar may "if he is satisfied that a good and sufficient reason has been shown for the extension" grant the extension. The explanation proffered by Jourdan both for the application being made out of time and in support of the application for extension of time to file the Notice of Opposition was that their agents had overlooked the matter. Such an explanation, it was submitted, could not amount to a good and sufficient reason for the grant of the extension of time.

Jourdan took the position, before the Principal Assistant Registrar, that the failure to apply for the extension on or before 23 April 2001 was a mere irregularity which can be cured under rule 83 of the Trade Marks Rules.

6. Rule 83 of the Trade Marks Rules reads as follows:

"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."

It would appear that the Principal Assistant Registrar considered that the failure to conform with the time constraints imposed by Rule 29(3) was an irregularity which fell within the purview of rule 83 and in the exercise of her discretion under that rule, she granted the extension sought.

7. Despite the fact that the Principal Assistant Registrar had granted the extension sought, the Registry accepted the registration and, on 5 June 2001, forwarded to NEP the Certificate of Registration for the trade mark in question. The Registrar's response, when this fact was brought to his attention, was that the Certificate had been issued in error. The Registrar, accordingly, asked for the return of the Certificate and informed NEP that the register had been amended to reflect that the application was "pending" instead of "registered".

8. Counsel for NEP, in this application for leave to issue certiorari, contended that the Principal Assistant Registrar, in granting the extension of time after the 2-month period had expired, had acted in breach of the statutory requirements of rule 29(3). He also submitted that the discretion in rule 83 could only come into play in respect of irregularities, the waiver of which would not cause any detriment to any person. In this case, he submitted, the extension of time had caused a detriment to NEP in that NEP had been deprived of a certificate that would otherwise have been issued to it.

9. Ms Hema Subramaniam, who appeared for the Attorney-General, made it clear from the outset that if indeed the Registrar had no powers to entertain the application for extension of time where such application was made after the 2-month period, then the Registrar's decision would be unlawful and would have to be quashed. Ms Subramaniam submitted, however, that the time period specified in the Rules related only to matters of procedure and that since rule 83 of the Trade Marks Rules gave the Registrar a discretion in such procedural matters to waive any non-compliance, the grant of the extension was lawful. In respect of the cancellation of the Certificate that had been issued, Ms Subramaniam submitted that as the Certificate had been issued in error, it had no validity and the Registrar was duty-bound to cancel it.

10. At this hearing I am not called upon to decide which of these two opposing views is correct. The court's duty in an application for leave to issue certiorari is, as stated in *IRC v National Federation of Self-Employed* [1981] 2 All ER 93 at 106 (adopted in *Chan Hiang Leng Colin & Ors v Minister for Information and the Arts* [1996] 1 SLR 609), as follows:

"If, on a quick perusal of the material then available, the court thinks that it discloses what might on further consideration turn out to be an arguable case in favour of granting to the applicant the relief claimed, it ought, in the exercise of a judicial discretion, to give him leave to apply for that relief."

It seems to me that there is an arguable case that the Principal Assistant Registrar in allowing an application for an extension of time made after the statutory period prescribed in the Rules had elapsed, was acting outside her powers. I therefore grant the leave sought.

S. RAJENDRAN
Judge

11 SEPTEMBER 2001
SINGAPORE

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