REPUBLIC OF TRINIDAD AND TOBAGO

IN THE COURT OF APPEAL

Cv. A. No. 14 of 1999

BETWEEN

CONTROLLER OF
THE INTELLECTUAL PROPERTY OFFICE APPELLANT

AND

SOCIETE DES PRODUITS NESTLE S.A. RESPONDENT

PANEL:

M. A. de la Bastide, C.J
R. Hamel-Smith, J.A.
M. Warner, J.A.

APPEARANCES:

MR. B. BUSBY appeared on behalf of the APPELLANT
MR. F. GILKES appeared on behalf of the RESPONDENT

DATE DELIVERED:

May 16th, 2001.

JUDGMENT

Delivered by M.A. de la Bastide, C.J.

CHIEF JUSTICE DE LA BASTIDE: I will state in short form what this appeal is about. The Trade Marks Act Chap. 82:81 gives the Registrar, now the Controller of Intellectual Property, the duty and power to decide whether a trade mark should be registered. Provision is made for notice of application for registration to be published. Persons wishing to oppose the registration may give notice of their intention to oppose within a prescribed time. The Registrar then sends a copy of such notice to the applicant who is required again within a prescribed time, to file with the Registrar a counter statement. If either the party opposing the registration or the party applying for it, defaults in filing these documents, then they are taken to have abandoned, as the case may be, either the application for registration or the opposition to it.

There is also a requirement that the opponent to registration file (or 'leave') evidence in support of his opposition with the Registrar within a prescribed time from the receipt by him of the counter statement of the applicant. Again, in default of his leaving that evidence within the prescribed time, he is taken to have abandoned his opposition. The time for the opponent to leave the evidence is one month. Now, there is a general power given to the Registrar under the Trade Mark Rules to extend time. This is in Rule 92 which provides as follows:

> "If in any particular case the Registrar is satisfied that the circumstances are such as to justify an extension of the time for doing any act or taking any proceedings under these Rules [subject to certain exceptions which are not relevant],. . . . he may extend the time upon such notice to other parties, and proceedings thereon (sic), and upon such terms as he may direct, and the extension may be granted though the time has expired for doing the act or taking the proceeding."

In this case, the respondent in this appeal filed a notice in opposition to an application for registration of a trade mark by a company called Trinidad Import and Export Company Limited ('TIECL'). A counter statement was duly filed by TIECL and a copy of that counter statement was received by the respondent on the 2nd November, 1995. Therefore, in accordance with the Rule to which I have referred, the respondent ought to have filed its evidence by the 2nd December, 1995. In fact, a letter from the Registrar required them to do so by the 30th November, 1995.

On the 29th November, attorneys for the respondent wrote to the Registrar requesting an extension of time for the filing of their evidence until the end of February, 1996. The Registrar, apparently in keeping with her normal practice, replied inviting the respondent to seek the consent of TIECL to the extension, and advising that if this was not forthcoming by the 31st January, 1996, a hearing would be fixed for the making of the application for the extension of time. The respondent did not succeed in obtaining TIECL's consent to the extension and so notified the Registrar.

Thereupon the Registrar wrote to the respondent's attorneys informing them that the application for the extension of time would be heard at 10:00 a.m. on the 16th February, 1996. Unfortunately, the attorney who was handling this matter lost sight of the fact that the matter had been fixed for that day and did not attend. A director of TIECL, Mr. Arrindell, did attend before the Registrar who after having waited for half an hour, proceeded to deal with the matter. Mr. Arrindell expressed his reasons for opposing the grant of the extension and the Registrar decided to refuse the application.

