



TRADE MARKS ACT 1955.
DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS,
WITH REASONS.

Re: Objection by the Registrar to an application by Valley View Poultry Pty Ltd for a belated extension of time to serve Evidence in Support of the Opposition to registration of Trade Mark Application 617853 in the name of Food Marketers Pty Ltd.

Background

Trade Mark application 617853 was advertised accepted for registration on 3.2.94. It is proceeding in the name of Food Marketers Pty Ltd ("Foods"). The trade mark in suit is the word VALLEYVIEW, and the application covers all goods in class 29; in general terms, meats, dairy products and cooked vegetables and fruits.

Notice of opposition to registration, as provided for by section 49 of the Trade Marks Act, was lodged by Valley View Poultry Pty Ltd ("Valley View") on 5.4.94. The opposition is quite specific, with only two grounds:

- the application applied for is very similar to our company name
- We have been trading in the food industry under this name for almost 30 years. We believe that confusion will occur....

This is sufficient to activate the opposition provisions of Division 1 of Part VII of the Trade Mark Regulations. Regulation 43 in Division 1 provides for the service on Foods of a copy of the evidence in support of the opposition, within 3 months of the date on which notice of opposition is lodged. The evidence was thus due by 5.7.94, with the originals of this evidence to be lodged at the Trade Marks Office.

When no evidence was lodged, the Trade Marks Office followed its usual practice and wrote to the parties, advising them that we presumed that the copies of the evidence had not been served within the time provided, and that, if so, it was open to Foods to apply for a hearing.

It is worth noting that this was not the first time that the parties were informed of the fact that there were obligations under the regulations. On 11.4.94, the Office acknowledged the lodgement of the Notice of Opposition by way of a standard letter. That letter concluded: "The provisions of Regulation 43 now apply".

Be that as it may, neither party took action, so on 29 August the Office again wrote to both parties. That letter advised that evidence in support was overdue and that the Registrar would allow a further 21 days to for either party to request a hearing, failing which the matter would be determined on the basis of the material on file.

On 7.9.94 the newly appointed patent attorney for Valley View, H R Hodgkinson and Co, lodged a belated request for an extension of time to serve evidence in support.

The application is supported by a statutory declaration by Mr Geoffrey Evans, who is the company secretary of Valley View. He has declared that on becoming aware of the acceptance of the opposed application he made a number of telephone calls to the Trade Marks Office, following which he lodged the Notice of Opposition.

He further declares that he received the two letters to which I have referred, but "did not recognise the significance of the reference in those letters to Regulations 49, 43, and 75." It was only on receipt of the third letter that he realised that Valley View had not complied with the requirements of the Trade Marks Act and Regulations.

As is usual where an extension is requested belatedly, the reasons given were assessed, and the officer dealing with the application formed the view that the extension should not be granted. Valley

View's attorney was informed of the intention to refuse the extension and it applied to be heard. Foods was given an opportunity to attend the hearing but did not appear.

At the hearing, Valley View was represented by Mr H R Hodgkinson, patent attorney. His submissions covered a range of factors relevant to the grant of a belated extension in the circumstances in which Valley View finds itself.

Essentially, Mr Hodgkinson stressed the need for application of the regulations with discretion if serious injustice was to be avoided. As per *Pioneer Hi-bred Corn Co v Hy-Line Chicks* [1979] RPC 410 at 435-6, he argued that the public interest will lie in full disclosure of the facts as affecting the likelihood of deception and confusion. He tabled a variety of letters from various traders which tend, to my deliberately cursory glance, to support the claim made by Valley View that there will be deception or confusion caused by use of the trade mark now at issue, and I give that fact considerable weight.

Mr Hodgkinson argued that, per *Outboard Marine Australia v Byrnes* 1974 1 NSWLR 27, where this could be done with justice to all concerned, a benign application was appropriate in interpreting procedural rules.

