

**Application For Extension Of Time To File Notice Of Opposition
In Trade Mark Application No. 9833/98
By American Cigarette Company (Overseas) Limited**

And

**Objection
By Kangaroo Industries (Regd)**

*Before Principal Assistant Registrar P Arul Selvamalar
5 December 2002*

Interlocutory hearing - application for extension of time to file Notice of Opposition made after 2 month deadline - objection by Applicant - whether good and sufficient reasons made out by intended Opponent

The Applicants are Kangaroo Industries whose trade mark application was advertised in the Trade Mark Journal on 21 June 2002. No opposition or an application for extension of time to file an opposition was filed by the 2 month deadline, 21 August 2002. On 7 October 2002, a Certificate of Registration was sent to the Applicants. On 15 October 2002, the American Cigarette Company (Overseas) Limited applied for an extension of time to file a notice of opposition to the Applicants' mark. On 18 October 2002, they filed the notice of opposition and served it on the Applicants. The intended Opponents' state that they are based overseas and that they knew of the advertisement of the Applicants' Trade Mark in the Trade Mark Journal. However they did not decide to oppose the mark until after the deadline because their decision to oppose was made as a "defensive" move, after another trade mark was cited against their own trade mark application. The other trade mark that was cited against the intended Opponents' trade mark application, is not the Applicants' mark. However the decision to become "defensive" was only made after the citation of the mark belonging to a third party.

Held, denying the late application for an extension of time,

- The Registrar considered that there is a public interest in that an opposition to an application should be heard and that the issues raised should be determined, so that that a mark that is objectionable will not proceed to registration, until after the issues are heard and determined. However there is also a public interest in ensuring that trade mark applicants who rely on the procedure set out in the Trade Mark Rules, have the benefit of the certainty that the rules provide. The period of time that an applicant has to wait before his mark proceeds to registration, as stipulated in the rules, is 2 months. He is assured that, if there is no opposition or an application for an extension of time to file an opposition within those 2 months, his mark will be registered.
- The application for an extension of time was made 8 weeks after the deadline, exactly one week before the maximum extension of time that the Registrar may grant. In addition, the intended opponents state that they had considered the applicants' mark when it was advertised and decided not to oppose it because the services provided under their mark and the applicants' mark were different. However when their own application met with objections, they decided to oppose the applicants' mark for "defensive" reasons. The length of the delay and the reasons given for the delay do not persuade the Registrar to exercise her discretion in the opponents' favour.
- The Opponents also raised other decisions of the Hearings Department in the Louis Jordan case and the Nalli Trade Mark, as authorities supporting their application for an extension of time. The Louis Jordan case did not involve a delay of such a length as the present case. In the Nalli case, good and sufficient reasons were made out.
- The application for an extension of time to file a notice of opposition is denied.

Provisions of legislation discussed:

- Trade Marks Rules 1998, rule 29

Cases referred to:

- Ritkam Trading Ritkam Trading &

- Branov v Sleep Better Bedding Mfg Pty Ltd [1995] 32 IPR 171
- Re Application by Playground Supplies Pty Ltd [1985] 5 IPR 433
- Racecase Pty Ltd v Calder Park Promotions Pty Ltd [1995] 32 IPR 635
- Hunt-Wesson Inc's Trade Mark Application Ch Div [1996] RPC 233
- Kaiser Aluminium Kaiser Aluminium &

Representation:

- Ms Moi Sok Ling (Khattar Wong & Prs) for the Intended Opponents
- Mr Ian Fok (Rodyk & Davidson) for the Applicants