



**TRADE MARKS ACT 1995
DECISION OF A DELEGATE OF THE
REGISTRAR OF TRADE MARKS, WITH REASONS**

Re: Applications 726667, 726668 and 726669 in the name of Nicholas Dynes Gracey

Background

Mr Nicholas Gracey is a resident of England. He is seeking to register various trade marks in Australia. Mr Gracey's applications are as follows:

726667, for class 3 goods,
for the trade marks:

ADRENALIN, ADRENALINE,
ADRENALINN

726668, for class 9 goods,
for the trade mark:

ADRENALIN

726669, for class 25 goods,
for the trade marks:

ADRENALIN, ADRENALINN

An essential part of his endeavour is to claim the benefit of the priority date of an earlier application he filed in the United Kingdom. The examination section of the Trade Marks Office has raised two objections to Mr Gracey's priority claims.

- It is the examiner's view that Mr Gracey was late in making his Australian applications. Accordingly, is Mr Gracey entitled to an extension of time under s 224 of the *Trade Marks Act*? That extension, if it can be granted, may allow Mr Gracey to claim priority within the time as extended. Without it, his claim is arguably invalid.
- If such an extension is allowed, do all three of Mr Gracey's Australian applications meet all of the requirements for making a valid claim to such a priority?

However, in view of my conclusions on the first of these issues, the second will be of no concern in this decision.

The history of these applications can be seen partly from the file at the Trade Marks Office, partly from Mr Gracey's declaration in the extension matter and partly from his submissions at the hearing. It is as follows:

On 28 January 1997, Mr Gracey inquired by fax about filing his applications. Mr Gracey asked for a reply by return fax, as he intended to claim a priority based on a filing date of 29.7.96 in the United Kingdom. Section 29 of the (Australian) *Trade Marks Act 1995* stipulates that claims for priority, such as the one Mr Gracey intended to make, must be made within 6 months of the overseas filing.

Mr Gracey sent that fax to the Patent Operations area of IP Australia, with whom he had other business to conduct. Patent Operations then sent his fax to the New Filings area of the Trade Marks Office, which at that time was located in another part of Canberra. There it was received at 8.55 am on 29 January 1997.

From Mr Gracey's fax, the Trade Marks Office knew of the urgency of the claim. It warned Mr Gracey to "ensure that your application and proof of payment reaches our office on 29 January 1997 (today)", when it replied to him by fax at 12.16 pm that day (Australian Eastern Daylight Saving time) or 1.16 am Greenwich Mean Time.

Mr Gracey arranged for payment of the fees by international bank transfer. The transfer was organised on 29 January 1997. However, his application was delayed. Mr Gracey has assured me that this was because he attended to the filing, along with filings in other countries, without regard to time zone differences that were to become critical. As matters apparently turned out, the Australian filing was the second-last he attended to. He sent the fax, containing the details of his application, to the Australian Trade Marks Office late on what was, for him in England, the evening of 29 January. By that time, 10.16 pm in England, it was already 30 January in Australia.

Extension of time to claim priority

Mr Gracey had, on the face of it, filed his applications for registration one day outside the period allowed under s 29 for the filing of an application on which the benefit of an international filing date is to be claimed.

An officer in the new filings area of the Trade Marks Office advised Mr Gracey that a request for an extension of time to file his Australian applications was an option that would allow the circumstances of his delayed filing to be assessed and perhaps remedied. What was at issue was an extension of the date by which his Australian application had to be filed if the benefit of the UK priority claim was to be gained. Mr Gracey accordingly applied for a one-day extension of time to file his Australian applications. He filed this request, in relation to all three applications for registration, on 31 January 1997.

The extension of time question was dealt with in the Trade Marks Office on the basis that s 224 is available to assist an applicant in his situation. S 224 is a general extension of time power. It provides, so far as is relevant:

224. (1) If, because of an error or omission by a trade marks officer, a relevant act that is required by this Act to be done within a certain time is not, or cannot be, done within that time, the Registrar must extend the time for doing the act.

(2) If, because of:

- (a) an error or omission by the person concerned or by his or her agent; or
- (b) circumstances beyond the control of the person concerned;

a relevant act that is required by this Act to be done within a certain time is not, or cannot be, done within that time, the Registrar may, on application made by the person concerned in accordance with the regulations, extend the time for doing the act.

(3) If:

- (a) a relevant act that a person is required by this Act to do within a certain time is not, or cannot be, done within that time; and
- (b) on application made by that person in accordance with the regulations, the Registrar is of the opinion that special circumstances exist that justify an extension of that time;

the Registrar may extend the time for doing the act.

(4) The time allowed for doing a relevant act may be extended, whether before or after that time has expired.

...

