



TRADE MARKS ACT 1955

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

Re: Objection by PARKHURST PINES PTY. LTD., ASHWOOD WAY PTY. LTD. and WALTER DELL PTY. LTD. to applications by TRUEFEAT PTY. LIMITED for an extension of time to serve evidence in support of an opposition to registration of Trade Mark Applications Nos. 597928, 604300, 604301, 604302 and 604303

Application No. 597928 was lodged on 15th March 1993 in the name of PARKHURST PINES PTY. LTD. The other applications Nos. 604300, 604301, 604302 and 604303 were lodged on 11th June 1993 in the name of ASHWOOD WAY PTY. LTD. and WALTER DELL PTY. LTD. All the applications are for the identical mark shown here:



Documents on file of application No. 597928 indicate that the mark is to be assigned to ASHWOOD WAY PTY. LTD. and WALTER DELL PTY. LTD. upon registration of the mark. Acceptance of the marks was advertised in the *Official Journal* on the following dates: application No. 597928 on 15th May 1994, Nos. 604300, 604301 and 604302 on 14th July 1994 and No. 604303 on 21st July 1994. Notices of opposition to registration of the marks of applications Nos. 597928, 604300, 604301 and 604302 were lodged by TRUEFEAT PTY. LTD. on 2nd September 1994 and on application No. 604303 on 14th September 1994.

In this decision, reference will be made to PARKHURST PINES PTY. LTD., ASHWOOD WAY PTY. LTD. and WALTER DELL PTY. LTD. as, collectively, the applicants and TRUEFEAT PTY. LTD. as the opponent.

Under the provisions of Regulation 43, the evidence in support of the opposition on these applications was due on 2nd December 1994 and on 14th December 1994, respectively. On 2nd December 1994, identical letters from Marsdens, attorneys then acting for the opponent, were transmitted to this Office by a facsimile in relation to the opposition matter on all five applications seeking extensions of time for serving the evidence in support, the pertinent part reading as follows:

"We advise that we have lodged a Notice of Opposition to the above mentioned trademark.

We request that there be a further extension of time for 2 months in order for us to prepare evidence in this matter.

We enclose a cheque for this extension."

On 19th December 1994, the applicants' attorneys objected to the extension of time applications on the grounds that no reasons whatsoever had been stated for the extensions and requested to be heard on the matter. A hearing was set down on 20th January 1995. On 16th January 1995, a firm of lawyers, Hunt & Hunt, advised that it was acting for the opponent and requested that the hearing be adjourned to after 27th February 1995, to which the applicants consented. A new date for the hearing was specified on 7th March 1995.

On 1st February 1995, a letter was received from the opponent's lawyers containing the following:

"We act for Truefeat Pty Limited.

A Notice of Opposition was lodged by the Opponent in September 1994 and an extension of time was granted on 2 December 1994 for a period of two months.

We now request a further extension of time for a period of two months and enclose our cheque for this extension.

The reason for the extension is that there are proceedings currently before the Federal Court of Australia involving Truefeat Pty Limited which are relevant to this application. We have not yet prepared our evidence in opposition to the registration of the trade mark as, in our view, the Applicant should first present their evidence in the Federal Court proceedings, in which they are the initiating party.

Should you have any further queries in relation to this matter, please do not hesitate to contact the writer."

The opponent's attorneys were advised, by an official letter of 7th February 1995, that at no time in the course of the opposition proceedings have any extensions of time been granted for the purposes of serving the evidence in support. On 17th February 1995, a letter was received from the applicants' attorneys objecting to each of the extension of time applications and applying to be heard in relation to those applications, and requesting that the matters be heard concurrently. A hearing was set down in Canberra on 7th March 1995 before me as the Registrar's delegate. The opponent was represented by Mr Malcolm Bell, solicitor of Phillips Ormonde & Fitzpatrick and Ms Kate Dobbie of Hunt & Hunt, lawyers.

