



TRADE MARKS ACT 1955

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

Re: Opposition by TRIVETT CLASSIC PTY LTD to an application to record the estate of the late JOHN WILLIAM TRIVETT as successor in interest in place of JOHN WILLIAM TRIVETT in whose name were lodged trade mark applications numbers 640145 and 670080

As provided for 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 opposition. Unless otherwise specified, any reference to the Act in this decision is a reference to the *Trade Marks Act 1955*.

Background

Trade mark applications numbers 640145 and 670080, both lodged in the name of John William Trivett, are seeking registration of the word mark TRIVETT. Application number 640145, lodged on 12 September 1994, is in respect of "motor vehicle sales", which are services included in class 42. The other application, number 670080, is a divisional of application number 640145 in respect of "motor vehicle repairs and services", in class 37, which was lodged on 21 August 1995, but is claiming the priority date of its parent application. Acceptance of both applications was advertised in the *Australian Official Journal of Trade Marks* of 30 November 1995. The applications bear two endorsements:

Registration is limited to the States of Queensland, New South Wales and Western Australia

and

The provisions of sub-section 24(2) applied.

On 16 February 1996, Trivett Classic Pty Ltd (the opponent) lodged notices of opposition to the registration of trade marks of both applications, under the provisions

of section 49 of the Act. The lodgment of the evidence in terms of regulations 43, 44 and 45 was completed on 29 June 1998.

The hearing on the opposition was set down before me, as the delegate of the Registrar of Trade Marks, in Sydney. Mr Wayne Muddle of Counsel, instructed by H.R. Hodgkinson & Co, patent and trade mark attorneys of Sydney, represented the opponent. Ms Angela Bowne, also of Counsel, instructed by Marshalls & Dent, lawyers of Melbourne, appeared for the applicant.

Since the applicant had applied for leave to adduce further evidence, I first heard submissions on this matter presented by both parties. I indicated that I would allow the application to serve further evidence and was prepared to grant the opponent time for reply. However, at the commencement of the opponent's submissions on the substantive opposition issues, a question arose concerning the applicant in the opposition proceedings as the applicant had died in May 1997. Having heard the submissions on this question, I decided to defer the hearing on the other issues concerning the opposition until the matter of standing of the applicant was determined. As a consequence and for reasons which will become apparent from this decision, I will also hold the further evidence matter in abeyance. What follows is my decision on a preliminary matter, the substitution of the "estate of the [late] John William Trivett" for the presently appearing name of the applicant. Henceforth in this decision the applicant will be referred to as "the deceased applicant".

Submissions on the applicant's standing

In addition to their oral submissions concerning the applicant's standing, both Mr Muddle and Ms Bowne proposed to forward to me further written submissions subsequent to the hearing, which were received and are included in this decision.

In opening his submissions on the primary question, Mr Muddle stated that the application, which had been lodged to substitute the deceased applicant's name, did not comply with the *Trade Marks Act 1955* for four distinct reasons:

- death of the applicant
- a local grant of probate was required
- the executors must act jointly
- there was no power to continue these proceedings.

With reference to section 40 of the Act, Mr Muddle pointed out that an application for registration of a trade mark may only be made by "a person". Owing to the applicant's death, the applicant of these applications did not now exist, he said. Here it will be convenient for me to refer to section 134 of the Act which provides that:

134. If a person who is party to a proceeding under this Act (not being a proceeding in a court) dies pending the proceeding, the Registrar may, on request, and on proof to his satisfaction of the transmission of the interest of the deceased person, substitute in the proceeding his successor in interest in his place, or, if the Registrar is of opinion that the interest of the deceased person is sufficiently represented by the surviving parties, permit the proceeding to continue without the substitution of his successor in interest.

Mr Muddle then continued submitting that, from the material supplied by Ms Bowne, an application had been made to substitute Philip Michael Trivett as the name of the applicant in the proceedings. However, the only persons having any standing or right to make an application for substitution were the late applicant's representatives, having obtained a grant of probate or administration in the Supreme Court of New South Wales, Mr Muddle said. If there were more than one legal representative, such persons ought to act jointly and only where the will contained an express power to do so, or the Supreme Court had so ordered. It was clear that section 134 of the Act required the Registrar to be satisfied of these qualifications before any substitution. Since the said Mr Trivett had not obtained a grant of probate from the Supreme Court of New South Wales, he did not qualify as such a person, Mr Muddle submitted. In this regard I must explain, that an application has been made by the deceased applicant's solicitors reading:

"As you are probably aware, the applicant has passed away and accordingly the name of the applicant should be changed to
ESTATE OF THE JOHN WILLIAM TRIVETT."