It appears that the absent attorney was notified of what had happened later the same day and there was subsequent correspondence between the Registrar and himself. By a letter dated the 27th February, 1996, the Registrar informed the respondent's attorney of her decision and what had transpired before her on the 16th February. By letter dated the 5th March, 1996, the respondent's attorney made what he described as a 'fresh application' in writing to the Registrar for an extension of time. In effect, what was being sought was that the Registrar revisit her decision to refuse the extension of time. The Registrar, it appears, sought the advice of the Solicitor-General as to whether it was competent for her to reconsider her decision in the light of such representations as might be made to her by attorney for the respondent. Eventually the Registrar, acting on the advice she received, declined to do so.

There appears to have been some continuing negotiations in connection with this matter; as informal representations were made to the Registrar. We were also told this morning that within a fairly short time an agreement was reached between the respondent and TIECL with regard to the registration of the trade-mark.

Nonetheless judiciai review proceedings were initiated on the 2nd March, 1998, and an order was made at the end of the trial quashing the decision of the Registrar not to re-open the application for the extension of time. The Judge also made an order of mandamus directed to the Registrar requiring her to hear and determine the application by the respondent.

While the order made by the learned trial Judge as formulated at the end of his judgment, appears to have the effect of quashing the Registrar's decision to refuse to hear the respondent's application for the extension of time for filing evidence in opposition, and ordering the Registrar by way of mandamus to hear and determine that application, it appears to me that the order which the judgment supports would more properly have the effect of quashing the decision of the Registrar not to entertain an application by the respondent to quash her decision to refuse an extension of time, and ordering her to hear that application i.e. to quash her refusal of the extension and re-hear the application for the extension. The difference may be a subtle one, but I think it is important.

It is clear from the judge's reasoning that he wished to leave open for the decision of the Registrar the question whether or not, given the explanation which the attorney offered for his absence as well as all other relevant circumstances, she should allow the matter to be reopened and receive the representations of the respondent. The positive order made by way of mandamus similarly was intended in my view not to compel the Registrar to reopen the matter but to compel her to hear the application of the respondent that it be reopened.

The question which these proceedings raise is whether or not the Registrar - although I have been referring to her as the Registrar and will continue to do so, she was in fact the Deputy Registrar -- had the power to reopen the question of granting an extension, having made her decision to refuse it in the absence of the attorney for the respondent. The learned trial Judge held that she did have that power or jurisdiction and that she was wrong to have declined to exercise it.

The appeal has been pursued by the Registrar because as her counsel Mr. Busby explained, it is considered necessary that she should have the benefit of the court's guidance with regard to her powers in the situation I have described, that is, where she has made an order in the absence of a party who was expected to attend the hearing, but for reasons which were not known to the Registrar at the time, did not attend and so was not heard even though he had notice of the hearing.

It is contended on behalf of the Registrar that her decision taken on the advice of the Solicitor General, that she does not have that power is correct and that we should accordingly reverse the learned trial Judge who held the contrary.

The gravamen of Mr. Busby's argument is that the Registrar has only those powers which are expressly given her by the statute, in this case, the Trade Marks Act; that the power of reopening a matter, once she has given a decision, is one which is not conferred on her by the Act, and in

the absence of any express provision giving her that power, she does not have it. She has no inherent jurisdiction, it is submitted, in the way the High Court or even Quarter Sessions in England, has an inherent jurisdiction.

It is a matter of surprise that counsel on both sides have only been able to refer us to two cases in which the specific question has been discussed i.e. whether or not a decision-making body is automatically endowed with the power of reopening a decision which it has taken in the absence of an interested party, notwithstanding that that party had notice of the hearing and an opportunity to attend either in person or by his representative. Those two cases are **R. v. London County Quarter Sessions Appeals Committee, ex parte Rossi** (1956) 1 Q.B. 682, and **R v. Kensington and Chelsea Rent Tribunal, ex parte Mac Farlane**, (1974) 1 W.L.R. 1486. Even in these two cases what was said about this question was 'obiter'.

