



TRADE MARKS ACT 1955

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

**Re: Objection by VESUDI PTY LIMITED to a Request for Extension of Time by SUPACENTA
PTY LIMITED in which to lodge Notice of Opposition to Application No 578119**

Application for registration No 578119 was lodged on 12 May 1992 in the name of VESUDI PTY LIMITED. Acceptance of the application was advertised on 25 August 1994 following examination. The mark sought to be registered consists of the words SUPA CENTA together with the device of an elephant's head within the C of the word CENTA. On 10 November 1994 SUPACENTA PTY LIMITED requested an extension of time to lodge notice of opposition to the registration of the trade mark pursuant to s49 of the Act. This company claimed to be the proprietor of the trade mark having acquired the title to it by purchase from the receivers of the applicant company, VESUDI PTY LIMITED. It was claimed that additional time was required to enable the transfer of the trade mark to itself or to arrange for the the withdrawal of the application. By letter dated 30 November 1994 the applicant formally objected to the grant of the requested extension. In that letter it was claimed that the applicant had never been placed in receivership and that the trade mark had never been transferred to SUPACENTA PTY LIMITED. Rather, the applicant, which was the trustee of a trust known as The 1990 Trust, had been deregistered and it was proposed to substitute the subsequent trustee as the applicant for registration of the trade mark. The matter was set down for hearing in Sydney on 2 March 1995. Mr Andrew Ford, solicitor, of Sydney Cove Law Group appeared on behalf of the applicant and Ms Catherine Chant of Davies Collison Cave, patent attorneys, on behalf of the opponent.

At the hearing Mr Ford repeated the allegations contained in the letter of 30 November 1994 and submitted that the opponent had not made out a proper case for the grant of an extension of time to lodge notice of opposition which was not an entitlement but which required adequate justification. The onus was on the opponent to provide such justification to the Registrar and this the opponent had failed to do. He further submitted that there was no question of public interest involved in the proposed opposition as the applicant had at all times been the owner of the trade mark and that therefore there was no serious opposition intended.

Ms Chant stated that the opponent had lodged its own application to register the trade mark, no. 646691, on 24 November 1994 and in the course of preparing to do so had only become aware of the applicant's application some three weeks before the expiry of the initial three-month period provided for by s49. She submitted further that as there was a dispute as to the proprietorship of the trade mark there was in fact good reason for lodging the notice of opposition and that there was a serious opposition foreshadowed: *Carlton and United Breweries v Miller Brewing Company* 9 IPR 295. Furthermore, since the use of the mark by the applicant would be deceptive there was a public interest involved in denying its registration by the applicant. Ms Chant claimed that the opponent had become entitled to the proprietorship of the trade mark by virtue of the purchase of the assets of the applicant company but that the applicant had failed to execute a deed of assignment of the trade mark. There was therefore a serious dispute as to the proprietorship of the trade mark. The opponent had in fact lodged its notice of opposition to registration by the applicant on 2 February 1995 but required an extension of time until that date from the due date which was 25 November 1994.

Mr Ford replied that the fact that the opponent had only become aware of the application in November was not a good reason for the grant of the extension since the application had been a matter of public record since the lodgment date, 12 May 1992. It was by its own omission to search the Register earlier that the opponent had been unaware of the application. It was also in the public interest to refuse the extension because use of the trade mark by the opponent would lead to deception or confusion.

Decision

The authorities on extension of time show that there are a number of relevant considerations to be taken account of. Among these are the following:

- whether the opposition is a serious one: *Vangedal Nielsen v Commissioner of Patents* (1980) 33 ALR 144
- whether there is a question of public interest involved for which the Registrar is responsible: *Bali Trade Mark* [1966] R.P.C. 387; *Pioneer Hi-Bred Corn Co v Hy-Line Chicks Pty Ltd* [1979] R.P.C. 410
- whether the allowance of the extension would cause prejudice to the other party: *Stafford Miller Ltd v Cosco Holdings Ltd* (1989) 15 IPR 199

As Shanahan points out at p65 of his book *Australian Law of Trade Marks and Passing Off* 2nd ed The Law Book Company Limited, 1990, the stipulation of Bowen CJ in *Vangedal Nielsen* that there should be a "serious opposition foreshadowed" has been the subject of some explanation. "In decisions of the Commissioner, his Honour has been taken to mean only that the opposition should be seriously intended (as distinct from frivolous or vexatious) rather than that the prospective opponent should demonstrate that the opposition would have significant prospects of success" see, for example, *Poltrock v Ennor* (1986) 8 IPR 217. I would agree with that explanation of *Vangedal Nielsen* and find that the applicant for extension of time has demonstrated that it is serious in its opposition and that there is a serious matter, proprietorship of the trade mark, at issue.

It follows from the above that if the opponent is in fact the owner of the trade mark the use of it by the applicant would be deceptive and it has been held in many cases before the Registrar that there is a strong public interest in denying registration to deceptive trade marks eg: *Bundy American Corp. v Rent-A-Wreck (Vic.) Pty Ltd* (1985) 5IPR 307; *Lord Bloody Wog Rolo v United Artists Corp.* (1988) 11 IPR 516. In these circumstances there is a public interest in allowing a potential opponent who makes serious claims to the proprietorship of a trade mark sought to be registered by another the opportunity to prove its case.

The applicant has not shown me that it would be peculiarly disadvantaged if the extension is allowed. Of course opposition proceedings will delay the registration of the trade mark should the applicant ultimately prove successful. But as Ms Chant pointed out this delay is part and parcel of all opposition proceedings and is inherent in them and the applicant has not demonstrated any special disadvantage peculiar to it which would tip the scales in favour of disallowing the extension of time.

For the above reasons I allow the opponent SUPACENTA PTY LIMITED an extension of time from 25 November 1994 until 2 February 1995 in order to lodge notice of opposition to application no. 578119.

Both parties made submissions as to costs but I see no reason to depart from the normal practice that costs should follow the event. I therefore award costs in the matter of this extension of time to the opponent SUPACENTA PTY LIMITED.

Michael Homann
Hearing Officer

12 May 1995