Ms Bowne responded to Mr Muddle's submissions by saying that the requirements of section 134 had been satisfied by providing to the Registrar certified copies of the deceased applicant's will and probate, proving that the administration of his estate was granted to the executors, and that the deceased had devised and bequeathed the residue of his estate to his executors. In her opinion, the written request which sought

the substitution of the "estate" rather than the executors should not detract from the fact that the application for substitution was made. It was clear that the proper applicant should be the executors of the estate. However, if one executor declined to be a party, there was nothing in the Act that prevented the other executor from being named as a party or from making an application to be substituted in his name, Ms Bowne said. In any event, the Registrar should not permit Mr Duncan's conflict of interest as a director of the opponent's company to defeat the deceased applicant's right to have his applications for registration determined.

In elaborating on his statement that no person had the power to bring the present proceedings because no grant of the probate had been obtained from the Supreme Court of New South Wales, Mr Muddle referred to G.L. Certoma's *The Law of Succession in New South Wales*, Law Book Company, Sydney, 1997, at 261, that "a foreign representative must obtain a local grant of representation before the representative can deal with assets within the jurisdiction or sue or be sued within the jurisdiction". He further cited *Nagel v Hough* (1927) 27 SR(NSW) 418 concerning proceedings in the state of New South Wales where there had been only a grant of probate from the Queensland Supreme Court, the court holding that "the law seems clear that the operation of a grant of probate is purely territorial and local". The fact that the Registrar was exercising Federal jurisdiction, Mr Muddle argued further, did not make the laws of probate irrelevant. The law of standing and the law of procedure was the law of the forum in which the Federal jurisdiction was exercised. Mr Muddle said that there was no Commonwealth law of probate and succession as the Commonwealth Parliament lacked power under the Constitution to make laws with respect to such matters, hence, according to the rules of private international law, the Registrar applied the *lex fori*, or law of the forum to such questions.

Ms Bowne submitted that the grant of probate was general and not limited with reference to property or purpose, so that the executors may fully administer and distribute the estate. Any intellectual property that is the subject of a statutory or common law right, is intellectual property in Australia, not in any one particular state or territory, she said, for support referring to *Lyndsay Edmonds & Associates Pty Ltd v Quest Sales Pty Ltd* (1979) 60 FLR 349. A trade mark was personal property and it was sited in the Commonwealth of Australia, as opposed to any particular state or

territory. Ms Bowne said that the case of *Nagel v Hough*, supra, applied to a totally different factual situation and could not be authority for the proposition that there must be a grant of local probate before an executor can seek to continue a proceeding, let alone a proceeding that was an application for a statutory entitlement through an administrative procedure.

Even if it was found that the probate from the Supreme Court of Queensland was sufficient, Mr Muddle argued, then, nonetheless, sub-section 49(5) of the *Succession Act 1981 (Qld)* required that "[t]he powers of personal representatives shall be exercised by them jointly", i.e. that the executors act jointly. The act of one of them alone would be a nullity, he said. He noted that the law in New South Wales in so far as it relates to the bringing or defending of proceedings was the same, that is, that the executors must act jointly - Mason & Handler, *Wills Probate and Administration* (Butterworths Service). In any event, it was clear as a matter of common sense and practice that the Registrar should not act on the request of one executor alone where there were two executors. Acting at the behest of one executor would place the Registrar in an impossible position if there was a disagreement between the executors as to continuation of the application.

With reference to *The Law of Succession in New South Wales*, supra, at 284, Ms Bowne responded by saying that the general principle relating to executors was that, where more than one executor was appointed, their authority was joint and several so that either one represented the deceased and may bind all of the others. The author had noted at 285 in that publication two exceptions to this general proposition, the first of which did not apply here, the second being that all representatives should generally be joined in bringing or defending actions. As to Mr Muddle's submissions in relation to sub-section 49(5) of the *Succession Act 1981 (Qld)*, Ms Bowne said that a legal personal representative had a duty to do everything in his power for the benefit of the estate - Williams, Mortimer & Sunnucks, *Executors, Administrators and Probate*, Sweet & Maxwell 1993, at 703 - and to protect a beneficial interest in the estate, even if only contingent. That was all that Mr Trivett was attempting to do in seeking a determination of the applications by the Registrar. The action of prosecuting the applications was merely part of the process of calling in the assets. If the trade marks of the applications were to proceed to registration, both the executors

would have an interest in the trade marks and would need to act jointly once the trade marks were registered. The effect of sub-section 49(5) was to require the personal representatives to act jointly in disposing of assets. Thus, the executors needed to act jointly in only disposing of the marks, not in registering them, Ms Bowne said.