In opening his submissions on the first extension of time application, Mr Bell stated that the law in relation to such matters was well settled as is indicated in numerous Office decisions, which have relied on the tests outlined in the Federal Court of Australia cases *Vangedal-Nielsen and Others v Smith (Commissioner of Patents) and Another* 33 ALR 144 and *Lyons and Another (Trading as Mitty's Authorized Newsagency) v Registrar of Trade Marks and Another* 1 IPR 416. From these decisions two aspects clearly emerged, namely, that the party seeking the extension of time must furnish some good reason why it has been unable to serve the evidence in support within the prescribed time, and it must also discharge the burden of establishing a proper case to justify the sought extension. In the present instance, the opponent's then solicitors had done neither, he said. To illustrate how the principles of *Vangedal-Nielsen* and *Lyons*, supra, have been applied and explained in the Office decisions, Mr Bell first selected *Lord Bloody Wog Rolo v United Artists Corporation* 11 IPR 516, where the hearing officer pointed out that the Registrar views favourably situations where the conflicting parties are in the process of negotiating, or where such negotiations have broken down and further time is required for the preparation of the evidence but, in such

situations, the opponent was not relieved of its onus of explaining the reasons for the need of any additional time. Moreover, the party applying for the extension of time was obliged to state the reasons, not only in the first application, but also in any subsequent applications.

Discussing the other factors to be taken into account in relation to extension of time matters: relative inconvenience to the parties and the public interest in granting or denying the extension, Mr Bell cited *Universal City Studio Inc v Frankenstein Pty Ltd* (1994) AIPC 91-044, asserting that such factors would need to be considered only if the opponent had removed its initial onus explaining why the time already allowed had been insufficient. In that case, having referred to *Vangedal-Nielsen* and *Lyons*, supra, once the hearing officer concluded that the opponent had not established a proper case for granting the required extension of time, he did not continue considering those issues. Even if the opponent had made out a case in the current proceedings, in Mr Bell's view the public interest and relative convenience did not justify the granting of the extension, as subsequent events had demonstrated that the opponent had no intention of preparing the evidence in support for a considerable time, notwithstanding the first application for two months for its preparation. While no indication had been given in the present application as to what inconvenience would be suffered by the opponent, the applicants certainly would be disadvantaged by the long delays in having their marks registered, should the applicants succeed in the opposition proceedings.

Mr Bell commented further that, as established in a number of cases, the public interest dictated that, if the opponent experienced difficulties in the preparation of the evidence, such circumstances were often not an adequate reason why another party's good and bona fide application should be shut out, given that bad trade marks should not be registered. With reference to *Lord Rolo*, supra, he said that the hearing officer had stated there that for the sake of protecting the public interest, normally an extension of time would be granted to ensure that the allegations of deception or confusion caused by the use of the opposed mark were investigated; however, the Registrar would give due weight to the ground of opposition based on such a claim only if the opponent itself demonstrated

interest and progress in the proceedings. An extension of time would not be granted in the event of the applicant's careless oversight or mere casual regard for the timetable imposed by the Act and regulations. Mr Bell also cited *Kimberley-Clark Corporation v Procter & Gamble Co* 20 IPR 425, a decision regarding an extension of time application in relation to a patent opposition proceeding, where the hearing officer pronounced, at p 428: "[t]here is a public interest aspect to consider in ensuring that a worthless patent is not granted simply because insufficient time has been available to prepare and serve evidence in support. It is also in the public interest that unreasonable delays do not occur in the proceedings." In the proceedings under consideration, the opponent had not stated that it had insufficient time to prepare the evidence, and from the second application for a further extension of time, it was implicit that it had not even attempted to prepare any evidence at all, therefore it could not be argued that it did not have sufficient time for the purpose. In conclusion, he sought costs in the matter.

Ms Dobbie did not make any submissions on behalf of the opponent in relation to the first application for the extension of time.

Discussion

Regulation 43 of the *Trade Marks Regulations* states, inter alia:

43. An opponent shall:

(a) serve on the applicant, within three months after the notice of opposition has been lodged at the Trade Marks Office, a copy of each of the declarations on which he relies in support of his opposition ...