Mr Hodgkinson also noted the factors to be shown if, in general terms, an extension is to be granted: has a proper case been made out, where does the public interest lie and how will the grant of the extension affect the balance of convenience as between the parties. Here he relied on the reasoning of Bowen CJ in *Vangedal-Nielsen v Smith* 33 ALR 144 and on *Lyons v Registrar of Trade Marks* 1 IPR 416, decided in relation to an application for (as is presently the case) additional time for service of evidence in support of a trade mark opposition.

Mr Hodgkinson noted that Valley View had acted promptly in obtaining professional advice once they realised that the matter was, as he put it, badly off the rails. He noted too that there was nothing to suggest that Foods was being unduly prejudiced by the delay in the matter, whereas if the

opposition is shut out at this point it may have severe consequences for Valley View. Nor is there what Mr Hodgkinson called a history of desultory correspondence on the part of Valley View.

Mr Hodgkinson was critical of the language used in the letters sent as part of the opposition process. He contrasted them with the helpfully plain language used in examiners' reports prior to acceptance.

He then went on to address regulation 69, which provides:

An application for an extension of time under these Regulations shall be in writing and shall be lodged at the Trade Marks Office -
(a) before the expiration of the time sought to be extended; or
(b) if the Registrar is satisfied that special circumstances existed which prevented the application being made before that time, within such time as the Registrar allows.

Mr Hodgkinson argued that on balance the extension had sufficient merit - public interest plus the severe consequences, for the applicant, of a refusal - and that as a total package it should be granted.

He also argued that regulation 69 is merely a filter on the making of extension requests, not on their grant by the Registrar. The Registrar is confronted with the present request, and my decision, if I understood Mr Hodgkinson correctly, is simply to grant or not grant it, not to decide if it was made in compliance with the terms of regulation 69. Mr Hodgkinson argued that, if regulation 69 was to be relevant to proceedings such as this, it would only be in circumstances where the Registrar had moved to disallow the lodgement in some way.

Mr Hodgkinson noted a variety of cases, referred to in *Jess v Scott*, (1986) 70 ALR 185 and went on to argue that in fact I have a wide discretion to excuse default in these matters.

Decision

The fact is that the Act cannot prevent the lodging of requests for extensions of time. To say that regulation 69 was put into the regulations merely to deter people from seeking extensions, or to "un-make" them if they are made, but without also being a filter on their grant, is perhaps one explanation for why it is in the regulations, but it is an extreme one. I prefer the straightforward interpretation, that it is at least a guide to the use of the broad freedom to grant, under the power of s 130, extensions of the times set out in the regulations, as distinct from times set out in the Act.

The matter is thus to be looked at as set out in *D'Urban Inc v Canpio Pty Ltd* 1990 AIPC 90-658. Regulation 69 applies to the allowance of an extension of the times set out in the regulations, even though the ultimate source of power to grant those extensions is elsewhere, in section 130.

In *D'Urban v Canpio* the facts at issue were of an initial misunderstanding as to the efficacy of service on a DX, followed by 14 months of inaction once the invalidity of that service was brought to the attention of the attorney concerned. In that case, though the extension was ultimately refused, Assistant Registrar Farquhar agreed that, as with the finding in *Genentech v Wellcome Foundation Ltd*, (1987-88) 11 IPR 401, reg 69 should be interpreted liberally.

In *Genentech*, and consistent with the approach advocated by Mr Hodgkinson, Supervising Examiner Roveta referred to *Jess v Scott*, supra, as establishing that the modern interpretation of the expression "special circumstances" in the Patents regulations should be a liberal one. Mr Roveta notes, at p 405, after he has looked at relevant court decisions:

The point is that both courts appeared to take the view that the particular expression with which we are here concerned - even though, apparently, a somewhat more stringent requirement than that of the court rule - ought to be liberally interpreted by a tribunal so as not to let an appellant suffer unfairly.

Mr Roveta also concluded that

the word "prevented" ought to be given a broad meaning so as to give effect to the regulation in situations where the person concerned has failed to apply on time owing to

some circumstance which has prevented the knowledge of the need to apply coming to that person's attention.