Turning to the will of the deceased applicant, Mr Muddle submitted that it did not grant to the executors a power to commence or continue trade mark applications or proceedings in relation to such applications. Given the long list of powers contained in the will, there needed to be an express power in respect of these matters, Mr Muddle said, noting that at common law the executors had very limited powers which did not include the power to commence or continue proceedings. In the absence of such a power, the executors should apply to the Supreme Court for an order - *Wills Probate and Administration*, supra, paras 8009 and 8013. In addition, Mr Muddle said, there was real prejudice to the opponent, because the Registrar's power to award costs was confined by section 119 to awarding costs against "a party to the proceedings". Moreover, there was no entitlement to an indemnity from the estate of the deceased applicant, except where both executors acted jointly in continuing the proceedings, pursuant to a power in the will or order from the Supreme Court.

Concerning the power to continue the proceedings, Ms Bowne said that an application for registration was not a "proceeding" as a "proceeding in a court", but was administrative in nature. It would appear, she continued, that there was no actual property in an application for registration, only a mere expectancy of future property, and that the present property came into existence upon the grant of registration of the trade mark. It was only when the mark was permitted to proceed to registration that the unsuccessful opponent could challenge the decision of the Registrar in court proceedings. Consequently, Ms Bowne submitted, any argument based on the lack of power in the will to prosecute proceedings was misconceived because (a): the hearing was not a proceeding as the opponent contended, but an administrative process undertaken as part of the executors' duty of getting in the assets; and (b): the fact that the executors had a duty to get in the assets could not be disputed. That duty or power in the will was implied but, in any event, clause 7 of the will required the executors to "call in" such parts of the estate which did not consist of money. Ms Bowne said that a distinction must be drawn between the roles of Mr Trivett and Mr Duncan as

executors of the estate as opposed to their appointment as trustees. The act of taking steps to have the trade marks registered was clearly a part of "collecting all the assets of the estate" which was one of the necessary conditions for the completion of the administration of the estate. Once the administration of the estate was complete, then Messrs Trivett and Duncan would hold the assets as trustees for the beneficiaries of the estate.

The issue

The provisions of section 40 of the Act state that:

40.(1) A person who claims to be the proprietor of a trade mark may make application to the Registrar for registration of that mark in Part A or Part B of the Register.

A "person" under section 6 of the Act "includes a body politic and a body of persons, whether corporate or unincorporate".

The copy of the probate tendered at the hearing shows that on 28 January 1998, the will of the deceased applicant, John William Trivett, who died in Brisbane on 24 May 1997, was proved and registered in the Supreme Court of Queensland. It provides that

"administration of all and singular the estate of the said deceased was granted by the Court to PHILIP MICHAEL TRIVETT of 79 Hawkesbury Esplanade, Sylvania Waters in the State of New South Wales, Company Director and GREGORY JAMES DUNCAN of 58 Hawkesbury Esplanade, Sylvania Waters aforesaid, Chartered Accountant, the Executors named in the said Will."

Inter alia, it has been submitted by the opponent, based on the law of succession, that it is not sufficient for this probate to be obtained only in the state of Queensland, but that it should also be granted from the Supreme Court of New South Wales for the hearing of the opposition on the subject applications to be allowed to proceed. I think it will be appreciated by both parties in these proceedings that a final decision of such a matter clearly falls outside of the Registrar's sphere of authority and should be taken to another forum.

During the hearing, I confirmed that a request has been received from the solicitors acting for the deceased applicant that the name of the applicant should be changed to the "Estate of the [late] John William Trivett". The requested amendment to

application number 670080, together with a copy of the first page of the probate, had been transmitted to the Trade Marks Office by facsimile on 14 October 1998. According to the office records, no such request has been made in respect of application number 640145.