Under section 130 of the Act, the Registrar has the discretionary power to extend the time within which an act or thing is to be done. The current extension of time matter falls under this section.

In considering an extension of time request for serving the evidence in support on the grounds of "[e]vidence in support of the opposition is in course of preparation but it is desired to have additional time to prepare that evidence and to serve copy thereof on the applicant", Beaumont J in

Lyons, supra, based his findings on the principles expounded by Bowen CJ in *Vangedal-Nielsen*, also supra. At p 420 he concluded:

"Although a more detailed explanation of the position may have been desirable, I think that it is possible to construe the rather bald statement of the ground for the request (*supra*) as indicating that, although efforts had been made in that behalf, it was not possible to finalize the form of the evidence sought to be adduced in the time allowed by the regulation. I accept that, on one view, it is possible to read the stated ground as being little more than an assertion that more time is required. However, the statement of the ground does at least attempt some explication of the position."

In light of the reasoning applied in the mentioned cases and in view of the above statement, I agree with Mr. Bell's contention that the opponent has failed to furnish adequate acceptable grounds for requiring the additional time, nor has it established a proper case justifying it. The opponent merely states that the time of two months is required for the preparation of the evidence. From the opponent's request it is impossible to infer that the gathering of the evidence is already under way, but even if it is, any explanation is lacking why the opponent should avail itself of more time for the continuation of the process of obtaining further evidence, or its finalization. In *Lyons*, supra, it was recognized that the statutory period of three months is generally insufficient for serving and lodging of the evidence, which frequently is a time consuming exercise involving third parties. This factor, however, does not absolve the party seeking the extension from providing at least some satisfactory reasons to enable the Registrar efficient operation of the system and to avoid unnecessary delays in the proceedings. Even though I need not look beyond the application at issue, the request of 1st February 1995 for a further period of two months reveals that the opponent had not commenced the collection process and may, in fact, require further extensions of time in the future for obtaining and collating the evidence.

Having found that the opponent has been unsuccessful in establishing an appropriate case in relation to the first extension of time application, I will briefly comment on the matters concerning the public interest and relative inconvenience.

If the opposition involves possible deception or confusion or trade marks, then the public interest factor weighs in favour of the applicant for the extension to allow consideration of any relevant evidence material which "will assist in providing a clearer picture of the awareness of rival marks as affecting the likelihood of deception or confusion" (see *Pioneer Hi-Bred Corn Co v Hy-Line Chicks Pty Ltd* [1979] RPC 410 at 435, also *Bundy American Corp v Rent-A-Wreck (Vic) Pty Ltd* 4IPR 307 at 310). Since, in the notice of opposition, there is no specific ground based on the claim of deception or confusion, and in the absence of any submissions relating thereto, the Registrar could not determine this matter in the opponent's favour, even if it had successfully discharged its initial onus discussed previously.

I do not think that, at this early stage of the opposition proceedings, the parties concerned could be said to have been harmed by unreasonable delays in the process. However, being aware of the opponent's determination not to prepare the evidence in support before the applicants lodge their evidence in relation to the Federal Court proceedings, as indicated in the opponent's second application for the extension of time, I believe that the applicants may eventually be adversely affected by being caught up in a lengthy process before the fate of their applications is decided, having regard to the strong possibility that the opponent will seek further extensions before the actual hearing of the opposition. No arguments as to any disadvantage experienced by the opponent were presented to me.

Decision

Having considered the relevant issues, I find that the opponent has failed to show any good reason why it should be allowed the extension of time to serve the evidence in support of opposition in relation to applications Nos. 597928, 604300, 604301, 604302 and 604303. Accordingly, I refuse to grant the extension requested in the application of 2nd December 1994 on each of the five applications.

Costs

I award costs, in accordance with the scale, to the applicants.

Application of 1st February 1995 to allow a further extension of time to serve the evidence in support

Having refused the opponent's previous application for the extension to serve the evidence in support of the opposition on each of the five applications identified above, it follows that I must also refuse the subsequent application for additional time in relation to those applications.

Vija Zars
Senior Examiner
21 March 1995