TRADE MARKS ACT 1995

DECISION OF THE REGISTRAR OF TRADE MARKS WITH REASONS

Re: Proposal to revoke acceptance of trade mark application number 718840 — DOC'S — which is filed in the name of Arista Enterprises Inc

Background

Trade mark application number 718840 was filed by Arista Enterprises Inc (Arista) of Hauppauge, New York, in the United States of America, on 3 October 1996. The trade mark is the word DOC'S and the goods nominated are in classes 9 and 28. Following an amendment to the class 9 goods, the specification stands as:

> Class 9: *Electrical and electronic goods included in this class; parts and accessories included in this class for the aforementioned goods,* and
>
> Class 28: *Games and playthings; parts and accessories included in this class for all the aforementioned goods.*

The examiner reported that there were grounds for rejection of the application under section 44 of the *Trade Marks Act 1995* citing, *inter alia,* trade mark registration 539359(9) and applications 648682(9), 707309(9), and 721209(9) all being in respect of trade marks which incorporate the word element DOCS and all of which were filed in the name of PC Docs Inc (PC Docs) of Tallahassee, Florida, in the United States of America. The address now recorded for the earlier marks is Burlington, Massachusetts.

After considering submissions from Arista's attorney, the examiner withdrew all the citations except application 721209(9), which sought registration of the single word trade mark DOCS in respect of *computer software; computer programs for the filing, retrieval, backup, storage and management of electronic files, namely, images, spread sheets, word processing documents, audio objects and/or video objects, and related instruction manuals.* Although this application was filed later than 718840, on

6 November 1996, it was endorsed with a claim for priority for the purposes of subsection 29(1) of the Act. This was based on a trade mark application (75-099972) filed in the United States of America on 7 May 1996 in respect of "computer programs for the filing, retrieval, backup, and storage management of electronic files, namely, images, spread sheets, word processing documents, audio objects and/or video objects, and related instruction manuals".

Application 721209 was allowed to lapse and therefore ceased to be a bar to acceptance of 718840 but PC Docs had filed a divisional application 769032 on 31 July 1998 which the examiner then raised as a citation against 718840 in terms of section 44. Application 769032 was filed for the goods specified in the initial application 721209 but excluded "*software for analysing printer malfunctions*"; this exclusion brought the divisional application within the terms of subsection 48(2) which only allows a divisional application to be filed in respect of some, but not all, of the goods specified in the initial application. It was endorsed with the statement:

> "Pursuant to the provisions of section 45, this application is divided out of initial application no. 721209 filed 6 November 1996."

In citing application 769032 against application 718840 the examiner took it that the right to priority in terms of section 29(1), which was claimed on filing application 721209, was automatically inherited by the divisional application, giving it a priority date of 7 May 1996. This citation was later withdrawn on the basis that application 769032 could not take advantage of the right to priority based on the Convention country application because the notice of a claim for priority required by section 29(1) and regulations 4.5 and 4.6 had not been filed in respect of the divisional application. Application 718840 was accepted and the acceptance advertised in the *Official Journal of Trade Marks* of 26 November 1998.

When PC Docs were advised of the circumstances surrounding acceptance of application 718840 they filed the further application 785389 as a divisional of 769032. This application was filed on 12 February 1999 in respect of the goods claimed by application 769032 with a further exclusion of "*software for analysing engine malfunctions*" which exclusion again brought the divisional application within the terms of subsection 48(2). It was endorsed with the following statements:

> "Pursuant to the provisions of Sections 45 and 48, this application is divided out of application no. 760932 having a filing date pursuant to Section 50 of 6 November 1996" and
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> "Pursuant to the provisions of Section 29, Convention priority is claimed from trade mark application no. 75-099972 filed in the United States of America on 7 May 1996 in respect of computer programs for the filing, retrieval, backup, and storage management of electronic files, namely images, spread sheets, word processing documents, audio objects and/or video objects, and related instruction manuals"

PC Docs claimed that, by virtue of its divisional status and its claim to priority under section 29, application 785389 had a priority date for registration earlier than 718840 and was therefore a bar to the registration of that application. On this basis, revocation of the acceptance of application 718840 was sought under section 38 of the Act.

