



## TRADE MARKS ACT 1955

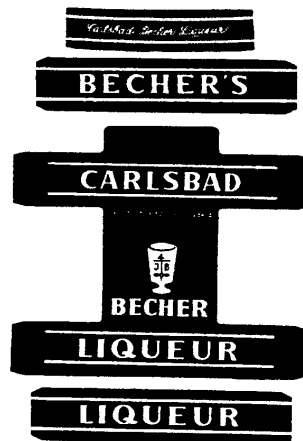
### DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS WITH REASONS

Re: An objection by **Johann Becher oHG, Likorfabrik** to an extension of time within which to lodge evidence in answer in respect of an opposition to registration of trade mark number 579418 in the name of **Jan Becher Výroba Lihovin, Národní Podnik**.

As set down in the transitional provisions of Part 22 of the *Trade Marks Act 1995*, the provisions of the *Trade Marks Act 1955* continue to govern this application. Accordingly the authority I refer to is the 1955 Act.

#### Background

Application 579418 was lodged on 29 May 1992 in the name of **Jan Becher, Výroba Lihovin Národní Podnik**, (the applicant), for goods specified as liqueurs and spirits. Acceptance of the mark, shown below, was advertised in the *Official Journal of Trade Marks*, of 15 September 1994 with a disclaimer of the right to the exclusive use of the word CARLSBAD and the letters JB.



Notice of opposition to the mark's registration was lodged on 15 March 1995 by **Johann Becher oHG Likorfabrik**, (the opponent), following the allowance of a three months extension of time within which to lodge an opposition. Evidence in support of the opposition was served six months later on 19 September 1995. In accordance with reg.44 the applicant's evidence in answer fell due on 15 December 1995. Extensions of time totalling four months within which to serve evidence in answer have been sought and allowed. The applicant requested a further three month extension of time from 4 May 1996 to 4 August 1996. The opponent objected to the extension sought and a hearing to determine the matter was set down in Canberra on 13 June 1996 before me as the Registrar's delegate.

Both parties waived their right to be heard on the matter but requested that written submissions be taken into consideration when deciding the matter. These were made by Ms Doreen Perrin of the Adelaide firm of Collison & Co, for the opponent and by Mr Raymond Walton of the Sydney firm of Griffith Hack & Co, for the applicant.

### **Submissions**

In her written submissions, Ms Perrin said that the law relating to extensions of time for the service of evidence in opposition proceedings is well established. She referred in particular to *Vangedal-Nielsen v Commissioner of Patents*, (1980) 33 ALR 144 and *Lyons (t/a Mitty's Authorised Newsagency) v Registrar of Trade Marks* (1983) 1 IPR 416. She reminded me that there is an onus on the party seeking the extension to establish that there were good reasons why the required act could not be completed in the time provided and also that I should take into account the private interests of the two parties, together with the public interest.

She noted that if this extension were to be granted the applicant would have had up to ten months within which to serve the evidence in answer. She claims that the applicant has not pursued the matter with diligence. She said that it may be inferred from the information contained in each of the applications to date that the applicant has taken little or no action in relation to the preparation of evidence. She referred to the reasons given for requiring each extension of time. The first extension of time of three months to 4 April 1996 stated:

“The attorneys for the applicant have found it necessary to communicate with instructing attorneys in the Czech Republic and instructions currently are awaited concerning evidence to be served in answer in the proceedings. The applicant's attorneys in Australia have consulted with the applicant's attorneys in the Czech Republic and a body of information has been obtained concerning the relationship of both the applicant and the opponent, and this material is to be documented, along with other material in declarations to be served in answer in the proceedings.

Further time is required to enable the applicant to serve evidence in answer in the proceedings when communications between Australia and the Czech Republic have been completed .....

The second application for an extension of time was for one month to 4 May 1996. The reasons given for requiring it were:

“Extensive correspondence has been directed to attorneys in the Czech Republic concerning procedures to be adopted in Australia in the preparation and lodgement of evidence in opposition proceedings.

Further information is required from the attorneys in the Czech Republic to enable the formulation of declarations to be served in answer in the proceedings and further time is required to enable receipt in Australia of information which is yet to be provided by attorneys in the Czech Republic. As indicated in the previous application for extension of time, some material has already been communicated but this has provoked questions which need to be answered ....”

The reasons given for requiring the extension of time which is presently under consideration are:

“The applicant has sought extensions of time totalling only four months to this point for serving evidence in answer in the opposition proceedings. Moreover, the attorney for the applicant has during the time provided the applicant with detailed information concerning the evidence served in support of the opposition and the nature of evidence to be served in answer in the proceedings. Also, the attorney for the applicant has consulted with the applicant’s principal instructing attorney in Prague with the object of advising concerning evidence served and to be served in the proceedings. It is understood that information concerning the opposition has been communicated to the applicant by the principal attorney in Prague and that the applicant is “extremely interested” in the case in Australia. It is understood that this means that the applicant is anxious to secure registration of the trade mark and, therefore, to resist the opposition. In this context, a copy of a letter (dated 2 May 1996) received from the applicant’s principal attorney in Prague is attached. As indicated previously, although extensive correspondence has been directed to the applicant’s attorneys in Prague and some information has been received, further information is required from the attorneys in Prague to enable formulation of declarations to be served in answer in the proceedings. Further time is required to enable receipt in Australia of the information which is yet to be provided and to enable preparation of the declarations to be served as evidence in answer.”

