



## TRADE MARKS ACT 1955

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

**Re:** Opposition by ALLAN RAMOND BURRELL to an application by INTERNATIONAL BUSINESS EXCHANGE LIMITED for an extension of time to serve Notice of Opposition to registration of Trade Mark Application number 631286

#### **Background**

Trade mark application No 631286 was lodged on 1st June 1994 by ALLAN RAMOND BURRELL. It seeks registration of the trade mark IBEX in respect of “footwear sports shoes clothing” in class 25.

The trade mark application was advertised as accepted in the *Official Journal* of 9th March 1995. The period for lodging a notice of opposition, under the provisions of s 49 of the Act, expired on 9th June 1995. On 27th June 1995, a late application for an extension of time of one month to lodge a notice of opposition, together with the appropriate fees, a statutory declaration by Trevor James Dredge and a notice of opposition to registration of the subject trade mark were received from INTERNATIONAL BUSINESS EXCHANGE LIMITED.

In the statutory declaration, dated 27th June 1995, Mr Dredge declares that he is the sole practitioner in his firm and does not employ any other professional staff. In a letter of 28th April 1995 to the prospective opponent, a copy of which is attached as exhibit TJD1, he had raised the matter of opposing registration of the subject mark and requested its instructions. Such instructions were received by him in a telephone call on 26th May 1995. Before leaving his office on that day, Mr Dredge had positioned the file in relation to the

matter for action on Monday 29th June (sic) 1995 and says he would most likely have diarised the file for bringing it up on the week commencing 5th June 1995.

According to Mr Dredge's declaration, at approximately 10.30 pm on 26th May 1995, Mr Dredge was seriously injured in a sporting accident which required surgery and hospitalisation. After being discharged from the hospital on 31st May 1995, he was under strict instructions from an orthopaedic surgeon and a physiotherapist not to return to work until the surgical repair of the achilles tendon had completely healed. In support, a surgeon's certificate for the period from 31st May 1995 to 16th June 1995 is annexed as exhibit TJD2. During the period covered by the doctor's certificate, Mr Dredge cancelled his attendance at a conference and a meeting in Sydney. He also cancelled or rescheduled other appointments until 16th June 1995. He had asked his secretary to check his diary for any urgent matters. Upon returning to work on 19th June 1995, he immediately recalled the instructions to lodge a notice of opposition in relation to application No 631286, but the serious swelling and aching of his foot, and other urgent matters needing his attention prevented him from carrying out the research in relation to the extension of time application. The research was necessary because he had never applied for an extension of time under s 131 of the Act. A further delay for lodging the notice of opposition was caused by a second member of Mr Dredge's secretarial staff, who finished up at his office on 12th June 1995 and was replaced on 26th June 1995. Mr Dredge had made every effort possible in the previous 6 months to obtain professional staff and has attached a copy of an advertisement for a patent attorney or technical assistant, which appeared in the *Official Journal* of 1st June 1995.

In an official letter of 11th July 1995, the prospective opponent was advised by the Office that its request for an extension of time to lodge the notice of opposition had been denied, but it could apply for a hearing on the matter within fourteen days from the date of the letter. A hearing was sought within the time specified. On 25th July 1995, solicitors acting for the applicant advised the Office of the applicant's objection to the application for the extension of time to 9th July 1995 and requested the matter to be set down for a hearing.

The hearing was held in Canberra on 26th October 1995. The applicant's solicitors, Bradfields of Hobart, lodged written submissions. The prospective opponent was represented on telephone by Mr Trevor Dredge, of Intellpro, trade mark and patent attorneys of Brisbane. Before the hearing Mr Dredge transmitted by facsimile some material to which he was to refer during the hearing.

### **Submissions**

The applicant's solicitors submitted that Mr Dredge appears to have attended his office prior to 8th June 1995 to check any matters requiring actioning, therefore the subject file placed for action on 29th May should have come to his notice.

According to *Pieve Pty Ltd v Calddran Pty Ltd* (1991) AIPC 90-832, in relation to s 131 of the Act, the solicitors said, any omissions by the person concerned or his agents were not to be countenanced, including sickness or negligence on behalf of the agents.