Section 38 reads:

> **Revocation of acceptance**
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> **38.** **(1)** If, before a trade mark is registered, the Registrar is satisfied:
>
> (a) that the application for registration of the trade mark was accepted because of an error or omission in the course of the examination; or
>
> (b) that, in the special circumstances of the case, the trade mark should not be registered, or should be registered subject to conditions or limitations, or to additional or different conditions or limitations;
>
> the Registrar may revoke the acceptance of the application.
>
> Note: For ***limitations*** see section 6.
>
> **(2)** If the Registrar revokes the acceptance:
>
> (a) the application is taken to have never been accepted; and
>
> (b) the Registrar must examine, and report on, the application as necessary under section 31; and
>
> (c) sections 33 and 34 again apply in relation to the application.

An acting Deputy Registrar in the Examination Section advised Arista that, after reviewing all the circumstances, he considered the following grounds exist for revocation:

- the acceptance officer did not have regard to the provisions of Article 7 of the *Trademark Law Treaty* that provides for preservation of the right of priority of an initial application by a divisional application. Therefore acceptance of 718840 in the face of application 769032 resulted from an error and omission in terms of section 38(1)(a), and

- application 785389 filed since acceptance of 718840 also has an earlier priority date for registration and now constitutes a further citation under section 44. This is a special circumstance in terms of subsection 38(1)(b) providing a further ground for revoking acceptance.

The Deputy Registrar advised that he proposed to revoke acceptance of application 718840 but before doing so offered the applicant an opportunity to seek a written decision to be made on the record. Through its attorney Mr John Davy, a partner in the firm of Freehills Patent Attorneys, of Melbourne, Arista has now filed written submissions and sought the Registrar's decision on the matter of revocation of acceptance. The matter has come to me for decision.

Submissions and Discussion

The following table lists the applications that are relevant to the matter of revocation of acceptance of application 718840 in the order of their being filed in the Trade Marks Office.

Number	Trade Mark	Owner	Date Filed	Date of any Priority Claimed	Endorsed basis for the Claim
718840	**DOC'S**	Arista Enterprises	3 Oct 1996	—	
721209	**DOCS**	PC Docs	6 Nov 1996	7 May 1996	US convention claim
769032	**DOCS**	PC Docs	31 July 1998	6 Nov 1996	divisional of 721209
785389	**DOCS**	PC Docs	12 Feb 1999	6 Nov 1996.... 7 May 1996…	divisional of 769032 US convention claim

The question of whether or not the acceptance of an application should be revoked under either or both of paragraphs (a) and (b) of subsection 38(1) depends ultimately on whether it was accepted because of an "error or omission" in the course of examination or whether there are "special circumstances" which satisfy the Registrar that the trade mark should not be registered. In the present case, this essentially depends on which, if any, priority date for registration should be accorded under the Act to applications 769032 and 785389. There has been no serious argument from Mr Davy that the trade marks DOC'S and DOCS are not at least deceptively similar or that the goods specified in each of the applications do not include goods that are similar.

The question of whether there were grounds for rejection under section 44(1) which should have been maintained in respect of application 769032, or raised in respect of application 785389, therefore turns on the criterion set down in paragraph 44(1)(b), that is, which of the conflicting applications has the earlier priority date for registration.

