

TRADE MARKS ACT 1995

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

Re: Opposition by AKT Consultants Pty Ltd to an application under section 92 of the Act by Alfa Laval Lund AB to remove trade mark number 515492(11) - **AKT** - in the name of AKT Consultants Pty Ltd

DELEGATE: Jock McDonagh

DECISION: **Review of taxation of costs:** Fee for non-use application not a fee in relation to proceedings brought before the Registrar of Trade Marks

1. On 29 April 2003, the applicant filed application for removal from the Register of “and all other goods in this class” in the statement of goods for the trade mark. The opponent duly filed Notice of Opposition to the application on 28 August 2003.
2. The matter came before me as a delegate of the Registrar of Trade Marks for hearing in Sydney on 16 March 2005. On 27 June 2006, I decided to dismiss the opposition and directed that the opponent’s registration be amended as requested¹. I also awarded costs against the opponent.
3. The applicant filed a bill of costs with the Trade Marks Office, which was duly taxed. The Taxing Officer allowed all of the items claimed with the exception of the non-use application fee.
4. Pursuant to Regulation 21.12(4) of the *Trade Marks Regulations 1995* (the Regulations), the applicant sought a review of the taxation of costs, submitting that removal application fee was a fee in relation to proceedings before the Registrar.
5. On 30 May 2006, I advised the parties that my preliminary view was that proceedings before the Registrar are commenced by the filing of a Notice of Opposition and sought submissions from the parties within 28 days. I also allowed the applicant an opportunity to be heard. Both parties declined to make further submissions.

¹ [2005] ATMO 36

6. Section 221 of the *Trade Marks Act 1995* empowers the Registrar to “award costs in respect of the matters, and in the amounts, provided for in the regulations against any party to proceedings brought before him or her.” Two key issues arise from this power: first, awards are made “against a party”; second, the costs are against a party “to proceedings brought before him or her”.
7. In *Stack v Commissioner of Patents* [1999] FCA 148 , at paragraph [23] Drummond J found:

I regard the expression "proceedings before the Commissioner" in s210(d) as a reference to a matter comprising a determination by the Commissioner with respect to the exercise or non-exercise of a power conferred on him by the Patents Act which he is permitted to make only after hearing the persons with opposing interests in the exercise of the power.
8. Section 210(d) of the *Patents Act 1990* confines the Commissioner's power with respect to costs to awarding costs "for the purposes of this Act" and to awarding costs "against a party to proceedings before the Commissioner". Thus His Honour’s finding is directly relevant to proceedings before the Registrar of Trade Marks.
9. For costs to be payable, there must be opposed parties. Thus, a removal application that is not opposed will proceed to the removal with the cost of the application fee borne by the applicant.
10. For there to be opposed parties to proceedings before the Registrar, there first must be a Notice of Opposition filed. This is the initiating document and the fee for it is the first that may be subject to an order of costs.
11. Having reviewed the taxation of costs, I affirm it and confirm that costs will be certified without the inclusion of the application fee.

Jock McDonagh
Hearings Officer
Trade Mark and Design Hearings
5 July 2006