(8) In this section:

relevant act means:

- (a) any act (other than a prescribed act) done in relation to a trade mark; or
- (b) the filing of any document (other than a prescribed document); or
- (c) any proceedings (other than court proceedings).

In leaving s 224, let me take particular note of the double negative introduced by s 224(8). The extension provisions of s 224 are available for extending times for doing acts other than

prescribed acts, filing documents other than prescribed documents and for proceedings other than court proceedings. Noting that context, reg 21.28(1)(b) provides:

Extension of time—prescribed acts and documents

21.28 (1) For the purposes of paragraph (a) of the definition of “relevant act” in subsection 224 (8) of the Act, the following acts are prescribed:

...

(b) claiming a right of priority for an application for the registration of a trade mark under subsection 29 (1) of the Act;

On 26 May 1998, an officer of the Trade Marks Office wrote to Mr Gracey, objecting to the extension under s 224(2). There is no record on the file of why this matter was not raised sooner. I do not believe that it will now be useful to explore for the purposes of this decision the delay in raising this apparent problem. However, I will, once I have issued my decision, raise the matter of the delay with the relevant work area.

In that letter to Mr Gracey, the officer did not explain why s 224(3) was not considered applicable. I presume, however, that the underlying basis of the letter was that simple oversights that delay the doing of an action such as the sending of a fax are not in themselves a special circumstance.

On 10.12.98, Mr Gracey made submissions, by telephone, at the hearing set down to decide the fate of his priority claim. I conducted that hearing as a delegate of the Registrar of Trade Marks. Mr Gracey had previously filed written submissions on these issues and I have taken these arguments in conjunction with his submissions at the hearing.

His argument is, firstly, that he was not late in filing his Australian application. Even though the filing occurred here on 30.1.97, Mr Gracey argues that the relevant date is not necessarily the date on which the thing is done in Australia. He argues that, in the case of an action carried out by fax, the relevant date is the one on which that action is, simultaneously, initiated in his country, England. A fax is received almost instantly, by relatively direct electronic transmission to a receiving fax machine. Thus there are none of the delays sometimes encountered by e-mail. Therefore, he argued, if he was within time in England, the place where the application on which he bases his priority claim was itself filed, how can his six months have ended?

Mr Gracey also pointed out that, in a case such as this, there is an apparent inequity faced by an applicant who must file an application and claim a priority date in a number of countries. At the time when he was filing his application, eastern Australia was on daylight saving time. We were thus 11 hours ahead of Greenwich Mean Time, where the US Patents office was five hours behind. How could it be, he argued, that the critical 6 months period appeared, from his point of view, to run out 17 hours earlier for one country than for another where a similar law applies?

Mr Gracey's argued that this was a situation that the *Paris Convention for the Protection of Industrial Property* would have dealt with had it been updated.

That is not convincing. The *Paris Convention* does not deal with that question and does not require member countries to make laws with special provision for fax transmissions. I reject Mr Gracey's claim that the due date for filing his application is anything other than the date in Australia.

Firstly, in the *Trade Marks Act 1995* itself, "file" is defined in section 6: "to file at the Trade Marks Office". "Filing date" means various things in different parts of the act, but for present purposes definition (a) is relevant: "the day on which the application is filed". Taking these together, it is clear that the legislation intended the filing date to be construed as the date at the place at which the filing occurred. For this reason, regulation 21.5(3) states:

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

Were there any remaining doubt, the *Acts Interpretation Act 1901*, s 37, says that a reference to "time" shall be deemed to mean the standard or legal time in that State or part of the Commonwealth. The matter can only be dealt with on the ordinary principle that an Australian law sets a time that applies in Australia, without reference to what the time or, by extension, the date, may be in England. The invention of the fax machine does not interfere with Australian law, which sets limits in terms of requirements in Australia.

As to Mr Gracey's argument about the *Paris Convention*, I do not believe that there is any conflict. In any case, if municipal law does not accord with the treaty, municipal law must prevail. See *Scaniainventor v Commissioner of Patents* 36 ALR 101, at 106.

As a fallback position, Mr Gracey noted that, if he was wrong on those points, his failure to file on time was clearly unintended and due to an accidental overlooking of time-zone differences. This failure, he said, was clearly an error or omission on his own part and within the scope of s 224(2).

For my own part, I agree with Mr Gracey on the last point. I am satisfied that he probably intended to file his application within the six months allowed, and set out to do so, and that he simply overlooked the critical time-zone difference.

That, however, is not to say that there is evidence on which I could come to a finding of such a critical question of fact. One full month before the hearing, I sent Mr Gracey a fax that stipulated that any evidence on which he wished to rely must, as required by regulation 21.25, be in declaratory form. Mr Gracey has made a declaration about his failure, but it does not set out the specifics of how the failure occurred. He offered no explanation for why he has not taken the opportunity to set the matter out in full. I do not believe that it is necessary, in view of the decision that follows, to further delay the matter by requiring an additional declaration.