The law

The *priority date* for registration of a trade mark in respect of particular goods or services is defined by section 12. It is the date of registration, that is the date from which the registration of the trade mark is or, in the case of a trade mark whose registration is being sought, will be taken to have effect in respect of those goods or services. The date of registration depends on which of the circumstances described in section 72 applies. Sections 12 and 72 read as follows:

> **Definition of priority date**
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> **12.** The **priority date** for the registration of a trade mark in respect of particular goods or services is:
>
> (a) if the trade mark is registered—the date of registration of the trade mark in respect of those goods or services; or
>
> (b) if the registration of the trade mark is being sought—the day that would be the date of registration of the trade mark in respect of those goods or services if the trade mark were registered.
>
> **Date and term of registration**
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> **72.(1)** Subject to subsection (2), the registration of a trade mark in respect of the goods and/or services in respect of which the trade mark is registered is taken to have had effect from (and including) the filing date in respect of the application for registration.
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> Note: For ***filing date*** see section 6.
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> **(2)** If:
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> (a) the application was in respect of a trade mark whose registration had also been sought in one or more than one Convention country; and
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> (b) the applicant claimed a right of priority under section 29 for the registration of the trade mark in respect of particular goods or services; and
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> (c) the trade mark is registered under this Act;
>
> the registration of the trade mark in respect of those goods or services is taken to have had effect:
>
> (d) if an application to register the trade mark was made in only one Convention country—from (and including) the day on which the application was made in that country; or
>
> (e) if applications to register the trade mark were made in more than one Convention country—from (and including) the day on which the earliest of those applications was made.

Note: For ***Convention country*** see section 225.

(3) Unless it is earlier cancelled, or the trade mark is earlier removed from the Register, the registration of the trade mark expires 10 years after the filing date in respect of the application for its registration.

Note 1: This is so even for a trade mark whose registration in respect of particular goods or services has effect from (and including) the day on which an application was made in a Convention country.
Note 2: For ***filing date*** see section 6.

According to subsection 72(1), for applications other than those claiming priority under section 29 the priority date for registration is the *filing date* of the application. Where the application is based on a valid claim to a right of priority under section 29 in respect of particular goods or services, subsection 72(2) applies and the priority date for registration is not the *filing date* but the date on which an application for registration of the trade mark, in respect of those goods or services, was first filed in a Convention country.

The *filing date* of an application for registration of a trade mark is defined in section 6 which also provides a definition of *file*.

Definitions

6. In this Act, unless the contrary intention appears:

file means to file at the Trade Marks Office.
Note: See section 213.

filing date means:

(a) in relation to an application for the registration of a trade mark other than an application referred to in another paragraph of this definition—the day on which the application is filed; or
(b) in relation to a divisional application for the registration of a trade mark—the day on which the initial application (within the meaning of Division 3 of Part 4) was filed; or
(c) ….

The two further paragraphs (c) and (d) of the definition of *filing date* are not relevant here as they refer to applications pending before repeal of the 1955 Act. Division 3 of Part 4 deals with divisional applications and section 50 provides a further reference to the *filing date* of a divisional application. The section reads:

Filing date

50. A divisional application is taken to have been filed on the day on which the initial application concerned was filed.
Note: For ***file*** see section 6.

The priority date for registration of application 769032.

Application 769032 was filed on 31 July 1998 as a divisional application pursuant to paragraphs 45(1)(b) and 48(2)(a). According to section 50 it is therefore taken to have been filed on the day on which the initial application 721209 was filed, namely 6 November 1996. Paragraph (b) under the definition for *filing date* in section 6 leads to the same conclusion. Therefore the priority date for registration of 769032 is at least as early as 6 November 1996. However, 721209 claimed a right of priority under section 29 for some of the goods claimed in the specification, that is a range of computer programs falling within the broader specification of "computer software". According to subsection 72(2), in respect of those goods, the date of priority for registration of 721209 was not its *filing date* but the date on which an application for the same trade mark was made in a Convention country (the United States of America), namely 7 May 1996. The question at issue is whether this date is automatically inherited by the divisional application 769032, in which case its priority date for registration will be earlier than that of 718840.

The Deputy Registrar, in his correspondence to Freehills, pointed out that the *Trademark Law Treaty* (the TLT), to which Australia is a party, provides that a divisional application preserves any priority right held by the initial application upon which it is based. Article 7 of the TLT which deals with the division of applications says that when goods or services are divided from an initial application into divisional applications

> *"(t)he divisional applications shall preserve the filing date of the initial application and the benefit of the right of priority, if any"*.

