**TRADE MARKS ACT 1955**

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

**Re:** Application for extension of time for acceptance of trade mark application number 578539 in the name of **OVERLAND FOOTWEAR COMPANY LIMITED, formerly SHOETOWN LIMITED**

## Background

The first examiner's report on application No 578539 for the mark OVERLAND was despatched to Shoetown Limited, the applicant, on 24th June 1993. A notice in terms of s 48 of the *Trade Marks Act 1955* was issued on 28th June 1994, advising the applicant that acceptance of the application was due on 28th September 1994. A change of the applicant's name to Overland Footwear Company Limited was recorded on 28th July 1994. On 10th August 1994, a further report was despatched in response to the applicant's submissions of 20th July 1994. The applicant's submissions in relation to that report, together with one month's extension of time request and a late fee, were received on 28th October 1994 taking the final date for acceptance of the application to the day the request for further time was received, namely, 28th October 1994. The examiner duly issued another report on 21st November 1994, but, because the applicant failed to apply for further extension of time beyond 28th October 1994 to place the application in order, the application was advertised as lapsed in the *Official Journal* of 5th January 1995. Having received an appropriate extension of time application and late fees, the Registrar's delegate revived the application on 20th January 1995. As the applicant had failed to overcome an outstanding objection and in the absence of further applications for extension of time, the application was again advertised as lapsed in the *Official Journal* of 25th May 1995.

In a letter of 14th June 1995, the applicant made further submissions on the outstanding objection and forwarded fees for an extension of time to 28th June 1995 for acceptance of the application. By an official letter of 22nd June 1995, the applicant was advised that the application could not be revived, having regard to the existence of application No 662153 for an allegedly deceptively similar mark, lodged one day after the present application was advertised lapsed. The applicant then requested a review of the Registrar's refusal to revive the application in light of contents of a statutory declaration and exhibits. In a letter of 7th September 1995, the Registrar's delegate advised that, as the revival of the application would adversely affect the rights of the proprietor who lodged the later application, the delegate did not propose to revive the application.

Consequently, the applicant applied for a hearing on the matter which was held in Canberra on 27th October 1995. The applicant was represented on telephone by Mr Trevor Dredge of Intellpro, patent and trade mark attorneys of Brisbane.

Before commencement of the hearing, Mr Dredge transmitted to me, by facsimile, a copy of an extract from the Melbourne telephone directory, copy of a letter from Davies Ryan De Boos and copies of Australian Securities Commission searches for the applicant of application No 662153, all of which he intended to refer to in his submissions at the hearing.

**Submissions**

Mr Dredge first explained that, following revival of the application, the case was diaried in his office for 20th March 1995 with the remark "accepted" rather than the words "extension requested", hence, when the matter came up for action, it was simply extended to the next month. As a consequence of that error, the application lapsed a second time. Throughout this period, the attorneys for the applicant in New Zealand and Australia believed the application to be on foot. A response to the examiner's further report, dated 14th June 1995, was lodged after the application had been advertised lapsed. At the time of preparing this response, the failure to apply for a further extension of time was found, the extension was requested and fees paid. In the meantime, application No 662153 had been lodged for the mark OVERLAND FOOTWEAR in respect of "the retail sale of clothing,

footwear and accessories, all being goods (sic) included in class 42 of the register" by Direct Solutions Melbourne Pty Ltd.

He then referred to the statutory declaration which was lodged in support of the application for an extension of time in the present case, dated 14th June 1995. This declaration by Shane Anselmi, director of the applicant company, Mr Dredge said, attested to the existing reputation in Melbourne and showed that the trading style "Overland Footwear" of Shoetown Limited had been used for the manufacture of shoes in Melbourne and therefore was known to the retail community of Melbourne. Mr Anselmi had also included a letter from Mr T J Mason concerning Mr Anselmi's enquiries on establishing stores in Australia, in particular in relation to two stores in Victoria. In his opinion, that information could have been available to manufacturers of shoes. On investigating the addresses for Direct Solutions Melbourne Pty Ltd appearing in the Melbourne telephone directory and on the documents held by Australian Securities Commission, it had been ascertained that there was no actual trading premises for the business. There was, however, evidence that the company was a direct marketing concern. Furthermore, no actual use of the trade mark of application 662153 had been found. In view of the background and the results of the investigations, Mr Dredge submitted, the circumstances of lodging application No 662153 appeared to be other than coincidental. There was strong circumstantial evidence that the application had been filed to take some advantage over the present applicant.

Mr Dredge further advanced the view that the wording of the statement of services of application No 662153, more suitable for goods in class 25, suggested prior knowledge of the present application which is also for services in class 42.

