



## TRADE MARKS ACT 1955

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

**Re:** Application for extension of time for registration of trade mark application number **521525** in the name of **MAYFAIR INTERNATIONAL PTY. LIMITED**

#### **Background**

Trade mark application 521525 was advertised accepted for registration in the *Official Journal* of 2nd January, 1992. It had proceeded in the name of Mayfair International Pty. Limited, a company incorporated in New South Wales, of 36-42 Chippen Street, Chippendale, New South Wales, 2008 and was accepted in respect of "luggage, bags, cases, travel goods and accessories for travel goods being goods in this class; wallets; purses; haversacks; and all other goods in this class". An extension of time was lodged on 27th March, 1992 to file notice of opposition to registration of the mark. A notice of opposition, under the provisions of section 49 of the Act, was lodged on 30th June, 1992 by Logomark, Inc., of Avenida Principal, Los Angeles, No. C-17, P.O. Box 9A-1074, Panama City 9A, Republic of Panama. Logomark, Inc. applied for two three month periods of extension of time within which to serve evidence in support of the opposition which were granted to 30th March, 1993. Subsequently, by a letter dated 26th March, 1993 the attorneys acting on behalf of Logomark, Inc., Spruson & Ferguson of Sydney, advised the Office that the opposition to registration of the subject mark was withdrawn. An official letter dated 19th April, 1993 was despatched to a firm of solicitors and trade mark attorneys, Holzman & Co. of Sydney, acting for the applicant, advising the withdrawal of the notice of opposition. In the same letter the applicant was informed that the delegate of the Registrar had directed that the subject trade mark be registered on or before

19th July, 1993, and that the registration fee was still outstanding. It also mentioned that the withdrawal of the notice of opposition was to appear in the *Official Journal* of 6th May, 1993.

On 13th September, 1993 a letter requesting an extension of time of three months within which to register the subject trade mark, pursuant to section 131, was received from the applicant's solicitors, together with two statutory declarations with an exhibit, and payment covering late extension and registration fees. The first declarant, Rachele Holzman, a secretary employed in her husband's legal firm Holzman & Co., states that the premises where the firm, Holzman & Co. is located are shared with two other legal firms, Gridiger & Co. and Neil Lawson & Co. The mail delivered to the three firms is placed on the common reception desk each morning where it is then collected by a secretary from each of the three firms. On occasions when the mail is mistakenly taken by a secretary from one of the other firms, it is handed to the correct party as soon as the mistake is noted. She further declares that since early 1993 the firm Neil Lawson & Co. has not had a permanent secretary, but has employed temporary secretaries working for only brief periods, some for only one or two days. On 3rd September, 1993 Mrs. Holzman had been requested to tidy up a small desk which that day had been transferred from rooms occupied by Neil Lawson & Co. to the room of Holzman & Co. On sorting out a large number of papers which had been left on the top of the small desk, she noted an unopened envelope from the Trade Marks Office addressed to Holzman & Co. which she opened and stamped 3rd September, 1993, being the date of receipt of the letter. As the letter was dated 19th April, 1993, she immediately drew it to the attention of Gary Holzman. She says she has no knowledge as to why the letter was amongst the papers on the desk but assumes that one of the temporary secretaries who had worked for Neil Lawson & Co. may have picked up the letter from the reception desk by mistake and left it with some other papers on the desk in the room occupied by Neil Lawson & Co., as she did not know who Holzman & Co. were.

The declarant of the second declaration, Mr. Gary Morice Holzman, solicitor of Holzman & Co., states that a small desk owned by him had been left in the rooms used by Neil Lawson & Co. He had recently decided to transfer the desk to his office and had requested his secretary Rachelle Holzman to sort through a large number of papers which had been left on top of the desk. While sorting out the papers, the secretary had discovered a letter from the Trade Marks Office addressed to Holzman & Co. Upon reading the letter, which is appended to the declaration as exhibit "A", the declarant realized that the date for registering the present application had expired and therefore immediately contacted the Trade Marks Office. He had been advised by a person, whose name he does not recall, to request a late extension of time to register the subject trade mark and to remit the fees involved.

In an official letter of 20th September, 1993, the applicant was advised that the requested extension of time for registration of the mark was not allowable. Although it was agreed that the failure to pay the registration fee had been caused by reason of circumstances beyond the control of the applicant, the Registrar had to take into account all the circumstances of the case including the interests of persons who had acted in the belief that this application had lapsed. It was considered that in the present instance reinstatement of the application would adversely affect the rights of Logomark, Inc., proprietor of a later lodged application No. 526369.

