



IN THE SUPREME COURT OF JUDICATURE OF JAMAICA

IN THE COMMERCIAL DIVISION

CLAIM NO. SU 2024 CD 00397

IN THE MATTER OF the Trade Marks Act
AND

IN THE MATTER OF an Appeal pursuant
to Section 60(1) of the Trade Marks Act

BETWEEN **SUNDAY RED, LLC** **APPELLANT**
(FORMERLY TAYLORMADE LIFESTYLE VENTURES LLC)

AND **THE REGISTRAR OF INDUSTRIAL PROPERTY** **RESPONDENT**

PUMA SE **INTERESTED PARTY**

Trade Mark - Appellant's response to objection filed out of time – Application to extend time – Trade mark application “deemed” abandoned – Whether decision of Registrar correct- Whether jurisdiction to extend time- Whether distinction between “deemed” and “treated as” within the Act - The Trade Marks Act.

Emile Leiba and Samantha Grant for the Appellant instructed by DunnCox

**Tanesha Rowe-Cooke and Karessian Grey for the Respondent instructed by the
Director of State Proceedings**

**Mark-Paul Cowan and Peta-Gaye Monteith for the Interested Party instructed by
Nunes Scholefield DeLeon & Co.**

Heard: 8th April and 19th May 2025.
IN CHAMBERS (by video conference)

Cor: Batts, J.

- [1] This is an appeal pursuant to section 60 of the **Trade Marks Act**. The facts and circumstances can be shortly stated. The Appellant, on the 19th July 2023, applied to the Respondent for a trade mark to be registered. At that time the Appellant was represented by another firm of attorneys-at-law. By letter dated 8th April 2024 the Respondent notified the Appellant's attorneys-at-law that the mark was "*accepted for publication*". On the 29th July 2024 an objection was filed by the Interested Party. By email, dated 7th August 2024, the Respondent advised the Appellant's attorneys-at-law of the objection and that the law allowed two months from the receipt of Notice of Objection to file a grounds of counter-statement failing which "*your application may be treated as withdrawn.*" At this juncture the Appellant's attorneys at law realized that they were unable to continue acting in the matter due to a conflict of interest and, on the 8th August 2024, advised the Appellant accordingly. Efforts to obtain alternate legal representation were unsuccessful until, on or about the 24th September 2024, the Appellant's new attorneys applied to be appointed as agent for the Appellant, see exhibit "JEW2" to the affidavit of Joanne Wood Rattray filed October 28, 2024.
- [2] An extension of time to file a counter statement was requested by letter dated the 30th September 2024, see exhibit JEW4 to the affidavit of Joanne Wood Rattray filed October 28th 2024. On the 1st October 2024 (the same day the new attorneys were advised that their appointment as agent was granted, see exhibit AT3 to the affidavit of Adrienne Thompson filed January 30, 2025) the Appellant was told that "*the Extension of Time cannot be granted*" and, as such, "*the application for registration has been abandoned as at October 1, 2024.*" The communication, of the 1st October 2024, was by an email from Mary Montague, a registration officer in the Respondent's office, see exhibit AT 3 to the affidavit of Adrienne Thompson

filed January 30 2025 and JEW5 to the affidavit of Joanne Wood Rattray filed 28th October 2024. By letter dated the 22nd October 2024 signed by Ms. Alecia Videl for the Respondent, see exhibit AT 1 to the affidavit of Adrienne Thompson filed on the 3rd April 2025, the Appellant's legal representative was advised as follows:

"October 22, 2024

DunnCox

48 Duke Street

Kingston

Jamaica, W.I.

Attention: Mrs. Joanne E. Wood Rattray Dear

Sirs:

Re: Abandonment of Notices of Opposition to the Registration of Trade Mark Nos. 90123, "SDR & Logo" (In Opposition - Opposition No. 7286/TM2024) AND 90124, "Design Mark" (In Opposition - Opposition No. 7287/TM2024)

Reference is made to the captioned matter and to your letter dated October 4, 2024 on the captioned subject.