Referring to the reasons for the Registrar's decision not to revive the application, Mr Dredge contended that the main factors to be considered here were the public interest and interests of the parties. The applicant had an existing reputation, particularly in Melbourne, and if the extension were to be refused, it would delay, by at least two years, resolution of the proprietorship issue of the mark. Moreover, the applicant had spent much time and effort in establishing its reputation and also in attempting to secure registration of the mark. On the

other hand, Direct Solutions Melbourne Pty Ltd did not appear to use the mark, there was strong evidence that its application was filed dishonestly and it did not have any existing proprietorship rights.

**Decision**

If an application has not been accepted within 12 months from the date of the examiner's first report and the acceptance has not been deferred under the provisions of sub-section 33(3), under the Act of 1955 the Registrar's practice has been to forward to the applicant a notice under the provisions of s 48, warning the applicant that the application would lapse unless accepted within three months, or within such further time as the Registrar allows. In the present circumstances, the applicant succeeded in having a belated application for extension of time allowed, and subsequently the application was revived on 20th January 1995, even though it had been advertised lapsed.

Where lapsing of an application has been advertised, the belated extension of time application for revival of the present application needs to be considered in terms of s 131 of the Act. That section of the Act provides that

> 131(1) Where, by reason of -
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> (a) circumstances beyond the control of the person concerned; or
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> (b) an error or action on the part of an officer or person employed in the Trade Marks Office,
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> an act or step in relation to an application of 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.

What constitutes the term "circumstances beyond the control of the person concerned" in the section, has been explained by Jenkinson J in *Atomic Skifabrik Alois Rohrmoser v Registrar of Trade Marks* (1987) 7 IPR 551 at p 558:

> "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 s. 131(1)(a), in my opinion. Nor, in my opinion, are the acts or omissions of the agent's servants. The section is, I think, correctly described as a force majeure provision."

Neither Mr Dredge in the submissions, nor Mr Anselmi in his declaration, has provided detailed information as to who was responsible for the incorrect diary entry which caused the lapsing of the application a second time. It seems to be clear, however, that the error was made by a person employed by Mr Dredge's firm who had been entrusted with the responsibility of recording appropriate entries in the diary for future actions in relation to trade mark applications and registrations. As the matter stands, in view of the criteria set out in *Atomic Skifabrik v Registrar*, supra, I do not think the error falls in the category of occurrences which could not be prevented by the person in charge of the matter or persons acting on his behalf to carry out the responsibility, as envisaged by Jenkinson J.

The main thrust of Mr Dredge's submissions concentrated on the applicant's alleged reputation, mainly in Melbourne, and the assumption that the proprietor of the later lodged application intended to take advantage of that reputation by lodging an application for a similar trade mark as soon as the present application was advertised lapsed. He argued that, as the mark of that later lodged application, being the applicant's trading style, had not been used, it was in the public interest and in the interests of both parties to revive the present application.

From Mr Anselmi's declaration and as submitted at the hearing, I note there has been a discussion on 11th November 1994 with the manager of Lend Lease Retail about establishing two stores in Victoria, as shown in exhibit SA2. Concerning actual use of the applicant's mark, Mr Anselmi declares that two shoe companies in Victoria manufacture

shoes under the mark for retail in New Zealand, but any evidence that the mark OVERLAND has been used in Australia is absolutely lacking. Moreover, even though the applicant vehemently challenges proprietorship rights of its trading style OVERLAND FOOTWEAR, it has failed to provide evidence that Direct Solutions Melbourne Pty Ltd has never used the words in trade itself. In any event, the matter in dispute concerns the mark OVERLAND, not the applicant's trading style. The present situation therefore is unlike that of *Re Application by DR and E M Sefton* 11 IPR 424, where 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 in that case that the applicants were the only users of the mark in Australia. It was decided that any disadvantages to the other parties would be minor when compared to the major disadvantages to the applicants of losing their presumptive validity rights under s 61.

In my opinion then, the applicant has failed to establish a case that revival of the application would be in the public interest, or in the interests of the parties concerned. In the circumstances, therefore, it is suggested that the proper forum for pursuing the public interest and the proprietorship questions would be during opposition proceedings against registration of the mark OVERLAND FOOTWEAR.

Perusing the history of this application, I am compelled to conclude that the application has not been prosecuted diligently from the outset. While I appreciate that the applicant, an overseas company, required some time to consider and respond to the citation objection raised by the examiner in the first report, I believe it took exceedingly long time, eleven months, to do so. This in itself would neither have been objectionable nor critical, had the applicant taken steps, by seeking sufficient extension of time after 28th October 1994, to ensure that the application was either in order for acceptance or that a further report was to issue. The applicant's attorneys waited until January 1995, when the application was well out of time, to lodge a belated extension of time application. It seems to me that, even before the first lapsing of the application, the attorneys' diary system was not as efficient as it ought to have been.

**Conclusion**

Having considered the matter, I conclude that the granting of the requested extension of time for the revival of this application is not justified under the provisions of para 131(1)(a) of the Act. Accordingly, I refuse to revive application 578539.

Vija Zars
Acting Hearing Officer
15th January 1996