



TRADE MARKS ACT 1955

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

Re: Whether a notice of opposition was lodged by the due date in the proposed opposition by COOGI AUSTRALIA PTY LTD to registration of trade mark application number 638388 in the name of SHAMAR PTY LTD

Background

As set down in the transitional provisions of Part 22 of the *Trade Marks Act 1995*, the provisions of the *Trade Marks Act 1955* continue to govern this application. Accordingly, unless otherwise specified, the authority I refer to is the 1955 Act.

Application number 638388 was lodged on 22 August 1994 in the name of SHAMAR PTY LTD (Shamar) to register the mark, as shown below, for the statement of goods “Children’s and babies’ clothing” in class 25.



The mark was advertised as accepted in the *Official Journal* of 30 November 1995. The period for lodging a notice of opposition to the mark’s registration, under the provisions of s.49 of the Act, expired on Thursday, 29 February 1996 - three months after the date of advertisement of acceptance. Such a notice was recorded as being lodged by COOGI AUSTRALIA PTY LTD (Coogi) at the Melbourne State Office of the Australian Industrial Property Organisation (AIPO) on

Friday 1 March 1996. As this was outside the due date for opposing the application, Coogi was advised of this by an official letter on 18 March 1996.

On 22 March 1996, Coogi, through its trade mark attorneys, Callinan Lawrie, lodged applications, under the provisions of s.131(1)(a), for extensions of time within which to lodge notices of opposition for this and accompanying application, 638389. There, Mr Kelson of Callinan Lawrie, said that, although the notices were given to a courier on 29 February 1996, they were not recorded as lodged until 1 March 1996. The extensions were sought on the grounds that the courier's actions were beyond Coogi's control. However, he also said that it was, "not certain that the dates of lodgement were correctly recorded". The applications were accompanied by a statutory declaration and exhibits by Mr Robert Kelson, a principal of Callinan Lawrie (first Kelson declaration). There, Mr Kelson stated that he had received instructions to lodge notices of opposition in the matter on 29 February 1996 and that those documents, the requisite fee and other documents were given to a courier at 4.10pm on that day. He said that the courier had standing instructions to deposit documents in the late lodgment box at the state office if lodgment over the counter was not possible.

On 26 March 1996, Callinan Lawrie withdrew the s.131 application for 638389, submitting that the notice of opposition there had in fact been lodged in time. That letter was accompanied by a supplementary declaration by Mr Kelson (second Kelson declaration). Mr Kelson declared that the courier organisation, Classic Couriers, had advised that its driver had indeed deposited documents in the late lodgment box on 29 February 1996. A Senior Examiner of Trade Marks advised Coogi in a letter dated 29 April 1996 that, following investigation and consideration, she was proposing that the s.131 application for 638388 should be refused. She said that, when opened on 1 March 1996, the late box contained documents from nine firms, none being Callinan Lawrie. Those documents were all credited with the previous working day's date, 29 February 1996. This was standard Office practice. The Senior Examiner further explained how the subject notice of opposition was removed from the late box on Monday, 4 March 1996 - along with other documents and fees from Callinan Lawrie - and was given a receipt number and dated the previous working day, Friday, 1 March 1996. She said that the late lodgment of the document was not a circumstance beyond the control of the person concerned, as envisaged by s.131(1)(a).

On 7 May 1996, Callinan Lawrie wrote to the Senior Examiner and enclosed a declaration by Mr Colin Ellis, the owner-driver courier employed by Classic Couriers. In his declaration, Mr Ellis stated that he had picked up a package from Callinan Lawrie at 4.10pm on 29 February 1996 and deposited it in the late lodgment box at approximately 4.35pm on the same day. He said that, although he had experienced some trouble inserting the package into the box, he had heard it drop within. Attached as an exhibit was a copy of a delivery slip dated 29 February and marked "IN LATE BOX" at the bottom. The Senior Examiner replied on 17 May 1996, advising that she was maintaining her objection that the subject notice of opposition had been lodged out of time. She enclosed the material on which she had relied to come to this conclusion, including copies of the late box lodgment statistics sheets for 29 February 1996, and 1 and 4 March 1996. Each of those sheets gave details of material found in the box on those dates and which was given the lodgment date of the previous working day. Documents from nine firms were found in the box on 1 March 1996 and they were given the lodgment date of 29 February 1996. No documents from Callinan Lawrie were found in the box on 1 March 1996.