The fact that an "error or omission" has been established is not the end of the matter. Such a key finding merely enables the grant of an extension. The grant is still a discretionary one. As a delegate, I "may" extend the time if an appropriate case is made.

The factors that argue against the grant of the extension are two. In the first place, there is a general interest in certainty about the terms of applications. That general interest is reflected here in a second factor: if I grant the extension and thus validate the priority claim, this will allow Mr Gracey's application to, prima facie, defeat an application that it would not otherwise preclude. That application was filed on 31.7.96 by Unilever Plc ("Unilever"). It seeks registration of a more or less identical series of trade marks for some of the same goods.

However, such an argument is somewhat circular: the benevolent provision of s 224, if it is available, is intended to be used without arbitrary restriction. If an extension can legitimately be granted to Mr Gracey, then it would be wrong for me to put undue weight on the fact that

this will disadvantage Unilever. I simply cannot say that this one factor will determine the matter.

The exercise of the registrar's discretion under s 224 has recently been dealt with thoroughly in relation to *Re application by Hall* (1997) 40 IPR 210 at 220, the WILD OATS trade mark. In that case, Acting Hearing Officer Murray noted:

"There is a significant body of case law which deals with the exercise of discretion under various circumstances. Mr Spence drew my attention to the reference *Sanyo Electric Co. Limited v Commissioner of Patents* (1996) AIPC 91-283. This was a determination by the Deputy President of the Administrative Appeals Tribunal. At page 37,844, the issues are summarised succinctly, and with reference to other relevant law:

The decisions of the courts concerning the approach to be taken to the exercise of a discretion to extend time are now well established and include:

- in the absence of nominated factors against which the discretion is to be exercised, regard should be had to the “subject-matter, scope and purpose of the Act” - per Mr Justice Mason (as he then was) in *Minister for Aboriginal Affairs and Another v Peko-Wallsend Limited and Others* (1986) 162 CLR 24 at 39-40. A further exposition of this is provided by the comments of Mr Justice Davies in *Chalk v Commissioner for Superannuation* (1994) 50 FCR 150 at 154 where he said “...the discretion should be exercised by reference to the words of the statute and the context within which the discretion is conferred”;...
- it is “more important to consider the consequences of extending or refusing to extend time than to debate the reasons why the act was not done in time” (per Davies J in *Chalk's* case, at 156, with whom Chief Justice Black and Mr Justice Cooper agreed. Similar comments are to be found in *Comcare v AHearn* (1993) 119 ALR 85, particularly at 88);...
- a legislative provision providing for the exercise of a discretion to extend time is beneficial in nature and should be applied beneficially (Davies J in *Chalk's* case at 155).

Mr Spence also drew my attention to D.R. Shanahan’s comments on the exercise of the Registrar’s discretion. In *Australian Law of Trade Marks and Passing Off*, at page 81, he says:

Where the Registrar does exercise a discretionary power under the Act, the primary concern will be the public interest, but other circumstances may be relevant, including the bona fides of the parties, the position in other jurisdictions and the balance of convenience. It has been said that the Registrar’s discretion should be exercised “upon judicial principles and affected neither by caprice nor over-caution” and that an application which is bona fide should not

be refused on a ground which is “fanciful” or “in a business sense, unsubstantial”.”

Ms Murray was, in summary, quite critical of any attempt to establish a blanket approach to the exercise of the discretion given by s 224. She said that each case had to be looked at carefully, not merely decided by automatic application of a standing practice.

On the facts of the present case, there is some public interest in certainty, in the priority entitlements of applicants remaining fixed. Granting the extension will leave Unilever in a significantly worse position than previously.

On the other hand, Mr Gracey has always asserted his priority claim, from the time the application was filed. That claim has been public knowledge for a considerable time and arguably there is some merit in simply maintaining the status quo. As to the allowance of the extension, the public interest, which to me is tantamount to the interests that all clients have in getting a fair application of the provision of the act, argues that cases such as Mr Gracey's should be decided on their merits. They should not be shut out simply because certainty is felt to require inflexibility. A general extension of time provision was not put in place to achieve certainty at the price of unfairness.

Therefore, were s 224 able to be exercised, I believe this would be a case for exercising it, though the matter is complicated by the fact that Mr Gracey has not fully brought the details of his error into evidence.

However, having looked at the matter carefully, I do not believe that s 224 ever was available. The entire of the present matter - extension, submissions and hearing - has been based on the view that the date by which Mr Gracey had to act to claim his priority was extendable in the first place. That view is, in my opinion, wrong.