Consequently, the applicant applied for a hearing on the matter which was held in Canberra on 12th January, 1994. Mr. Gary Holzman, solicitor of Holzman & Co. appeared for the applicant.

### **Submissions**

Mr. Holzman commenced his submissions by outlining the history of the present application as well as two other applications for trade marks which have now been registered, No. 511100 in class 18 and No. 512524 in class 42. He then tendered two statutory declarations, with

exhibits, of Mr. Leonard Frederick Milner, director of the applicant company, concerning use of the subject trade mark in Australia since 1989. Mr. Milner declares that he had no knowledge of Logomark, Inc. until service of the notice of opposition, that he has never had any contact or communication with that corporation, and that he believes no other party but his company has used the mark in Australia either before or after November, 1989.

Mr. Holzman had caused a search of the Australian Securities Commission records on Logomark, Inc., which had not revealed any such registered business name in Australia, and he has been unable to obtain any information on that corporation. He suggested, however, that there could be some connection with Jack & Jones Collections Limited, the company which had opposed registration of the applicant's marks 511100 and 521524.

He further submitted that in exercising his discretion the Registrar should consider the extension of time issue in light of all the circumstances of the case (see *J. Lyons & Co Ltd's Appn* (1959) RPC 120), including public interest (*W & G Du Cros Ltd's Appn* (1913) 30 RPC 660). He then referred to *Crooks Michell Peacock Stewart v Mark Kaiser* 1992 AIPC 90-883 in which the delegate of the Registrar, dealing with the provisions of s 130 and reg 69 of the Act, had drawn on three factors considered in *Lyons v Registrar of Trade Marks* (1983) 1 IPR 416, namely: the public interest and the consequences of the decision for both the applicant and for the opponent. Relying on these factors Mr. Holzman advanced the argument that, despite serving a notice of opposition and requesting extensions of time, Logomark, Inc. had not lodged any evidence as to use of its mark. Furthermore, if the current extension of time were not granted and in the event of Logomark becoming the registered proprietor of the mark, then the members of the public would be misled and confused, because they have associated the mark with the applicant in view of its extensive use, as established in the evidence. Concerning the two other factors, Mr. Holzman said that Logomark, Inc. had had every opportunity to establish its rights in the mark, therefore it was difficult to see how it could be adversely affected by a

decision to grant the requested extension of time, particularly in the instance where the subsequent application by Logomark, Inc. had been deferred. It was noted by him that the period of time between the lapsing notice being advertised and the applicant becoming aware of it was less than a month. He further stressed that it was not uncommon occurrence to reinstate applications, and with reference to D R Shanahan's *Australian Law of Trade Marks and Passing Off*, 2nd ed., p 61, reminded me that the mere fact that a lapsing notice of an application had appeared in the *Official Journal* was not sufficient for the Registrar to exercise his discretion against extension of time.

Mr Holzman then directed my attention to two cases concerning the exercise of the Registrar's discretion in allowing extensions of time. In the first of these cases, *Re Application by D R and E M Sefton*, 11 IPR 424, the restoration of registration of a mark was allowed even though the rights of another party were to be affected by the restoration. It had been found that there had been no use of the mark in Australia other than by the applicants. Any disadvantages to the other parties, it was decided, would be minor when compared to the major disadvantages to the applicants of losing their presumptive validity rights under s 61. The facts of this case are similar to the matter in suit, Mr. Holzman contended. In the second case, *Metropolitan Dairies Pty Ltd v Pura Natural Spring Waters Pty Ltd*, (1990) AIPC 90-684, the Registrar allowed an extension of time for renewal of registration, notwithstanding the fact that another party was to be adversely affected by an infringement action taken against them by the applicant on the basis of the trade mark of the registration and by an action of removal of the mark from the Register under s 23 of the Act. In addition, Mr. Holzman noted that although it was not stated in the case itself, the Trade Marks Office records revealed that the party opposing the renewal of registration had applied for subsequent applications to register similar marks in respect of the same goods, one of the applications having been lodged within the period of time when the applicant's mark had been removed from the Register. This situation, he pointed out, was analogous to the present one.

## Decision

Section 131 provides that

131(1) Where, by reason of -

- (a) circumstances beyond the control of the person concerned; or
- (b) an error or action on the part of an officer or person employed in the Trade Marks Office,

an act or step in relation to an application for the registration of a trade mark or in proceedings under this Act (not being proceedings in a court) required to be done or taken, the Registrar may extend the time for doing the act or taking the step and permit the act to be done or the step to be taken.

(2) The time required for doing an act or taking a step may be extended under this section although that time has expired.