On 24 May 1996, Mr Kelson from Callinan Lawrie sought a hearing in the matter. He also requested that he be able to question relevant state office staff at the hearing.

A hearing was held in Melbourne on 3 June 1996 before me as a delegate of the Registrar. Mr Kelson appeared on behalf of Coogi. State office staff present for questioning by Mr Kelson were Mr Robert MacRae, who was the Acting Assistant Manager of the Melbourne state office in February/March and the direct supervisor of the Collector of Public Monies (CPM), and Mr Tom Power, the present CPM for the Melbourne state office. Although several people have acted as the CPM in the past few months, the person who was most probably carrying out the duties of CPM at the time of the disputed receipt of the notice of opposition, Ms Jo Markoutsas, was on maternity leave and was unavailable for questioning. Both Mr MacRae and Mr Power answered Mr Kelson's questions on oath. I was unable to personally inspect the late box in question as the state office has moved from its old premises in Lonsdale St to new accommodation in Bourke St. The old late box was not transported to the new office and has in fact been disposed of. Mr Kelson sent me a letter later the same day pointing out that the statement of events put forward by Coogi were

as encapsulated in the statutory declarations. He said that there was no direct evidence from Ms Markoutsas. Mr Power could only testify (on oath) as to his observations of Ms Markoutsas' procedure on other occasions (than the days concerned).

The Hearing

Mr Kelson asked Mr MacRae to outline the daily procedures followed by the CPM in opening and removing the contents of the late box. Mr MacRae said that the CPM's first duty every morning was to unlock the late box and remove the contents. S/he would then open any envelopes which were in the box, list the items and the attorney firms from which they had come, divide the contents between fee and non-fee items, issue receipts for any cheques received and then process the lodgments. Mr Kelson asked if the CPM fully checked the interior of the late box when emptying it and if this was difficult at the previous office location, given that one would have had to check that nothing was caught up in the flap of the box used at that time. Mr MacRae replied that, although one had to bend over and look up to check the flap, this would not have been too difficult to do. He said that, in his experience, the CPM always fully checked the box and felt around inside for any further items.

Mr Kelson then questioned Mr Power with respect to the CPM's procedures in the emptying of the late box. Mr Power said that emptying the box is the CPM's first duty on arriving in the morning. In his own case, this is around 8am. Any items inside are then stamped as having been received on the previous working day. Mr Kelson then asked if Ms Markoutsas, who was pregnant at the time of the events in question, may have been physically inconvenienced by her condition, making bending over to look inside the box difficult. Mr Power said that, in his opinion, Ms Markoutsas was not hampered in any way and could easily bend over to look inside the box. Questioned further about the usual procedures involved in emptying the late box, Mr Power said that, at the premises previously occupied by the state office, the items were taken from the box and placed on a desk outside the CPM's office. There the envelopes were opened, the contents recorded and then taken inside the CPM's office where receipting procedures were carried out. He said that care was taken to ensure that the previous working day's date was given to the material brought in from the late box.

Mr Kelson then submitted that, on one hand, both his and Mr Ellis' declarations outlined what had happened with respect to the notice of opposition being lodged in the late box on 29 February 1996. He said that the courier, Mr Ellis, had previously made deliveries to the state office - both over the counter and via the late box. He was well aware of the procedures involved. On the occasions that he had used the late box, he had written the words, LATE BOX, on the delivery docket in exactly the same manner as that of the docket for 29 February 1996. On the other hand, the statements of Mr MacRae and Mr Power outlined the usual procedures involved in the clearing of the late box and the recordal of the lodgment date on the items within. Mr Kelson said that it appeared that, in this instance, something had broken down in the execution of these procedures, with the document's lodgment not being recorded or being recorded at the wrong time. He said that Mr Ellis had declared that he had difficulty inserting the package into the late box but then he had heard it drop within. Mr Kelson said that it was possible that another package may have been stuck in the flap of the box and, when Mr Ellis inserted the package in question, he may have dislodged the first package, its fall into the box being the sound he had heard. However, the package in question may have then been stuck in its place. Mr Kelson further submitted that, given both his and Mr Ellis' declarations concerning delivery and receipt, and Mr MacRae's and Mr Powers' statements describing the correct procedures to be followed, it seemed quite plausible that some intervening circumstance had caused the date of the notice of opposition's lodgment to be incorrectly recorded.

