



TRADE MARKS ACT 1955

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

Re: An opposition by **Levi Strauss & Co** to applications by the **Australian Football League** for extensions of time to serve evidence in answer in relation to opposition to registration of trade mark applications, 634395, 634396, 634398, 634399 and 634400 in the name of the **Australian Football League**.

Background

These applications in classes 14, 16, 28, 32 and 41 respectively were lodged on 8 July 1994 by the Australian Football League (AFL) for the trade mark **FREMANTLE DOCKERS**. Acceptance was advertised in the *Official Journal of Trade Marks* on various dates between 31 August 1995 and 2 November 1995. Levi Strauss & Co lodged notices of opposition, under section 49 of the *Trade Marks Act, 1955* to registration of each of these trade marks. The opponent is the owner of registered trade marks in classes 18, 25 and 26 for trade marks that comprise or include the word **DOCKERS**.

Under the provisions of section 241 of the *Trade Marks Act 1995*, proceedings under section 49 of the repealed Act which were pending immediately before 1 January 1996 continue to be dealt with under the repealed Act. Therefore, any references in this decision to sections of the Act should be taken as referring to the *Trade Marks Act 1955*.

All the evidence in support of the opposition to each of these applications was lodged at the Trade Marks Office on 19 June 1996. A question arose as to whether all of the evidence in

support had been properly served on the applicant. This matter was resolved and the date of service of this evidence was set at 13 August 1996. As a consequence, the due date for the applicant's evidence in answer, under the provisions of regulation 44, was set for 13 November 1996.

The applicant applied for and was granted extensions of time for the service of evidence in answer to 13 April 1997. Some of the evidence in answer was served on 13 and 28 February 1997. On Monday 14 April the applicant applied for a further extension of time to 13 June 1997. Levi Strauss & Co objected to the granting of the extension and the matter was set down for hearing in Canberra on 5 June 1997 before me, as a delegate of the Registrar.

Both parties requested that they be heard by telephone. The trade mark applicant, who is also the applicant for the extension of time, was represented by Mr Greg Chambers of Phillips Ormonde & Fitzpatrick. The opponent, who is both the opponent to registration of the trade mark and the opponent to the extension of time was represented by Mr Jim Dwyer of Allen Allen & Hemsley.

Submissions

At the outset Mr Chambers said that the opponent was a clothing manufacturer and merchant and the applicant's goods fall outside the normal trading interests of the opponent. He then went on to say that the evidence in support was global evidence rather than separate evidence for each application. He said that in each case the issues that arise in many respects are different for each application. He also noted that the evidence is quite voluminous and needs to be considered in a systematic fashion to assess its relevance to each of the five applications and to then prepare evidence in answer. He said that another declaration in answer had been served on 3 June 1997 and that the extension was required for service of the remainder of the evidence. The declaration served on 3 June 1997 did not complete the evidence in answer.

Mr Chambers said that the evidence in support was served toward the end of the football year, the busiest time of the year for the applicant and for the potential witnesses for the applicant. The applicant which does not have a separate legal department came under new management towards the end of 1996. The new chief executive officer, Mr Wayne Jackson, was inexperienced in the job and had to undertake the gathering of evidence, some of it from third parties, while pursuing the AFL's core activities. At the same time attempts were made to explore the possibility of negotiating a settlement. Mr Chambers also said that the gathering of evidence during the Summer holiday period posed an additional difficulty for the applicant.

Mr Chambers said that the relevant considerations to be taken into account in the allowance of an extension of time for service of evidence in opposition proceedings, under the provisions of section 130 of the Act were settled. These are:

- the length of time already allowed
- the reason put forward to justify the extension
- the seriousness of the opposition
- the inconvenience likely to be suffered by the two parties and
- the public interest in the matter.

He referred to *Mitty's Authorised Newsagency v Registrar of Trade Marks*, 78 FLR 217 at pp 219-221, *Brennan & Anor v Australian Olympic Committee Incorporated*, 1994 AIPC 91-081 and to the unpublished decision of Ms Sandra Jarvis of 12 February 1996 in *S & A Restaurant Corporation v Conquip Holdings Pty Ltd* as relevant authorities.