Kindly be informed that upon careful review of your submissions in letter dated October 4, 2024, and our files for the captioned marks, we maintain that:

- 1. Pursuant to Rule 54 of the Trade Marks Rules, 2001 as amended by the Trade Marks (Amendment) Rules, 2022, the time period for which to file a counter-statement pursuant to Rule 12(3) of the Trade Marks Rules, 2001 as amended by the Trade Marks (Amendment) Rules, 2022 is non-extendable; and*

2. Pursuant to Rule 12(4) of the Trade Marks Rules, 2001, the captioned applications for registration of the trademarks 90123 and 90124 shall be deemed withdrawn as the counter-statements were not filed in time in accordance with Rule 12(3) of the Trade Marks Rules, 2001.

Further, we note your arguments advanced with respect to disagreement with the calculation of time, particularly that the effective deadline for the submission of the counterstatements was the close of business on October 1, 2024. Yet, you filed the Notice and Grounds of Counterstatements in defense of the applications on October 4, 2024; three (3) days later than your calculated timeframe. In any event, based on our calculations from the date of service of the Notice of Opposition, that is, July 29, 2024; the said counter-statements were due for filing on September 30, 2024 yet you filed the Notice and Grounds of Counterstatements on October 4, 2024, which is calculated to be filed out of time.

Consequently, the said Notice and Grounds of Counterstatements dated October 4, 2024 filed out of time will not be considered and the Trade Marks Act (as amended) and the Trade Marks Rules (as amended) do not afford the Registrar the opportunity to exercise her discretion in these circumstances.

Accordingly, the captioned applications have been duly withdrawn in keeping with the above-mentioned legal references herein.

Thanks for your attention and cooperation herein.

Yours faithfully.

*Alecia Vidal (Ms.)
for Registrar of Industrial Property”*

[3] The Appellant has, in these proceedings, appealed against the decision of the Respondent that no extension of time to file counter-notice was possible and that the application to file a trade mark was withdrawn or abandoned. The Amended Fixed Date Claim Form, filed on the 9th January 2025, lists the grounds of appeal as follows:

- a. The decision was made ultra vires the provisions of Section 21 (4) and Section 24 of the Trade Marks Act.
- b. To the extent that Rule 12 of the Trade Marks Rules, 2001, deems applications to be withdrawn due to the absence of counter-statements, without the exercise of a discretion by the Registrar, this is contrary to the express provisions of Section 24 of the Trade Mark Act and is therefore invalid.
- c. Under the provisions of the Trade Marks Act a Registration Officer has no power to deem an application made under the Act as abandoned.
- d. Under the provisions of the Trade Marks Act, the time for the calculation of submission of a response to the opposition of the Claimants Applications were incorrectly calculated by the Registration Officer or by the Defendant. The Trade Mark Rules establish a period of two [2] months for the Applicant to submit a counterstatement to an opposition. Under the provisions of the Interpretation Act, the date on which a period of time is to be counted commences on the date after the event that commences the calculation. To properly illustrate the Claimant's deadline to file its counterstatements by October, 1, 2024, it is noted that the Oppositions Nos. 7286/TM2024 and 287/TM2024 were served on the Claimant on July 29, 2024.
- e. The Trade Marks Act does not require a specific form for indication of a response to opposition to an application.
- f. The Claimant's First indication of a response to opposition came on September 30, 2024.

- g. The Claimant was prejudiced by the incorrect decision that is the subject of this Appeal, as it prevented the Claimant from submitting further counter statements to the Defendant on October 1, 2024.