The "right of priority" referred to here follows from Article 4 of the *Paris Convention for the Protection of Industrial Property* (the Paris Convention), certain provisions of which are legislated for in section 29 of the *Trade Marks Act 1995*. The Deputy Registrar was of the opinion that the provisions of Article 7 of the TLT entitle application 769032 to the *priority date* of initial application 721209 irrespective of the applicant's failure to comply with regulations in the *Trade Marks Regulations 1995* which require the making of a claim to priority. He considered the failure to recognise the priority conferred by the TLT when accepting application 718840 for registration, provided grounds under paragraph 38(1)(a) for revocation of acceptance.

In his submissions, Mr Davy, rightly points out that until specific legislation is passed to implement the provisions of a treaty ratified by Australia, those provisions have no legal effect on Australian domestic law. In any case, the requirements in the *Trade Marks Act 1995* for an applicant to give notice of a claim to priority do not appear to be in conflict with the TLT. Article 3 of the treaty, which sets out the conditions that a Contracting Party may require for an application, includes the following provision in Article 3(a):

> *Any Contracting Party may require that an application contain some or all of the following indications or elements: …….*
>
> > *(vii) Where the applicant wishes to take advantage of the priority of an earlier application, a declaration claiming the priority of that earlier application, together with indications and evidence in support of the declaration of priority that may be required pursuant to Article 4 of the Paris Convention;*[1]

The requirement for notification of a claim to priority, and the associated time limit, were introduced into the *Trade Marks Act 1995* on the recommendation of the Working Party to Review the Australian Trade Marks Legislation[2] (the Working Party). Under the repealed *Trade Marks Act 1955* a claim to priority under the Convention could be made at any time after filing the Australian application. This had on occasion given rise to situations where another mark with an earlier filing date had proceeded to acceptance on the false assumption that it had priority over a later filed but undisclosed Convention application. The amendments introduced into the 1995 Act, which require early disclosure of a claim to priority, were intended to avoid this undesirable consequence.

It seems to me that the provisions in the *Trade Marks Act 1995* relating to divisional applications and to a right to priority under the Convention are consistent with the *Trademark Law Treaty.*

In the present case, application 769032 preserves the filing date of initial application 721209 by virtue of its divisional status. According to section 50 application 769032

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[1] Article 4(D)(1) of the Paris Convention says that "[a]ny person desiring to take advantage of the priority of a previous filing shall be required to make a declaration indicating the date of such filing and the country in which it was made. Each country shall determine the latest date on which such declaration must be made."

[2] See paragraph 4.1.5 of the Working Party's report to the Minister for Science and Technology in July 1992, "Recommended changes to the Australian Trade Marks Legislation".

is taken to have been filed in the Trade Marks Office on 6 November 1996, the date on which initial application 721209 *was filed*. Under section 29, application 769032 also preserves the right to benefit from the priority of an application filed in a Convention country up to 6 months before its filing date. However, subreg 4.6(1) requires that, in order to obtain that benefit an applicant "must claim a right of priority for an application by filing notice of the claim". The imposition of a requirement of this kind is allowed by Article 3(a)(vii) of the TLT.

There is nothing in the wording of section 29 or the regulations to suggest that the requirement to give notice of a claim to a right of priority does not apply to all applications, regardless of whether they might be initial or divisional applications. Subsection 72(2) only applies where all the conditions set by paragraphs (a), (b) and (c) are met. The condition in paragraph (b) is that "the applicant claimed a right of priority under section 29". There was no notice of a claim to priority under section 29 filed in respect of application 769032. Therefore application 769032 does not qualify in terms of subsection 72(2) and its priority date for registration is determined by subsection 72(1) to be its *filing date* which by virtue of its divisional status is 6 November 1996. Accordingly application 718840 has and earlier priority date for registration than application 769032 and there was no error made in accepting 718840 in the face of 769032.