The solicitors referred to *Atomic Skifabrik Alois Rohrmoser v The Registrar of Trade Marks* (1987) 7 IPR 551 on the meaning of "circumstances beyond the control of the person concerned", pointing out that the principles of that case have been applied in a number of instances, one being *Re Application by Esselte Letraset Ltd* 21 IPR 517, where the hearing officer had found that a disruption, caused by an office cleaner, of a system used by the responsible attorney to determine priorities, did not fall within the definition of a *force majeure*, as envisaged by Jenkinson J in *Atomic v Registrar* case, *supra*.

If a more liberal approach was taken, the solicitors continued, then, in the present situation, the matter in suit was outside Mr Dredge's control until he asked his secretary to check the diary for any urgent matters which, in their estimation, was prior to 8th June. In their view, any *force majeure* character in these circumstances could only be held to operate until that date which was still inside the expiry of the time limit of 9th June 1995.

Mr Dredge first emphasized that his was a sole practice, and that there was no other person who could have taken over the responsibility for preparing and lodging the notice of opposition when it was due. He then moved on to exploring exactly what *force majeure* principle was and how the law concerning it had developed, because he believed that the request for the extension of time had been denied in an incorrect application of the principle. Referring to the copies of extracts from *Force Majeure and Frustration of Contract*, edited by Ewan McKendrick, Lloyd's of London Press Ltd, 1991, which were received by the hearing officer before the hearing, and particularly the extract on *Force majeure in English law*', Mr Dredge briefly commented on the origins of the term "*force majeure*".

Mr Dredge remarked that the European Court has had difficulties devising a definition or test on *force majeure* with which it is satisfied. The court had begun to tackle the problem in *Schwarzwaldmilch* case [1968] ECR 377. In 1970, it had moved away from the idea of impossibility being an integral part of *force majeure* as evident in *Internationale Handelsgesellschaft v Einfuhr-und Vorratsstelle* [1970] ECR 1125. Frustration of contract was actually a doctrine established in English law dealing with the same kind of issues as *force majeure* in the French sense. He said *force majeure* arose, as did the doctrine of frustration of contract, out of contractual law and from this he would seek guidance concerning its meaning, and how it should be applied to the present case. Mr Dredge then referred to copies from the *Frustration and Force Majeure* by G H Treitel, London, 1994, the extract dealing with circumstances involving the death or unavailability of a particular person. By citing the following passage on p136:

“[w]here the contract is one which would be discharged by the death of a party, it may likewise be discharged by that party's supervening incapacity. For example, a contract to paint a picture would (it seems) be discharged if the painter were struck blind; a contract to write a book would be discharged by the supervening insanity of the author; a contract to act in a play or to give a musical performance could be discharged by the actor's or the performer's illness on the day or days fixed for the performance”,

he argued that, in the present case, there was a doctor's certificate on file establishing that over the period when he, as an attorney, was required to carry out the task of preparing and lodging the notice of opposition, he was not fit for work, so it was not possible for him to discharge his obligations to lodge the notice of opposition at that time. From further

readings of the passage on supervening incapacity, he deduced that supervening insanity was a form of frustration and *force majeure* that may result in discharge of a contract, therefore, insanity, in the sense of an illness of an agent, would fall within the provisions of para 131(1)(a) of the Act. The factual incapacity would suffice to bring the contract to an end. As the principle of discharge by supervening incapacity had been extended to cases in which a party received medical advice that the health of that party would be injured by performance or continued performance of the contract, the circumstances in suit would again fall within the scope of para 131(1)(a). The doctor's certificate, he stressed, appeared to have been disregarded in the official letter of 11 July 1995.

Continuing his argument in relation to his reference source, *Frustration and Force Majeure*, supra, particularly the extract on '*Unavailability of party*', where it is stated that "a contract which requires a party to render 'personal' services may be discharged as a result of that party's unavailability for the purpose of performance (no less than by his death or incapacity)", he submitted that he, as a patent attorney in a sole practice, was contracted by his client to lodge a notice of opposition, but the contract would be discharged as a result of his unavailability, therefore the situation would fall within the scope of para 131(1)(a).