On consideration of those comments, Mrs Farquhar, in *D'Urban*, supra, had formed the conclusion that regulation 69 can be applied to remedy the consequences of "errors or omissions made by the applicant for extension, or by their agent".

I agree with Mr Hodgkinson that there are powerful arguments for the grant of the extension. However, in the application of regulation 69 all of the surrounding circumstances must be considered and the final question must be if, as a whole, there is anything about them that is special.

In the present instance we have a party which had no professional representation. In deciding that it could adopt such a course it made a considered decision, and in doing so it assumed at least the responsibility of finding out what was to be done and when.

Nor was this a course without warnings. Valley View had ample opportunity to see that there were matters which it did not understand. I completely reject Mr Hodgkinson's criticism of the standard notices used by this Office. The Trade Marks Office should not give legal advice in what is no less than a dispute between two parties about a piece of property. Nor does the Office attempt to soften the obvious face of the law at issue in any opposition matter by breaking down the timetable of events provided for in the regulations into a user-friendly format. A party which cannot or will not exert itself to come to grips with the obligations under the regulations will not be equipped to deal with the complexity of preparing the evidence necessary to address the issues of registrability.

This is simply not an area of law that can be tackled by the unprepared, and if a party is not willing or able to find out what needs to be done then there is no point in luring it on by suggesting that the matter is easily managed. The warning signs were posted but in this case Valley View simply did not make the investigations necessary in the task which it elected to take on.

Valley View made a decision to intervene, without legal advice, in an application by a third party, yet it had done nothing, in the time between the advertising of the acceptance of the application and the letter of 29 August last year, to come to grips with what it actually needed to do if it was to succeed. It is simplistic to say that it did not understand the warnings in letters sent to it, since that failure was symptomatic of a desultory approach to its self-appointed task.

Valley View has acted with dispatch only once it realised that it had failed, totally, to do what was required of it. This is not a case which can be said to be a "failure of procedure" (*Kaiser Aluminium and Chemical Corporation v The Reynolds Metal Company*, 120 CLR 136) so much as a lack of all necessary application.

It has been said many times, for example in decisions of long standing such as *Bundy American Corp v Rent-A-Wreck*, (1985) IPR 307, that it is not open to a party to seek an extension of time simply to make good a careless oversight or a mere casual regard for the times prescribed by the Act and the Regulations. In *Leser v Spiritual Sky*, (1985) 5 IPR 149, that proposition was described as a corollary of *Vangedal-Neilsen v Smith* (1980) 33 ALR 144.

Once the time set by the relevant regulation has passed, the onus on an applicant to justify the conduct that has caused it to need extra time is considerably increased. While belated extensions of time may fairly be granted to overcome delays due to the death or unavailability of key officers, the clear-cut loss of documents, the errors of legal representatives or many unforeseeable and unusual circumstances, the failure of Valley View is not something which I can now remedy.

Despite the factors which Mr Hodgkinson has argued should support the grant, I cannot stretch the language of reg 69 to a point where I can justify the grant of this extension. Valley View has brought this matter to its present state and I do not think that the public interest in the orderly conduct of oppositions is well served by an extension sought in such circumstances.

Accordingly I am obliged to refuse the application for further time to serve evidence in support.

Mr Hodgkinson foreshadowed an application, at the final hearing, of an application for leave to adduce further evidence. I will note, however, that such an application must fail. There is no evidence in support in this matter so, by definition of the word "further", there can be no further evidence.

As a fall-back, Mr Hodgkinson requested me to consider withdrawing acceptance under the "special circumstances" provision of s 44(3). Such a course is totally inappropriate, since there is nothing special about this case. The opponent has failed to meet the obligations on it, and I do not see why the opposed application should not proceed.

This is a case where the grounds of opposition require the support of evidence. Since I have not allowed such evidence to be introduced, I put the parties on notice that, subject to any appeal from this decision, the opposition by Valley View will be dismissed after one month from the date of the present decision unless within that time either party requests that it be heard in the matter.

T. E. Williams
Hearing Officer

9 January 1995