Discussion

The *Trade Marks Act* 1955, which relates to the proposed opposition in the present case, and the regulations which were in force under that Act, were silent with respect to the use of a late box. Until this anomaly was overcome by the regulations in force under the *Trade Marks Act* 1995, trade mark documents lodged outside state office hours were treated in the same manner as those lodged under the patents regulations to the Patents Act 1990.

Reference to late filing is made in patents regulation 3.5. It reads:

Filing date

3.5 (1) For the purposes of section 30 of the Act ("filing date"), the filing date of a patent application is the date on which a patent request in relation to the application that is accompanied by a specification is filed.

(2) The Patent Office and each sub-office of the Patent Office may provide facilities for the filing of documents when the Office or sub-office is not open to the public for business.

(3) A document filed under subregulation (2) is taken to have been filed on the day on which the Office or sub-office was last open for business before the document was filed.

It is worth noting here that new regulations were in force and applied to the late lodgment box as at the relevant date - although not specifically to papers lodged under the 1955 Act. Such reference is made in regulation 21(5) in force under the 1995 Act. As there is now trade marks legislation which specifically refers to the topic, I think that this case should be considered in the light of that legislation.

Regulation 21(5) reads:

Filing of documents—date of receipt to be marked

21.5 (1) A document that is received for filing must be marked by the Registrar with the date on which it is received.

(2) If the Trade Marks Office or a sub-office provides a facility for the receipt of documents (other than documents filed electronically or by facsimile transmission), when the Trade Marks Office or sub-office is not open to the public for business, a document received by means of that facility is taken to have been received on the day on which the Trade Marks Office or sub-office was last open to the public for business before the document was received.

(3) Except as otherwise provided by the Act or these Regulations, a document is taken to be filed at the Trade Marks Office on the date on which it is received by the Trade Marks Office.

In the present instance, as at the dates in question, the Melbourne state office provided a facility for the receipt of documents outside the hours of that office being open to the public. Therefore, the date which was stamped on documents cleared from that facility - the late box - was that of the previous working day.

It is possible to infer from regulation 21(5) that any documents filed in that box *up until* the state office is open to the public, i.e. 10am on a certain day, should receive a filing date of the previous working day. However, the normal procedure in the Melbourne state office is for the CPM to clear the box on his/her arrival at work - as early as 8am - and not open it again until the same time the

next morning. This means that documents could be filed between 8am and 10am - at which time the office is open for business - and not be cleared until the next day.

This means that, for those two hours, despite the box still being *in situ*, the office does not provide that facility for the purpose of the receipt of documents outside opening hours. Staff would therefore not record any documents, put in it between 8am and 10am, as being filed on the previous working day. Any such documents would not be discovered until the following morning and would be recorded as being received on the day that they were actually filed, albeit before the office was open to the public. I have made inquiries which reveal that the various state offices have different procedures. Some do not empty the late box until 10am, when they open to the public, while others follow the same procedures as the Melbourne office and clear the box when the CPM arrives at work. Therefore, there appears to be divergent views on when the late box facility is considered to be in use. This issue is clouded by the locations of the various state offices and whether the premises are easily accessible to the public outside the normal business hours of nine to five. In the case of the Melbourne office, as I have previously stated, the late filing facility is not provided for the entire time that the office is closed.

To lessen the possibility of problems occurring such as in the present case, I would recommend that, in each state office, the local procedures for emptying the box, and the filing date attributed to documents filed in it at certain times of the day, should be clearly displayed to the public, perhaps in a sign next to the box. Alternatively, the late box could be covered over in some way to make it impossible for people wishing to file material to do so in the time after the box is emptied in the morning until 4pm. This would remove any ambiguity or misconceptions about the facility. A literal reading of the regulations would seem to indicate that, if a box has been made available, then documents should be able to be filed in it at any time that the office is not open. However, there are other considerations, including ease of building access, as I have said, which could intervene. I believe that there is an uneven, and perhaps unfair, set of circumstances existing, where trade mark clients in one state may have longer access to a late filing facility than those in another. I have been advised that this anomaly is being investigated with a view to bringing procedures throughout the state offices into conformity.