- [4] In the course of oral argument, I asked for, and received from the parties, submissions on the question whether a deeming provision can be rebutted by proof of facts to the contrary of that which was “*deemed*.” I understood Mr. Leiba to have withdrawn the contention that the filing of the counter notice was within the time stipulated (of two months). All three parties provided full written and oral submissions. I am grateful for the industry displayed but will not repeat the submissions. Counsel should rest assured that all arguments have been carefully considered and, informed my decision.
- [5] I have come to the conclusion that this appeal ought to be allowed. Statutory provisions are to be given the meaning which their clear words convey. Parliament, however, is presumed not to intend absurdity or injustice. To the extent possible therefore provisions must be given the meaning which avoids injustice or absurdity. The authorities long ago made this clear see, **Grey v Pearson (1857) 6 HL Cas 61** and **Adler v George [1964] 2 QB 7**.
- [6] The relevant updated provisions are rather hard to decipher given that the Act and subsidiary rules were recently twice amended. One amendment was to remove the power of the Respondent, hitherto enjoyed, to extend time to file counter statements. The relevant provisions now read as follows:

The Trade Marks Act:

“21. (1) The Registrar shall examine whether an application for registration of a trade mark satisfies the requirements of the Act and rules, and for that purpose shall carry out a search of earlier trade marks to such extent as the Registrar considers necessary.

(2) Where it appears to the Registrar that the requirements for registration are not met, the Registrar shall inform the applicant

and give him an opportunity, within such period (being not less than thirty days) as the Registrar may specify, to make representations or to amend the application.

(3) Where the applicant –

(a) fails to satisfy the Registrar that those requirements are met or to amend the application so as to meet them; or (b) fails to respond before the end of the specified period, the Registrar shall refuse to accept the application.

(4) The Registrar shall accept the application if it appears to him that the requirements for registration are met.

22. (1) On acceptance of the application along with the specified registration fee and advertisement fee, the Registrar shall cause the application to be published in the Intellectual Property Journal in such manner as may be prescribed.

(2) Any person may, within the prescribed time from the date of the publication of the application and in the prescribed manner, give to the Registrar written notice of opposition to the registration, stating the grounds of opposition.

(3) Where an application has been published, any person may, at any time before the registration of the trade mark, make observations in writing to the Registrar as to whether the trade mark should be registered; and the Registrar shall inform the applicant of any such observations.

(4) A person who makes observations does not thereby become a party to the proceedings on the application.

23. (1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application; and if the application has been published, such withdrawal or restriction shall be published in like manner.

(2) An application may be amended otherwise than under subsection (1), at the request of the applicant, but only by the correction of-

(a) the name or address of the applicant;

(b) errors of wording or of copying; or

(c) obvious mistakes,

and so long as the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

(3)...

24. (1) Where an application has been made for the registration of a trade mark and –

(a) no notice of opposition is given within the period referred to in section 22 (2); or

(b) all opposition proceedings are withdrawn or decided in favour of the applicant,

the Registrar shall register a trade mark unless it appears to the Registrar, having regard to matters coming to the Registrar's notice since the acceptance of the application, that it was accepted in error or unless the prescribed fee has not been paid within the prescribed period.

(2) Where the prescribed fee is not paid within the prescribed period, the application shall be deemed to be withdrawn.

(3) Where the registration of a trade mark is not completed within six months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in the notice.

(4)...

(5)...

60. (1) *Except where otherwise expressly provided by rules, an appeal lies to the Court from any decision of the Registrar under this Act and on any such appeal the Court shall have and exercise the same discretionary powers as are conferred on the Registrar under this Act.*

(2) *Any appeal that may be filed under this Act against a decision shall be filed within twenty-eight days after the date of the decision.*

(3)...

(4) *For the purpose of this section "decision" includes any act done by the Registrar in exercise of a discretion vested in him by or under this Act.*

74. *In proceedings before the Court under this Act, the costs of the Registrar shall be in the discretion of the Court, but the Registrar shall not be ordered to pay the costs of any other of the parties.*

78. *The Minister may from time to time make such rules subject to affirmative resolution –*

a. for regulating the practice under this Act including the service of documents;

b. to (f) ...

(g) generally, for regulating the business of the Office in relation to trade marks and all things by this Act placed under the direction or control of the Registrar."

[7] The **Trade Mark Rules (2001)** issued by the Minister pursuant to section 78 of the **Trade Marks Act** have been amended several times. The most recent being in 2022. The rules relevant to this matter are:

“Rule 12 (1) Any person may, within two months from the date of any publication of an application for registration of a trade mark, give to –

(a) the Registrar notice of opposition to the registration in Form TM4; and

(b) the applicant a duplicate of the notice.

