

## TRADE MARKS ACT 1995

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

Re: Opposition by Cat Media Pty Ltd to extension of time for registration of trade mark application 810133 HAIR NO MORE proceeding in the name of Apex Marketing Group LLC.

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| <b>DELEGATE:</b>       | <b>Iain Thompson</b>   |
| <b>REPRESENTATION:</b> | <b>Opponent</b><br>.Written submissions by Brian Elkington of Clayton Utz<br><b>Applicant</b><br>Andrew Fox of Counsel instructed by Janet Lazzaro of Goldrick Farrell Mullin. |
| <b>DECISION:</b>       | 1. s224(2) Extension of time in which to pay registration fee. Opposition not established – time extended<br>2 Costs ordered against opponent.                                 |

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#### **Background**

1. This matter flows directly from that decided by Hearing Officer Skivington in *Cat Media Pty Limited v Apex Marketing Group LLC* [2004] ATMO 31. The applicant, in that matter, Apex Marketing Group LLC ('Apex') was represented by Mr Mark Landyn, Director and Chief Executive Officer of the applicant, who attended by teleconference from the USA.
2. Material to this decision, Ms Skivington found:

On the basis of the facts before me I am satisfied that the applicant [Apex] was the first user, in Australia, of its trade mark HAIR NO MORE, in relation to 'the same kind of thing' - *Re Hicks' Trade Mark* (1897) 22 VLR 636. It follows that in terms of section 58 of the Act, the applicant is the owner in Australia, of the trade mark, HAIR NO MORE.

3. Ms Skivington appears to have concluded that, on the evidence before her, Apex made first public use of its trade mark in Australia in November 1998, whereas Cat Media Pty Ltd ('Cat') made first public use of its trade mark in Australia some six months later in May 1999.
4. Ms Skivington decided:

None of the grounds of opposition relied on by the opponent [Cat] has been established. Therefore, the applicant's trade mark may proceed to registration one month from the date of this decision. If the Registrar has been served with a notice of appeal before that time, I direct that registration shall not occur until the appeal has been decided or discontinued.

5. No appeal against Ms Skivington's decision was filed by Cat.
6. Mr Landyn attests that he believed that the registration fees had been paid and that it was a matter of time until he received a certificate of registration. At the time of, and subsequent to the hearing by Ms Skivington, I gather that, with responsibility for the application divided between Mr Landyn and his then legal representatives, each believed the other to be responsible for the payment of this fee. This fee was not paid despite a standard notice from the office to his address for service (which appears to have been Cowley Hearne, Lawyers), Apex's legal advisors at that time. Mr Landyn is now represented by Ms Janet Lazzaro of Goldrick Farrell Mullin, Solicitors, and Apex has applied for an extension of time in terms of subsection 224(2) in which to pay the registration fee.
7. This application has been opposed by Cat. Cat have re-filed and re-served the evidence which was present in the substantive matter before Hearing Officer Skivington. Cat also argue that a grant of the extension of time in which to pay the registration fee will disadvantage them as they have four pending applications 857384, 875751, 875724, and 1041755 which contain or consist of the words HAIR NO MORE. I note that Apex has opposed registration of the first three of these applications.
8. As a delegate of the Registrar of Trade Marks, I heard this matter – the opposition to the extension of time – in Sydney on 12 February 2007. The applicant was represented by Andrew Fox of Counsel, instructed by Janet Lazzaro of Goldrick Farrell Mullin. Mr Mark Landyn, Managing Director of Apex, attended the hearing by teleconference from the USA. The opponent did not appear and was not represented at the hearing.

## **Evidence**

9. The following statutory declarations have been served and filed by the parties:
10. Apex filed the following statutory declarations in support of its application for extension:
  - Statutory declaration of Mark Landyn dated 9 May 2005
  - Statutory declaration of Mark Landyn dated 19 August 2005
  - Statutory declaration of Mel Landyn dated 19 August 2005
  - Statutory declaration of Colin Goldrick dated 19 August 2005
11. Cat served and filed the following declaration in support of its opposition to the extension of time:
  - Statutory declaration of Sonia Amoroso dated 16 February 2006
12. Apex served and filed the following declarations as evidence in answer:
  - •Statutory declaration of Mark Landyn dated 19 May 2006
  - •Statutory declaration of Peter Reed dated 22 May 2006
  - •Statutory declaration of Janet Lazzaro dated 19 May 2006
13. Cat served and filed as evidence in answer:
  - Statutory declaration of Sonia Amoroso dated 30 August 2006
14. There is considerable debate in the evidence as to Cat's use of the trade mark and the potential impacts on it of the request for extension of time for final registration, if granted. I accept Apex's submissions that, following Ms Skivington's decision, it appears from the evidence that Cat have been 'destocking' goods which carry the trade mark. To an extent, however, this (for reasons which will become obvious) is not of primary relevance to my decision. What is potentially more important to note in the

context of Ms Skivington's decision is that Apex's use of the trade mark HAIR NO MORE in Australia has continued.

### **Reasoning**

15. Section 224(2) provides:

#### **224 Extension of time**

(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.

16. Subsections 224(5) and (6) provide:

(5) If an application is made under subsection (2) or (3) for an extension of time for more than 3 months, the Registrar must advertise the application in the *Official Journal*.

(6) A person may, as prescribed, oppose the granting of the application.