Legislation applicable to priority claims

Before going any further with this matter, it is necessary to set down the terms of s 29 and of the relevant regulations. Section 29 is headed as follows, and reads:

Application for registration of trade mark whose registration has been sought in a Convention country—claim for priority

29.(1) If:

- (a) a person has made an application for the registration of a trade mark in one or more than one Convention country; and
 - (b) within 6 months after the day on which that application, or the first of those applications, was made, that person or another person (*successor in title*) of whom that person is a predecessor in title applies to the Registrar for the registration of the trade mark in respect of some or all of the goods and/or services in respect of which registration was sought in that country or those countries; that person or that person's successor in title may, when filing the application, or within the prescribed period after filing the application but before the application is accepted, claim a right of priority for the registration of the trade mark in respect of any or all of those goods and/or services in accordance with the regulations.
- (2)** The priority claimed is for the registration of the trade mark in respect of the goods or services:
- (a) 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
 - (b) 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.

The prescribed period to "claim a right of priority" is currently set by regulation 4.5 as two working days after the filing of the Australian application. Regulation 4.6 is also relevant. It reads as follows:

How to claim priority

4.6 (1) For the purposes of subsection 29 (1) of the Act (which deals with claims for priority), an applicant must claim a right of priority for an application by filing notice of the claim.

(2) Any notice under subregulation (1) must specify, in respect of the earlier application or, if there is more than 1 earlier application, in respect of each earlier application:

- (a) the Convention country in which the earlier application was filed at the trade marks office (or its equivalent) of that Convention country; and
- (b) the date on which the earlier application was filed; and
- (c) if a number is allocated to the earlier application in the trade marks office (or its equivalent) of that Convention country—that number.

(3) If, as a result of a claim for a right of priority, more than 1 priority date applies in relation to an application, a person who claims a right of priority under subsection 29 (1) of the Act must specify the goods and/or services to which each priority date relates.

It would seem at first sight that to "claim a right of priority", all that needs to be done is to file what regulation 4.6 calls notice of the claim. However, s 29 shows that there are two

steps in claiming a right of priority. The preliminary step is under s 29(1)b: the making of the Australian application within six months of the date of the overseas filing.

That step is part of the action of claiming a priority based on an overseas filing. In *Scaniainventor v Commissioner of Patents* 36 ALR 101, the full Federal Court made it clear that this is so, or was under the legislation at the time, in relation to the analogous claim for priority in a patent matter. The case shows that obtaining a filing date for a convention claim is a thing "requisite or needed in order to secure an advantage or avoid a disadvantage", see p 104. Such an act, in terms of the patents legislation, is an act "required to be done" within a certain time.

I therefore apply that logic to Mr Gracey's case. If Mr Gracey is to claim a right of priority, he must do so by, first of all, filing his Australian application within time. That filing is therefore potentially, ie subject to the exclusions in the regulations, what s 224(8) defines as "an act (other than a prescribed act) done in relation to a trade mark". Similarly, it is, subject to the same exclusion, what s 224(2) describes as one "required by this Act to be done within a certain time".

Filing the application is not the only thing that needs to be done to claim the right of priority. A second step, filing notice of that claim, is also required. Neither step, alone, is sufficient. An application that is filed does not automatically attract a priority claim. Nor can a mere written notice of the claim, filed on its own, claim that priority. Each action is a part of the claiming of a right of priority. Both actions, either together or separately, would ordinarily be "relevant acts". However, that is subject to the exclusions set out in regulation 21.28(1)(b).

Subregulation 21.28(1)(b) is a limit on the extension power available under s 224 in relation to convention claims. No such limit was applicable in *Scaniainventor*, supra.

Regulation 21.28(1)(b) is cast broadly. Under it, "claiming a right of priority for an application for the registration of a trade mark under subsection 29 (1) of the Act" is a prescribed act. Any such act ceases to be a relevant act. I can see nothing that limits the prescribed act to just the obvious one of filing notice of the claim under reg 4.6. That is only one of the two necessary acts in the claiming of the right of priority. Therefore, unless the

terms of reg 21.28(1)(b) are, by some accident of drafting, not applicable to the time set under reg 4.5, they must also apply to the time set by s 29 itself.

If more time is needed to do either of the two things required to be done to claim such a right, there is no provision that can be used to grant it. In consequence, the right cannot be claimed.

Conclusion

These things being as they are, I conclude that Mr Gracey cannot be granted the extension he was advised was available to him. My conclusion is not so much that the extension should be refused, as that there was at no stage a power in the legislation that would allow Mr Gracey to be granted that which he seeks. None the less, since he has made his application under s 224 of the Act, I think I am obliged to frame my denial of the possibility of the extension as a refusal of this extension. Accordingly, I hereby refuse to grant to Mr Gracey a one-day extension of time for the purpose of filing trade mark applications 726667, 726668 and 726669.

T. E. Williams
Hearing Officer
17 March 1999