

## TRADE MARKS ACT 1995

### DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS WITH REASONS

Re: Opposition by the Real Estate Institute of Victoria Ltd to registration of trade mark application 1075971(9, 35, 36, 38 & 42) - **REALESTATE.COM.AU** - filed in the name of realestate.com.au Ltd.

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<b>DELEGATE:</b>	<b>Jock McDonagh</b>
<b>REPRESENTATION:</b>	<b>Opponent: Benjamin Fitzpatrick instructed by Griffith Hack Attorneys</b> <b>Applicant: did not wish to be heard</b>
<b>DECISION:</b>	<b>2009 ATMO 28</b> <b>Regulation 5.7 application for extension of time to file and serve evidence in support of opposition.</b> <b>Extension of time allowed, to be served by 16 April 2009</b>

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#### **Background**

1. Trade mark application number 1075971 in the name of realestate.com.au Ltd (“the applicant”) was advertised as accepted for possible registration on 17 January 2008. The statutory three month opposition period therefore ended on 17 April 2008.
2. On 16 April 2008, The Real Estate Institute of Victoria Ltd (“the opponent”) applied for an extension of time to file notice of opposition to 17 July 2008. This was approved by the Trade Marks Office. The opponent duly lodged its notice of opposition within time.
3. On 16 October 2008 the opponent applied for an extension of time to file and serve evidence in support of the opposition until 16 January 2009. The opponent stated that it was in the process of gathering and collating its evidence and required further time to complete the process. This application was approved by this office.
4. On 15 January 2009 the opponent applied for a further extension of time to file and serve evidence in support of the opposition, this time until 16 April 2009. The opponent again stated that it was in the process of gathering and collating its evidence and required further time to complete the process. This application offered no more explanation than its predecessor and was consequently not considered acceptable by this office. Further and better reasons in support of the application were sought.

5. The opponent provided, on 2 February 2009, a declaration containing evidence in support for the application for an extension of time. However, on 17 February 2009, a delegate of the Registrar of Trade Marks advised the opponent that the evidence was insufficient to support the application and offered the opponent an opportunity to attend a hearing on the matter. I quote from that declaration, my emphasis added:

"2. The Opponent is still in the process of gathering and collating its evidence in support of the opposition and requires further time to complete the process.

3. There are a number of parties who have filed Notices of Opposition against the registration of the above trade mark.

4. The Opponent is seeking to confer with one or more of the other opponents with a view to co-ordinating the opposition strategy.

5. The Opponent has **approached one** other opponent seeking a conference to discuss a co-ordinated opposition strategy.

6. The Opponent **had arranged an appointment with the director of another opponent and its legal representative but the meeting was cancelled due to the director travelling overseas.**

7. The Opponent is endeavouring to re-schedule the meeting for early March.

8. The Opponent **wishes to confer with the other opponent** prior to filing evidence in support and therefore seeks the extension."

6. The matter was set down before me, a delegate of the Registrar of Trade Marks, for a hearing on 26 March 2009, in Melbourne. The opponent was represented by Benjamin Fitzpatrick of counsel instructed by Griffith Hack Patent & Trade Mark Attorneys. The applicant was not represented at the hearing and did not wish to be heard.

### **Submissions**

7. Counsel drew my attention to Regulation 5 of the *Trade Mark Regulations 1995* ("the Regulations") and the relevant and oft-cited principles for the grant of an extension of time as follows:

- The broad discretion afforded by the Regulations cannot be reduced to insistence on imperative compliance with particular requirements.
- The exercise of this discretion requires proper, genuine and realistic consideration of all the relevant aspects that pertain to the application.

- The provision of a satisfactory explanation of the delay is a relevant consideration, but is not mandatory.
  - The public interest in determining a serious opposition on its merits is a relevant consideration and must be balanced with the requirement that matters before the office should be dealt with in an efficient manner and not be unduly prolonged.
  - The interests of the opponent, the applicant and any other parties are a relevant consideration.
8. Mr Fitzpatrick advised that the opponent had completed its evidence in support, copies of which had been filed with the Trade Marks Office and provided to the applicant. He submitted that the evidence was directly relevant to the ground of opposition based on s 41 of the *Trade Marks Act 1995*, as it relates to the legitimate interests of real estate agents in using domain names that include the term “real estate” together with the descriptive nature of that term.
  9. Counsel highlighted the proposition that there is a public interest that a serious opposition be dealt with on the merits rather than being shut out through a failure of procedure, citing *Kaiser Aluminium & Chemical Corporation v The Reynolds Metal Co* (1969) 120 CLR 136.
  10. Mr Fitzpatrick submitted that the interests of the opponent, indeed the entire real estate industry, favoured the grant of an extension. On the other hand, he submitted that there was no real disadvantage to the applicant.

### **Discussion**

11. The applicant’s trade mark does appear to include the name of an entire industry. The evidence that is sought to be relied upon raises what appears to be issues that are worth ventilating in a hearing.
12. Given the importance of the issues, I am somewhat surprised at the amount of time required to put together a four page declaration with exhibits that comprise information that seems quite readily available to the opponent and its attorneys.

13. While I agree with counsel for the opponent that the substance of an issue should prevail over process, I do not agree that there is no requirement to provide a satisfactory explanation for delay. To adopt such a course would only encourage laziness and lack of effort by parties to the opposition process. I must stress that a person applying for an extension of time bears the onus of establishing that the grant of more time is “appropriate”. This may be difficult to do where the extension applicant’s conduct is dilatory.
14. The *Kaiser Aluminium & Chemical Corporation v The Reynolds Metal Co* case, cited above, refers to failure of procedure, not failure of effort. There is still little explanation as to the reason it has taken so long to gather the relatively small amount of evidence sought to be adduced. However, the fact remains that such evidence has now been provided.
15. The Regulations buttress the requirement that matters before the Office should be dealt with in an efficient manner and not be unduly prolonged. This is an important consideration; however, I am also guided by the judgment of Dawson, Gaudron and McHugh JJ in *The State of Queensland v JL Holdings Pty Ltd* [1997] HCA 1; (1997) 189 CLR 146 at 154:

Case management is not an end in itself. It is an important and useful aid for ensuring the prompt and efficient disposal of litigation. But it ought always to be borne in mind, even in changing times, that the ultimate aim for a court is the attainment of justice and no principle of case management can be allowed to supplant that aim.
16. While this Office is not a Court, in exercising its administrative decision-making functions it is guided by judicial principles relevant to its decisions.
17. The evidence sought to be relied upon by the opponent has been filed with this Office and provided to the applicant. This fact, and the seriousness of the substantive matter, suggest that the extension can now be allowed.
18. In my opinion, while the public interest is not served where parties do not exert sufficient effort in supporting their claims, the public interest will best be served by the opposition process being assisted by relevant evidence being before the Registrar.

## **Decision**

19. My decision is to allow the application for an extension of time to file the evidence in support of opposition.
20. The evidence having already been filed with this Office, I direct that a copy be served on the applicant, as required by Regulation 5.7, on or before 16 April.

Jock McDonagh  
Hearing Officer  
Trade Marks Hearings  
07 April 2009