He noted that there was no definition of the expression *force majeure* in the *Australian Contract Law Reporter* by CCH, but directed the hearing officer's attention to the statement "the death or incapacity of a contracting party (where the performance of the contract was conditional on that person's continued personal capacity to perform it)" in the chapter on '*Instances of frustration*' at p 53-050, describing it as a situation where the doctrine of frustration to discharge parties from the performance of a contract would apply.

Mr Dredge saw the situation in *Stafford-Miller Ltd v Jean Patou Parfumeur* 11 IPR 409 as completely different from that under consideration. He pointed out that in that case the secretary, who was forced to go home with a severe migraine headache, was not a person contracted with carrying out the task of lodgment of the notice of opposition, and in a large firm of patent attorneys it would have been possible for a partner to take over the task where a person contracted to carrying out the task was eliminated.

Turning to his statutory declaration in support of the application for the extension of time, he said that, had the accident not occurred, the opposition would have been lodged in time. Considering the injury of his achilles tendon, the orthopaedic surgeon had advised him not to walk, and to wait until the swelling of the foot subsided. Even when he returned to work on 19th June 1995, the gravitational effect of trying to get around the office caused swelling and the wound actually broke open and became partially infected. His injury, he said, was not an incapacity that could be treated lightly in the sense of a migraine headache; it was an incapacity of the critical person, and an incapacity of the sole practitioner, unlike the circumstances in *Stafford-Miller v Jean Patou*, supra. Consequently, the circumstances were completely beyond his control. As the doctor's certificate had been disregarded by the officer considering the application for the extension of time, it appeared that he was being denied sick leave.

Mr Dredge then commented on the applicant's written submissions, first denying the the allegations that he had attended the office during his incapacity. Furthermore, he said, the statutory declaration did not state that matters requiring actioning were checked; the diary was checked only for complete patent applications.

Concerning the solicitors' claim that, if the circumstances which fell in the category of *force majeure* only existed until 9th June 1995, Mr Dredge said that in his declaration he had explained that the instructions relating to lodgment of the notice of opposition had been taken on the day he ruptured his achilles tendon, that the file had been placed centrally in front of his chair, and there was no reason why his staff, one secretary, would check what was near the chair as well as in the diary. He had set down his task list, which he had sent to the hearing officer before the hearing, showing that considerable amount of work was being dealt with in his office, and that he had taken the precaution of trying to find out what work could not be postponed during his convalescence. The particular notice of opposition was not in the material that his secretary would normally check. Furthermore, the doctor had been quite specific that the consequences of the ruptured achilles tendon could be harmful to his health for the rest of his life if he returned to work earlier than 16th June 1995.

## Discussion

Under sub-section 49(1):

A person may, within 3 months after the date of the advertisement of the acceptance of an application, or within such further period, not exceeding 3 months, as the Registrar, on application made to him within the first-mentioned period, allows, by notice in writing specifying the grounds of opposition and lodged at the Trade Marks Office, oppose the registration of the trade mark.

Sub-section 131(1) provides that:

131.(1) Where, by reason of -

- (a) circumstances beyond the control of the person concerned; or
- (b) an error or action on the part of an officer or person employed in the Trade Marks Office,

an act or step in relation to an application for 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.

There has been no indication that the failure to lodge the notice of opposition was caused by an error or action of an officer or person employed in the Trade Marks Office. Consequently, it is for me to decide whether the circumstances surrounding the belated lodgment of the application to lodge and serve the notice of opposition fall within the specific term, “circumstances beyond the control of the person concerned”.

Section 131 is said to be a “remedial provision to deal with *force majeure* situations arising within the framework of s 49” (*Lyons v Registrar*, supra, at p 428). The provisions of that section are limited, allowing very little scope for varying and extending the time. The limited application of s 131 has been explicitly outlined by Jenkinson J in *Atomic v Registrar*, supra, 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 operation 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 that agent's servants. The section is, I think, correctly described as a force majeure provision."

This principle has been applied in cases dealing with extension of time applications for the purpose of lodging a notice of opposition.