The priority date for registration of application 785389.

Application 785389, filed in the Trade Marks Office on 12 February 1999, was divided from application 769032 under paragraph 48(2)(a). The lapsing of application 721209 had been advertised on 3 September 1998 and pursuant to section 46 it was therefore not possible for it to serve as an initial application from which 785389 could be divided.

In the words of section 50, a divisional application *is taken to have been filed* on the day on which the initial application concerned *was filed.* The Note to section 50 draws attention to the definition of *file* in section 6 where the meaning is given as "to file at the Trade Marks Office". Under the definition of *file* there is a further Note referring to section 213 which describes the various means by which a document may be filed at the Trade Marks Office or a sub-office of the Trade Marks Office. These are references to the actual filing of documents. Given the wording of section 50 and the

content of the explanatory Notes, I consider that the filing date for a divisional application is determined by the actual date of filing of the initial application concerned. I come to the same conclusion by reference to paragraph (b) of the definition of *filing date* in section 6. There again the use of the words "was filed" (immediately after a definition of the meaning of *file*) indicates that it is the date of actual filing of the initial application that will determine the filing date of the divisional application rather than any deemed date of filing which may apply to the initial application.

In reaching this conclusion, I believe I am entitled to consider the effect the alternative interpretation of section 50 would have in the overall provisions for divisional applications in the *Trade Marks Act 1995*. Under the repealed Act of 1955 the Registrar had a discretion to direct that a divisional application be deemed to have been filed on the date on which the application from which it was divided was lodged. In exercising that discretion the Registrar was entitled to take account of all the circumstances and any adverse effect which might result from allowing the claim to an earlier date. That discretion no longer exists under the 1995 Act and the deeming provision in section 50 applies automatically provided the application properly falls within the definition of a divisional application in section 45. One of the effects of allowing a divisional application to be deemed to have been filed on the deemed date of filing of an application which is itself a divisional, would be to circumvent indefinitely the time limits for prosecution of a trade mark application. It would only be necessary to delete a minor item from the specification of goods or services at each filing to achieve divisional status under paragraphs 45(1)(b) and 48(2)(a). I also take comfort here from the apparent parallel reasoning behind section 72(2)(e) which restricts the operation of a priority claim to the earliest Convention country application and thereby prohibits a sequence of claims which might otherwise indefinitely extend the terms for claiming priority.

The divisional claim endorsed on the application form for 785389 claims a filing date of 6 November 1996, which is the date on which application 769032 is deemed to have been filed. On my interpretation of section 50 I do not believe this is allowable.

Had 785389 been filed while 721209 was still pending and able to serve as its initial application, 785389 could have been taken to have been filed on 6 November 1996,

the date on which 721209 was actually filed, notwithstanding the fact that the 769032 already had divisional status based on 721209. However, as matters stand it is the date of actual filing of 769032, 31 July 1998 which, in my opinion, must be deemed to be the filing date of 785389.

I must now consider the effect, if any, of the claim made by the applicant, PC Docs, to "Convention priority" on the basis of application no. 75-099972 filed in the United States of America on 7 May 1996. In order to claim priority from an application made for the same trade mark in a Convention country, section 29 requires filing of the Australian application within 6 months after the day on which the application was filed in the Convention country. I have found that the *filing date* of application 785389 is 31 July 1998. This is more than 26 months later than the date on which the US application was filed, so no valid claim to priority can be made under section 29. The priority date for registration of application 785389 is therefore its filing date 31 July 1998 which is later than the priority date for registration of application 718840.

Decision

For the reasons stated above I have found that neither of applications 769032 or 785389 have a priority date for registration earlier than application 718840. I am therefore not satisfied that the acceptance of application 718840 in the face of applications 769032 and 785389 provides any grounds under paragraphs (a) or (b) of section 38 for me to consider revocation of acceptance. I therefore decline to revoke acceptance of application 718840.

Helen R. Hardie
Deputy Registrar

29 March 2000