The case which is more directly in point is **R v.Kensington and Chelsea Rent Tribunal, ex parte Mac Farlane** as that concerned a rent tribunal which was wholly the creature of statute. In that case the decision turned on whether or not the rent tribunal was right to dismiss a reference to it by a tenant of a Notice to Quit served on him by his landlord on the ground that it was frivolous and vexatious, when neither the tenant nor the landlord turned up at the hearing of the reference.

The court held that having embarked on the determination of the reference, the tribunal did not have any jurisdiction to dismiss it on the ground that it was frivolous and vexatious. The court, however, considered whether or not the tenant, who was the applicant in the judicial review proceedings, might not have applied to the tribunal to reopen the matter. Although notice of the hearing appears to have been served on him in compliance with the requirements of the relevant statutory provisions, he did not actually receive it.

In connection with that issue, it was held that it was the tribunal's duty when they received the tenant's letter asking for the matter to be reopened, to consider whether they would allow the case to be reopened. Although the court went on to stress that this power to reopen a case should be exercised sparingly by tribunals such as these, it was in connection with this side issue that Chief Justice Widgery referred to the earlier case of **Rossi**, and quoted extensively from the judgment of Denning L.J. as he then was, in that case. In **Rossi** there was an application by the putative father of a child to quash certain bastardy proceedings which had been taken on appeal to the Quarter Sessions on the ground that he had not been properly served with notice of those proceedings. His application failed because it was held that there had been no flaw in the service of the notice.

Denning L.J., however, went on to hold that the applicant could have applied to the Quarter Sessions to recall its order and to hear the appeal. In this connection Denning L.J. said at page 693:

"It was suggested before us that the Court at Quarter Sessions had no power to set aside its own order even when made in the absence of the respondent. But on looking into the matter I am satisfied that it has, and that the intimation of Lord Goddard Chief Justice on this point is well founded. Suppose, for instance, that Mr. Rossi had received proper notice of the date of the hearing but failed to attend because he was ill and the court not knowing of it heard his pleading in his absence and decided against him, or suppose that the registered letter had not been returned undelivered so that the court were entitled to assume that it had been delivered in the ordinary course of post. In each of these cases the order of Quarter Sessions would be regularly obtained, but Mr. Rossi would be able to have it set aside on such terms as the court thought fit, and he could be let in to defend on the merits. That was done over two hundred and fifty years ago in the days of Queen Anne, where Holt, C.J. was clearly of the opinion that Quarter Sessions have just the same power as the Queen's Bench to set aside a judgment or order made in the absence of a party."

Counsel for the appellant has criticised the reliance placed on that passage from Denning L.J's judgment by Widgery C.J., in the later case of **Mac Farlane** on the ground that the rent tribunal did not have the same sort of inherent jurisdiction as was attributed to the court of Quarter Sessions initially by Holt C.J., and latterly by Denning L.J.

It is clear, however, from Widgery's C.J.'s judgment that he regarded the principle established with regard to the Quarter Sessions in **Rossi** as being of general application. Thus at page 1493, Widgery CJ said:

> "The conclusion which I reach on the basis of what Denning LJ said is this, that whereas in the present case the tribunal has acted impeccably so far as its own duty is concerned, has, in other words, sent out the right notices, in the right means, at the right time and has had no indication that the notices have gone astray or that the applicant for any other reason cannot attend, then an order made, in those circumstances, is a regular order and not normally open to challenge on certiorari. However, the disappointed party has what is certainly a cheaper, if not more effective remedy open to him, that he can go back to the tribunal, explain why he did not attend and the tribunal will then have the jurisdiction, if it thinks fit, to reopen the matter and to reconsider its decision in the light of representations made by the absent party. It seems to me that

quite independently of the frivolous and vexatious point with which I have already dealt, it was open to the applicant if he had wished to go to the tribunal, indeed, as he did by correspondence, to ask the tribunal to accept his explanation of his absence and give him a further opportunity of being heard. It was the tribunal's duty, on receipt of that application from the applicant, to consider whether they would allow the case to be reopened, and I would stress that tribunals must be very firm in the view which they take about this kind of case. There must be no question of absent parties taking no action over a period of months and then coming back to the tribunal with some story of having been ill or being in South America when the hearing occurred. Tribunals must be satisfied before they reopen a case that there is a good argument on the merits for giving the absent party a chance to be heard and that he has got a real and reasonable cause, and that in considering whether he ought to be given a further chance regard must be had to the other party to the proceedings and to any third parties who may have acted upon the tribunal's decision on the assumption that it was right and to be sustained."