As evident from Mr Dredge's medical certificate, following the surgery and discharge from the hospital on 31st May 1995, Mr Dredge was unfit for work, i.e. unable to attend his office for performing any tasks until at least 16th June 1995, and he appears to have followed the doctor's strict instructions. The seriousness of his injury and the likely effect to his health, should he disobey the doctor's advice, are not in any way doubted. From the statements in the statutory declaration and the submissions at the hearing, it is clear that, during his convalescence, Mr Dredge contacted his secretary to check his diary "for any urgent matters including complete patent applications falling due during the period". In his submissions, Mr Dredge explained that the secretary had not perused the files on his desk, including the file concerning the lodgment of the notice of opposition. It would appear that, upon placing the relevant file in a location for his attention on the subsequent working day, Mr Dredge had intended to enter the matter relating to the file in his diary as a reminder for the week beginning 5th June 1995. Whether the secretary would have noticed the entry in relation to the relevant file, had it, in fact, appeared in the diary, is not apparent, because, as Mr Dredge submitted, the diary had been checked only for complete patent specifications. Be that as it may, in the absence of Mr Dredge from his office, the matter concerning the notice of opposition was not pursued.

The circumstances surrounding the belated application for lodgment of the notice of opposition are indeed most unfortunate, having been caused by a number of adverse and

coincidental factors: the injury occurring at a time when Mr Dredge was the sole practitioner in his firm, and therefore the only person charged with the responsibility of acting in the matter; the accident occurring on the day he had placed the file in a strategic position intending to deal promptly with the notice of opposition matter on the next working day; and the surgery resulting in his total immobility and incapacity to carry out any work at his office during the critical period before 9th June 1995.

Whilst I sympathize with Mr Dredge's calamity, I am unable to place much weight on his concept of the *force majeure* principle. Having regard to the unambiguous conditions expressed in the provisions of para 131(1)(a) of the Act, and the fact that these provisions have been interpreted strictly by the courts and, likewise, applied by the Registrar in various situations concerning late applications for lodging notices of opposition, in the present case, the circumstances which prevented the timely lodgment of the notice of opposition, namely, Mr Dredge's injury and its consequences, regrettable as they are, cannot be justified in light of Mr Dredge's extensive arguments in relation to the *force majeure* and frustration of contract principles and their application to his circumstances.

In *Stafford-Miller v Jean Patou*, supra, the hearing officer stated at p 411:

“While Jenkinson J [in *Atomic Skifabrik v The Registrar*, supra] referred to the “operation of nature and the activities of strangers” as coming within these sorts of circumstances, I do not believe he had in mind this sort of unexpected illness of an agent or employee of an agent as such an operation. I must agree with Mr McInnes that the prudent organisation of an office whose business is to act on behalf of clients in matters potentially of such importance as these would include some duplication or back-up of responsibility to ensure that vital steps were taken despite the incapacity of one member of staff during the normal course of duty. A disaster such as a heart attack or motor vehicle accident while en route to deliver the documents to the lodgment office, which obviously could not be foreseen or easily recovered from, is a totally different category and could be accurately designated an operation of nature.”

Assuming that Mr Dredge had actually entered the matter concerning the lodgment of the notice of opposition in his diary, then, upon contacting his secretary, she might have directed his attention to the urgency of the action, and Mr Dredge could have taken steps to pass the matter over to another firm of patent and trade mark attorneys. In the event of failing to utilize the diary promptly in relation to the particular trade mark matter and in relying only on

his memory, or a system by placing files in a certain location, or order of priorities, he exposed himself to any contingencies. A more adequate and efficient system, preferably with back-up means, could have avoided the occurrence under consideration.

Accordingly, the reasons for the delays in seeking the extension of time for lodging the notice of opposition cannot be regarded as “circumstances beyond the control of the person concerned” as contemplated in para 131(1)(a) of the Act. The delays, as I see the matter, were caused by not taking measures to ensure reliable precautions to prevent eventualities such as the present one, therefore the circumstances do not fall within the *force majeure* principle as it is applied to trade mark matters under the said provisions. The application for the extension of time to lodge the notice of opposition is therefore refused.

Vija Zars  
Acting Hearing Officer  
27th February 1996