In these proceedings the first consideration must be to determine whether the failure to pay the registration fee before the time specified was caused by "circumstances beyond the control of the person concerned", as prescribed by para 131(1)(a) of the Act. In *Atomic Skifabrik Alois Rohrmoser v The Registrar of Trade Marks* (1987) AIPC 90-365 Jenkinson J. said at p 37294:

"In the context in which it is found, the expression "circumstances beyond the control of the person concerned" does in my opinion designate - and designates only - occurrences which neither the person concerned nor any person acting on his behalf to do the act or take the step could prevent. The operations of nature and the activities of strangers may result in such occurrences. So, too, may the acts and omissions of certain independent contractors engaged by the person concerned or by his agent, as for example the carrier of mail or the office cleaner, either of whom causes the loss or destruction of a document to be filed. But the acts or omissions of the agent who on behalf of the person concerned is to do the act or take the step are not occurrences of the description specified in para. 131(1)(a), in my opinion. Nor, in my opinion, are the acts or omissions of that agent's servants. The section is, I think, correctly described

as a force majeure provision."

It is clear from the statements in the statutory declarations submitted by Mrs. Holzman and Mr. Holzman that although the official letter of 19th April, 1993 had been delivered to the premises shared by the three firms of solicitors and presumably placed on their common reception desk, it had been removed by an unidentified person not responsible to or employed by the applicant's solicitors, Holzman & Co., and had been left on a desk located in an area occupied by another firm of solicitors. In the circumstances, I believe, neither Mr. Holzman nor Mrs. Holzman could have been aware of the contents of the material on top of the desk or in its drawers before the time Mr. Holzman expressed a need to have the desk, his property, to be returned to his office.

Sub-section 54(1) of the Act prescribes that a trade mark be registered within 12 months from the advertisement of acceptance. However, where a delay has arisen through opposition or court proceedings, or death of the applicant, to register a trade mark, the Registrar directs the registration date depending on the circumstances of the case, under the provisions of sub-ss 54(3) and (4), and advises the applicant accordingly. It could not be expected that in the present case Mr. Holzman, acting on behalf of the applicant, could have anticipated the date of registration of the application before receipt of the official letter of 19th April, 1993, which advised the applicant of the withdrawal of opposition and the date of registration directed by the Registrar, under s 54 of the Act.

In view of my previous comments, I find that the failure to pay the registration fee was caused by circumstances beyond the control of the person concerned, within the meaning enunciated by Jenkinson J. in *Atomic Skifabrik v Registrar*, supra.

Turning to the question as to how the granting of the requested extension of time, and the subsequent registration of the applicant's mark, would affect Logomark, Inc., the applicant of application No. 526369 for an identical mark in respect of the same goods, I note Mr. Milner's

statements in his statutory declarations that the subject mark has been used throughout Australia continuously since November, 1989, which indicates use almost since lodgment of the application, being 23rd October, 1989. The goods bearing the mark, he continues, are being sold through Mayfair Boutique Pty Ltd, which operates shops under the names Jack & Jones and Pierre Cardin, and through wholesale by sale to a number of leading Department stores, duty free shops and other retailers. More detailed information on these outlets is provided in Mr. Milner's second declaration. It appears therefore that the applicant has established some reputation in the mark of this application. If the same mark has also been used in Australia by Logomark, Inc., no evidence of that use has been made available. In this regard I draw a parallel with the situation in *Sefton* case, supra. Had Logomark, Inc. seriously wished to challenge the applicant's claims to proprietorship, use or reputation, or any other claims, it should have pursued its opposition to registration of the subject mark. From the time of lodging the notice of opposition to the expiry of the second period of extension of time within which to serve the evidence in support, it had nine months at its disposal to act on the matter, but it chose not to do so. I agree with Mr. Holzman's submissions therefore that Logomark, Inc. had ample opportunity to establish its alleged rights in the mark. In my opinion, a party which has not actively endeavoured to ensure protection of its interests when the opportunity arises, cannot be disadvantaged to a greater degree than the applicant in the present instance, who, by losing rights otherwise to be granted by registration of the subject mark, would need to resort to expensive and time consuming litigation in the process of protecting its rights.

### **Conclusion**

Having considered the current circumstances in light of the findings in *Sefton* and *Metropolitan Dairies v Pura Natural Spring Waters*, both supra, I conclude that the granting of the

requested extension of time is warranted under the provisions of para 131(1)(a) of the Act. I therefore allow the extension of time for registration of trade mark application 521525.

V. Zars

Acting Hearing Officer

24 January 1994