Reliance was also placed by counsel for the appellant on the case of **Addidas S.A.R.L.'s Trade Mark**, (1983) R.P.C. 262. That case, like ours, concerned an application for an extension of time for filing evidence in opposition to the registration of a trade mark

It appears that several extensions had been granted and the Registrar had indicated in the letter granting the last of these extensions that it was the final one. Nonetheless, a further extension was sought and refused by correspondence. The question was whether an application for an oral hearing was made within the time limit prescribed by the Rules.

The case, therefore, did not involve any question of whether or not the Registrar could reopen a decision given in the absence of an interested party. Nevertheless, the appellant, both here and in the court below, relied on a passage from the judgment of Forbes J, at page 267:

"Mr. Patterson then suggested that this is justified when one is seeking to construe these Rules in a practical way. It is justified because otherwise, he says, there would be no end to applications for extensions of time. It would be possible for somebody to make an application for an extension of time to apply for a hearing in relation to that and then apply for a further extension and so on. I do not think that that is right because I think Mr. Laddie is correct when he says that a refusal in a case where no hearing is requested, and a refusal given after a hearing both preclude any further application just as with an application for an extension of

> time to file a Statement of Claim or a Defence or some other pleading in an ordinary action. I think that is right. I think the situation is if you apply for an extension of time to do something without the complications introduced by these Rules and that application is refused, subject to any right of appeal, that is the end of the matter. If you take your right of appeal and the appeal tribunal decides that the first decision was right and that you should not have an extension of time, then you cannot subsequently go back and ask again for an extension of time for doing that for which you have been refused leave. I cannot see anything in the Trade Marks Rules themselves which alters that situation. I feel satisfied that once a final decision to refuse an extension has been taken, no further application for an extension of time can be made."

Counsel, however, was forced to concede that Forbes J. did not, when he spoke these words, have in his contemplation a situation in which there had been a hearing but one of the interested parties had not been for whatever reason present at that hearing,. It is clear that when he spoke of the finality of a decision reached after a hearing, he was not addressing the question of what would be the result if the hearing had not, as contemplated, involved the making of representations by all interested parties. Therefore, it is impossible, since that question was obviously not present to his mind, to draw any inferences from his judgment as to how he would have answered the question with which we are faced.

We have not reserved our decision in this matter and therefore we have not had the opportunity to research the authorities with a view to finding some guidance on the issue which this appeal raises. As I have said, the assistance which is provided by the authorities cited to us is limited, but certainly the judgment of the court in **Mac Farlane** strongly suggests that there is a principle of general application that tribunals and individuals who have the function of making decisions after hearing parties may, even in the absence of express statutory sanction, vacate an order which they have made after a hearing which was not attended by one of the interested parties who would have been entitled to be heard, regardless of whether or not the absent party was given the opportunity of attending.

There are, of course, a number of different factual situations in which a party who was expected to attend a hearing does not attend and is not represented. There may be a failure to inform him effectively of the time and place of the hearing. This, in turn, may be either as a result of a failure by those with the responsibility to provide him with that notice, to do either what is prescribed by the law or what is reasonable to give him notice of the hearing, or it may be that despite compliance by those with that responsibility with the statutory form of service, or despite having

taken all reasonable steps to bring the notice to his attention, the notice has nevertheless failed to reach its intended target.