Mr Chambers said that if this extension were to be allowed the time allowed would be ten months which, in his opinion, was not out of the time ordinarily allowed and certainly comparable to the time allowed for the opponent to serve its evidence in support. In *Bundy American Corp v Rent-A-Wreck (Vic) Pty Ltd* (1985) AIPC 90-260,

he noted that the time allowed for service of evidence had been thirty-three months. He said that I should have regard to all the surrounding circumstances in relation to the time allowed. These included the voluminous nature of the evidence, the change in management of the AFL, the efforts made to negotiate with the opponent, the complexity of the issues, given that there were five different applications and the difficulties that exist because key witnesses are in Western Australian while the applicant is based in Victoria.

Mr Chambers said that the reasons given in the application for the extension of time were more detailed than is the norm for such applications. He said the application provides a history of events, progress to date, steps required to complete the evidence as well as advice that the applicant is awaiting a response from the opponent in relation to a request from the applicant for an opportunity to explore the possibility of an amicable resolution of the matter. A further reason for the extension of time, he said, concerns the results of research which allegedly indicate no relevant use in Australia of the four registered trade marks upon which the oppositions are based. The AFL has now filed applications for removal of these trade marks for non-use.

Mr Chambers said that the applicant has made a significant investment in its trade marks which have been used in relation to a broad range of goods and services and the applicant has already served a number of declarations in answer to the opposition as an indication of the seriousness with which it regards this opposition.

Mr Chambers then went on to say that the applicant would suffer a great inconvenience if it were prevented from serving the remainder of the evidence in relation to these trade marks which are of critical importance to the applicant's ongoing marketing and licensing arrangements. On the other hand, he said, it was difficult to see that Levi Strauss & Co would suffer any inconvenience if the extension were allowed because as a company, the opponent is only interested in making and selling clothing. The opponent does not have any registered trade marks in classes 14, 16, 28, 32 and 41.

With regard to the public interest, Mr Chambers said there was a public interest in seeing that opposition was finally resolved in the light of all the relevant information and again referred to the decision in *S & A Restaurant Corporation v Conquip Holdings Pty Ltd.*, supra.

Mr Dwyer in his response to the submissions made in support of the applicant's extension application first observed that the applicant had been aware of the opponent's DOCKERS trade marks from a time prior to the adoption of its preferred name and that the applicant had in fact made an approach to the opponent.

Mr Dwyer then addressed the matter of the time already allowed, the length of time the applicant had been in possession of the evidence in support and, here he emphasised that the reality of that time, rather than the time from the "artificial" date of service was of great importance, and, the matter of the irregularity in the service of the evidence in support. He said that the applicant had been in possession of all the evidence in support since 19 June 1996 and if this extension were to be allowed the applicant would then have been allowed almost twelve months to serve its evidence in answer.

The problem with the evidence in support had arisen because a declaration made by Terence Christopher Gaze referred to magazines attached as exhibits whereas only photocopies of the cover pages and relevant pages were attached. The applicant expressed a concern that it had not received complete copies of the exhibits and therefore was not in possession of all the materials upon which the opponent intended to rely. The opponent subsequently advised that the remaining parts of the magazines were not served because the opponent does not intend to rely on the other materials in these magazines. This satisfied the applicant and the effective date of service of this evidence was then set at 13 August 1996. Mr Dwyer stressed that the reality of the situation is that the applicant has been in possession of all the evidence in support from 19 June 1996 and that this should be taken into account when considering the length of time already allowed.

Mr Dwyer then said it should have come as no surprise to the applicant that the opponent's evidence in support is global in nature given the opponent's business. He reiterated that all of the evidence is relevant to each of the five oppositions.