(2) ...

(3) Within two months from the date of receipt of the duplicate referred to in paragraphs (1) and (2) the applicant shall file in duplicate a counter-statement on Form TM5 setting out-

(a) the grounds on which he relies in support of his application; and

(b) the facts, if any, alleged in the notice of opposition that are admitted by him,

and shall send a duplicate of the counter-statement to the opponent.

(3A) At any time before the two month period referred to in paragraph (3) expires, the parties may agree to a two month extension of time for the filing of Form TM5 (hereafter in this rule referred to as the “cooling-off period”).

(4) At any time before the expiry of the cooling off period the Registrar may, as he sees fit, grant such further extensions of time as may be –

(a) requested in writing by the applicant accompanied by the payment by the applicant of the cooling-off fee prescribed in the First Schedule; and

(b) agreed to in writing by the opponent, up to a period of six months following on the expiration of the cooling-off period.

(5) Within one month of expiry of the cooling-off period, the applicant may submit a counter-statement on Form TM5, to the

Registrar who shall send a duplicate of the counter-statement to the opponent.

(6) If the applicant fails to file a counter-statement within the period allowed by these Rules, the application for registration of the trade mark shall be deemed to be abandoned.

(7) to (18)...

Rule 53 (1) Where the time for doing anything under these Rules expires, the Registrar shall—

(a) in the case of an excluded day, extend that time to the next day, not being an excluded day; or

(b) in the case of such other day not being an excluded day, extend that time to such time as the Registrar may direct.

Rule 54 (1) The time or periods-

(a) prescribed by these Rules, other than times or periods prescribed by the rules mentioned in paragraph (6); or

(b) specified by the Registrar for doing any act or taking any proceedings,

may at the written request of the person or party concerned and upon payment of the fee prescribed in the First Schedule or on the initiative of the Registrar, be extended by the Registrar as he thinks fit and upon such terms as he may direct.

(2)...

(3) Subject to paragraph (4) a request for extension under paragraph (1) shall be made before the expiration of the time period in question.

(4) Where a request for extension is made after the time period referred to in paragraph (3) the Registrar may extend such time period if –

(a) *The Registrar is satisfied with the reason given for the delay in requesting the extension; and*

(b) *after consideration of any response or objection to the request by any other party, it appears to the Registrar that it is reasonable for the extension to be granted.*

(5)...

(6) *The times or periods excepted from paragraph (1) are those prescribed by rules 9(7), 12(1), 12(3), 14(2), 19(4), 21(4), 24(2), 25, 26(3), 34(2) and 35(2)".*

[8] Rule 54(6), by an amendment made in 2022, removed or reduced dramatically the power of the Registrar to extend various time periods. Interestingly the power to extend time in relation to Rule 10(2), that is the time to remedy deficiencies in an application for registration of a trade mark, was not removed. It may therefore not be a coincidence that Rule 10(2) does not “*deem*” an application, whose deficiency is not remedied within two months, as “*abandoned*” but rather provides that it shall be “*treated as abandoned*”. Parliament must have intended a different consequence, by the use of different words, in the same legislation.

[9] It is significant that the rules provide that, where an answer to the opposition (counter statement) has not been filed within time, the application for registration “*shall be deemed abandoned*.” A distinction ought to be drawn between a stipulation that something be “*treated*” as abandoned as against one which is “*deemed*” to be abandoned. Logically that which is deemed can be proven to be otherwise in that it is so deemed unless the contrary is established. However, a direction that something be “*treated*” in a particular way, is an indication that the real situation is irrelevant. “*Deeming*” suggests a mental attitude while “*treating*” suggests an action towards. The Oxford English Dictionary (3rd edition Revised) defines “*deem*” to mean “*regard or consider something in a particular way*”. “*Treat*” is defined as to “*behave toward or deal with in a particular way*”.