However, in any event, a possible shortfall in the morning hours that the late box was available to the public in the Melbourne is not the issue here. As Mr Kelson has reminded me, Mr Ellis, the courier employed by Callinan Lawrie, has made a statutory declaration that he delivered a package containing the notice of opposition to the Melbourne state office by utilising the late box facility in the afternoon - when the box was unambiguously available for late lodgments. He said in his declaration that he picked up the package - which Mr Kelson confirmed as containing the notice of opposition, along with other documents - from the premises of Callinan Lawrie at Kew at 4.10pm and, at approximately 4.35pm on 29 February 1996, the last day on which that document was due to be filed, put it in the late box. Why then was it not discovered by Ms Markoutsas when she emptied the box on the next morning, 1 March 1996? One explanation is that the package may have become caught in the flap, dislodging another package already wedged there and which caused the sound which Mr Ellis heard inside the box. Ms Markoutsas may then have not checked the flap properly when she emptied it. However, from the answers given by the state office personnel during the hearing, I think that such a train of events is unlikely. Mr MacRae said that it was standard procedure for the CPM to look inside the box and feel around for all of the items within. Mr Power was adamant that, in his opinion, Ms Markoutsas had not experienced any difficulties at all while carrying out her duties - which included fully emptying the box. It is unfortunate that I was not able to physically inspect the box myself at the hearing. Its non-availability and the absence of Ms Markoutsas on maternity leave is an unfortunate combination, making my deliberations reasonably circumstantial.

However, I do not think that a package could easily become wedged in a flap of such a box. I can recall, from my own experience of visiting the old premises used by the state office, that its opening was similar in style to a post box. Any item such as a package containing two notices of opposition and the requisite fee, along with other documents, would be reasonably bulky. One could imagine, say, a sheet of paper, becoming caught in a flap but not a heavier packet of papers. The list of articles cleared from the box on 1 March 1996, and which was completed by the CPM, shows items lodged by nine firms - none of them being Callinan Lawrie. These items were all given the lodgment date of 29 February 1996. This means that the whereabouts of the entire package from Callinan Lawrie - not just the notice of opposition in dispute here - is unknown between the time it was collected from its source until its contents were recorded on the morning of 4 March 1996 as

having been filed on 1 March 1996. If one is to first contemplate that the package became wedged in the flap of the box after its declared 4.35pm delivery, it then seems to be stretching credibility to the extreme to believe that there were no more late lodgments on that day which could have, in turn, dislodged it, as Mr Kelson has surmised that his package did to another.

Another possibility, which I should consider, is that the package in question was cleared from the box on 1 March 1996, taken along with the rest of the box's contents to the table outside the CPM's office and somehow not recorded as having been received on 29 February 1996, or given the wrong date because of the extra day in February, as Mr Kelson has implied. However, all of the other items from other firms received on 1 March 1996 were duly recorded as being received on 29 February 1996, and there is nothing to suggest that the Callinan Lawrie package, if it was there, was given different treatment. It also seems unlikely that the package was dropped on the way from the box to the table and not retrieved until the following working day. The Melbourne state office is, and was at the time of the missing package, an orderly and clean environment, and I am sure that any package lying around the floor would have been noticed and retrieved immediately by one of the staff members.

I do not dispute Mr Ellis' remembered version of events as laid out in his declaration. I believe that he honestly declared what he believed to be the truth. However, that declaration was not made until 6 May 1996 and concerned events which took place some nine weeks previously. Therefore, it is reasonable to expect that his recollection of the delivery of one package, amongst the many that a courier would make, could become clouded by time. I understand that Mr Ellis' delivery docket shows the pick-up time of a package from Callinan Lawrie at 4.10pm on 29 February 1996 and that it includes the words, IN LATE BOX. The notice of opposition in question was definitely found in the late box because the Official Receipt for the fees included in the package shows it was received, "At NIGHT", i.e. in the late box. However, it is unclear whether that lodgment was made in the late box that Thursday afternoon or after the box had been cleared the next morning, Friday. The latter course would mean that the package would not be discovered until the next time that the box was cleared - the following Monday.

In my opinion, the possibilities of a package being mislaid in such a small area as the confines of a late box, or its loss and later recovery within the office are extremely remote. I do not believe that an error was made in relation to the recordal of the date of receipt of this one notice of opposition, when hundreds of other documents are filed daily with no question as to the accuracy of their date of receipt.

Decision

Given the foregoing, I am of the opinion that it is highly improbable that the notice of opposition was lodged by the due date of 29 February 1996. It would appear more likely that the package containing it was delivered after the box was emptied on the morning of 1 March 1996 and Mr Ellis' declaration to the contrary, although undoubtedly honestly made, is flawed by the passage of time, memory and circumstance. I therefore find that the notice of opposition to the registration of trade mark application number 638388 was made out of time and is therefore not valid.

Ian Forno
Hearing Officer

17 June 1996