In reference to the attempt to negotiate a settlement, Mr Dwyer said that the report of a telephone conversation between Ms Karen Hanna, the new managing director of Levi Strauss (Australia) Pty Ltd, a subsidiary of the opponent, and Mr Wayne Jackson contained in the applicant's application for an extension of time, was incomplete. He said that Ms Hanna had indicated to Mr Jackson, that while from a commercial standpoint she was prepared to listen to any proposals the AFL might make the opponent expected that the proper timetable for the serving of evidence should be followed. Mr Dwyer then went on to say that the applicant had been made aware by letter that any extensions of time beyond 13 February 1997 would be vigorously opposed.

Mr Dwyer said it was beyond question that there was a public interest in opposition matters being decided in the light of all the relevant information but this must be balanced with the public interest in having oppositions proceed at a reasonable pace. He noted that the applicant does not have to contend with the difficulty of seeking information from sources outside Australia.

The timetable for these oppositions should not in any way be interfered with, Mr Dwyer said, by the AFL's decision to file applications for removal from the Register of four of the opponent's registered trade marks. He said that this was a separate issue and expressed concern that it might be used to delay these opposition proceedings. He then referred to the Statutory Declaration of 26 May 1996 by Mr Terence Christopher Gaze in which he declared that Levi Strauss (Australia) Pty Ltd is an authorised user of the DOCKERS trade marks and to the declarations supporting the removal applications for the opponent's class 25 registrations, which revealed use of the trade marks in Australia which, he said, indicated there is no basis for removal of these registrations.

Discussion

Section 130 of the Act reads:

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

As a delegate of the Registrar, before exercising my discretion under section 130 of the Act, I must assess the merits of the cases for and against the granting of the extension of time. The issues to be determined are those to which Mr Chambers referred in his submissions.

I think that it is undoubtedly a fact that the AFL's attorneys were in possession of all of the evidence in support on 19 June 1996. It is equally true that the question as to whether they were in possession of all of the evidence in support was not confirmed for nearly two months. As this is so, I find, that if I allow this extension of time the length of time allowed will be ten months. I do not consider that this period of time is unreasonably long for the service of evidence in answer, although I do consider it to be more than the "modest period" described by the applicant's attorneys.

The extension of time application is overly long and not entirely relevant insofar as the reasons for requiring additional time are concerned, however, it states in part,

"After considering the files Mr Jackson endeavoured to discuss the issues by telephone with Ms Hanna for the purpose of exploring amicable settlement. He telephoned at least six times through December 1996 but was unable to make contact.

Eventually he spoke with Ms Hanna. Both chief executives are new to the positions. They had a constructive telephone conversation but Ms Hanna indicated that she was not fully familiar with the issues. The conversation was concluded on the basis that Ms Hanna was to communicate back with Mr Jackson after she had further reviewed the problem and consulted with her advisers. The AFL is hopeful that a reasonable amicable resolution may be negotiated and are waiting for further communication from Ms Hanna."

I think that as both parties' executive officers were new to their respective jobs, it was not unreasonable to expect each of them to require extra time to consider all the issues. Even though Ms Hanna may have indicated that the opponent had an expectation that the applicant should serve its evidence in answer within the timetable allowed, it is not disputed that the applicant sought to negotiate a settlement and is still waiting for the opponent to respond. If there is a possibility of achieving an amicable settlement the Registrar as per *Stafford Miller Limited v Cosco Holdings Pty Limited* (1989) AIPC 90-583 will allow a reasonable period of time for negotiations and if these should break down, as per *Jamieson v Amecican Dairy Queen Corp* (1985) 5 IPR 551 additional time may be allowed for the service of evidence. The applicant in this case has attempted to open negotiations and this provides an adequate ground for justifying an extension of time.

It is apparent from the evidence already served that the applicant has a serious interest in this opposition and would be seriously inconvenienced if it were prevented from serving the remainder of its evidence. I agree with Mr Dwyer that there is a public interest in progressing oppositions at a reasonable pace. I do not think, however, that the time allowed so far is excessive and on balance I think that the public interest would be best served if the applicant were to be granted additional time to serve the remainder of its evidence in answer.

Decision

I find that a sufficient case has been made for the granting of the extension of time to 13 June 1997 and accordingly that extension is allowed. I award costs in this matter to the applicant.

Mary Skivington
Senior Examiner

21 July 1997