As will be obvious from the submissions, the present problem has arisen because the second executor, Gregory James Duncan, named in the will of the deceased applicant, has not consented to the request to be a party to the applications. Mr Duncan is also a director of the opponent company and, naturally, would be assumed to have conflicting interests in the matter.

Decision

In the present circumstances, where the applicant's death occurred while his applications were pending and subject of opposition proceedings, the deceased applicant was "party to a proceeding" under the 1955 Act, hence the Registrar is bound to ensure that the provisions of section 134 are met. The section specifies that before allowing any substitution for the applicant in the proceedings, the Registrar would require documentary evidence which satisfies him or her that the interests of the deceased applicant have been transmitted to the person or persons applying for the substitution. Alternatively, the Registrar could allow the proceedings to continue without the substitution of the deceased's successor in interest, if he or she found that the interests of the deceased applicant were adequately represented by the persons surviving him.

Concerning the proposed amendment to enter the name the "Estate of the John William Trivett" as a substitute for that of the deceased applicant, I am not prepared to entertain such an amendment as fulfilling the requirements of section 134, because the designation "the estate" of the deceased applicant constitutes neither a person within the meaning of sections 40 and 6 of the Act, nor the "successor in interest" of the deceased, in accordance with the furnished documents. The copies of the probate and will of the deceased applicant unambiguously indicate that his estate is to be administered by two executors, Philip Michael Trivett and Gregory James Duncan.

While it is not in the Registrar's competence to decide what powers are granted to the executors of a will, given the manner in which the will is constructed, whereby various clauses provide specific instructions in relation to particular property, i.e. clauses 4, 5 and 6, even though intellectual property is not specifically mentioned in the will, it would appear that the phrase "all the rest and residue of my estate" in clause 7 embraces matters dealing with trade mark applications. The relevant portion of clause 7 reads:

"I GIVE DEVISE AND BEQUETH all the rest and residue of my estate both real and personal and situated anywhere in the world ("my residuary estate") to the Executors to sell, call in and convert into monies such part or parts thereof as shall not consist of money and to hold the proceeds of such sale, calling in or conversion on trust:

- a. to pay the income of my residuary estate until distribution to my wife BEVERLEY ANNE TRIVETT; and
- b. to divide the capital of my residuary estate as and when it is realised:
 - i. as to two thirds by value to such of my wife BEVERLEY ANN TRIVETT and my son JUSTIN WAYNE TRIVETT as survive me and if both as tenants in common in equal shares; and
 - ii. as to one third by value on trust for my daughter PETINA JAYNE TRIVETT when she attains the age of thirty-five (35)

.....".

When the quoted part of clause 7 of the will is read in conjunction with clause 8, which contains the powers of the executors, it seems to me that the executors' power to continue with the pending trade mark applications of the deceased applicant was implied. Thus, had there been an agreement between the two executors named in the will of the deceased applicant, for the purpose of section 134 the Registrar would have permitted the continuation of the proceedings in relation to the present applications currently before the Registrar.

Conclusion

In light of the fact that the proposal to substitute the estate of the deceased applicant in place of the presently entered name in respect of these applications fails to satisfy the Registrar's requirements of section 134 of the Act and the related complex matters which emerged from the submissions, such as, whether the granting of probate in the state of New South Wales is necessary in the present case, whether a single executor could be substituted as a party to the present applications, and whether express powers

should have been included in the deceased applicant's will for the executors to prosecute the present applications, which matters are entirely outside the Registrar's province, I have decided to defer the proceedings for a period of two months to enable the parties to resolve the existing conflict. In the circumstances, the proper course of action, as already implied by the parties, would be to seek an order or direction from the Supreme Court of Queensland on how to deal with the matter in suit so as to remove the obstacle which prevents the continuation of the opposition proceedings. However, an application for substitution as the deceased applicant's representative or representatives in the proceedings, supported by documentary evidence, which would satisfy the provisions of section 134 of the Act would be acceptable.

As it is in the public interest to conclude the current proceedings in an expeditious and efficient manner, before the expiry of the two months from the date of this decision allowed for the proposed action, the parties are required to provide evidence that the matter is proceeding to the court. Alternatively, an application may be filed in that period, as suggested earlier. If these requirements are not met, the Registrar may consider refusing registration of trade marks of the subject applications. Before issuing the final decision, however, a hearing will be reconvened for the parties to present submissions on the matter.

Vija Zars
Hearing Officer
15 January 1999