Ms Perrin submitted that the reasons given do not indicate that a serious case is foreshadowed by the applicant and that in reality no substantial activity has been undertaken to produce evidence in answer. Finally, she reminded me that there is a public interest in ensuring that opposition matters are dealt with expeditiously and to this end suggested that

there were no justifiable grounds for granting the applicant any extension beyond that which had been granted to the opponent for its evidence in support.

In his written submissions, Mr Walton said that the complex nature of the ownership of the mark, a matter which the opponent gave as its reason for seeking an extension of time to lodge an opposition to registration of the mark, was a matter that the applicant also needed time to consider. He advised that he had been informed that great difficulties were being experienced in the newly created Czech and Slovak Republics following the downfall of communist control. Legal systems are slowly being recreated and commercial enterprises are slowly being restored to a situation where they may trade competitively with the rest of the world. More importantly, the people within the new Republics must be re-educated and re-conditioned to think and trade in the non-communist world. These were factors that acted as impediments to the conducting of business in a way which most people in “western” cultures found relatively easy.

Mr Walton went on to state that in the light of the present situation in the Czech Republic, he had in January provided the principal attorneys with very detailed comments concerning the evidence in support of the opposition, the nature of the evidence to be served in answer and general information concerning the conducting of opposition proceedings in Australia. Further letters had been sent on 6 March, 1 April, 3 April, 24 April, 3 May, 17 May, 27 May, 3 June and 5 June 1996.

Some communications in reply had been received. The most recent dated 3 June 1996 contained information which Mr Walton interpreted as meaning that the principal attorneys in the Czech Republic were to meet with the newly appointed executive officer of the applicant in Prague during the week 10 to 14 June 1996 and that following the meeting further information would be provided to the Australian attorneys.

Mr Walton reproduced the relevant paragraph in that particular letter and this would seem to be a fair interpretation. He noted that the letter dated 6 May 1996 from the applicant’s Czech attorney stated that the applicant company is “extremely interested in this application in Australia”. He understands this to mean that the applicant is anxious to secure registration of the mark. He concluded his submissions by stating that having regard to the applicant’s foreign domicile, the fact that the applicant had indicated a desire to preserve the trade mark and the Australian attorneys efforts on its behalf, the extension of time should be allowed.

## **Discussion**

Regulation 44 of the Trade Marks Act states, inter alia,

“An applicant shall;

(a) serve on the opponent, within three months after the date on which the declarations of the opponent were served, a copy of each of the declarations on which he relies in answer to the opposition;”

Section 130 states,

“Where, by this Act, a time is specified within which an act or a thing is to be done, the Registrar may, unless otherwise expressly provided, extend the time either before or after its expiration.”

The provisions of section 130 apply in the matter presently under consideration. I believe that in determining the matter I must consider the circumstances outlined in the *Lyons* case, supra. These are whether a proper case has been made out; the relative inconvenience to both parties of the allowance, or otherwise, of the extension; and the public interest. In that case Beaumont J. said that the delegate is “entitled to have regard to the notorious fact that opposition proceedings usually involve the gathering of evidence from third parties and this usually takes considerable time.” In this particular case the gathering of evidence is from people with an obviously limited competence in English and a poor understanding of opposition proceedings in a western culture. The radical changes in the political and legal systems of the Czech Republic have created a special circumstance demanding a degree of tolerance in relation to the granting of extensions which, moreover, have to date not been unduly excessive. I am satisfied that the applicant’s Australian attorneys are acting diligently in pursuing this matter on the applicant’s behalf and that they will continue to stress to the applicant and its Czech attorneys the need to comply with statutory requirements in Australia.

Regarding the balance of convenience, I am aware that if I allow this extension the delay may cause the opponent considerable inconvenience and possible expense. On the other hand, if I do not allow the extension, the applicant may lose its case because it will be denied the opportunity to present its evidence in answer. I therefore find that the balance of convenience lies with allowing the extension.

Finally I must consider the matter of the public interest. D.R. Shanahan’s, *Australian Law Of Trade Marks And Passing Off*, second edition, says at page 69, “The public interest in denying registration to a deceptive mark will often weigh heavily in favour of extension.” Given the opponent’s claim in its notice of opposition to registration of the applicant’s mark that it is the owner of mark, which through use, enjoys a very substantial reputation and which is substantially identical or deceptively similar to the applicant’s mark, I believe that the public interest will best be served by a full disclosure of all the facts and evidence by both parties.

## **Decision**

I find that the applicant has discharged its onus of establishing a “good reason” for allowing the extension of time and I therefore allow the extension sought. On the matter of costs, since I have found that the reasons given, were, in the circumstances sufficient to justify the extension sought, I can see no reason why costs should not follow the result. Accordingly, I award costs in the matter of the extension to the applicant.

Mary Skivington  
Senior Examiner  
Trade Mark Hearings  
25 July 1996