Again, there may be at least two types of situation in which the party has received notice of the hearing but nonetheless does not attend or is not represented. One category of case is where there has been some fault or negligence on his part or more usually on the part of his attorney (such as occurred in this case), where the person whose duty it is to attend forgets about the fixture and is not reminded of it until it is too late.

The other situation is where there is no fault whatever attributable to the absent party or his attorney. Obviously, this would be the case when owing to the intervention of illness or some other circumstance over which the party has no control, it becomes impossible for him to attend.

Counsel for the appellant sought to distinguish cases in which the non-attendance of the interested party was due to some fault on the part of those who were supposed to give him notice and those in which the failure to attend was due to other causes. Put differently, if the decision taken in the absence of the party could be declared a nullity because it was in breach of the rules of natural justice, or because notice had not been given in accordance with the requirements of service contained in some statutory provision, then the option would exist for the decision-maker, whether a person or a tribunal, to vacate his order and reopen the matter. But in all other cases he would not have the power to do so in the absence of some express statutory provision conferring that jurisdiction on him.

It is clear that if that is the law, as counsel submits, in situations like the instant one in which there is no right of appeal, grave injustice could result. I refer particularly to the category of case I have identified in which although notice has been received, the absence of a party is due to no fault of his or of any representative of his. Counsel argues that even if that had been the case, the remedy must lie with Parliament and there is nothing that the courts can do about it. But is that the law? He has, as I have said, cited no case in which that has been held to be the law. On the other hand, there is at least the 'obiter dicta' of Widgery C.J. in **Mac Farlane** which suggest that there is no such restriction on the right of a decision-maker to reopen a decision made by him in the absence of a party with a right to be heard.

The Rule in this case which gives the Registrar the power to extend time makes it clear that that power may be exercised virtually at any time: there is no restriction on when it must be exercised. It is also clear from Rule 94 that a person against whom a discretion may be exercised adversely by the Registrar is entitled to insist on being heard by the Registrar. That was not a right which had to be exercised in this case because the

Registrar of her own volition indicated that she would only make a decision after having orally heard both interested parties on the grant of an extension.

In the result, she never received any representation from the respondent either orally or in writing with regard to the grant of the extension. She heard, as it turned out, only the applicant for the trade mark. This admittedly was due to no fault of hers or indeed of the applicant. It was wholly attributable to the fault of the attorney or his support staff. In those circumstances, I can find no reason in principle and nothing in the authorities which would propel me to the conclusion that the Registrar did not have the power to reopen the matter and to give an opportunity to the respondent to be heard. That seems to me rather to be consistent with principle and with such authority as exists. I do not think that in order to achieve a result which is likely to avoid injustice, it is necessary to await action by Parliament.

It seems to me that Widgery C.J. was right, with respect, to treat the capacity to reopen a decision in circumstances like these as an inevitable concomitant of any decision-making power whether conferred by statute or by common law.

I do recognise that this power should not be regarded as exercisable in situations in which it would involve the decision-maker in resolving the very same question a second time. In other words, the operation of this principle is subject to the requirement of finality. What I have in mind is a situation in which at the initial hearing the person or body conducting the hearing is informed fully of the reasons for the absence of the party or his lawyer and receives representations as to why, in those circumstances, he should not proceed to deal with the matter and arrive at a decision, and that having been done, the decision-maker proceeds to make the decision. It seems to me that in that situation, which in my experience is highly unusual, it would not be right to permit an application to the same effect to be made subsequently by, or on behalf of, the absent party. But almost inevitably, when the matter proceeds ex parte, the tribunal or the person making the decision is not in full possession of the facts which account for the absence of the party. I hope that this rather discursive 'ex tempore' judgment has provided the guidance which the Registrar was seeking. In the result, I would dismiss the appeal with costs, and subject to the correction which I indicated at the beginning of my judgment, affirm the orders of certiorari and mandamus made by the learned trial Judge, as well as his order with regard to costs.

Mitchell J. Smith