TRADE MARKS ACT 1955

DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS

Re: Application number 560537 to register a trade mark in the name of PACIFIC ACCESS PTY LTD - Proposal to withdraw acceptance

Application number 560537, in the name of PACIFIC ACCESS PTY LTD, was lodged on 29 July 1991 for the mark, as shown below, to cover what is essentially the Class heading for International Class 16. Following examination, the mark was advertised as accepted in Part A of the Register in the *Official Journal* of 18 February 1993.

The applicant was then advised in an Official letter of 12 March 1993 that:

> "A search was carried out, but, following acceptance of the application, was found to be deficient, in that a number of citable marks had not been extracted or considered. On re-search a total of fourteen marks were found which contain the words PACIFIC or ACCESS solus and where the goods are considered to be goods of the same description as those of the accepted application A560537. These marks should have been raised as citations in the first examination report."

The implication was that, had the information been brought to the attention of the acceptance officer and taken into account, then objections to the mark's registration would have been taken under s.33 of the Act. However, this was not stated in the advice to the attorney which comprised the Assistant Registrar's proposal to withdraw acceptance.

The applicant asked to be heard on the matter as to whether or not acceptance of the mark should be withdrawn under paragraph 44(3)(a) of the Act and it became the subject of a hearing before me in Melbourne on 1 June 1993. The applicant was represented by Mr J. Roger Green of Carter Smith & Beadle.

Mr Green submitted that the advice from the Office did not give any valid grounds as to why it was proposed to withdraw acceptance of the mark although he surmised that objections would subsequently be taken under s.33 to the mark's acceptance. He said that the examiner who had conducted the original search had extracted, considered, but not cited, three marks which were now included in the fourteen marks intended to be raised as citations. It was not apparent why these and the additional eleven marks now also proposed to be cited had not been extracted during the original search. He said that it was significant that the mark had been advertised as accepted in the *Official Journal* of 18 February 1993 and that the opposition period had now expired without any objections being raised to the mark's registration. His further submissions concerned whether the existence of any of the potential citations was sufficient reason for the present mark not to be accepted. He concluded by asking me to award costs to the applicant as it had been inconvenienced by having to attend a hearing in the matter.

Decision

Sub-section 44(3), as it relates to the matter in hand, reads as follows:

> Where, after the acceptance of an application for registration of a trade mark but before the registration of the trade mark, the Registrar is satisfied-
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> (a) that the application has been accepted in error;...
>
> the Registrar may withdraw the acceptance and proceed as if the application had not been accepted.

I am therefore required to decide, firstly, if the mark was accepted in error and secondly, if it was, if the Registrar's discretion should be exercised to withdraw acceptance. I should note here that I have not considered Mr Green's submissions on whether the fourteen marks proposed to be cited are any bar to registration to the present mark under s.33. As I have stated, the issue of this hearing is whether an error has occurred in acceptance and whether to exercise the Registrar's discretion to withdraw it. Any submissions regarding whether such marks are substantially identical or deceptively similar should more properly be made in response to an examiner's report which details the objections or at a hearing specified to decide the matter.

In the Office decision re *Remington Inc's* Appln, (1990) AIPC 90-680 (the *Smooth and Silky* case), the Hearing Officer said that there was a paucity of trade mark decisions relating to withdrawal of acceptance but, in applying decisions of the Deputy Commissioner of Patents in relation to a Patents matter and the High Court in relation to s.44(3):

> ...'accepted in error' must thus be restricted to mean acceptance of a trade mark where the acceptance officer is either mistaken as to the facts or in ignorance of the facts. It cannot be extended however to the reversal of a decision to accept when there is no more than a change of opinion as to the way the facts should be interpreted.

Mr D.R.Shanahan, in his book on trade marks says at p.62 regarding the Registrar's discretion to withdraw acceptance:

> This power is used infrequently, but the Registrar will withdraw acceptance where it is found, for example, that the examiner has missed a relevant dictionary meaning or an earlier registration that is clearly in conflict

In the present case, it is evident from the case file that the acceptance officer had access to the original search strategy and resultant extract list prior to the issuance of the examiner's first report. This report did not contain any objections to acceptance under s.33. I have had the opportunity to view the original search and the later search conducted post-acceptance. I am

of the opinion that, although the rationale used in that subsequent search is, in most respects, the same as the original, it did produce an extract list including marks which had not been placed before the acceptance officer at the time of the first report and later acceptance. Thus, there has been an "error" in acceptance as contemplated by s.44(3) in that the acceptance officer was not in possession of all the facts at the time of acceptance. However, I think it is significant to note that, as pointed out by Mr Green, three of the potential citations listed in the Official letter of 12 March 1993 were listed in the original extraction list and therefore must have been considered in the first instance. This would indicate that, at least for those marks, there has been a change of opinion as to whether they constituted objections under s.33 to the mark's acceptance and not "an ignorance of the facts". However, this still leaves eleven marks which had not been considered in the first instance. Thus, the first part of the question referred to in s.44(3) has been answered; that I, as the Registrar's delegate, am satisfied that the application has been accepted in error. Notwithstanding the foregoing, I think that an applicant is entitled to a brief explanation in any advice of a proposal to withdraw such acceptance as to how that error occurred and the section of the Act which would, following the withdrawal, form an objection to the mark's acceptance. Such was not the case here.

I must now turn to the question of whether, having found that the application has been accepted in error, the Registrar's discretion should be exercised adversely to the applicant and acceptance withdrawn in the matter. I have come to the conclusion that it should not. I think it is significant that no oppositions or other complaints have been lodged to the mark's registration. I therefore feel that this supports the view that the public interest, which is my primary concern, will not be harmed if the mark proceeds to take its place on the Register. Any withdrawal of acceptance should not be proposed lightly and, while I have found that an "error" did occur, I do not agree that the applicant should be put to the further expense of prosecuting its application in the face of what do not appear to be strong objections to its acceptance. I think that the balance of convenience must lie with the applicant and the best course is to maintain the status quo by not withdrawing acceptance.

Conclusion

As a consequence of the foregoing, I find that trade mark application number 560537 for the mark PACIFIC ACCESS and TRIANGLE device has been accepted in error but that the Registrar's discretion should not be adversely applied by withdrawing acceptance. I therefore direct that the mark should proceed to registration.

With respect to Mr Green's submission seeking costs on behalf of the applicant in the matter, there is no precedent for such an action. The Registrar is a public official charged with safeguarding the public interest. The proposal to withdraw acceptance was not an unreasonable one but based on a legitimate effort to ensure that conflicting marks do not co-exist on the Register. I therefore do not think that it is exceedingly onerous for the applicant to bear all of the costs associated with prosecuting its application to registration. I therefore refuse to award costs in the matter in the applicant's favour.

Ian Forno
Hearing Officer

14 June 1993