17. This matter is not a revisit of the substantive issues that were decided by Ms Skivington. However, if it were, the position cannot have altered from her finding that Apex is the owner of the trade mark in Australia.

18. It is in the light of this prior finding of ownership that I approach the principles that I should apply in assessing whether this application should be allowed. Guidelines upon the issues to be determined have been laid down in cases such as *Vangedal-Nielsen v Smith (Cmr of Patents)* (1980) 3 ALN N21; 33 ALR 144; 1A IPR 731 and *Lyons (t/as Mitty's Authorized Newsagency) v Registrar of Trade Marks* (1983) 50 ALR 496; 1 IPR 416. I must consider and balance whether:

- the length of time is appropriate;

- sufficient reasons have been provided;
- a proper case has been made out justifying the extension; and,
- the relative inconvenience to the parties concerned and the public interest.

19. The date at which the respective positions of the parties should be considered is the filing date of the application to extend the final date of registration.
20. The final date for registration of the application was 13 October 2004. The application to extend the final date of registration was filed was 16 May 2005. The elapse of time was thus some seven months. Given Mr Landyn's apparent misapprehension, the elapse of time is not surprising – however, in this regard, principles from the parallel provisions of section 223 of the *Patents Act 1990* operate where, as the Patent Manual observes:

Section 223 is beneficial in nature and should be applied beneficially; (*re Sanyo Electric Co Ltd and the Commissioner of Patents* (1996) 36 IPR 470 at 480). Section 223 (and section 160 which is the corresponding section of the *1952 Patents Act*) is a general remedial section and has general application, applicable unless there is some clear indication to the contrary. (See *Scaniainventor v Commissioner of Patents* (1981) 36 ALR 101 and *Danby Pty Ltd v Commissioner of Patents and Another* 12 IPR 151).<sup>1</sup>

21. Prior to the hearing before Ms Skivington, the prosecution of the application was initially by Allen Allen & Helmsley, then by Callinan Lawrie, then by Ian Betts, then by Cowley Hearne, Lawyers. As previously discussed, Goldrick Farrell Mullin became Apex's legal representative's after the hearing before Ms Skivington. In the hearing before Ms Skivington, Mr Landyn represented Apex by teleconference from the USA. Somewhere along the way, Mr Landyn gained the impression that the registration fee had been filed. The effulgence of time proved him to be wrong and, he attests, as soon as he discovered his mistake, he took steps to extend the final date of registration and pay the fee.

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<sup>1</sup> The elapse in time in *Sanyo*, above, totaled some four years.

22. Mr Fox, for Apex, submits that, whatever Cat's perceptions about the relevance of its pending applications, registration of which is opposed by Apex, the owner of the trade mark HAIR NO MORE at common-law is Apex. This is unaltered by any subsequent application for registration.
23. As I have previously stated, I agree with Apex that its status as the owner of the trade mark is unaltered by subsequent applications made by Cat. As observed by Carr J in *PB Foods Ltd v Malanda Dairy Foods Ltd* [1999] FCA 1602 at paragraph 78, "The scheme of the Act is not proprietorship by registration but rather registration of proprietorship ..."
24. Cat's evidence does not establish that Apex has abandoned its trade mark or lost its ownership by acquiescence or estoppel. On the contrary, Apex has continued to use the trade mark whilst it would appear that Cat has been running down its inventory of goods which carry the trade mark. In *Riv-Oland Marble Co (Vic) Pty Ltd v Settef SpA* (1988) 19 FCR 570, Bowen CJ said at paragraphs 8 and 9 of his judgment:

Once having acquired proprietorship it can only be lost upon some established general law basis such as estoppel, acquiescence or abandonment. [...]

[...] However, in my opinion, to show abandonment of the mark in circumstances such as the present it would be necessary to demonstrate more than slightness of use. There would have to be some evidence indicating an intention to abandon the trade mark to result in the right to proprietorship being lost; see *Mouson & Co v Boehm* (1884) 26 Ch D 398 at 405. [parenthetical material excluded] [Parenthetical material omitted]

25. I accept that the failure to pay the registration fee by the due date was an error or omission on the part of the applicant. An omission to pay registration fees *per se* cannot, in my consideration, be construed as an abandonment of ownership of a trade mark. The owner of the trade mark remains Apex, whatever the status of the statutory protection afforded to the trade mark.

26. Viewed in this light, the balance of conveniences, and the public interest, flow very much in the direction of allowing the application. Cat, despite having three opposed acceptances, is not the owner of the trade mark HAIR NO MORE and so cannot be disadvantaged by the registration of the trade mark. It is in the public interest to have the Register accurately reflect the ownership of the trade mark, with a minimum of expense to traders. This object will be most readily achieved by allowing the application to extend the final date of registration.

**Decision**

27. I therefore allow the application and direct that the date for final registration be extended until 16 May 2005, subject to any appeal against this decision notified to the Registrar within one month of the date of these reasons. If such appeal is notified to the Registrar, the disposition of the application for extension of time for final registration should be in accordance with the Court's direction.

28. I note that the registration fee was paid prior to 16 May 2005 and thus, if there is no appeal against this decision, registration may proceed.

**Costs**

29. Apex sought its costs, should it be successful in these proceedings. Having been

30. successful, Apex is entitled to its costs at the official scale.



Iain Thompson  
Hearing Officer  
Trade Marks Hearings

**26 March 2007**