[10] This approach, to the construction of Rule 12, is supported by high authority since a “*deeming*” provision can be countered by evidence of the true situation see, **Timothy Watson v Rory Daley Junior et al [2023] JMSC Civ. 241 at paragraphs 17 and 18**, applying **Virgo v Graham [2023] JMCA Civ 31**. It is also supported by the fact that such an interpretation avoids absurdity. In the case at bar the Respondent had in hand two letters from the Appellant, written to her before the two month period expired. One letter informed of the appointment of an agent to continue the application and, the other requested an extension of time to file the counter statement. Yet, if the Respondent’s and the Interested Party’s interpretation of the deeming provision is correct, the Respondent is by law compelled to “*deem*” the application as abandoned. It is absurd to expect that, while she has in hand clear evidence to the contrary, the law absolutely compels her to “*deem*” the opposite. The man on the Clapham omnibus, and I daresay the ordinary Jamaican, would consider that situation not just absurd but decidedly unjust. It is therefore appropriate that in relation to Rule 53, where the Registrar’s power to extend time has been removed, a deeming unless proven otherwise construction is adopted; whilst in relation to Rule 10, where the Registrar must treat the application as abandoned, her power to extend time remains in place.

[11] Counsel for the Interested Party urged me not to treat the deeming provision in a less than absolute way. He stated that everyone ought to know the rules and therefore if someone was out of time their application should disappear. I think otherwise. In the first place one must interpret legislation for all people and for all time. In Jamaica it is unsafe, to say the least, to presume everyone to be sophisticated and hence familiar with the intricacies of this statute. Secondly, in this case the rule removing the power to extend time had been recently amended. Thirdly, even the Registrar’s letter of the 7th August 2024, advising the Appellant of the two month time period, used the word “*may*” rather than “*shall*” suggesting an element of discretion. Counsel also submitted that the removal of the Registrar’s discretion to extend time reduced the possibility of unfairness in the

way different applicants were treated. That may be so but, to my mind, nothing could be more unfair than striking out an application, on the ground of it being abandoned, while one knows that it is in fact being actively pursued. I think this court would be failing in its duty were it to construe this deeming provision in that way particularly because the Registrar has no power to extend time.

[12] The Appellant urged other points, such as whether subsidiary legislation could detract or take away from the governing Act. The Act he submitted envisioned a situation where applications and/or objections were decided by the Registrar. The rules, if the Respondent's interpretation was correct, envisioned the issue being determined by a deeming provision without consideration by the Registrar. It is an attractive argument. The net effect might be that an applicant with a perfectly good application could see it "*abandoned*" although the objection might be entirely unsustainable and frivolous. The subsidiary rules are, however, all subject to Parliament's affirmative resolution. I do not therefore, since the rule making power was conferred by Parliament, think that the rule in question could be overturned on this ground.

[13] The Appellant also urged that the letter, conveying the decision, was not issued by the Registrar and therefore for that reason should be set aside. This submission ignores the fact that the letter was followed by one from the Registrar, see the letter to the Appellant's attorneys dated 22nd October 2024 exhibit "AT1" to the affidavit of Adrienne Thompson filed 3rd April 2025. In any event the impugned letter merely conveyed the legal position as understood by the writer. Therefore, the validity of that letter cannot be challenged on the basis that a functionary had usurped the Registrar's authority. I would not have upheld that ground.

[14] In the result however, and for the reasons stated, I grant the following orders and declarations:

- a. The appeal is allowed.

- b. It is Declared that on a true construction of Rule 12 (6) of the Trade Marks Rules (2001) as amended by The Trade Mark (Amendment) Rules (2022) the Registrar is not required to deem an application to be abandoned where, at or before the time when the deeming provision is to take effect, the Registrar is aware that the application was not in fact abandoned.
- c. The Registrar is directed pursuant to power contained in section 60 subsection (1) of the Trade Marks Act to permit the counter statement filed by the Appellant to stand and to proceed to treat with the opposition proceedings in the usual manner.
- d. The court will hear submissions on costs.

David Batts
Puisne Judge