



TRADE MARKS ACT 1955

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

Re: Opposition to an extension of time for serving a notice of opposition on trade mark application number A618680(30)

Trade mark application number A618680 is filed in the name of Wintercorn Edible Products Pty Ltd (Wintercorn Edible Products) and is for registration of the trade mark BOTINNI. This mark has been accepted for all goods in International class 30 and was accordingly advertised in the *Official Journal of Trade Marks* on 12 January 1995.

The time allowed for serving opposition against this mark consequently ran for the 3 months to 12 April 1995 and on that date Societé des Produits Nestlé S.A. (Nestlé), through their agent Shelston Waters, patent and trade mark attorneys, filed an application to extend this time. They asked for a further three months the maximum allowed under sub-section 49(1) of the Trade Marks Act. This three months, if granted, will bring the time to 12 July 1995. The reasons for the extension of time as specified in the application are stated shortly as follows:

The acceptance of the application has only recently come to our attention and further time is required to determine whether formal Opposition proceedings are required

The trade mark applicant, Wintercorn Edible Products, through its agent, George A. Duncan, solicitor, opposed this extension. A hearing in the matter was thus set down, and the matter

came before me in Sydney on 7 July 1995. Wintercorn Edible Products was represented by Mr Tom Davie of Counsel. Nestlé had advised, through Phillips Fox, who, as of 30 May 1995 had replaced Shelston Waters as Nestlé's agent, that they did not wish to be heard. In lieu of a personal appearance, they provided me with some written submissions. These were made available to Mr Davie at the commencement of the hearing.

Mr Davie's submissions were brief. He explained that on receiving notice of Nestlé's intention to oppose, Wintercorn Edible Products had endeavoured to negotiate a settlement. To this end, Mr Duncan had written three letters, one in May and two in June of this year, in each of which he requested to be furnished with information regarding the goods included in Wintercorn Edible Products' trade mark application, which overlapped with Nestlé's trade. No response had been received to any one of these letters. Mr Davie referred to the fact that Nestlé is an international company and he said that it would have extensive resources to command, with various specialist agents continually engaged in managing and maintaining its portfolio of trade marks. He said that in circumstances of this kind, there was no reason why the statutory three months set down by section 49 should not be adequate. He submitted that Nestlé's location in Switzerland was not sufficient grounds to justify the additional time. He contended that the resources employed by Nestlé actually put it in a stronger position to meet the time limit, than was the case for many small Australian companies. Mr Davie then described the tight intellectual property budget under which small companies are likely to operate. He said that Wintercorn Edible Products was suffering such constraints and he suggested that the delay brought about by the present application for more time, was simply obstructionist. In support of this allegation, he pointed to Mr Duncan's un-answered letters which, he claimed, confirmed Nestlé's unco-operative attitude.

The submissions from Phillips Fox on behalf of Nestlé, recount a brief history of the matter and then refer to principal case law relating to extensions of time in opposition matters - namely *Lyons -v- Registrar of Trade Marks (Mitty's case)* (1983) 1 IPR 416 and

Vangedal-Nielsen -v- Smith (1980) 33 ALR 144. The specific criteria that decide the issue, and which are extracted from these cases are then quoted by Phillips Fox as

- (i) the interests of the prospective opponent
- (ii) whether a serious opposition is foreshadowed
- (iii) the public interest
- (iv) whether the applicant for the extension has made out a proper case justifying the extension

The submissions then go on to say 'the first three considerations need not be specifically addressed by the Applicant [for the extensions] but the Hearing Officer must nevertheless consider them.' The submissions then claim that in light of *Mitty's case*, the present reasons are sufficient; that the three months requested is not an unreasonable delay; that the public interest is in favour of allowing an opposition where deception and confusion is at issue; and that there is little relative disadvantage to the trade mark applicant if the extension is allowed.

Decision

Taking the criteria in turn:

(i) **the interests of the prospective opponent** - this, I think, should more properly be stated as the relative disadvantage to the two parties. Mr Davie has argued that delays in achieving registration are indeed going to disadvantage Wintercorn Edible Products. On the other hand, I am certainly aware that should I refuse the extension of time that will put an end to Nestlé's capacity to launch an opposition to this trade mark. However, while I have had the advantage of Mr Davie's recital of what this will mean to Wintercorn Edible Products, I can only surmise so far as Nestlé is concerned. On the facts before me, I find that in relation to this criterion, the balance is in favour of disallowing the extension request.

(ii) **whether a serious opposition is foreshadowed** - here I find that the application for the extension of time is seriously wanting. In the submissions from Phillips Fox, there is no

clear indication what the grounds for the opposition actually are. The only intimation is an alleged but unspecified risk of deception and confusion. I do not know what that risk may be. The Notice of Opposition was not filed at the time of the hearing, so that could not assist me. It may be that in some instances, as the Phillips Fox submissions say, it is not necessary for the applicant for the extension to specifically address this point - I do not know the basis on which this claim is made. But it is necessary for the applicant for the extension to justify the extension (*Vangedal-Nielsen -v- Smith* - supra). If I am not advised of the grounds, then I can not assess the seriousness of the foreshadowed opposition and I can only find that Nestlé has not satisfied this criterion.

(iii) **the public interest** - in as much as I have been left in the dark so far as the grounds of the proposed opposition is concerned, I find I am also at a loss to determine whether the opposition is, or is not, in the public interest. Phillips Fox do no more than imply that the subject mark is substantially identical or deceptively similar to a Nestlé trade mark. I have not been told what that mark may be. Certainly, as the Phillips Fox submissions point out, if the public interest is involved, this will weigh heavily in favour of allowing additional time. However, the onus is on the applicant for the extension to demonstrate what public interest will be served by proceeding with the opposition. This onus, I consider, has not been discharged

(iv) **whether the applicant has made out a proper case for justifying the extension** - first, the reasons stated in the application, and recited above, are brief. They are reasons, however, which have, per the findings of *Lyons -v- Registrar of Trade Marks* (supra), been accepted on various occasions. More details would indeed have been desirable - not only I might say, for the edification of the Registrar who is obliged to determine the matter, but in addition, for the information of the trade mark applicant who must determine its chances of successfully challenging the extension request. Phillips Fox in their submissions say that Nestlé is situated in Switzerland and that "it is not unreasonable to assume that publication of the acceptance of this mark would not have come to their attention in time for the Opponent to fully consider whether or not to formally oppose Application A618680". I am mindful of

Mr Davie's submission that an international corporation of Nestlé's stature is likely to have good care taken of its portfolio of trade marks. In light of that proposition I find it less than satisfactory that the submissions in support of the extensions simply ask me to surmise a delay in the acceptance notice coming to Nestlé's attention. If there was a delay, then I would expect it recorded. Instead, all that has been put forward is an implication that there may have been delays. In today's terms, where communications around the world are no more difficult than communications between points within Australia, and where there is no statement that Nestlé did suffer delays in receiving information on the acceptance of the subject mark, I give preference to Mr Davie's argument, and in consideration of the application and submissions find that a case for the extension has not fully addressed.

On all five of the criteria I am called to consider, I have found for the trade mark applicant who here opposes the grant of an extension of time for lodging the notice of opposition. The extension of time request is therefore refused.

Mr Davie applied for costs and as there is no reason why these should not follow the cause, I accordingly award costs to the trade mark applicant.

Helen R Hardie
Deputy Registrar
13 July 1995